

This Opinion is Not a  
Precedent of the TTAB

Mailed: February 14, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Branded LLC*

Serial No. 87749455

Jeffrey M. Furr of Furr Law Firm,  
for Branded LLC.

Jonathan Ryan O'Rourke, Trademark Examining Attorney, Law Office 104,  
Zachary Cromer, Managing Attorney.

Before Ritchie, Adlin and English,  
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Branded, LLC ("Applicant") seeks registration on the Principal Register of the standard character mark EMPORIO ITALIA for "bed sheets; pillow cases; comforters; bedspreads" in International Class 24.<sup>1</sup>

<sup>1</sup> Application Serial No. 87749455; filed January 10, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a claim of a bona fide intent to use the mark in commerce. Applicant has entered the following translation statement into the record: "The English translation of 'EMPORIO ITALIA' in the mark is 'EMPORIUM ITALY'."

The Trademark Examining Attorney refused registration on the ground that Applicant's mark is primarily geographically deceptively misdescriptive in relation to the goods identified in the application under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3). When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied Applicant's request for reconsideration, and the appeal was resumed. We affirm the refusal to register.

### **I. Decision**

Section 2(e)(3) of the Trademark Act prohibits registration of marks that are primarily geographically deceptively misdescriptive of the identified goods or services. A mark is primarily geographically deceptively misdescriptive if:

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the goods do not come from the place named in the mark, but the relevant public would be likely to believe that the goods originate there; and
- (3) the misrepresentation is a material factor in the purchaser's decision to buy the goods in question.

*In re Miracle Tuesday, LLC*, 695 F.3d 1339, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1490-95 (Fed. Cir. 2009); *In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853, 1857 (Fed. Cir. 2003); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1210.01(b) (Oct. 2018).

**A. The Primary Significance of Applicant’s Mark is a Generally Known Geographic Location.**

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English. *In re Spirits Int’l*, 90 USPQ2d at 1491 (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005)). The doctrine applies only in those situations where the ordinary American consumer, including those proficient in the foreign language, would stop and translate the mark into English. *Id.* at 1491-92. We find that to be the case here, and Applicant agrees.<sup>2</sup> We further find that non-Italian-speaking American consumers would readily perceive the mark as “Emporium Italy” because the English translation is substantially similar in appearance and sound to Applicant’s mark EMPORIO ITALY. The Italian word “Italia” is even defined in American English dictionaries as meaning “Italy.”<sup>3</sup>

Turning to whether the primary significance of Applicant’s mark is a generally known geographic location, we consider Applicant’s mark in its entirety. *In re Save*

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<sup>2</sup> Appeal Brief, 7 TTABVUE 3 (“As a modern United States consumer may stop and translate these words, the English equivalent may be considered.”); *see also* translation statement in n.1 above, and February 16, 2018 Office Action at TSDR 7 and 9 (translations of “emporio” and “italia” from Collins Italian to English Dictionary).

Citations to the prosecution record are to the Trademark Status & Document Retrieval (“TSDR”) system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVUE, the Board’s online docketing system.

<sup>3</sup> Examiner’s Statement, 9 TTABVUE 19 and 22-23. Pursuant to the Examining Attorney’s request, we take judicial notice of the American English dictionary entries for the term “Italia” from Collins Dictionary and YourDictionary.com, both sourced from Webster’s New World College Dictionary by Houghton Mifflin Harcourt Publishing Company. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In*

*Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001). “A mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods.” *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1549 (Fed. Cir. 1999). The evidence shows that Italy is not an obscure, remote or minor geographic location, but rather a European country with a population of more than 58 million<sup>4</sup> and exports of more than \$506 billion.<sup>5</sup> Moreover, as discussed in Section IB below, the evidence establishes a connection between Italy and the goods covered by Applicant’s application – “bed sheets; pillow cases; comforters; bedspreads.” The word “emporia” meaning “emporium” in English is defined as “a place of commerce; trading center; marketplace” and “a large store with a wide variety of things for sale,”<sup>6</sup> and merely reinforces the geographic significance of the term “Italia.” *See In re California Innovations*, 66 USPQ2d at 1858 (the word “innovations” and the design element of the mark CALIFORNIA INNOVATIONS did not contradict the primary geographic significance of the mark; “the primary meaning remains focused on the state of ‘California’”); *In re Wada*, 52 USPQ2d at 1541 (primary geographic significance of the mark NEW YORK WAYS GALLERY “not lost by the

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*re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

<sup>4</sup> October 9, 2018 Final Office Action at TSDR 10 (The Columbia Gazetteer of the World Online) (2007). The population for 2014 is estimated at more than 61 million. *Id.* at 45-46 (Fiber2Fashion.com).

