

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 Marcos A. Castillo

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Serial No. 87117266

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Heather A. Sapp and Robert J. Makar of LegalForce RAPC Worldwide P.C.,
for Marcos A. Castillo

Nelson B. Snyder III, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

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Before Kuhlke, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Marcos A. Castillo (“Applicant”) seeks registration on the Principal Register of the mark LAROMANA (in standard characters) for “brown sugar,” in Class 30.¹ During the prosecution of the application, Applicant submitted the following translation of the mark: “The English translation of ‘LAROMANA’ in the mark is ‘THE ROMAN’”.

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¹ Application Serial No. 87117266 was filed on July 26, 2016 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as January 1, 2010.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3), on the ground that the mark LAROMANA is primarily geographically deceptively misdescriptive. According to the Examining Attorney, La Romana is a province and city in the Dominican Republic known for sugar and because Applicant's brown sugar does not come from La Romana, the mark is primarily geographically deceptively misdescriptive.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

The elements of whether a mark is primarily geographically deceptively misdescriptive are set forth in *In re Miracle Tuesday LLC*, 695 F.3d 1339, 104 USPQ2d 1330 (Fed. Cir. 2012):

1. Is "the primary significance of the mark ... a generally known geographic location?";
2. Is "the consuming public ... likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place?"; and
3. Would "the misrepresentation [be] a material factor in the consumer's decision" to purchase the goods?

² In a telephone conference between the Examining Attorney and Applicant documented in a note to the file on September 22, 2016, Applicant stated that his brown sugar does not originate from or have any connection with La Romana.

Id. at 1332 (quoting *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1854 (Fed. Cir. 2003)); *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1746 (TTAB 2016).

I. Is the primary significance of LAROMANA a generally known geographic location?

The Examining Attorney submitted the following evidence to show that “La Romana” is a generally known geographic location:³

- “La Romana,” *The Columbia Gazetteer of the World* (2016) (columbiagazetteer.org), identifies La Romana as a province in the Dominican Republic along the Caribbean Sea coast,⁴ as well as the major port city of the La Romana province and the site of several resort hotels;⁵
- Wikipedia (wikipedia.org) identifies La Romana as the seventh largest city in the Dominican Republic located in the La Romana province. The Wikipedia entry describes La Romana as “hub for a growing tourist industry.”;⁶

³ The misspelling of La Romana as LAROMANA has little bearing on our Section 2(e)(3) analysis because a misspelling or variant of a geographic location is considered the equivalent of the actual name. *See In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1642 (TTAB 2011) (the primary significance of KUBA is Cuba).

⁴ September 22, 2016 Office Action (TSDR 6). References to the TSDR database are to the downloadable .pdf format.

⁵ *Id.* at 7.

⁶ *Id.* at 8. The Examining Attorney submitted another Wikipedia entry for the La Romana province in the July 12, 2017 Denial of Request for Reconsideration (TSDR 96) stating that La Romana is “the home to Casa de Campo, one the world’s largest resorts and golfing destinations.” TripAdvisor.com also identifies La Romana as the home to Casa de Campo and “internationally renowned golf courses.” *Id.* at 170.

- According to the La Romana Tourist Ports website (cdcports.com) more than 100 cruise ships visited La Romana’s port, including Carnival Cruise Lines, Aida Cruises, MSC Cruises, Tui Cruises, and Costa Cruises;⁷
- The Go Dominican Republic website (godominicanrepublic.com) identifies La Romana as “one of the country’s top visitor destinations.”;⁸
- Thirteen articles appearing in newspapers or the PR Newswire identify La Romana as a geographic location in the Dominican Republic;⁹
- Getty Thesaurus of Geographic Names Online (getty.edu) identifies La Romana as a city in the La Romana province of the Dominican Republic located on the Caribbean Sea.¹⁰

On the other hand, Applicant argues that the primary significance of the term “Laromana” is its English translation “The Roman,” not a geographic location.¹¹ According to Applicant, because Spanish is the second most widely spoken language

⁷ September 22, 2016 Office Action (TSDR 13).

⁸ *Id.* at 14.

⁹ October 17, 2016 Office Action (TSDR 6-30). The Examining Attorney submitted more than 50 additional articles in the July 12, 2017 Denial of Request for Reconsideration (TSDR 12-95) identifying La Romana as a city in the Dominican Republic.

¹⁰ December 17, 2016 Office Action (TSDR 5).

