

This Opinion is Not a
Precedent of the TTAB

Mailed: September 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re A. ZETA S.R.L.

Serial No. 88300086
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John P. Murtaugh of Pearne & Gordon LLP
for A. ZETA S.R.L.

Erin Falk, Trademark Examining Attorney, Law Office 101,
Zachary R. Sparer, Managing Attorney.

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Before Wellington, Heasley, and English,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

A. ZETA S.R.L., an Italian limited liability company, (“Applicant”) seeks registration on the Principal Register of the standard character mark **PARMA COFFEE** (COFFEE disclaimed) for “chocolate; chocolate-based beverages; cocoa; cocoa-based beverages; coffee extracts; coffee and coffee substitutes; honey; honey substitutes; natural sweetener; sugar; tea; tea extracts; tea-based beverages; preparations for making coffee-based beverages” in International Class 30.¹

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¹ Application Serial No. 88300086 was filed on February 13, 2019, and is based on Applicant’s ownership of a foreign registration issued in the European Union, under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e).

The Examining Attorney refused registration to Applicant's mark on the ground that the proposed mark is primarily geographically descriptive of the identified goods, under Section 2(e)(2) of the Trademark Act (the "Act"), 15 U.S.C. § 2(e)(2).

When the refusal was made final, Applicant appealed. The appeal has been briefed.

We affirm the refusal to register.

I. Whether PARMA COFFEE is Primarily Geographically Descriptive – Analysis

The elements for proving that a mark is primarily geographically descriptive, and thus prohibited from registration on the Principal Register absent a showing of acquired distinctiveness,² under Section 2(e)(2) of the Act, are as follows:

- (1) The mark is the name of a place known generally to the public;
- (2) The goods for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to believe that the goods originate in the geographic place identified in the mark.

See In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Broken Arrow Beef & Provision, LLC*, 129 USPQ2d 1431, 1432 (TTAB 2019); *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, *5 (TTAB 2020).

² Applicant does not argue, nor has it alleged, that the proposed mark has acquired distinctiveness under Section 2(f) of the Act.

“[T]he presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary geographical significance of the mark as a whole.” *Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853-54 (TTAB 2014) (quoting *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars from Minnesota). Here, the disclaimed term COFFEE in Applicant’s proposed mark is generic for at least some of the goods identified in the application, i.e., “coffee and coffee substitutes.” Thus, the addition of the generic term COFFEE does not obviate any determination that proposed mark PARMA COFFEE is primarily geographically descriptive for the identified goods.

A. Is PARMA is a generally known place?

In its brief, Applicant “agrees that the Italian city of Parma is indeed well known for its architecture, music, art, ham and cheese,” but goes on to argue that Parma is “not [well known] for the goods claimed by applicant, that is, coffee, tea, cocoa, sugar, honey, etc.”³ The relevant inquiry under the first element, however, is whether PARMA is a generally known geographic location, and not whether PARMA is “known for” any of the identified goods.

In support of the refusal, the Examining Attorney submitted printouts from the Wikipedia online encyclopedia website describing Parma as “a city in the northern Italian region of Emilia-Romagna famous for its architecture, music, prosciutto

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(ham), cheese and surrounding countryside.”⁴ The Examining Attorney also attached an online dictionary entry for the city describing it as a “city of north-central Italy southeast of Milan.”⁵ The record shows that the primary meaning of Parma is to signify the city in northern Italy.

Accordingly, based on Applicant’s admission and the evidence, we find that the primary significance of PARMA is that of a generally known geographic location, namely, a well-known city in Italy.

B. Do Applicant’s goods originate from Parma?

As to the question of the identified goods’ origin, Applicant “confirm[ed] that the goods in question are being developed in Parma, Italy.”⁶ We further note that Applicant is an Italian corporation with an Italian address. Indeed, Applicant does not argue that the goods will not originate from Parma, Italy.

With Applicant’s admission of the goods being “developed” in Parma and with no evidence to the contrary, we find Applicant’s goods originate from Parma, Italy. *See In re Joint-Stock Co. “Baik,”* 80 USPQ2d 1305 (TTAB 2006) (BAIKALSKAYA – the Russian equivalent of “from Baikal” or “Baikal’s” – held primarily geographically descriptive of vodka, where the record showed that applicant was located in Irkutsk,

⁴ Printouts attached to May 10, 2019 Office Action, at TSDR pp. 2-13.

⁵ Printout from The Free Dictionary website, *id.*, at p. 14. Definition is based on AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition (2016). Additional dictionary entries describing the city in the same manner were also attached to September 17, 2020 Office Action, at TSDR pp.2-14.