<sup>5</sup> *Id.* at TSDR 48.

<sup>6</sup> February 16, 2018 Office Action at TSDR 27-28, Collins English Dictionary definition for “emporium”; *see also* October 9, 2018 Final Office Action at TSDR 9, Macmillan Dictionary definition for “emporium.” Pursuant to Applicant’s request, we also take judicial notice of the Merriam-Webster definition of “emporium” even though this evidence is cumulative. Reply Brief, 10 TTABVUE 3-4.

addition of WAYS GALLERY to NEW YORK”); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1844-45 (TTAB 2012) (“It is not improper ... to give greater weight to the dominant feature of a composite mark in the course of evaluating the mark as a whole.”); *see also* TMEP § 1210.02(c)(i).

Applicant argues that when its mark is considered as a whole, it is “suggestive, arbitrary, or fanciful, such as when a geographic mark may indicate that a product is stylish or of a high quality, *i.e.* HYDE PARK or NANTUCKET for clothing, and FIFTH AVENUE for a car.”<sup>7</sup> We disagree. Because there is an association between the geographic location in Applicant’s mark and Applicant’s goods, Applicant’s mark is not suggestive, arbitrary or fanciful for Applicant’s goods. *See* TMEP 1210.04(d) (“The name of a geographic location that has no significant relation to commercial activities or the production of the relevant goods or services ... is treated as an arbitrary mark because it is unlikely that consumers would believe that the mark identifies the place from which the goods originate.”); *see also In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 893-94 (CCPA 1982) (summarizing cases where marks incorporating geographic terms were found arbitrary because there was no connection between the place named in the mark and the goods). Rather, when considered as a whole, Applicant’s mark immediately conveys to relevant consumers that Applicant’s goods come from a place of commerce, trading center, marketplace, or store in Italy.

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<sup>7</sup> Appeal Brief, 7 TTABVUE 4.

In view of the foregoing, we find that the primary significance of Applicant's mark is the generally known geographic location of Italy.

**B. Purchasers would be Likely to Mistakenly Believe that Applicant's Goods Come from Italy.**

In response to an information inquiry, Applicant specified: "The goods will come from or will originate from India. The goods are not and will not be manufactured, packaged, shipped from, sold in or have any other connection with the geographic location named in the mark."<sup>8</sup> Accordingly, the first part of the second inquiry is satisfied.

As to the second part of the inquiry, the Office does not have to prove an "actual goods/place association." *In re Miracle Tuesday*, 104 USPQ2d at 1333 (quoting *In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003)). Rather, the Office need only "establish 'a *reasonable predicate* for its conclusion that the public would be *likely* to make the goods/place association on which it relies.'" *Id.* (citing *In re Pacer Tech.*, 67 USPQ2d at 1631 (quoting *In re Loew's Theaters, Inc.*, 769 F.2d 764, 226 USPQ2d 865, 868 (Fed. Cir. 1985)). "It is sufficient if the geographic connotation of the mark has significance for the goods, such that purchasers would expect the goods to have their origin in the identified locality." *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1100 (TTAB 2012). If the evidence shows that the geographic location in the mark is known for producing the product,

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<sup>8</sup> April 9, 2019 Request for Reconsideration, 4 TTABVUE 3.

an inference can be made that the consumer associates the products with the geographic location. *In re Miracle Tuesday*, 104 USPQ2d at 1333.

