

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

Mailed: December 11, 2009

Cancellation No. 92048266

Marquez Brothers
International, Inc.

v.

Zucrum Foods, L.L.C.

Before Bucher, Cataldo and Mermelstein,
Administrative Trademark Judges

By the Board:

Zucrum Foods, L.L.C. ("respondent") is the record owner of a registration for the mark AZUCAR MORENA in typed form for "unrefined sugar; brown sugar; molasses" in International Class 30.¹

Pursuant to the Board's March 11, 2009 order, Marquez Brothers International, Inc. ("petitioner"), on April 10,

¹ Registration No. 2476161, issued August 7, 2001, Section 8 and 15 declaration accepted and acknowledged. The registration includes a disclaimer of AZUCAR and a statement that "[t]he English translation of 'AZUCAR MORENA' is 'sugar beautiful dark-complexioned brunette Latin girl.'"

In the drawing that was filed in the application for the involved registration, the mark was set forth as AZUCAR MORENA in stylized form. During the prosecution of the statement of use in that application, respondent, by examiner's amendment, amended the drawing page to display the mark in typed form as AZÚCAR MORENA having a diacritical mark above the letter "U." However, the registration issued with the mark displayed as AZUCAR MORENA in typed form, apparently because use of the foreign character "Ú" was not then permitted for typed form marks. See TMEP Section 807.09 (2d ed. rev. 1997). We do not consider this difference of any legal significance in this case. See also footnote 3.

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2009, filed a second amended petition to cancel such registration. The second amended petition to cancel is accepted as the operative complaint herein.

In the second amended petition to cancel, petitioner seeks cancellation of respondent's registration on grounds that: (1) the involved registered mark is Spanish wording that is generic for "brown sugar"; and (2) during *ex parte* examination of the application for the involved registration, respondent committed fraud upon the USPTO by making false statements regarding the meaning of the involved mark; and (3) in both the statement of use and the declaration under Trademark Act Sections 8 and 15, 15 U.S.C Section 1058 and 1065, in the involved registration, respondent committed fraud upon the USPTO by making false statements regarding use of the registered mark on molasses.

This case now comes up for consideration of the following motions: 1) petitioner's renewed motion (filed April 10, 2009) for summary judgment on the grounds of genericness and fraud; 2) respondent's consented motion (filed May 14, 2009) to extend time in which to respond to petitioner's motion for summary judgment; and 3) respondent's renewed cross-motion (filed June 1, 2009) for summary judgment in its favor on the pleaded genericness

claim.² The cross-motions for summary judgment have been fully briefed.³

Respondent's consented motion to extend time to respond to petitioner's renewed motion for summary judgment and to file an answer to petitioner's second amended petition to cancel is granted. Respondent's brief in response to petitioner's renewed motion for summary judgment and answer to the second amended petition to cancel are accepted as timely filed.⁴

We turn now to the parties' renewed cross-motions for summary judgment on petitioner's pleaded genericness claim. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining

² In view of the filing of the renewed cross-motions for summary judgment, the parties' original motions for summary judgment will receive no consideration.

³ In petitioner's briefs, petitioner consistently refers to the registered mark as "AZÚCAR MORENA." Throughout respondent's briefs, respondent refers to its registered mark as "Azucar Morena," while packaging for respondent's goods displays the registered mark as both "AZUCAR MORENA" and "AZÚCAR MORENA." Inasmuch as respondent does not contend that the minimally different spellings create a different commercial impression, we will treat the different spellings as creating the same overall commercial impressions.

⁴ In that answer, respondent denied the salient allegations of the second amended petition to cancel.

for trial and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an

affidavit by a knowledgeable affiant." *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 941, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

There are two steps in determining whether a mark is generic: (1) What is the genus of goods or services at issue? and (2) Is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services? See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The foreign equivalent of a generic English word is no more registrable than the English language term. See *In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986). When a registered term is generic for one or more of the goods identified in a registration, that registration may be cancelled in its entirety. See *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988).

With regard to the first step of such inquiry, respondent argues at length and submits considerable evidence in support of its position that AZUCAR MORENA is not generic because the products sold under its registered mark are azúcar estándar, an unrefined sugar, which is not brown sugar, as commonly understood in the United States.⁵

⁵ Such evidence includes the declaration of respondent's president and CEO Jorge de la Vega ("the de la Vega declaration"), who avers to information surrounding the

However, we find that the genus of goods at issue is determined by respondent's chosen identification of goods in its involved registration, i.e., "unrefined sugar; brown sugar; molasses."⁶ See *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1654 (TTAB 2005).

