

**THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB**

Mailed: August 26, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Atelier Profumo Artistico Firenze S.r.L.

Serial No. 77212553

John S. Egbert of Egbert Law Offices for Atelier Profumo
Artistico Firenze S.r.L.

Seth A. Rappaport, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Seeherman, Bergsman and Wellington, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Atelier Profumo Artistico Firenze S.r.L. (applicant) has
filed an application to register the mark:

**PROFUMO
di
FIRENZE**

for goods ultimately identified as "perfumes, eau de cologne,
scented body sprays, toilette water, oils for toiletry purposes,
deodorants for personal use, perfumed creams, essential oils for

Serial No. 77212553

personal use, cosmetic pencils, make-up removing lotions, toilet soaps, bar soaps, deodorant soaps, hair shampoos, hair lotions, bath salts, bath gels, beauty lotions, beauty masks, shaving preparations, after-sun lotions, cosmetic preparations for body care, cosmetic milks, cosmetic creams, talcum powder for toilet use" in Class 3.¹ Applicant ultimately provided the following translation statement: The foreign wording in the mark translates into English as "SCENT OR PERFUME OF FLORENCE."

The trademark examining attorney has refused registration under Section 2(e)(2) of the Trademark Act on the ground that applicant's mark, as applied to the identified goods, is primarily geographically descriptive of the goods.

When the refusal was made final, applicant concurrently filed a request for reconsideration and an appeal. The request for reconsideration was denied by the examining attorney and briefs were filed.

A mark is deemed to be primarily geographically descriptive, and thus unregistrable under Trademark Act Section 2(e)(2), if (i) the primary significance of the mark is the name of a place known generally to the public, and (ii) the public would make a goods/place association, that is, believe that the goods or services for which the mark is sought to be registered originate

¹ Serial No. 77212553, filed June 21, 2007, based on Section 1(b) (bona fide intention to use the mark in commerce) and Section 44(e) (ownership of a foreign registration).

Serial No. 77212553

in that place. If those two elements are met, and if the applicant's goods and/or services in fact originate in or from the place named, then the mark is primarily geographically descriptive, and registration must be refused under Section 2(e)(2). See *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305 (TTAB 2006); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988).

Primary Significance

First we consider whether the primary significance of the mark is the name of a place generally known to the public. In making this determination, it has long been held that words from modern foreign languages, such as in this case Italian, are translated into English to determine their descriptiveness. *In re Northern Paper Mills*, 64 F.2d 998, 17 USPQ 492 (CCPA 1933); *In re Spirits Int'l N.V.*, 86 USPQ2d 1078 (TTAB 2008). We follow this principle in determining whether the significance of PROFUMO DI FIRENZE would be regarded primarily as the name of a place.

At the outset, we note that applicant's primary argument as to why its mark is not primarily geographically descriptive rests on what it believes should be the appropriate translation of its mark. The application, as filed, contained a statement that the mark may be translated from Italian into English as "scent of Florence." In the first Office action, the (previously assigned) examining attorney not only refused registration based on the

Serial No. 77212553

mark being primarily geographically descriptive of the identified goods, but, *inter alia*, required applicant to state that the mark translates as "scent or perfume of Florence." In its response to that Office action, applicant stated that it "has since determined the translation of the mark into English [in the original application] was incorrect" and that the translation should be "sweet smell of Florence." The (current) examining attorney then issued a "final refusal" requiring applicant to amend its translation statement to "perfume of Florence."

Ultimately, in its request for reconsideration, applicant amended its translation statement to "scent or perfume of Florence" which the examining attorney accepted and withdrew the requirement.

In its brief, applicant argues that the amended translation "does not imply that applicant agrees with the Examiner's conclusion that the term 'profumo' is an additional 'generic term' which translates into the English wording 'perfume.'" Brief, p. 4. Rather, applicant contends that "the term 'profumo,' when combined with 'di Firenze,' takes on a meaning that is better translated into English as 'scent of Florence.'" *Id.* at 5. In particular, applicant relies on a website (www.wordreference.com) that, according to applicant, "shows that when the term 'profumo' is followed by 'di' and a noun such as a 'rose' (or in this particular case, the city of Florence), that the term 'profumo' will take on the more 'sensory-related'

Serial No. 77212553

translation of the word as opposed to the 'product-related' translation of the word that the Examiner would like to use." *Id.* Based on this asserted connotation of the mark, applicant asserts that consumers will perceive the mark "in a manner that is consistent with the 'scent of Florence' as opposed to 'bottles of perfume originating from Florence.'" *Id.* And, applicant concludes, [i]n this context, due to the composite nature of the mark, Firenze is simply used to invoke a historic place, where a sweet scent is in the air, not a geographical description related to perfume." *Id.* at 10.

The examining attorney, on the other hand, contends that "while an Italian language speaker *may* translate the mark into English as SCENT OF FLORENCE, most will translate the term PROFUMO in the mark into English as PERFUME and thus see the mark in English as PERFUME OF FLORENCE." Brief, (unnumbered) p. 6 (emphasis in original). And, he argues that "even if the wording PROFUMO is translated into English as SCENT, the applicant's mark is still primarily geographically descriptive because the addition of generic or highly descriptive wording to a geographic word does not diminish that geographic word or term's primary geographic significance." *Id.* at (unnumbered) p. 7.

