

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 6/29/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Order Sons of Italy in America
v.
Richard Callisi

Opposition No. 99,992
to application Serial No. 74/633,337
filed on February 13, 1995

Joseph Scafetta, Jr. for Order Sons of Italy in America.
Richard Calissi, pro se.

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Richard Calissi to
register the mark GOODFELLAS and design shown below

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for services which were subsequently identified by amendment as "entertainment services, namely, live performances by a musical group."¹

Registration has been opposed by the Order Sons of Italy in America under Section 2(a) of the Trademark Act. As grounds for opposition, opposer alleges that since its founding in 1905, it has provided fraternal assistance, moral support and entertainment services to its Italo-American members through approximately 2700 lodges in the United States and Canada; that at many of the lodges, live entertainment is provided; that the Commission for Social Justice (CSJ) is a separate corporate entity of opposer which works to eradicate bias, bigotry and prejudice against Italo-American citizens; that opposer, through the CSJ, has worked to eliminate the use of the terms "Mafia", "Cosa Nostra", and "Goodfellas" in reference to Italo-Americans; that "Goodfellas" is a code word used by organized criminals to refer to each other; that a synonym for "goodfellas" is "mafioso" which refers to members of the "Mafia", also known as "Cosa Nostra"; that the term "Goodfellas" became generally known throughout the United States and Canada for its criminal meaning when the movie of the same name was released in 1990; that opposer and the CSJ object to use of the term "Goodfellas" beyond its meaning and description of

¹ Application Serial No. 74/633,337 filed February 13, 1995;

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a small group of organized criminals both in Italy and America; that "Goodfellas" is a word detested by most law-abiding Italians and Italian Americans, and to call an honest Italian or Italian American "goodfellas", i.e., members of the Mafia or Cosa Nostra, is considered a grave insult that disparages the character and damages the reputation of the individual by labeling him or her a criminal; and that the mark "GOODFELLAS" and design, when used in connection with the identified services, disparages the members of opposer, and brings opposer as an institution into contempt or disrepute.

Applicant, in an amended answer, denied the allegations of the notice of opposition.

The record consists of the file of the involved application and the trial testimony, with exhibits, of opposer's witnesses John G. Spatuzza, Vincent S. Romano, Gabriel Bevilacqua, and Augustus Accurso². Applicant took no testimony and offered no other evidence.³ Only opposer filed a brief and no oral hearing was requested.

alleging dates of first use of January 17, 1994.

² We note that opposer submitted under notice of reliance a list of the depositions and accompanying exhibits. This was unnecessary, however, inasmuch as the depositions and exhibits, at the time of filing with the Board, automatically became part of the record herein. See Trademark Rule 2.123(h).

³ We should point out that accompanying applicant's original answer were copies of excerpts taken from dictionaries and a book. These materials, however, do not form part of the record herein. See Trademark Rule 2.122(c).

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The record shows that the Order Sons of Italy in America was established in 1905. There are approximately 2700 existing lodges with about 450,000 family memberships throughout the United States. During the course of testimony, opposer introduced a copy of a study prepared by the U.S. Bureau of Census which shows that as of 1990 Italian Americans comprised 14,664,550 or 5.9% of the population of 248,709,873 in the United States. As such, they were the fifth largest of the top 100 ancestry groups ranked by the Bureau of the Census. Also, opposer introduced a copy of the results of a survey conducted at its request in October 1990 concerning the public images, beliefs, and misconceptions regarding Americans of Italian descent. Opposer notes that 74% of the persons surveyed identified Italians as the ethnic group "into a lot of the organized crime in this country." Further, opposer introduced definitions of the words "Mafia" and "Mafioso" taken from The American Heritage Dictionary (2 ed.):

Mafia : 1. A secret terrorist organization in Sicily operating since the early 19th century in opposition to legal authority.
2. An alleged international criminal Organization believed active esp. in Italy And the United States since the late 19th century.

Mafioso: A member of the Mafia.