It is well-settled that registrability of a mark must be decided on the basis of the identification of goods set forth in the registration, regardless of what the record may reveal as to the particular nature of a respondent's goods and the particular channels of trade or the class of purchasers to which the sales of goods are directed. Accordingly, we must consider respondent's goods based on their identification in the involved registration and cannot read any limitations into those goods, as respondent wishes. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d

manufacture and marketing of goods under the involved mark and differences between various types of sugars, which makes of record: (a) photographs of product packaging for respondent's goods; (b) excerpts from the Mexican Refined Sugar Standards, and (c) an invoice dated September 9, 2008 for a sale of sugar from respondent to petitioner.

⁶ In any event, respondent's assertion in its brief in opposition to petitioner's motion for summary judgment and in support of its cross-motion for summary judgment that "'brown sugar' is a product type [that] ... is virtually unknown in Mexico" is contradicted by the excerpts from Mexican Refined Sugar Standards that respondent submitted as Exhibit E to the de la Vega declaration. That bibliography in that document refers to "[d]eterminación de color en azúcar morena," "[d]eterminación de cenizas sulfatadas en azúcar morena," and "[d]eterminación de cenizas por conductividad en azúcar morena." The accompanying translation of these phrases states that these phrases mean "[d]etermination of color in brown sugar," "[d]etermination of sulfated ash in brown sugar," and "[d]eterminación de cenizas por conductividad in brown sugar." (sic).

1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Because respondent's registration describes its goods as "unrefined sugar; brown sugar; molasses," and there is no limitation as to the nature or type thereof, we must presume that the registration encompasses all goods of the type described. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Thus, the goods in respondent's registration must be presumed to include all types of "unrefined sugar," "brown sugar," and "molasses."

Regarding the second part of our inquiry, a determination of the public's understanding of a mark is based on consideration of the mark as a whole. See *In re Steelbuilding.com*, 75 USPQ2d 1420 (Fed. Cir. 2005). Evidence of the relevant public's understanding can be obtained from any competent source, including dictionaries, newspapers, magazines, trade journals and other publications. See *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985).

Because the wording at issue in this proceeding is in Spanish, the next question is whether the doctrine of foreign equivalents applies. The Federal Circuit has discussed the applicability of the doctrine of foreign equivalents in trademark cases:

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks...

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline...

The doctrine should be applied only when it is likely that the ordinary American purchaser would 'stop and translate [the wording] into its English equivalent.' *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976).

Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). In a case involving a foreign language mark, the "ordinary American purchaser" refers to the ordinary American purchaser who is knowledgeable in both English and the foreign language at issue. *In re Peregrina Limited*, 86 USPQ2d 1645 (TTAB 2008). See also *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006).

Petitioner contends that registered mark is Spanish wording which means "brown sugar"; that, to American purchasers who are familiar with Spanish, the phrase "azúcar morena" is generic as applied to brown sugar; that, in response to respondent's discovery requests, petitioner produced examples of generic use of "azúcar morena" in connection with brown sugar, including excerpts from websites, online grocers, and recipes; that, in response to

petitioner's interrogatories, respondent stated that "morena" describes the color of its sugar; that alternative meanings of "azúcar morena" outside of the context of sugar are irrelevant to this action; and that respondent uses the term generically in literature and recipes on its website. Based on the foregoing, petitioner contends that the genericness claim is ripe for determination on summary judgment and that complete cancellation of respondent's involved registration is warranted.

Petitioner's evidence in support of its motion includes (1) the declaration of Tracy Calk, an employee of the law firm of petitioner's attorney, which makes of record copies of the following: (a) excerpts from Spanish-English dictionaries⁷ and Internet translation programs⁸ which indicate that "azúcar morena," and its masculine formative "azúcar moreno," translate to "brown sugar"; (b) excerpts from Internet websites and cookbooks which provide Spanish language recipes which include "azúcar morena," or its masculine equivalent, "azúcar moreno," as an ingredient and

⁷ Such dictionaries include *Cassell's Spanish Dictionary* (1959 ed.); *Vox New College Spanish and English Dictionary* (1989 ed.); *Larousse Spanish Dictionary* (year unspecified); *English-Spanish Dictionary of Health Related Terms* (3d ed. 2005).

⁸ Such online translation programs include translate.google.com, www.wordreference.com, dictionary.reverso.net, www.babylon.com, www.iberianature.com, www.spanishdict.com, ultralingua.com, education.yahoo.com, www.freedict.com, and www.zimbio.com.

