

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Salvador Cababie
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Serial Nos. 86265910 and 86265949
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Gregg A. Paradise of Lerner, David, Littenberg, Krumholz & Mentlik, LLP
for Salvador Cababie.

Theodore McBride, Trademark Examining Attorney, Law Office 102,
Michael Hamilton, Managing Attorney.

—
Before Seeherman, Cataldo and Hightower,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Salvador Cababie, an individual, (“Applicant”) seeks registration on the Principal Register of the marks BAJATUSEGURO.COM in standard characters and BAJATUSEGURO.COM and design, as shown below,



for “Insurance brokerage and reinsurance underwriting services offered via a global computer network.”¹

The Trademark Examining Attorney has determined that the words BAJATUSEGURO.COM are merely descriptive of Applicant’s identified services, and has refused registration of Applicant’s standard character mark BAJATUSEGURO.COM pursuant to Section 2(e)(1) of the Trademark Act on the ground that the mark is merely descriptive, and has, for the word and design mark, required a disclaimer of BAJATUSEGURO.COM pursuant to Section 6(a) of the Trademark Act.

Applicant has appealed the refusal and requirement. Because both appeals involve the same question—whether BAJATUSEGURO.COM is merely descriptive—and the evidence and arguments in both are essentially the same, we have decided both in this single opinion.²

Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits the registration of a mark which, when used on or in connection with the goods of the applicant, is merely descriptive of them. Section 3 of the Trademark Act makes this provision applicable to service marks. Section 6(a) of the Act, 15 U.S.C. § 1056(a), provides that the Director may require the applicant to disclaim an unregistrable

¹ Application Serial No. 86265910 is for the mark in standard characters, and 86265949 is for BAJATUSEGURO.COM and design. Both applications were filed on April 29, 2014, pursuant to Section 1(b) of the Trademark Act (intent-to-use). The application for the word mark initially showed the mark as BAJA TU SEGURO; after the first Office action refusing registration on the ground of mere descriptiveness, Applicant amended the mark to BAJATUSEGURO.COM.

² To the extent that there is any difference in the page number in which a statement is made or a particular piece of evidence is found, we have cited to Application Serial No. 86265949.

component of a mark otherwise registrable. A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services it identifies. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Determining the descriptiveness of a mark is done in relation to an applicant's identified goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831. In other words, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

This appeal has the added element that the words asserted by the Examining Attorney to be merely descriptive are in Spanish. However, some of the issues that may occur when the doctrine of foreign equivalents comes into play are not present here. That is, neither Applicant nor the Examining Attorney is disputing that the words are in Spanish, or that the ordinary American purchaser would “stop and translate” the foreign term into its English equivalent.

The crux of the dispute is what BAJATUSEGURO.COM would mean to Spanish speakers. The Examining Attorney asserts that it means “lower your insurance.com,” while Applicant contends that it means “download your insurance” or is a double entendre meaning both “download your insurance” and “lower your insurance.”

In support of his position the Examining Attorney has submitted a Translation Statement prepared by the U.S. Patent and Trademark Office. The statement is:

The original language of the non-English wording ‘BAJA TU SEGURO’ is “Spanish”. The English translation of the non-English wording in the mark is “lower your insurance”.

The statement includes the explanation that it was prepared by the USPTO’s Scientific Technical Information Center by “a translator proficient in the aforementioned language, employed by the U.S. Patent and Trademark Office.”³

The Examining Attorney also submitted several translations retrieved from online translation services:

SDL FreeTranslation.com, from Spanish to English: “baja tu seguro” translates as “Low your insurance.”
www.freetranslation.com⁴

Merriam-Webster, Spanish Central: Spanish “baja tu seguro” is “lower your insurance” in English.
www.spanishcentral.com⁵

Babylon 10, “baja tu seguro” translates as “Low your insurance.”
<http://translation.babylon.com>⁶

³ October 7, 2015 Office action, p. 25.

⁴ March 12, 2015 Office action, p. 8.

⁵ *Id.*, p. 14.

⁶ *Id.*, p. 10.

imTranslator: “baja tu seguro” translation is “it lowers your insurance.”
<http://imtranslator.net>⁷

Bing: “baja tu seguro” is translated as “lower your insurance.”
www.bing.com⁸

WorldLingo: “baja tu seguro” is translated as “low your insurance.”
www.worldlingo.com⁹

In addition, to counter Applicant’s evidence that BAJATUSEGURO.COM means “download your insurance,” the Examining Attorney submitted the following evidence of how “download your insurance” would be translated into Spanish:

Merriam-Webster Spanish Central: “download your insurance” translates as “descargar tu seguro.”¹⁰

Babylon 10, “download your insurance” is translated as “Descargar su seguro.”¹¹

imTranslator: “download your insurance” is translated as “descargue su seguro.”¹²

Applicant, on the other hand, submitted evidence in an attempt to show that, when “baja tu seguro” is combined with the top level domain “.com,” it takes on the meaning of “download your insurance.” In particular, Applicant submitted the declaration of Vianey Romo de Vivar, a partner in a law firm in Mexico City that

⁷ *Id.*, p. 18.