¹¹ In his September 27, 2016 “Voluntary Amendment,” Applicant submitted the translation of LAROMANA as “The Roman.” Although Applicant did not submit any evidence to prove that LAROMANA is a Spanish term that is translated into English as “the Roman,” the Examining Attorney accepted the translation statement and made it of record in the October 17, 2016 Office Action. Accordingly, we accept the translation of LAROMANA as “The Roman.”

in the United States, with an estimated 52.6 million people who speak the language, the primary significance of LAROMANA is not geographic.¹²

The above-noted evidence shows that La Romana is not an obscure place to reasonably informed consumers in the United States. *See In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985) (finding that Durango, Mexico is not an obscure place to reasonably informed non-Mexicans). Applicant's argument that the term LAROMANA is not primarily geographical because it has another meaning (i.e., The Roman) is not persuasive. "Because a term may have other meanings does not alter the primacy of its geographical significance." *In re Opryland USA Inc.*, 1 USPQ2d 1409, 1413 (TTAB 1986). Geographic significance must be evaluated in the context in which the mark is being used. *See In re Loew's Theatres, Inc.*, 226 USPQ at 867 (geographic descriptiveness or misdescriptiveness "must be determined as 'applied to the goods of the applicant'") (citation omitted); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1857 (TTAB 2014). While the term LAROMANA may have a different connotation depending on context, in the context of brown sugar, there is no allusion to the alternative meaning of "The Roman" particularly where, as here, the evidence regarding the meaning of LAROMANA as

¹² Applicant's Brief, p. 9 (6 TTABVUE 10). Applicant bases his argument on an article posted in the online version of the New York Post on June 29, 2015. June 19, 2017 Request for Reconsideration (4 TTABVUE 13). The URL for the New York Post article was provided in the text of the Request for Reconsideration. (4 TTABVUE 8). However, the New York Post article is probative only to show what has been printed, not the truth of what has been printed. *See Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010). Accordingly, Applicant's contention that Spanish is spoken by over 52 million people in the United States is not substantiated by the evidence of record. Also, there is no evidence of record that Spanish is the second most widely spoken language in the United States.

“The Roman” is so thin.¹³ See *Hollywood Lawyers Online*, 110 USPQ2d at 1858. In this case, the primary significance of LAROMANA used in connection with brown sugar is geographic. See *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1844 (TTAB 2012) (“A mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods.”).

- II. Is the consuming public likely to believe La Romana indicates the geographic origin of the brown sugar, when in fact the brown sugar does not come from La Romana?

“[T]he goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product.” *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (citing *Loew’s Theatres*, 226 USPQ at 868 (“The PTO’s burden is simply to establish that there is a reasonable predicate for its conclusion that the public would be likely to make the particular goods/place association on which it relies.”) and *Cal. Innovations*, 66 USPQ2d at 1855 (affirming the “reasonable predicate” standard)). To establish a goods/place association, the Examining Attorney may provide excerpts from telephone directories, gazetteers, encyclopedias, geographic dictionaries, the LexisNexis® database, or the results of an Internet search. See *Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1847. Thus, to make a goods-place association, the case law permits an inference that the consumer associates the product with the

¹³ The Examining Attorney correctly notes that there is no evidence that Applicant markets its brown sugar in association with any Roman imagery. Examining Attorney’s Brief (8 TTABVUE 8).

geographic location in the mark because that place is known for producing the product. *Les Halles De Paris J.V.*, 67 USPQ2d at 1541.

The Examining Attorney submitted the evidence listed below to show that consumers identify La Romana as a source of sugar:

- “La Romana,” The Columbia Gazetteer of the World (2016) (coubiagazetteer.org) lists sugarcane and sugarcane milling as an economic activity;¹⁴
- La Romana Tourist Ports website (cdcports.com) reports that the La Romana port has two berths: one for cruise ship operations and the export of sugar and one reserved exclusively for cruise ship operations;¹⁵
- The Go Dominican Republic website (godominicanrepublic.com) describes La Romana as “defined by sugar cane, golf, beaches and diving. To arrive, tourists drive past sprawling sugar cane fields.”;¹⁶
- The La Costa Destinations website (lacostadr.com) describes La Romana as “[k]nown for its sugar factories ... In fact, it’s the sugar that makes La Ramona and neighboring San Pedro de Macoris two of the leading Major League Baseball player producing towns.”;¹⁷

¹⁴ September 22, 2016 Office Action (TSDR 6).

¹⁵ *Id.* at 13.

¹⁶ *Id.* at 14.

¹⁷ *Id.* at 16.

- Thirteen articles appearing in newspapers or the PR Newswire associate La Romana with the sugar industry.¹⁸ While in most cases, the association between La Romana and sugar is made in passing (e.g., “This is a nonprofit hospital that caters primarily to Haitian migrant cane-cutters who work on the sugar cane plantations in surrounding La Romana.”),¹⁹ the following are more probative:
 1. The Washington Post (February 7, 2013) (“In the scruffy neighboring sugar-mill town of La Romana ...”);²⁰
 2. The New York Post (January 10, 2013) (“The 40-year-old resort was built by the local sugar barons who essentially built the entire town of La Romana. There are still around 25,000 Dominicans working for the local sugar mill.”);²¹
 3. Sunday News (Lancaster, Pennsylvania) (June 25, 2006) (“In the east, La Romana is not only known for sugar factories, but also for the Altos de Chavon artist colony featuring medieval architecture built in modern times and even more modern Euro-style cafes and restaurants.”);²² and

¹⁸ October 17, 2016 Office Action (TSDR 6-30). The Examining Attorney submitted more than 50 additional articles in the July 12, 2017 Denial of Request for Reconsideration (TSDR 12-95).

