

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN. 28, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Undeas, Inc.

Serial No. 74/624,747

Thomas G. Carulli and Wendy E. Miller of Cooper & Dunham
for applicant.

Peter W. Cataldo, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Simms, Walters and McLeod, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Undeas, Inc. has filed a trademark application to
register the mark JUNIOR M.A.F.I.A. for "prerecorded video
cassette tapes and discs and prerecorded audio cassette
tapes, discs and phonograph records featuring musical
performances" and "entertainment services, namely, live
musical concerts and performances by a musical group."¹

¹ Serial No. 74/624,747, in, respectively, International Classes 9 and
41, filed January 23, 1995, based on an allegation of a bona fide
intention to use the mark in commerce.

The Trademark Examining Attorney has finally refused registration, under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the grounds that applicant's mark "comprises immoral or scandalous matter and may disparage or bring into contempt or disrepute Americans of Italian ancestry and ethnicity."²

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

The Examining Attorney contends that, based on dictionary definitions in the record, "the term 'Mafia' denotes a criminal and terrorist organization operating in Italy and the United States for approximately the last century"; that the term "Mafia" targets Italian Americans in view of its origin in the Italian language and "the definitions of the term indicating membership, racial composition, and geographical spheres of operation"; that "the term 'Mafia' carries a highly negative connotation as applied to Italian Americans"; and that this connotation is

² Upon remand at the Examining Attorney's request, the Examining Attorney asserted as an additional ground of refusal that the mark comprises immoral or scandalous matter and withdrew the refusal made by the previous Examining Attorney on the ground that the mark "falsely suggests a connection between Italian Americans and the criminal organization known as the Mafia." The Examining Attorney maintained the refusal on the grounds that the mark comprises matter that disparages Italian Americans and brings them into contempt or disrepute.

not altered by the additional term "Junior" in the mark. The Examining Attorney contends, further, that, as intended to be used in connection with the identified goods and services, the mark "glorifies[,] glamorizes [and trivializes] the violent, criminal, and terrorist activities of the Mafia and appears to connote that such activities are goals to be striven for and attained[;] [and that] 'Junior Mafia' connotes a deference for and idolization of full 'Mafia' status." Acknowledging that the term "Mafia" has other denotative meanings, the Examining Attorney argues that the principal denotative meaning is the criminal organization originating in Italy. As such, the Examining Attorney concludes that the mark is scandalous and disparages Italian Americans and holds them in contempt and disrepute by unjustly equating them with an international criminal and terrorist organization.

In support of his position, the Examining Attorney has submitted dictionary definitions, several excerpts from websites on the Internet, and numerous excerpts of articles from the LEXIS/NEXIS and Dialog databases.³ The majority of

³ We note that a substantial number of these excerpts are from foreign publications and/or from newswire services. These excerpts are of minimal evidentiary value. Newswire stories are of minimal evidentiary value because it is not clear that such stories have appeared in any publication available to the consuming public. See, *In re Marico Inc.*, 24 USPQ2d 1938 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986). Similarly, we have no evidence concerning the possible circulation in the United States of

the excerpts use the term "Mafia" as a reference to organized crime, and several excerpts use the term to refer specifically to Italian organized crime. Several articles report that some Italian Americans are sensitive to stereotyping of Italian Americans as "Mafia." Two excerpts appear to refer to applicant.

Applicant contends that the term "mafia" has a more universal meaning than as a reference only to Italians or Italian Americans; that it appears "in a variety of political, social and business contexts, to describe closely knit or influential groups, both in a positive and a negative light"; that "these vastly common uses have nothing to do with Italians or Italian Americans, and are not disparaging or suggestive of any of them"; and that the term "mafia" has "transformed from a proper noun to a common noun." In support of its position, applicant has submitted excerpts of news articles.⁴ In these articles the term "Mafia" is used to refer to an influential clique, for example, "California Mafia" referring, separately, to the

the foreign publications from which to infer the possible impact on the perceptions of the relevant public in this country. See, *In re Men's International Professional Tennis Council*, supra.

⁴ Applicant has submitted several exhibits with its supplemental brief on appeal and the Examining Attorney has objected thereto. Inasmuch as the evidentiary record in an application must be complete prior to the filing of the notice of appeal, we sustain the objection and will not further consider the exhibits. See, 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

inner circle of advisors of Senator Diane Feinstein and of former President Ronald Reagan; "Massachusetts Mafia" referring to the advisors of former President John Kennedy; and "Georgia Mafia" referring to the advisors of former President Jimmy Carter.