English translations of those recipes;⁹ and (c) an excerpt from the website of the online grocer www.splendaespanol.com which shows generic use of "azúcar morena," or its masculine equivalent, "azúcar moreno" for brown sugar; (2) respondent's responses to petitioner's first set of interrogatories;¹⁰ and (3) the declaration of Kathleen Latourneau, petitioner's attorney, which makes of record: (a) copies of packaging for respondent's goods, which shows inconsistent use of "azúcar morena";¹¹ (b) excerpts from respondent's website, www.zulka.com;¹² and (c) translations

⁹ Such recipes, which call for various quantities of "azúcar morena," are taken from the following sources: www.micocinalatina.com ("Las Originales Galletas con Chocolate de Nestlé Toll House"); chefdenais.blogspot.com ("Cheesecake de Calabaza"); S. Verti, *La Costeña, Tradiciones Mexicanas* 216 (1992) ("Pure 'Belén' de Manzanas").

¹⁰ As noted *supra*, respondent was asked in interrogatory no. 5 to describe its efforts to research the definition of the wording in its involved registered mark. In that response, respondent stated as follows: "The word azucar in Spanish means sugar. The word moreno in Spanish means brown. The phrase 'Azucar Morena' refers to a beautiful dark-complexioned brunette Latin girl, and also describes the sugar color." Respondent was asked in interrogatory no. 12 to identify the types of goods offered or sold under the involved mark. In that response, respondent included "brown sugar (sugar which is brown in color)" among those goods.

¹¹ In its product packaging, respondent uses "AZÚCAR MORENA" both with and without a trademark registration symbol and uses the wording "azúcar morena" in lower case letters as an ingredient in a recipe for almond cake that is included on that product packaging.

¹² The website includes a page entitled "Mamá de Hoy," which translates to "Today's Mom" or "Mother of Today." The text of that page states in relevant part that "Zulka es las azucar morena que llega a ti bajo estrictos controles de calidad..." This passage translates to "Zulka is the brown sugar that arrives under strict quality controls...." Respondent's website also

of Spanish text therefrom which is obtained from translate.google.com and babelfish.yahoo.com.

In response to petitioner's motion and in support of its cross-motion, respondent contends that brown sugar is often known in Spanish by the adjectives "rubio, terciado, negro" and the masculine "moreno," all of which lack the connotation of a "lovely young brunette girl of Latin heritage" that respondent's mark connotes; that "morena" is understood in the Latin community to refer to "a lovely tanned brunette girl of Latin heritage; that the preferred Spanish translation for "brown sugar" is "azúcar terciado," with the secondary translation being "azúcar moreno" using the masculine gender; that several pending applications and current registrations use the term "morena" to refer to a "dark-complexioned brunette girl of Latin heritage"; and that the USPTO previously determined that respondent's mark is arbitrary. Accordingly, respondent asks that the Board deny petitioner's motion for summary judgment and instead grant its cross-motion for summary judgment on petitioner's pleaded genericness claim.

Respondent's evidence includes: the Dunbar declaration, which makes of record copies of: (a) excerpts from www.google.com, which show respondent's goods offered for sale; (b) definitions from www.urbandictionary.com,

includes a recipe for "Cheesecake de Mango," in which "azucar

which indicate that "morena" refers to dark-haired or dark-skinned women; (c) excerpts from online translation programs, which indicates that "azúcar terciado" translates to "brown sugar;"¹³ (d) Wikipedia entries for Morena, India, the vocal group Azúcar Morena, and (e) excerpts from social networking websites in which various women refer to themselves as "azúcar morena"; and (e) an excerpt from Williams, *The Bantam New College Spanish & English Dictionary*, in which "brown sugar" is translated into Spanish only as "azúcar terciado."

Based on the evidence of record, we find that petitioner has made a *prima facie* showing that that there is no genuine issue of material fact that the Spanish term "azúcar morena" directly translates to the English term "brown sugar," one of the products identified in respondent's involved registration.¹⁴ In this case, the foreign language is Spanish, "one of the common, modern languages of the world," which is presumed to be spoken or understood by an appreciable number of U.S. consumers for the goods at issue. *In re La Peregrina Ltd.*, 86 USPQ2d at 1648. Because Spanish terms are so ubiquitous and the

morena" (sic) is recited as an ingredient.

¹³ Such excerpts are obtained from www.spanishdict.com, dictionary.reverso.net, and education.yahoo.com.

¹⁴ Indeed, as noted *supra*, in the Mexican Refined Sugar Standards excerpts that respondent submitted, the wording "azúcar morena"

language is spoken by many people in the United States, there is no genuine issue of material fact that many ordinary American purchasers will "stop and translate" the words AZUCAR MORENA and that, in doing so, they will immediately understand that the term refers to the genus of respondent's goods. *Id.*

The burden now shifts to respondent to demonstrate the existence of genuine issues of material fact that must be resolved at trial. Respondent's arguments and evidence in support of its assertion that AZUCAR MORENA is not generic because "azúcar morena" or "morena" standing alone can, in another context, refer to a dark-skinned or brunette Latina, are insufficient to create a genuine issue of material fact as to the genericness of "azúcar morena" in the context of respondent's goods. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). We consider the meaning of the mark in the context of the identified goods, and not in the abstract. Thus, use of "Azúcar Morena" as the name of female vocal group and to describe certain women on social networking websites does not make that wording any less generic when it is considered in the context of respondent's goods. See *Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d 1473 (TTAB 2008) (GUANTANAMERA found primarily geographically deceptively misdescriptive of

is used generically three separate times and is translated to

"tobacco, namely cigars" under Trademark Act Section 2(e)(3), 15 U.S.C. Section 1052(e)(3), notwithstanding use of "Guantanamera" as the title of a Spanish language folk song and to identify a female from the city or province of Guantanamo, Cuba).