The Examining Attorney submitted evidence that bedding<sup>9</sup> and textiles<sup>10</sup> are among Italy's main exports:

- “Furniture, **bedding**, lighting, signs, [and] prefab buildings” are listed together as number eight on the list of “**Italy’s Top 10 exports**” at \$13.7 billion annually.<sup>11</sup>
- “The **leading exports** [of Italy] are machinery, **textiles**, chemicals, motor vehicles, and metals[.]”<sup>12</sup>
- “**Italian products of the textile** and apparel industry are **known worldwide.**” In 2013, the textile industry contributed 3% to Italy’s gross domestic product.<sup>13</sup>

The Examining Attorney also submitted articles and third-party websites touting Italian bedding and textiles used in bedding:

- Undated “Fashion & Style” article in THE NEW YORK TIMES: “Peracle is a smooth, flat fabric that conducts the heat away from the body.... **Italian percale sheets**—one of the most luxurious kinds of percale—once available only through very high-end stores, can now be found in more accessible stores and at moderate prices.”<sup>14</sup>
- January 8, 1998 article in the ST. LOUIS POST-DISPATCH (MISSOURI): Quoting the manager of Laundry at Linens Limited: “[T]here are ‘a lot of gorgeous, **beautiful sheets coming in from Italy**, where people buy them. They’re

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<sup>9</sup> “Bedding” is defined as “sheets, blankets, and covers that are used on beds.” October 9, 2018 Final Office Action at TSDR 56 (Collins English Dictionary).

<sup>10</sup> “Textile” is defined as “A cloth, especially one manufactured by weaving or knitting; a fabric” and “Fiber or yarn for weaving or knitting into cloth.” *Id.* at TSDR 17 (The American Heritage Dictionary of the English Language).

<sup>11</sup> *Id.* at TSDR 48-49 (worldstopexports.com).

<sup>12</sup> *Id.* at TSDR 10-11 (The Columbia Gazetteer of the World Online).

<sup>13</sup> *Id.* at TSDR 45 (Fiber2Fashion.com, “Italian Textile Industry Overview”).

<sup>14</sup> *Id.* at TSDR 19-20.

usually very high thread count, a beautiful shine with unbelievable beautiful trim.”<sup>15</sup>

- October 14, 2006 article in the SAN JOSE MERCURY NEWS: “**Sferra sells its high-end Italian made linens<sup>16</sup> throughout the world.** Company President Paul Hooker says there is a whole new awareness of high-quality bedding in America, and sheets are part of it.”<sup>17</sup>
- October 5, 2006 article in THE DALLAS MORNING NEWS: “In the front guest room, a turn-of-the-20<sup>th</sup>-century Anglo-Indian bed from Calcutta gets luxury hotel treatment with **600-thread count Italian-made linens.**”<sup>18</sup>
- May 15, 2008 article in THE WASHINGTON POST: “**Luxury bed linens, such as Italian-made 1,020 thread-count sheets** from manufacturers including Frette or Sferra Bros., can cost more than \$2,000 per set, and **are the go-to-brands for resorts, royals and fine hotels.**”<sup>19</sup>
- January 24, 2007 article in the SAN FRANCISCO CHRONICLE: “Mark Scheuer, whose Scheuer Linens features ultra luxury in the Milos by Sferra brand of **1,020-thread-count Italian bedding** (\$1,185 for a queen set) keeps handy 20 samples from other stores, catalogues and Web sites so that consumers can test the feel of various thread counts.”<sup>20</sup>
- January 20, 1996 article in the PITTSBURG POST - GAZETTE: Describing Calvin Klein brand’s Home Collection of “**luxury linens**” as “**made of sateen cotton or Italian linen or hemp or silk**” and “\$375 for a **queen sheet in Italian linen[.]**”<sup>21</sup>
- February 13, 1999 article in the ROCHESTER DEMOCRAT AND CHRONICLE: Describing hotel “niceties” including “soft-as-cloud bed sheets” as “[n]ow ... readily available to the public” and noting that the Chambers catalog “**devotes**

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<sup>15</sup> Denial of Request for Reconsideration, 5 TTABVUE 7.

<sup>16</sup> The definition of “linen” includes “Articles or garments, such as sheets, tablecloths, or underwear, formerly made of linen and now usually made of other fabrics, especially cotton.” October 9, 2018 Final Office Action at TSDR 54.

<sup>17</sup> Denial of Request for Reconsideration, 5 TTABVUE 9.

<sup>18</sup> *Id.* at 10.

<sup>19</sup> *Id.* at 11.

<sup>20</sup> *Id.* at 12.

