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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shanghai Leather, Inc.

Serial No. 77846384

Howard A. MacCord, Jr. of MacCord Mason PLLC for Shanghai Leather, Inc.

Ronald E. DelGizzi, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Kuhlke, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Shanghai Leather, Inc. ("applicant") filed an intent-to-use application on the Principal Register for the mark LAPELLE, in standard character form, for "leather for furniture," in Class 18. The Trademark Examining Attorney refused to register applicant's mark under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark is merely descriptive of applicant's goods. According to the Examining Attorney, LAPELLE is Italian for "the leather" and, thus, it

describes applicant's products. Specifically, the examining attorney makes the following argument:

In this case, both the individual components and the composite result are descriptive of the applicant's goods and do not create a unique, incongruous or nondescriptive meaning in relation to the goods. The applicant's merging of the terms "LA" and "PELLE" into the same term does not alter the commercial impression of the mark.¹

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech*,

¹ Examining Attorney's Brief, unnumbered page 11.

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Inc., 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); *see also, In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

We must also account for whether the mark sought to be registered is an Italian term. The doctrine of foreign equivalents generally requires considering the meaning of a mark in a non-English language to the speakers of that language. *In re Spirits International N.V.*, 91 USPQ2d 1489, 1491 (TTAB 2009). "Under the doctrine of foreign equivalents, foreign words from common languages are translated into English" *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). The doctrine has been summarized in a leading trademark treatise in the context

of determining whether a mark is descriptive under Section 2(e)(1) of the Trademark Act:

Under the "doctrine of foreign equivalents," foreign words are translated into English However, the "doctrine of foreign equivalents" is not an absolute rule, for it does not mean that words from dead or obscure languages are to be literally translated into English for descriptive purposes.

J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §11:34 (4th ed. 2011) (footnotes omitted).

The Examining Attorney submitted the following evidence with his January 20, 2010 Office action.

1. The word "Pelle" is Italian for "skin, hide, pelt, felt, leather, rind." *Babylon.com* website.

2. "La" is an Italian article meaning "the."² *Allwords.com* website.

² An "article" is "any member of a small class of words ... that are linked to nouns and that typically have a grammatical function identifying the noun as a noun rather than describing it. In English the definite article is *the*, the indefinite article is *a* or *an*, and their force is generally to impart specificity to the noun or to single out the referent from the class named by the noun." The Random House Dictionary of the English Language (Unabridged), p. 118 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In his September 25, 2010 Office action, the examining attorney asserted that the Translation Branch of the USPTO found an additional dictionary definition of the Italian word "Pelle" as meaning "leather." Although the examining attorney provided a citation for the source of the translation, he failed to attach a copy of it to the Office action. The better practice is to attach copies of the information for which the examining attorney wants the Board to take judicial notice. Nevertheless, we note that Cassell's Italian Dictionary, p. 366 (1967) also defines the Italian word "pelle" as "skin; hide, leather; peel, rind."

"Although words from modern languages are generally translated into English ... The doctrine of foreign equivalents should be applied only when it is likely that the ordinary American purchaser would 'stop and translate [the word] into its English equivalent.'" *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 USPQ2d at 1696. Italian is a modern language and that fact is not in dispute. See *In re Ithaca Indus., Inc.*, 230 USPQ 702, 704-705 (TTAB 1986) (Italian is a common, major language spoken by many people in the United States).³

³ The examining attorney requested that we take judicial notice of the 2000 U.S. census reporting that over 1 million Americans

"The 'ordinary American purchaser' is not limited to only those consumers unfamiliar with non-English languages; rather, the term includes all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English." *In re Spirits International N.V.*, 91 USPQ2d at 1491. Applicant's reliance on *Spirits International* is misplaced. Applicant argues that the examining attorney has not shown that the number of people who speak Italian is great enough to constitute a "substantial portion" of the intended audience.⁴ However, *Spirits International*, involved a refusal under Section 2(e)(3) of the Trademark Act based on the ground the mark was primarily geographically deceptively misdescriptive. The court explained that in view of the third element that the misdescription be material in determining whether the mark MOSKOVSKAYA for vodka was primarily geographically deceptively misdescriptive, "foreign language marks must

speak Italian. Applicant provided a link to the census, rather than the census document itself. A link is not a proper way to introduce evidence because the underlying data identified by a link is subject to change. Nevertheless, because the U.S. census is a standard reference, we may take judicial notice of the information. See *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001); *In re 3Com Corp.*, 56 USPQ2d 1060, 1061 n.3 (TTAB 2000); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980).