According to the record, The Commission for Social Justice (CSJ), a separately chartered arm of opposer, is

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charged with "fight[ing] discrimination, slander, bias, and prejudice against Italian Americans." (Bevilacqua deposition, p. 7). Of particular concern to opposer and the CSJ are false portrayals of Italian Americans. As part of its efforts in this regard, opposer, in 1971, succeeded in having Attorney General John N. Mitchell issue a memorandum which noted that "many good Americans of Italian descent are offended by the use of the term Mafia and Cosa Nostra in news reports about organized crime" and directed Department of Justice officials to discontinue use of these terms. In addition, in 1977, Attorney General Griffin Bell wrote opposer's president, indicating in a letter that "terms like 'Mafia' and 'cosa nostra' have no place in the discourse of Justice Department officials" and that it continues to be departmental policy "not to use such disparaging terms when referring to organized crime."

Further, in this regard, it has been opposer's policy to oppose registration of marks which it considers disparaging to Italian Americans. Opposer introduced copies of oppositions which it had filed against the following marks: MAFIA, MA-FI-O-SO, DON VITO, MAFIA BOB, and MAFIA FOR MOB. In each of these oppositions, judgment by default was entered against the applicant. Also, in this respect, the CSJ placed a notice in the September 1995 issue of the Journal of the Patent and Trademark Office Society advising

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trademark practitioners that opposer had opposed and would continue to oppose on the grounds of disparagement any applications for marks which include the terms "COSA NOSTRA, MAFIA, MAFIOSO, DON VITO, MAFIOSI, or WOP." In November 1994 the CSJ adopted a resolution denouncing the use of "Goodfellas" by three separate entities. One was using the mark for pizza and the two others were using it for restaurant services. In addition, opposer sent cease and desist letters to two of the entities which had applied to register the mark. Both applications were ultimately abandoned.

The record includes a frame from the movie "GoodFellas" which appeared on the cover of The Italic Way (Vol. 6, No. 1, 1993). The frame features a group of men, who are apparently gambling, seated around a table. One of the men is pointing a gun at another man. Appearing within the frame are the following: "Strangers Among Us: The Mafia and its Ilk," and "Hollywood's Love Affair: Italian-American cast of the 1990 movie GoodFellas." Also made of record were copies of six magazine/newspaper reviews of the "GoodFellas movie." In the September 21, 1990 issue of the Chicago Tribune, Gene Siskel described the movie as a "workaday mob drama" concerning "the life of self-described 'wiseguys' and 'goodfellas'." David Ansen, in the September 17, 1990 issue of Newsweek, wrote a story in which he

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reviewed "GoodFellas" and two other movies. The story was entitled "A Hollywood Crime Wave" with the subtitle "Three brilliant and bloody new gangster movies kick off a season of mayhem, molls and mafiosi." In the September-October 1990 issue of Film Content, Kathleen Murphy described "GoodFellas" as "chronicling the rise and fall from grace of a trio of mafiosi." (emphasis in original). In the 1991 edition of Magill's Cinema Annual, Patricia Kowai described one of the main characters in the movie as "a 'goodfella' who loved to steal." Another principal character was described as always wanting "to be a gangster" and that "life in the Mafia appealed to him." In the September 14, 1990 issue of the New York Times, the review of "GoodFellas" is headlined "A Cold-Eyed Look at the Mob's Inner Workings." Finally, in the September 24, 1990 issue of Time magazine, the review is entitled "Married to the Mob" and the lead characters are described as "gangsters, hit men, wise guys - good fellas."

Each of opposer's witnesses is an officer or member of opposer and expressed the opinion that the mark GOODFELLAS and design, when used in connection with the identified services, would bring the Order as an institution into contempt and disrepute; that the mark perpetuates the stereotype fostered on the American public of a connection between Italian Americans and organized crime, or criminal

activity in general; and that it will have a negative impact on not only members of the Order, but all Americans of Italian descent.

In view of the above evidence, it is opposer's position that the mark GOODFELLAS and design, as used in connection with the identified entertainment services, disparages members of the Order and brings the Order as an institution into disrepute. In this regard, opposer maintains that the term "Goodfellas" means "mafiosi" which in turn means a member of the Mafia. According to opposer:

Words like "goodfellas" and "mafiosi" are specifically addressed to and associated with the Italian-American community. Such terms tar the reputation and hold up to ridicule the members of the Italian-American community.
(Brief, p. 25).