<sup>21</sup> *Id.* at 24-26



**several pages to hotel bedding basics. Among the luxuries: expensive Italian bed sheets.”**<sup>22</sup>

- March 20, 2000 article in HOME TEXTILES TODAY: “[M]any consumers are willing to pay a premium to sleep on Italian sheets or cozy up under an Italian throw. According to the companies that import these goods, Italy’s reputation for fine textiles is wellfounded [sic].”<sup>23</sup>
- July 18, 1994 article in the LOS ANGELES BUSINESS JOURNAL: “Young customers are spending \$600 a pop to buy sets of **luxury bed sheets** at Frette, said Dan Moss, the **Italian linen** store’s CEO and general counsel.”<sup>24</sup>
- Made-in-Italy.com blog: “**Italian textiles and fabrics are famous** all over the world for their high quality.... Fabric products in Italy supply the **worldwide market** of fashion and **home textiles** and accessories with their refined materials.”<sup>25</sup>
- bedding.lovetoknow.com article: “**Italian bed linens are highly sought after by customers who value high quality, luxury bedding.**” Many “Italian textile manufacturers are known also [to] sell to specialty stores, boutiques, and some department stores. This enables them to reach consumers who want to use these fine linens in their homes.”<sup>26</sup>
- Online retailer ZigZag Zurich: “**Italy is still considered the home to the best brands in home textiles and bedding** .... If you ask any leading retailers who are the top brands in duvet covers and bed lines, most of the Italian manufactured brands will come up. Indeed many of the top USA designer brands, source their fabrics from Italy[.]”<sup>27</sup>

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<sup>22</sup> *Id.* at 28-30.

<sup>23</sup> *Id.* at 32-34.

<sup>24</sup> *Id.* at 18-20.

<sup>25</sup> October 9, 2018 Final Office Action at TSDR 24.

<sup>26</sup> February 16, 2018 Office Action at TSDR 16-17.

<sup>27</sup> *Id.* at TSDR 12-14.

- Online retailer Belvivere touting “**Luxury bedding** ... direct from our factory workroom in **Florence, Italy**.”<sup>28</sup>
- Vero Linens: “Undisputedly, **the finest bed linens in the world are made in Italy** and we produce some of Italy’s finest.”<sup>29</sup>

With this evidence, the Examining Attorney has met the initial burden of establishing a goods-place association between Applicant’s goods and Italy. *In re California Innovations, Inc.*, 66 USPQ2d at 1858-59 (leaving “undisturbed” the Board’s finding of a goods-place association based on third-party websites, articles and blogs); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1641 and 1644 (TTAB 2011) (finding a goods-place association between Cuba and cigars based on The Columbia Gazetteer of the World Online’s identification of cigars as “one of the five ‘important’ exports from Cuba” and third-party websites showing that Cuba is known for producing tobacco and cigars).

Applicant has attempted “to rebut this showing with evidence that the public would not actually believe the goods derive from” Italy. *In re Miracle Tuesday, LLC*, 104 USPQ2d at 1332-33 (internal quotations omitted). Applicant submitted two pieces of evidence:<sup>30</sup> (1) one result from a Google search for the phrase “what is italy known for”; and (2) a September 12, 2016 article in Town&Country Magazine titled

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<sup>28</sup> *Id.* at TSDR 18-24 (listing bedding for sale in U.S. dollars).

<sup>29</sup> October 9, 2018 Final Office Action at TSDR 21-23.

<sup>30</sup> Applicant initially submitted this evidence with its August 13, 2018 Office Action response, but the Examining Attorney objected because the evidence did not include URL addresses and the dates the pages were accessed. October 9, 2018 Final Office Action at 6. Applicant resubmitted the evidence with its April 9, 2019 Request for Reconsideration and in the text of its submission provided the URL addresses and dates the pages were accessed. April 9, 2019 Request for Reconsideration at TSDR 3. Accordingly, we have considered this evidence.

“10 Things You Need to Buy When You’re in Italy.” One Google search result has limited probative value compared to the Examining Attorney’s voluminous evidence of a connection. Moreover, the Google results are truncated and Applicant submitted only one of the 522 million results that the search generated. *In re Int’l Bus. Machines Corp.*, 81 USPQ2d 1677, 1679 n.3 (TTAB 2006) (listings of search results from Google database of limited probative value because the excerpts are extremely truncated). The Town&Country article also is unpersuasive. Although bedding does not appear on the list of Italian products the author recommends buying, this single article falls far short of rebutting the Examining Attorney’s evidence showing that Italy is known for bedding and textiles used in bedding.

