

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 7, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re LANA GROSSA Mode mit Wolle Handels-und Vertriebs GmbH
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Application Serial No. 88807623
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Thomas L. Moses of Southeast IP Group, LLC,
for LANA GROSSA Mode mit Wolle Handels-und Vertriebs GmbH.

Amy Kertgate, Trademark Examining Attorney, Law Office 113
Myriah Habeeb, Managing Attorney.

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

Opinion by Bergsman, Administrative Trademark Judge:

LANA GROSSA Mode mit Wolle Handels-und Vertriebs GmbH (“Applicant”) seeks registration on the Supplemental Register of the mark FILATI (stylized), reproduced below, for “Knitting yarns; Thread; Yarn; all of the foregoing for textile use,” in International Class 23.¹

¹ Application Serial No. 88807623 was filed on February 24, 2020, under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), based upon Applicant’s European Trademark Office Registration No. 018020144, registered June 13, 2019.

FILATI

“The English translation of ‘FILATI’ in the mark is ‘yarn.’”² Applicant disclaimed the exclusive right to use the word “Filati.”³

The Examining Attorney refused to register FILATI (stylized) under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c), on the ground that the term FILATI is Italian for yarn and, therefore, is generic and incapable of registration. In addition, the Examining Attorney explained that the stylization was not sufficiently distinctive to justify registration:

The sole issue on appeal is whether the stylization in Applicant’s mark creates a separate and inherently distinctive commercial impression apart from the wording itself such that the mark as a whole is capable of identifying and distinguishing Applicant’s goods from the goods of others.⁴

Citations to the record refer to the USPTO Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf format. Citations to briefs refer TTABVUE, the Board’s online docket system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020).

² September 9, 2020 Response to Office Action (TSDR 2 and 3).

³ May 21, 2021 Response to Office Action (TSDR 1). The Examining Attorney made a note to the file on June 21, 2021, to delete the disclaimer pursuant to TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 1213.06 (2022) (“Entire Mark May Not Be Disclaimed”). However, as discussed below, Applicant contends the stylization of the term “Filati” creates a distinct commercial impression capable of registration. In addition, Applicant, in its brief, notes that it disclaimed the exclusive right to use the word “Filati.” Applicant’s Brief, pp. 4 and 6 (4 TTABVUE 5 and 7). Therefore, we do not consider the disclaimer deleted.

⁴ Examining Attorney’s Brief (6 TTABVUE 4).

I. Preliminary Issue

Before proceeding to the merits of the refusal, we address two preliminary issues.

First, as noted above, there are two issues on appeal:

- Whether “Filati” is generic; and
- Whether the stylized lettering of Applicant’s mark is presented in a distinctive display capable of creating a commercial impression separate and apart from the word “Filati.”

Second, because Applicant is seeking registration of its stylized FILATI mark on the Supplemental Register with a disclaimer of the exclusive right to use the word “Filati,” Applicant has conceded that “Filati” is generic. *See In re Consumer Protection Firm PLLC*, 2021 USPQ2d 238, at *23 (TTAB 2021) (“Applicant disclaimed FIRM.COM on the Supplemental Register and therefore has conceded it is generic.”) (citing *In re Volvo White Truck Corp.*, 16 USPQ2d 1417, 1420 (TTAB 1990) (“Applicant has ... conceded that the generic term for an over-the highway tractor equipped with sleeping compartment is ‘sleeper’, and has disclaimed that term.”)); *In re Haden*, 2019 USPQ2d 467424, at *5 (TTAB 2019) (“Generic matter must be disclaimed to permit registration on the Supplemental Register.”) *In re Carolyn’s Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980) (“Section 6 of the Trademark Act of 1946, which provides for the disclaimer of ‘unregistrable matter’, does not limit the disclaimer practice to marks upon the Principal Register.”).

However, because both Applicant and the Examining Attorney treat whether the word “Filati” is generic as being at issue, we will treat it as such.

II. Whether “Filati” is a generic term for yarn.

A. Applicable Law

“A generic name—the name of a class of products or services—is ineligible for federal trademark registration.” *USPTO v. Booking.com B.V.*, 591 U.S. ___, 140 S. Ct. 2298, 2020 USPQ2d 10729, at *2 (2020). A generic term “is the common descriptive name of a class of goods or services.” *Royal Crown Co., Inc. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term to be protected to refer to the genus of goods or services in question.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *Marvin Ginn*, 228 USPQ at 530).

The Federal Circuit has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) of goods or services at issue? Second, does the relevant public understand the term sought to be registered primarily to refer to that genus of goods or services? *Marvin Ginn*, 228 USPQ at 530. The relevant public’s perception is the chief consideration in determining whether a term is generic. *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1833 (Fed. Cir. 2015). We may obtain evidence of the public’s understanding of a term from “any competent source, such as consumer surveys, dictionaries, newspapers and other publications.” *Id.* at 1830 (quoting *In re*

Northland Aluminum Prods., Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)).