Even if respondent uses its mark in combination with a design of an attractive dark-haired female on some, but not all, of its product packaging, we note that the mark in the drawing is in typed form, which covers any reasonable presentation of the wording in question, and does not include a design element. See *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999). Moreover, a determination of genericness is based on the perception of the relevant public, as opposed to the trademark owner's intended connotation. See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 228 USPQ at 530. The evidence of record makes clear that the common perception of respondent's mark is in reference to the genus defined by respondent's goods.

Respondent asserts that the involved mark is arbitrary because an examining attorney allegedly so determined in a September 11, 2008, office action in which respondent's involved registration was cited against a third-party's pending application. Even if the citation of respondent's

"brown sugar." See the de la Vega declaration, exhibit E.

registration could be considered a "determination" of validity,¹⁵ it is well-settled that determinations made by examining attorneys are not binding on the Board and have no precedential value. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Accordingly, the office action in question has no bearing upon our decision.

We are likewise not persuaded by respondent's assertion that its mark is not generic because there are other generic terms which translate to "brown sugar." Even if we assume, as respondent argues, that the goods at issue could also be identified as "azucar terciado," "azucar rubio," "azucar negro," and other terms, a product may have more than one generic name, none of which is registrable. See *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970). The question is not whether a term is more frequently chosen colloquially than any of its synonyms, but whether that term retains its generic meaning. See *S.S. Kresge Company v. United Factory Outlet, Inc.*, 202 USPQ 545 (1st Cir. 1979).

Likewise, the third party registrations and applications which show use of the word MORENA as referring

¹⁵ In fact, no such determination is made by an examining attorney when citing a prior registration as a ground for refusal. The validity of the prior registration is not before the examining attorney, and the prior registration must be presumed valid. Trademark Act Section 7(b), 15 U.S.C. Section 1057(b). An *ex parte* proceeding offers no opportunity (for either the applicant

to a dark-skinned or brunette Latina upon which respondent relies are insufficient to create a genuine issue of material fact regarding petitioner's genericness claim. In particular, none of the marks in those applications and registrations include the phrase "AZUCAR MORENA" or "AZÚCAR MORENA." Moreover, each case must be decided on its own facts and the Board is not bound by prior decisions involving different records. See *In re Nett Designs, Inc.*, 57 USPQ2d at 1566; *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986). A generic term should not remain registered simply because other such marks appear on the register. See *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

Based on the foregoing, we conclude that there is no genuine issue of material fact that purchasers would understand the wording "azucar morena" as referring to the genus to which applicant's goods belong, including brown sugar. Accordingly, we find that there is no genuine issue of material fact that such wording is generic for the goods at issue. In view thereof, petitioner's motion for summary

or the examining attorney) to question the validity of a prior registration.

judgment on its genericness claim is granted, and respondent's cross-motion for summary judgment is denied.¹⁶

Finally, we note that, to prevail in this proceeding, petitioner must establish not only a valid ground for denying the registration sought, as it has, but must also establish that there is no genuine issue of material fact as to its standing. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Petitioner alleges in paragraphs 1-3 of the second amended petition to cancel that it sells brown sugar imported from Mexico and that it has received letters from respondent in which respondent, citing the involved registration, asserted ownership of the phrase "azúcar morena" for use on or in connection with brown sugar, demanded that petitioner cease use of "azúcar morena," and threatened legal action. The de la Vega declaration that respondent submitted, wherein respondent's president and CEO avers that petitioner is a "long-time customer" of respondent who has purchased sugar products bearing the AZUCAR MORENA mark for ten years, and respondent's response to petitioner's interrogatory no. 14, in which respondent states that it "has sent or communicated cease and desist requests" to various parties, including petitioner, are sufficient to establish petitioner's

¹⁶ Accordingly, we need not reach petitioner's motion for summary judgment with regard to its various fraud allegations.

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standing. See *id.*; *IpcO Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988).

In view thereof, the petition to cancel is hereby sustained, and judgment is hereby entered against respondent. Registration No. 2476161 will be cancelled in due course.