The record includes definition entries for the term "profumo" submitted by both applicant and the examining attorney. Essentially, they are the same in substance. For example,

Profumo, *n.m.* Perfume, scent, sweet smell, fragrance.
[Cassell's Italian Dictionary (Macmillan Publishing Company, 1967)]

Profumo, *noun, masculine.* Perfume, scent
[Pocket Oxford Italian Dictionary (Oxford University Press, 2006), obtained via website www.wordreference.com]

In addition, the examining attorney submitted the following third-party registrations for marks containing the term PROFUMO and translation statements indicating said term is translated into English as "perfume."²

AMORVERO PROFUMO (Reg. No. 2596930)
The English translation of AMORVERO PROFUMO is "true love of perfume."

PROFUMO DI VINO (Reg. No. 3009019)
The English translation of the foreign word(s) in the mark is: PERFUME OF WINE.

As to the geographic portion of applicant's mark, DI FIRENZE, there is no dispute and the evidence demonstrates that this wording translates into English as "of Florence." Furthermore, the evidence of record shows that Florence is a well-known city (and province). It is "the capital city of the Italian region of Tuscany, and of the province of Florence."³ It

² In his brief (at unnumbered p. 6), the examining attorney states that attached to the first Office action were "numerous third party registrations, which include the term PROFUMO, which show that the Office has consistently translated this wording into English as PERFUME." There are several third-party registrations attached to the first Office action; however, only two of these registrations (identified in this decision) contain the term PROFUMO in the mark.

³ Wikipedia online encyclopedia, en.wikipedia.org., attached to applicant's Request for Reconsideration filed on January 22, 2009. See also printouts from www.bartleby.com website, citing to The Columbia Encyclopedia (6th Ed., 2001-07).

Serial No. 77212553

is "known for its history" and has been described as "the birthplace of the Italian renaissance; in fact, it has been called the Athens of the Middle Ages."⁴ "It is a commercial, industrial, and tourist center and a rail junction. Tourism is the main industry..."⁵ "It continues to attract millions of tourists each year and was declared a World Heritage Site by UNESCO in 1982."⁶

As the Board stated in *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455, 1456 (TTAB 1987), which involved the issue of whether THE GREAT AMERICAN BASH was primarily geographically descriptive, "the mere fact that a mark contains a geographical term, even one which is well known and which names the geographical area from which the goods or services originate, does not automatically render the mark unregistrable under Section 2(e)(2). As always, a mark must be considered in the context of its use and the meaning it would have for the relevant public when so used."

Based on the evidence of record, we cannot conclusively determine whether the mark, considered as a whole, will be perceived by those able to translate the wording as "perfume (the goods) of Florence" or as "the scent (or sweet smell) of Florence." The former connotation is clearly geographically

⁴ *Id.*

⁵ *Id.*

⁶ *Id.*

Serial No. 77212553

descriptive of the identified goods and if that were the only possible translation of the mark, our decision would be clear. However, as evidenced by the dictionary translations of the term "profumo," the term is not only the generic word for the goods, but can also have a sensory connotation. Further, the evidence shows that, as used in the mark, PROFUMO can continue to convey this connotation, such that one meaning of the mark as a whole is the sensory connotation. This sensory connotation is nebulous inasmuch as it remains unclear whether the "scent" or "sweet smell" of Florence is to be taken literally, i.e., the goods may actually attempt to replicate odors of the city, in the manner of "the scent of the sea," or to be interpreted as giving a "flavor" of the city, i.e., suggesting the goods will conjure images or "the aura" of the historic city of Florence. In either instance, we find this connotation takes the mark out of the geographically descriptive realm. Specifically, because this meaning of PROFUMO is not the generic term for the goods, this connotation of the mark does not describe where applicant's goods are made, but suggests that the goods contain or project the "scent" or "sweet smell" of the city. The evidence of record, at the very least, supports the existence of this alternative meaning. In addition to the dictionary definitions providing the alternative meanings, we note that the website www.wordreference.com (relied on by both applicant and the examining attorney) shows "al profumo di rosa"

Serial No. 77212553

is translated as "rose-scented" and there is an excerpt from an encyclopedia indicating that an Italian film from 1975 titled "Profumo di Donna" was remade into the American movie production titled "Scent of a Woman."⁷

We recognize that there is also evidence to support the examining attorney's position that the word "profumo," as used in the context of the mark and in relation to the goods, may be understood as identifying the actual goods, so that the mark could also be viewed as describing that applicant's goods, i.e., perfume, are made in the city of Florence. However, because of the additional, non-geographically descriptive connotation of the mark, as discussed above, at the very least the mark must be viewed as having a double entendre, and is therefore registrable. See *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961) (POLYPITCHER not merely descriptive of polyethylene pitchers inasmuch as it is an incongruous expression suggestive of MOLLY PITCHER) and *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products inasmuch as it is suggestive of a nursery rhyme).

To the extent that there is any doubt as to the primary significance of the mark "PROFUMO DI FIRENZE," we resolve that

⁷ Submitted with applicant's Request for Reconsideration filed on January 22, 2009.

Serial No. 77212553

doubt in favor of the applicant. See *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451, 1455 (TTAB 1994). Accordingly, we cannot conclude that the primary significance of the mark PROFUMO DI FIRENZE is geographic and that the public would believe, based on the mark, that applicant's goods are from Florence.⁸

Decision: The refusal to register under Section 2(e)(2) is reversed. The application will be forwarded to publication.

⁸ Because we find that applicant's mark is not primarily geographic, we need not consider the second element, i.e., whether the public would make a goods/place association between applicant's identified goods and its mark.