⁴ Applicant's Brief, pp. 9-10.

meet the requirement that 'an appreciable number of consumers for the goods or services at issue will be deceived.'" *In re Spirits International N.V.*, 91 USPQ2d at 1495. The court held that in determining whether the mark MOSKOVSKAYA for vodka was deceptive, the Board "failed to consider whether Russian speakers were a 'substantial portion of the intended audience.'" *In re Spirits International N.V.*, 91 USPQ2d at 1495. In this case, applicant has conflated the elements of proving that a mark is deceptive with the elements of proving that a mark is merely descriptive. The essential question before us in this application is whether Italian speakers would translate the mark or take the mark at face value; not whether Italian speakers would find the mark deceptive.

We agree with applicant that consumers who do not speak Italian will perceive LAPELLE to be an arbitrary term without any meaning associated with leather for furniture. However, Italian speakers would understand LAPELLE to mean "the leather." Without the space, LAPELLE is equivalent in sound, meaning and commercial impression to LA PELLE which means "the leather" and, therefore, it is merely descriptive of leather for furniture identified in the description of goods. *Cf. In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007). Numerous cases have held

that compressing two words, which when separate are merely descriptive, into a single term does not avoid a finding of mere descriptiveness for the combined term. *In re Cox Enterprises Inc.*, 82 USPQ2d at 1044; *In re Omaha National*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (FIRSTIER, the equivalent of "first tier," is merely descriptive of banking services); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897 n. 2 (TTAB 2001) ("the compound term RUSSIANART is as merely descriptive as its constituent words, 'Russian art.'"); *In re U.S. Steel Corp.*, 225 USPQ 750 (TTAB 1985) (SUPEROPE merely descriptive of wire rope); *In re Gagliardi Bros., Ind.*, 218 USPQ 181 (TTAB 1983) (BEEFLAKES is merely descriptive of thinly sliced beef); and *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED is merely descriptive of jellies and jams).

Our finding that LAPELLE would be perceived as the combination of the Italian words "LA" and "PELLE" is further supported because applicant's mark is presented in standard character form; therefore, it is not limited to any special form or style as displayed on or in connection with leather for furniture. When a mark is presented in standard character form, the Board must consider all manners in which applicant could depict the mark. For example, applicant's mark could be depicted as LaPelle or

laPELLE, thereby creating a visual separation between the two words.⁵ *In re Cox Enterprises Inc.*, 82 USPQ2d at 1044, citing *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) ("we must not be misled by considering [applicant's] mark only in its printed or typewritten form, with all the characters being of equal height.").

Applicant argues that the doctrine of foreign equivalents should not apply because LAPELLE has multiple meanings. According to applicant, "foreign and English marks are only considered equivalents where they are exact, unambiguous equivalents of each other: that is, "words are not foreign equivalents where a foreign word has multiple English meanings."⁶ Applicant cites *In re Buckner*, 6 USPQ2d 1316, 1317 (TTAB 1987) as authority. However, *Buckner* is inapposite because it involved likelihood of confusion between applicant's mark DOVE for solid fuel burning stoves and furnaces and the mark PALOMA for gas heating apparatus. The word "Paloma" is Spanish for dove and pigeon. The Board found that PALOMA and dove were not exact synonyms

⁵ In view of the foregoing, we are not persuaded by applicant's argument that Italian speakers do not see the mark as "La Pelle." (Applicant's Brief, p. 7). For the same reason, we are not persuaded by applicant's argument that there is no word "La" in applicant's mark. (Applicant's Brief, p. 8).

⁶ Applicant's Brief, p. 6.

and that in view of the differences in appearance and sound, the marks were not similar.

In this case, the issue is whether the mark is merely descriptive and because the issue of descriptiveness is determined in connection with the description of goods, an Italian speaker will understand immediately without the need for any thought or reflection that the goods are leather. Consumers have no reason to associate the mark LAPELLE with any other possible meaning such as a sport coat collar. Likewise, these same Italian speakers upon hearing the word LAPELLE used in connection with leather for furniture will perceive the mark as describing the material used for the furniture and not a part of a sport coat.

Finally, applicant argues, in the alternative, that LAPELLE is not merely descriptive because it creates a double entendre: the descriptive Italian meaning and part of a sport coat. A "double entendre" is a word or expression capable of more than one interpretation. For trademark purposes, a "double entendre" is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely

descriptive in relation to the goods or services. TMEP §1213.05(c) (8th ed. 2011). There is no double entendre created by applicant's mark. As indicated above, the issue of descriptiveness must be determined in connection with the description of goods and, therefore, there is no basis upon which to find that a consumer would associate LAPELLE with a lapel. Moreover, an Italian speaker who recognized the mark LAPELLE as meaning "the leather" will not perceive LAPELLE as meaning a lapel because in Italian a "lapel" is translated as "risvolto."⁷

In view of the foregoing, we find that the mark LAPELLE for use in connection with leather for furniture is merely descriptive.

Decision: The refusal to register is affirmed.

⁷ Cassell's Italian Dictionary, p. 808.