⁶ Applicant’s November 8, 2019 response, at TSDR p. 2.

Russia, a city near Lake Baikal, and that applicant's vodka is made from the water of Lake Baikal).

C. Would consumers believe the goods originate from Parma?

Finally, we address whether purchasers would likely believe that the goods originate in Parma, Italy, i.e., make a "goods/place association." The USPTO needs to show "a reasonable predicate" for its conclusion that the public would be likely to make the particular association. *Newbridge Cutlery*, 113 USPQ2d at 1449 (quoting *In re Miracle Tuesday, LLC*, 695 F.3d 1339, 104 USPQ2d 1330, 1333 (Fed. Cir. 2012) (quoting *In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003))); *In re Loew's Theatres*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985) ("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.").

Where, as here, the geographic significance of a term is its primary significance and the geographic place is neither obscure, but rather well-known, for purposes of §2(e)(2), the goods/place association may be presumed from the fact that the applicant's goods originate in or near the place named in the mark. *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 1621 (TTAB 2007) (YOSEMITE BEER held geographically descriptive of beer produced and sold in a brewpub in Merced, California, the Board stating that "[s]ince the goods originate at or near [Yosemite National Park], we can presume an association of applicant's beer with the park."); *Joint-Stock Co. "Baik"*, 80 USPQ2d at 1310 (goods/place association presumed

“because applicant is located near Lake Baikal, in the city of Irkutsk.”); *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (“in addition to the fact that applicant’s services originate and are rendered in California, we think a services/place association can be presumed from the nature of the services and the particular geographical place named in the mark”); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982) (DENVER WESTERNS held primarily geographically descriptive of western-style shirts originating in Denver).

Accordingly, because Applicant’s goods are admittedly “developed” in Parma, Italy, we presume that there is a goods/place association amongst the consuming public.

We have considered Applicant’s argument that:⁷

it is clear that American purchasers would not be likely to make a goods-place association, that is, American purchasers would not be likely to believe that the goods originate in Parma, Italy, since the evidence irrefutably shows that the typical American consumer is aware that PARMA is a common trademark word used for all kinds of goods and services in America.

Applicant relies on 6 third-party registrations for the mark PARMA (or PARMA!) for various types of goods and services, including: hard wood flooring, flavorings and seasonings, restaurant services, faucets and shower heads, bath accessories, computer software, and fluid pumps.⁸ Applicant also points to its ownership of the

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⁸ Applicant submitted “hard” copies of the third-party registrations with its November 8, 2019 response, at TSDR pp. 2-16. These copies do not show the current status and title of the registrations. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (2021) provides that in order “to make a third-party registration of record, ... a copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration must be submitted.” The Examining

European Union registration for the same mark and goods, serving as the filing basis for the application at issue (see Note 1).⁹

With respect to the third-party registrations, as the Examining Attorney points out, they “do not appear facially to originate in the place named, but in any event, when determining whether an applied-for mark is eligible for registration, each application must be considered on its own record.” *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, including non-genericness, even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”). We agree with this analysis. As the Board has long and often held, each decision is decided on its own facts, and each mark stands on its own merits. *See In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017) (quoting *In re Boulevard Entm’t*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003)).

In addition, Applicant’s European Union registration of the proposed mark is irrelevant. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612 (TTAB 1991); *Bureau Nat’l Interprofessionnel Du Cognac v. Int’l Better*

Attorney did not object to these hard copies and discussed them in the September 17, 2020 Office Action (“Applicant argues in support of registrability inasmuch as a few registrations exist on the Principle for PARMA alone.”). Accordingly, the registrations are treated as stipulated into the record. *Id.*; *see also In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because the examining attorney addressed applicant’s registrations in her brief and neither objected to the discussion of the other, Board treated both registrations as though they are of record).

⁹ A copy of the registration was submitted with Applicant’s August 17, 2020 response, at TSDR pp. 2-4.

Drinks Corp., 6 USPQ2d 1610, 1618 (TTAB 1988) (“an applicant’s ownership of a foreign registration of its mark is immaterial to applicant’s right to register the mark in the United States”).

D. Conclusion

Because the primary significance of PARMA is a generally well-known geographical location, the goods at issue originate in Parma, Italy, and, therefore, we presume there is a goods/place association, we ultimately find that Applicant’s proposed mark PARMA COFFEE is primarily geographically descriptive of the goods, and must be refused registration on the Principal Register under Section 2(e)(2) of the Trademark Act.

Decision: The refusal to register Applicant’s proposed mark is affirmed.