⁸ *Id.*, p. 32.

⁹ *Id.*, p. 34.

¹⁰ *Id.*, p. 16.

¹¹ *Id.*, p. 12.

¹² *Id.*, p. 19.

represents Applicant in Mexico.¹³ Ms. Romo de Vivar avers that she is a native Spanish speaker; that she is proficient in English, having attended a program at UNH School of Law in New Hampshire from 2005-2006; that she associates “.com” with goods or services provided on the Internet; that “baja” comes from the Spanish verb “bajar”; and that she would “translate the word ‘baja’ to mean ‘download’ or another similar English word or phrase when ‘baja’ is used in relation to the Internet.” ¶ 6. She concludes her declaration, “When I see the mark BAJATUSEGURO.COM, I would therefore translate it to English to mean DOWNLOAD YOUR INSURANCE.” ¶ 9. With her declaration she has submitted certain exhibits. She explains that Exhibit A is a page from a dictionary of Internet terms from the year 2004. According to her declaration, the dictionary states that on the Internet the verb “bajar” means to download something from the Internet onto your computer, and that the verb is synonymous with “download.”¹⁴ Ms. Romo de Vivar also provided Exhibit C, the result of a Google search for the definition of BAJAR. According to her declaration, “BAJAR means to copy or transfer information in the memory of one computer to that of another, especially through the Internet or other information network.”¹⁵ The third exhibit to her declaration, also in Spanish, is

¹³ February 17, 2015 response, pp. 7-15.

¹⁴ See paragraph 6 of her declaration. We rely on her statements as to what the dictionary says, as Exhibit A (found at p. 10) is in Spanish. The heading for the page is “Diccionario de términos de Internet,” with a copyright by Jorge Sánchez 2004. We note that the word for which the definition is provided is “BAJAR.”

¹⁵ See paragraph 7 of her declaration, at p. 7 of response. Again, we rely on what she asserts the exhibit, found at p. 12, says, as it is in Spanish. The actual words are “copiar o transferir información (datos, programas, etc.) en la memoria de una computadora desde la de otra,

from a website with the logo “BAJA EBOOKS.com and design.” The declaration states that below the logo is the phrase “Libros para descargar,” which she translates as “Books to download.”¹⁶

Applicant also asserted that the Mexican Patent Office issued registrations for the design mark which is the subject of Serial No. 86265949 for, *inter alia*, “Price comparison services in the insurance industry.” However, although Applicant submitted copies of the registrations, they are in Spanish, and Applicant did not submit an actual translation of the registrations; the records from the Corsearch database do not constitute an official translation. In any event, these registrations have no probative value. The Mexican Patent Office follows its own statutory framework, not the laws of the United States, in determining whether to issue a registration. Further, the price comparison services Applicant states are the subject of the most pertinent registration are different from the “insurance brokerage and reinsurance underwriting services offered via a global computer network” that are identified in the subject applications.

Applicant also submitted a webpage from Google Translate which lists, as what appears to be the primary translation of “bajar,” “get off.” Other listed translations are, *inter alia*, “lower,” “bring down” and “drop.”¹⁷ “Download” is not in this list. However, Applicant has supplied a separate exhibit from this same source that

especialmente a través de Internet u otra red informática. “bajaré el correo electrónico en cuanto llegue a casa; me bajé un antivirus de Internet”; *sinónimos*: descargar.”

¹⁶ Declaration paragraph 8, p. 8 of response.

¹⁷ <https://translate.google.com>. February 17, 2015 response, pp. 3-4.

translates “bajar música” as “download music.”¹⁸ In addition, Applicant submitted a webpage from Merriam-Webster Spanish Central which lists, as one of the English translations of “bajar,” “DESCARGAR: to download.” (The primary translation provided is “bajar = to lower.”)¹⁹

Analysis

First, we note that there is no dispute that if BAJATUSEGURO.COM means only “lower your insurance,” it would be merely descriptive of Applicant’s services. Applicant has not made any argument to the effect that “lower your insurance” is not merely descriptive of his services.²⁰

As for the dispute as to what BAJATUSEGURO.COM means when used in connection with the identified services, our opinion can be summarized as, “Stop, you’re both right.” That is, we accept Applicant’s claim that when “.COM” is combined with BAJATUSEGURO, the resulting mark BAJATESURO.COM may have a different meaning from BAJATUSEGURO *per se*. However, we must also recognize that adding “.COM” does not necessarily change the meaning of the word or words with which this top level domain is used. *See In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009) (“hotels” did not lose its generic character by placement in the domain name HOTELS.COM). In fact, at the time Applicant sought

¹⁸ February 17, 2015 Office action, p. 6.

¹⁹ September 11, 2015 response, p. 3.