B. The genus of the goods.

With respect to the first part of the *Marvin Ginn* inquiry, we may define the genus by the products identified in the application: “knitting yarns; thread; yarn; all of the foregoing for textile use.” See *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (finding the description of services properly defined the genus of the services); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration).⁵ In this appeal, “knitting yarns; thread; yarn; all of the foregoing for textile use” is an accurate description of the genus of goods.

C. The relevant public.

The second part of the *Marvin Ginn* test is does the relevant public understand the term sought to be registered primarily to refer to that genus of goods? The relevant public is the purchasing public for the identified goods. *Sheetz of Del., Inc. v.*

⁵ The Examining Attorney agrees the description of goods defines the genus of the goods. Examining Attorney’s Brief (6 TTABVUE 5). Applicant agrees that “[a] mark is generic if its primary significance to the relevant public is the class of category of goods or services in connection with which it is used.” Applicant’s Brief, p. 3 (4 TTABVUE 4).

Doctor's Assocs. Inc., 108 USPQ2d 1341, 1351 (TTAB 2013). In this case, the relevant public consists of ordinary consumers who purchase yarn and thread.⁶

D. How the relevant public perceives “Filati.”

We now turn to how the relevant public perceives the term “Filati” when they see it used in connection with thread and yarn. We start our analysis by defining the term “Filati.” In addition to Applicant translating the word “Filati” as the Italian word for yarn, the Linguee website (linguee.com) also defines “Filati” as the Italian word for yarns.⁷

The Wikipedia.org entry for “Pitti Immagine” defines “Pitti Immagine” as “a collection of industry events in Italy.”⁸ “Pitti Immagine Filati” is listed as a subcategory and is defined as “knitting yarn collections. In Florence, at the Fortezza da Basso, two editions per year.”⁹

The Knitting Industry website (knittingindustry.com) identifies “Pitti Filati” as “[t]he key international event feature the world of yarns for the knitting industry.”¹⁰

⁶ The Examining Attorney agrees “the relevant public comprises ordinary consumers who purchase applicant’s goods.” Examining Attorney’s Brief (6 TTABVUE 5). Applicant agrees that “[t]he relevant public for a genericness determination refers to the purchasing or consuming public for the identified goods and/or services.” Applicant’s Brief, p. 4 (4 TTABVUE 5).

⁷ November 30, 2020 Office Action (TSDR 17). *See also* the Google Translate website (translate.google.com) (“filati” is the Italian word for yarn). *Id.* at TSDR 20.

⁸ November 30, 3030 Office Action (TSDR 37).

⁹ *Id.*

¹⁰ *Id.* at TSDR 40.

The exciting and engaging rendezvous brings together the novelties, excellence and creativity of the international yarn industry.¹¹

See also the Women's Wear Daily website (wwd.com) (July 3, 2019) reporting on the Pitti Filati for Fall 2020 ("Pitti Filati Spotlights Cozy, Voluminous and Colorful Yarns");¹² The New York Times (April 30, 2015) ("Pitti Filati, which takes place in Florence Italy. It is a yarn fair, not a fabric fair.").¹³

U.S. consumers of yarn will translate the word "Filati" to the English word "yarn" when "Filati" is used in connection with yarn, and thus, U.S. consumers will perceive it as a generic term.

Applicant argues to the contrary, contending that there is no evidence U.S. consumers will translate the Italian word "Filati" into the English word "yarn."¹⁴ While conceding that "words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule, but merely a guideline."¹⁵

Under the doctrine of equivalents, the foreign equivalent of a merely descriptive English word is no more registrable than the English word itself. "[A] word taken from a well-known foreign modern language, which is, itself, descriptive of a product,

¹¹ *Id.*

¹² *Id.* at TSDR 22-23.

¹³ May 20, 2020 Office Action (TSDR 39).

¹⁴ Applicant's Brief, p. 6 (4 TTABVUE 7).

¹⁵ *Id.* at p. 8 (4 TTABVUE 8) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005).

will be so considered when it is attempted to be registered as a trade-mark in the United States for the same product.” *In re N. Paper Mills*, 64 F.2d 998, 17 USPQ 492, 493 (CCPA 1933). See *In re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB 2008) (AYUMI and its Japanese-character equivalent held merely descriptive for footwear where the evidence, including applicant’s own admissions, indicated that the primary meaning of applicant’s mark is “walking”); *In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986) (Chinese characters that mean ORIENTAL DAILY NEWS held merely descriptive of newspapers); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985) (SAPORITO, an Italian word meaning “tasty,” held merely descriptive because it describes a desirable characteristic of applicant’s dry sausage).

The doctrine should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. See *Palm Bay Imps.*, 73 USPQ2d at 1696; see also *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 (TTAB 2016) (noting that the doctrine of foreign equivalents applies even when the foreign wording in the mark will appear with its English equivalent, because ordinary purchasers will still recognize the terms as equivalents due to the provided translation).