Applicant’s attempts to discredit the Examining Attorney’s evidence similarly are unpersuasive. Applicant argues that there can be no goods-place association because Italian bedding is expensive, and “only ... a very small group of people are aware of Italy producing very exclusive and expensive bedding.”<sup>31</sup> It is the public’s perception of the mark that is controlling. *In re Jonathan Drew, Inc.*, 97 USPQ2d at 1647. Applicant has not submitted any evidence that the price point of Italian bedding would affect whether consumers perceive an association between Applicant’s goods and Italy. In addition, the record includes articles from national and regional newspapers in general circulation reflecting the general purchasing public’s exposure to an association between Italy and Applicant’s goods.

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<sup>31</sup> Appeal Brief, 7 TTABVUE 8.

In view of the foregoing, we find that there is a goods-place association between Applicant's goods and Italy.

**C. The Misrepresentation is a Material Factor in the Purchaser's Decision to Buy the Goods.**

“[T]o establish a prima facie case of materiality there must be some indication that a substantial portion of the relevant consumers would be materially influenced in the decision to purchase the product or service by the geographic meaning of the mark.” *In re Spirits Int'l*, 90 USPQ2d at 1495; *Corporacion Habanos, S.A.*, 102 USPQ2d at 1097. Indirect or circumstantial evidence, such as gazetteer entries, third-party websites, and articles, is permitted, and “materiality may be established by inference.” *Corporacion Habanos, S.A.* 102 USPQ2d at 1098; *In re Jonathan Drew, Inc.*, 97 USPQ2d at 1645. The dictionary definitions, gazetteer entry, third-party websites and articles summarized above establish that “Emporio Italia” means “Emporium Italy”; that Italy is a well populated European country with a large economy; that bedding and textiles used in bedding, as identified by Applicant, are principal and traditional products of Italy; and that Italy is well-known for producing high-quality bedding and textiles used in bedding. We infer from this evidence that a substantial portion of customers in the market for “bed sheets; pillow cases; comforters; bedspreads” will be motivated to purchase Applicant's goods because of the mistaken belief that the goods originate in Italy.<sup>32</sup> See *In re Jonathan Drew, Inc.*,

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<sup>32</sup> Applicant asserts “[t]he record provides evidence that the source of product is not a material factor” pointing to Sferra as an “example” of a company “sought after for the style and quality of bedding, just the same as other cited Italian manufacturers, while it is owned and manufactures bedding in New York.” Appeal Brief, 7 TTABVUE 9-11. To support this assertion, Applicant cites an article that the Examining Attorney submitted stating that

97 USPQ2d at 1645 (noting that “materiality may be inferred from a showing that the goods are ‘a principal product’ of the place named in the mark, that the place is ‘noted for’ the goods, or that the goods are, or are related to, the ‘traditional’ products of the place named in the mark”); *see also* *Corporacion Habanos, S.A.*, 102 USPQ2d at 1100-1103 (recognizing that advertisements, websites, publications and encyclopedias are probative on the issue of materiality).

For the same reasons discussed above, Applicant’s evidence is not sufficient to rebut this inference.

## II. Conclusion

The evidence establishes that the primary significance of Applicant’s mark is Italy, a generally known geographic location; that relevant consumers would be likely to mistakenly believe that Applicant’s goods come from Italy; and that relevant consumers would be motivated to purchase Applicant’s goods based on that mistaken belief. Accordingly, Applicant’s mark is primarily geographically deceptively misdescriptive.

**Decision:** The refusal to register Applicant’s proposed mark under Section 2(e)(3) of the Trademark Act is affirmed.

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Gennaro Sferra “relocated his family and company [from Italy] to New York in a shop on Fifth Avenue.” February 16, 2018 Office Action at TSDR 16-17. The article, however, does not state that Sferra operates exclusively in the United States. Indeed, the article identifies Sferra among the “Famous Names in Italian Bed Linens.” *Id.* Moreover, and importantly, regardless of where Sferra operates, articles in the record publicize Sferra as creating and selling Italian bedding and this is relevant to public perception. TMEP § 1208.01 (explaining that printed online publications are “evidence of how a term or mark may be perceived, rather than of the truth of the underlying information”).