²⁰ Applicant’s present attorney stated, in the responses filed February 17, 2015, that the responses filed on February 14, 2015 by Applicant’s previous attorney were “without authorization, and directly against explicit instructions from Applicant to do no further work on this matter,” and that such responses “should be disregarded.” Accordingly, we have given such responses, and the arguments contained therein, no consideration.

to amend his original word mark, BAJA TU SEGURO, to BAJATUSEGURO.COM, he stated that the “essence of the mark has not changed,” citing the language in TMEP § 1215.08(a) that “the essence remains the same regardless of whether the TLD is present or not.”²¹

Accordingly, the fact that the translations made of record by the Examining Attorney were for “BAJA TU SEGURO,” rather than BAJATUSEGURO.COM, are still probative of the meaning that consumers may ascribe to the mark BAJATUSEGURO.COM. Of these translations, we accept the point that the online or automatic translations that are generated by software may not be totally accurate, or may merely combine the translations of individual words. In fact, the WorldLingo translation for “baja tu seguro” actually cautions that it is “a computer translation of text. It is provided for general information only and should not be regarded as complete nor accurate.”²²

Nevertheless, the Examining Attorney also made of record a translation of “BAJA TU SEGURO” provided by a Spanish language translator employed by the Patent and Trademark Office, and we find that this translation does not suffer from the infirmities that may occur with a computer-generated translation. This translation is sufficient for us to find that BAJA TU SEGURO means “lower your insurance,” and that the mark BAJATUSEGURO.COM would have this meaning to many consumers.

²¹ Response filed Feb. 17, 2015, p. 1 in Application Serial No. 86265910.

²² March 12, 2015 Office action, p. 34

On the other hand, the translation supplied by Applicant, from a native Spanish-speaker who is also fluent in English, regarding the effect of “.COM” added to BAJA TU SEGURO in the context of “insurance brokerage and reinsurance underwriting services offered via a global computer network,” is sufficient for us to find that, at least to an appreciable number of consumers, the mark would have the meaning of “download your insurance.”

Thus, we reach the question of whether BAJATUSEGURO.COM is a double entendre, that is, a term with one meaning that is merely descriptive, but a second meaning that is not. *See In re The Place Inc.*, 76 USPQ2d 1467, 1469 (TTAB 2005). Double entendres, of course, are registrable because they are not *merely* descriptive.

During examination of the application, the Examining Attorney did not address the issue of whether “download your insurance” also has a descriptive meaning. Rather, his focus was solely on his contention that the mark meant only “lower your insurance.” Applicant, however, asserted that “download your insurance” is not descriptive, stating:

Applicant’s goods and services include brokering insurance policies and underwriting reinsurance. Purchasers may use Applicant’s goods and services to buy a policy to protect certain items they own. These goods and services are not downloadable, nor do they involve downloading an insurance policy; therefore the mark is not merely descriptive.”²³

The Examining Attorney did not respond to this argument during examination. In his brief, in discussing what meaning the mark would have, he said, “To understand the mark as DOWNLOAD YOUR INSURANCE is an incongruous

²³ Response filed Feb. 17, 2015.

interpretation that the average consumer simply will not reach.” Examining Attorney’s brief, 11 TTABVUE 8. However, in the section of his brief addressing the double entendre argument, the Examining Attorney stated that “DOWNLOAD YOUR INSURANCE is simply a descriptive phrase that indicates that the insurance services feature an online component that can be downloaded.” 11 TTABVUE 10.

We are troubled by the fact that during examination the Examining Attorney submitted no evidence of the descriptiveness of this alternative meaning in the face of Applicant’s argument that his mark is a double entendre. The Examining Attorney now states that the services feature an online component that can be downloaded. However, he has not shown that downloading an online component is a feature of “insurance brokerage and reinsurance underwriting services offered via a global computer network” and, as noted, he has instead taken the position that DOWNLOAD YOUR INSURANCE would be an “incongruous interpretation that the average consumer simply will not reach.” If, indeed, DOWNLOAD YOUR INSURANCE would have an incongruous meaning as used for the identified services, it seems to us that this meaning cannot be considered to be merely descriptive, as it would not immediately and directly convey to consumers information about a characteristic of the services. Accordingly, because we have found that the declaration of Ms. Vianey Romo de Vivar shows that one meaning that BAJATUSEGURO.COM would have to consumers is DOWNLOAD YOUR INSURANCE, and because the Office has not shown that this meaning is merely descriptive, this incongruous second

meaning qualifies BAJATUSEGURO.COM as a double entendre, such that it is not merely descriptive of the identified services.²⁴

Decision: The refusal to register Applicant's mark BAJATUSEGURO.COM on the ground that it is merely descriptive is reversed, and the requirement to disclaim BAJATUSEGURO.COM in Applicant's mark BAJATUSEGURO.COM and design is reversed as well.

²⁴ This is not to say that we would not reach a different conclusion on a different record, such as might be adduced in an *inter partes* proceeding, which includes evidence of the descriptiveness of "download your insurance."