In *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1736 (TTAB 1999), the Board articulated the test for determining whether a mark is scandalous as follows:

First, the Court or Board determines 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 and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services;] and, second, whether in view of the likely meaning, the matter is scandalous to a substantial composite of the general public.

Once we have determined the likely meaning of the matter in question, to decide whether that matter may disparage or bring into contempt or disrepute "persons, living or dead, institutions, beliefs, or national symbols," we must consider the views of a substantial composite of the referenced person, group, etc. *Harjo, supra* at 1739.

Turning, first, to the likely meaning of the term "M.A.F.I.A." in applicant's mark JUNIOR M.A.F.I.A., we consider dictionary definitions as our initial source. The

dictionary definition of "Mafia" made of record by the Examining Attorney from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) includes three definitions of the term as follows (*examples omitted*):

1. A secret terrorist organization in Sicily, operating since the early 19th century in opposition to legal authority.
2. An alleged international organization believed active, especially in Italy and the United States, since the late 19th century.
3. Often **mafia**. *Informal*. A tightly knit group of trusted associates, as of a political leader.

We take judicial notice of similar definitions of the term "Mafia" as follows:

In *Webster's II New Riverside University Dictionary* (1984) (*examples omitted*):

1. A secret terrorist organization in Sicily, operating since the early 19th century in opposition to legal authority.
2. An alleged international organization believed active, especially in Italy and the United States, since the late 19th century.
3. **mafia**. An exclusive group allegedly exercising control over a particular field, esp. politics.

In *The Random House Dictionary of the English Language* (2nd ed. 1987):

1. a hierarchically structured secret organization allegedly engaged in smuggling, racketeering, trafficking in narcotics, and other criminal activities in the U.S., Italy, and elsewhere.
2. (in Sicily) a. (l.c.) a popular spirit of hostility to legal restraint and to the law, often manifesting itself in criminal acts. b. a 19th century secret society, similar to the Camorra in Naples, that acted in this spirit.
3. (often l.c.) any small powerful or influential group in an organization or field; clique.

The evidence of record demonstrates use of "Mafia" in news articles as a term referring, in different instances, to either a criminal organization or a clique. There is insufficient evidence indicating that "Mafia" is a term that *per se* either "targets Italian Americans" or would be considered offensive or disparaging to a substantial composite of the general public or Italian Americans. In fact, the record indicates that the term is appropriately used when reference is being made, as indicated in the dictionary definitions, to an historical crime organization in Sicily, to a specific crime organization composed of persons of Italian origin, or, as indicated in both the dictionary definitions and the evidence properly made of record by applicant, to a clique, regardless of whether its origin is criminal, political, business or social.

Thus, we turn to consider the meaning most likely to be attributed to the term "Mafia" as it appears in applicant's mark, JUNIOR M.A.F.I.A., and in connection with applicant's goods and services. While the excerpted articles that refer to applicant's musical group are very brief and far from conclusive, it appears that applicant's musical group performs "rap" music; and that the lyrics to at least some of the group's songs contain themes of sex and violence. However, based on the record before us, we

find, first, that the Examining Attorney has not established whether the connotation of JUNIOR M.A.F.I.A., as proposed to be used in connection with applicant's identified goods or services, refers to any of the indicated meanings of "Mafia" or whether it refers to something entirely different.⁵ See *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364, 1368 (TTAB 1999).

Further, even if the record had established such a connection between the mark and any of the indicted meanings of the term "Mafia," we find that the Examining Attorney has not established that a substantial composite of the general consuming public or of Italian Americans would be offended either by the use of "Mafia" to refer to any of the indicated meanings of the term or by the appearance of the term "Mafia" in the context of applicant's mark, JUNIOR M.A.F.I.A., as proposed to be used in connection with applicant's identified goods and services.

Thus, we conclude that the Examining Attorney has not established that the term "Mafia," as proposed to be used

⁵ In particular, we note that, in applicant's mark, the term "Mafia" appears as an acronym, "M.A.F.I.A.," and may have a denotative or connotative meaning other than the indicated meanings of the term "Mafia."

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by applicant in the mark JUNIOR M.A.F.I.A. in connection with the identified goods and services, is immoral⁶ or scandalous or may disparage Italian Americans or bring them into contempt or disrepute.

Decision: The refusal under Section 2(a) of the Act is reversed.

R. L. Simms

C. E. Walters

L. K. McLeod
Administrative Trademark Judges,
Trademark Trial and Appeal Board

⁶ While the Examining Attorney refused registration on the ground that matter in the mark is "immoral," he did not separately address this ground of refusal or present any evidence persuasive thereof.