“The ‘ordinary American purchaser’ in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language. . . . [Defining “ordinary American purchaser” as the “average American buyer”] would write the doctrine out of existence.” *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006). The “ordinary American purchaser” includes “all American purchasers, including those

proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see also In re Highlights for Children*, 118 USPQ2d at 1271 (“The ‘ordinary American purchaser’ is not limited to those purchasers who speak only English.”).

Because the Pitti Filati is the premier international yarn event covered by websites and publications in the United States, U.S. consumers, particularly those with knowledge of Italian, will tend to translate the word “Filati” into “yarn” when encountering it in connection with yarn products.

We find that the Italian word “Filati” is a generic term for yarn.

III. Whether the stylized lettering of Applicant’s mark is a distinctive display capable of creating a commercial impression separate and apart from the word “Filati.”

Our finding that the Italian word “Filati” is a generic term for yarn is not

dispositive of whether Applicant’s stylized drawing **FILATI** is registrable.

A stylized drawing may be registrable even when the word itself, taken alone is not:

Although an entire mark cannot be disclaimed and also registered, nevertheless where the unregistrable components of a mark are presented in a distinctive display, it is possible to disclaim the unregistrable components and still have a mark which is registrable as a whole. *See: In re Carolyn’s Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980), and cases cited therein, and *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984). Whether a particular mark of this type is registrable, and, if so, upon which register, are questions that must be determined on the basis of the character of the mark sought to be

registered along with the other facts and circumstances in the case.

In re Miller Brewing Co., 226 USPQ 666, 668 (TTAB 1985).

Miller Brewing sought to register the disclaimed word LITE in the stylized form reproduced below for beer:



The Board held that the stylized version of the word “Lite” was registrable, in part, because the stylized version of the word “Lite” on Miller Brewing’s label is “most likely to make an impression upon and be remembered by, purchasers” and Miller Brewing’s “configuration of the word ‘LITE’ is distinctly different from and, in our opinion, more unique, than the ‘LITE’ configurations known by applicant to have been used by its competitors.” *Miller Brewing*, 226 USPQ at 670.

Likewise, *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (CCPA 1977), Wella Corp. applied to register, on the Supplemental Register, the stylized lettering of the disclaimed word “Balsam” for hair care products as reproduced below, the court found the stylization was so distinctive that it formed a commercial impression separate and apart from the word itself.

balsam

Finally, applicant in *In re Clutter Control Inc.*, 231 USPQ 588 (TTAB 1986), applied to register the stylized term “Construct-A-Closet,” reproduced below, for components used to construct personal storage systems, namely, panels, shelves, rods, rod cups, shelf clips, and angle brackets.”



CONSTRUCT-A-CLOSET

The Board held that the mark was registrable because “the tubelike rendition of the letter ‘C’ in the words ‘construct’ and ‘closet’ make a striking commercial impression, separate and apart from the word portion of applicant’s mark.” *Id.* at 589-590.

In the appeal before us, Applicant’s drawing depicts the Italian word “Filati” in nondescript Elephant font that reflects very little stylization, unlike the stylization in the examples discussed above. *See generally In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1487 (TTAB 2012) (common and prosaic lettering with minimal stylization unlikely to make impression on purchasers). In *Sadoru*, applicant applied to register the stylized drawing of the disclaimed word “Sadoru,” reproduced below, for motorcycle seats:



The Board affirmed the refusal to register the mark finding “the stylization of the lettering in which SADORU appears does not create a separate and inherently distinctive commercial impression apart from the word itself.” *Id.* at 1490. Likewise, here, we find that the stylization of Applicant’s purported mark FILATI does not create a separate and in inherently distinctive commercial impression apart from word itself.

Applicant argues to the contrary, likening its mark to the stylization of the disclaimed geographic designation “Jackson Hole,” reproduced below:¹⁶



The Board found that the display of the mark created distinct commercial impression because the letters JH were twice the size of the other letters, the letters J and H were partly joined together creating the visual impression of a monogram, and the positioning of the letters J and H below the other letters had the effect of highlighting

¹⁶ Applicant’s Brief, p. 5 (4 TTABVUE 6).

them. *In re Jackson Hole Ski Corp.*, 190 USPQ 175, 176 (TTAB 1976). None of those characteristics of the JACKSON HOLE mark or similar variations of those characteristics appear in the stylized mark **FILATI**. As discussed above,

the Applicant's stylization is nondescript. *See In re Anchor Hocking Corp.*, 223 UPSQ 85 (TTAB 1984) (**MICROWAVE TURNTABLE** with disclaimers of "Microwave" and "Turntable" refused registration because MICROWAVE TURNTABLE is "displayed in a plain block style lettering which is obviously not unique" and neither is the positioning of the words).

The stylized display of the purported FILATI mark does not create a distinct commercial impression separate and apart from the word itself. Therefore, Applicant's purported stylized mark FILATI is a generic term and not subject to registration on the Supplemental Register.

Decision: We affirm the refusal to register Applicant's purported stylized mark FILATI on the ground that it is a generic term and not subject to registration.