At the outset, we note that the Board has applied different tests for disparagement depending upon whether the party alleging such is an individual/commercial corporate entity or a non-commercial group such as a religious or ethnic group. In this case, although opposer, in the notice of opposition, seeks relief alleging disparagement of the organization and its members, opposer claims that applicant's mark is disparaging to all Italian-Americans who are honest. In view thereof, and because it appears that the issue which has actually been tried is whether honest Italian Americans are disparaged by applicant's mark, the

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appropriate test in this case is that set forth in *Harjo v. Pro-Football, Inc.*, ___ USPQ2d ___ (Cancellation No. 21,069 decided April 2, 1999). That test is as follows:

- (1) What is the likely meaning of the matter in question, taking into account, not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services;
- (2) And, if that meaning is found to refer to identifiable persons, institutions, beliefs, or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

While we have carefully considered the record herein, we are not persuaded that applicant's mark GOODFELLAS and design, when used in connection with its services, may be disparaging to honest Italian Americans.

Considering first the likely meaning of GOODFELLAS as used in applicant's mark, we note that there are no dictionary definitions of the term "goodfella[s]." While opposer has made of record dictionary definitions for the words "Mafia" and "Mafiosi," neither of these definitions is particularly probative of the meaning of the term "goodfellas" since there is no reference to the term in either definition. In any event, neither "Mafia" or "Mafioso" has been labeled "offensive," and it appears from the definitions that "Mafia" is perfectly acceptable when

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referring to either the secret terrorist organization in Sicily or the specific international criminal organization. In short, we cannot say from these dictionary definitions that the term GOODFELLAS, as used in applicant's mark would be understood by the general public to associate organized crime with Italian Americans.

Looking next at the reviews of the "Goodfellas" movie, it is clear from these reviews that the movie depicted a criminal lifestyle and that the term "goodfellas" refers to the criminals depicted in the movie. Thus, this is some evidence of the likely meaning of the term "goodfellas." However, there is insufficient evidence from which to conclude that the movie created an image of criminals that extended generally to Italian Americans. Also, while we recognize that the movie was critically acclaimed, there is no information regarding the public's exposure to this movie. Thus, we cannot say from this evidence that the term GOODFELLAS as used in applicant's mark would be understood by the general public to associate organized crime with Italian Americans.

Further, the letter and memo from Justice Department officials which concern use of the specific terms "Mafia" and "Cosa Nostra" are not particularly probative of the generally understood meaning of the term "goodfellas." Again, there is no mention of the term "goodfellas" in

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either the letter or memo. Also, while the Department agreed to refrain from using the terms "Mafia" and "cosa nostra" when referring to all organized crime, there does not appear to be a prohibition against using the term to refer accurately to the specific international criminal organization. In any event, we cannot conclude from this letter and memo that the Justice Department considers "goodfellas" to be disparaging in any context.

We recognize that opposer has undertaken numerous efforts (adoption of resolutions, letter writing, filing oppositions, etc.) to prevent the use of terms which it considers disparaging to Italian Americans. However, opposer's efforts in this regard are not conclusive of whether such terms, and in particular "goodfellas," are disparaging.⁴ Also, while we recognize that the public opinion survey which was conducted revealed that a substantial number of people identified Italian Americans with criminal activity, there were no questions concerning the term "goodfellas."

As to the opinions of opposer's witnesses with respect to applicant's mark, they are of little persuasive value as all are members/officers of opposer. Notwithstanding opposer's attorney's attempt to qualify them

⁴ We should point out that in none of the oppositions was there a final decision on the merits, i.e., a determination that the mark involved was disparaging to Italian Americans.

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as such, there is insufficient basis to find that opposer's witnesses are experts on the issue of trademark disparagement, or on the attitudes of all or even a substantial composite of, Italian Americans. Also, the opinions of opposer's witnesses as to the ultimate issue before us, i.e., whether applicant's mark is disparaging, are not considered in determining this issue. In any event, we regard the testimony of opposer's witnesses to be the views of a few Italian American individuals.

In sum, opposer has failed to establish that the term GOODFELLAS, as used in applicant's mark and in connection with the entertainment services specified in the application, is understood by the general population to associate all organized crime with Italian Americans, or that a substantial composite of Italian Americans feel disparaged by such use in the context of the mark and the identified services.

In view of the foregoing, we find that opposer has not established that the mark GOODFELLAS and design for entertainment services in the nature of live performances by a musical group may be disparaging to Italian Americans.

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Decision: The opposition is dismissed.

R. F. Cissel

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board