¹⁹ October 17, 2016 Office Action (TSDR 23).

²⁰ *Id.* at 13.

²¹ *Id.* at 21.

²² *Id.* at 28.

4. Associated Press Financial Wire (June 1, 2006) (leaders from Central America are “meeting this weekend in the coastal city of La Romana, which bills itself as the Dominican sugar capital” and sugar jobs are “still key to the identity in sugar growing areas like La Romana.”);²³
- The World Factbook by the Central Intelligence Agency identifies the Dominican Republic as having “long been viewed primarily as an exporter of sugar ... but in recent years the service sector has overtaken agriculture as the economy’s largest employer.”;²⁴
- The La Romana Direct website (laromanadirect.com) identifies La Romana as a city with nearly 200,000 inhabitants whose economy is driven by sugar and tourism;²⁵ and
- The Explore La Romana website (explorelaromana.com) explains that the local economy in La Romana “is greatly dependent on the Central Romana Corporation currently celebrating their 100th anniversary, whose sugar mill on the coast employs more than 25,000 locals.”²⁶

We find the above-noted evidence sufficient to establish a goods/place association (i.e., a reasonable predicate that the public will make the goods/place association). As noted above, La Romana is not an obscure location. The cited Gazetteer, CIA World Factbook, third-party websites touting La Romana as a tourist destination, and news

²³ *Id.* at 29.

²⁴ *Id.* at 34-35.

²⁵ July 17, 2017 Denial of the Request for Reconsideration (TSDR 120).

²⁶ *Id.* at TSDR 228.

articles published in various newspapers and wire services identify sugar as a principal crop. “The issue is not the fame or exclusivity of the place name, but the likelihood that a particular place will be associated with particular goods.” *Loew’s Theatres*, 226 USPQ at 868. Thus, the above-identified evidence establishes the goods/place association.

III. Would a substantial portion of the relevant consumers likely be deceived by LAROMANA’s misrepresentation of the goods/place association?

The materiality element reflects the deceptiveness requirement of Section 2(e)(3). *Cal. Innovations*, 66 USPQ2d 1853. “[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 services by the geographic meaning of the mark.” *Miracle Tuesday*, 104 USPQ2d at 1334 (quoting *In re Spirits Int’l, N.V.* 563 F.3d 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009)). In determining “materiality,” the Board looks to evidence regarding the probable reaction of purchasers to a particular geographic term when it is used in connection with the goods. *Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1850. Thus, the materiality element in cases involving goods may be satisfied under the following conditions:

- there is evidence showing that the place named in the mark is well known for the goods;
- the goods are a principal product of the place named in the mark;

- the goods are, or are related to, the traditional products of the place named in the mark; or
- the goods are an expansion of the traditional products of the place named in the mark.

Id. (citing *Cal. Innovations*, 66 USPQ2d at 1857).

In support of the refusal, the Office should submit evidence showing that the association between the goods and the geographic place would be a material consideration in a consumer's decision to purchase the goods. Searches that combine the place name with the name of the goods and terms such as "famous," "renowned," "well known," "noted for," "principal or traditional" may be useful to establish materiality. The stronger the connection between the geographic place and the goods, the more likely the misrepresentation will be a material one. *In re California Innovations, Inc.*, 66 USPQ2d at 1857 ("[I]f there is evidence that goods like applicant's or goods related to applicant's are a principal product of the geographical area named by the mark, then the deception will most likely be found material and the mark, therefore, deceptive." (quoting *In re House of Windsor*, 221 USPQ [53, 57 (TTAB 1983, recon. denied, 223 USPQ 191 (TTAB 1984)]).

Id. at 1850-51

Although the evidence demonstrates that sugar is a principal product of La Romana, the evidence does not demonstrate the consumers are interested in purchasing sugar from La Romana or that the origin of sugar has any role in their purchasing decision. We decline to draw an inference that the geographic misrepresentation is a material factor in the purchasing decision because such an inference must be based on a "heightened" association between the goods and the location. *In re Les Halles De Paris J.V.*, 67 USPQ2d at 1542 (the Patent and Trademark Office may raise an inference of materiality with evidence that the place

is famous as a source of the goods at issue). The evidence shows that sugar is a principal product of La Romana, but it does not rise to the level of showing that La Romana is famous or well-known for sugar.

Further, the record does not show what factors consumers consider when they purchase sugar or that the origin of the sugar plays a role in that decision. *See U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1542 (TTAB 2006) (“The record does not show that a material reason for a tourist’s choice of playing cards is that the cards were made or used in Las Vegas.”). Contrary to the Examining Attorney’s arguments, the evidence of record does not demonstrate that a significant portion, or any portion, of the relevant consumers would be influenced, let alone materially influenced, in the decision to purchase brown sugar by the geographic meaning of LAROMANA.²⁷

Decision: The refusal to register Applicant’s mark LAROMANA is reversed.

²⁷ Examining Attorney’s Brief (8 TTABVUE 17).