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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mothers and Fathers Italian Association

Serial No. 75/197,967

Edward J. Quirk of Quirk & Tratos for Mothers and Fathers
Italian Association.

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

Before Hairston, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Mothers and Fathers Italian Association has filed an
application to register the mark "MAFIA BRAND"¹ for
"cheeses, soups, olive oil, processed tomatoes, crushed
processed tomatoes, and processed tomato puree" in
International Class 29, and "spaghetti sauce, pasta,
seasonings, and bread crumbs" in International Class 30.²

¹ The mark includes quotation marks.

² Application Serial No. 75/197,967, filed November 14, 1996.
Applicant disclaimed the word BRAND. Applicant claimed dates of

Registration has been finally refused 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." (Brief, p. 1).³

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but applicant did not request an oral hearing.

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" (brief, p. 2); that, based on the Nexis and Dialog database excerpted stories in the record, "the term "Mafia" carries a highly negative connotation as applied to Italian Americans" (brief, p. 2); and 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

first use and first use in commerce of March 14, 1984 and April 6, 1984, respectively.

³ Upon remand at the Examining Attorney's request, the Examining Attorney asserted for the first time the additional ground of refusal that the mark comprises "immoral" matter. While the Examining Attorney refused registration on the ground the mark is

"immoral," he did not separately address this ground of refusal or present any evidence persuasive thereof.

operation" (brief, p. 5). Further, the Examining Attorney contends that "a substantial portion of Italian Americans consider the term 'Mafia' to be offensive to the conscience or moral feelings..." (brief, p. 5); and that "use of the mark "MAFIA BRAND" on ethnic Italian foods dishonors, disgraces, and scorns Italian Americans by depicting them as synonymous with organized crime." (Brief, p. 6). 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 Nexis and Dialog databases.⁴ The majority of the excerpts use the term "Mafia" as a reference to organized

⁴ Applicant objected to the Examining Attorney's Nexis and Dialog evidence as inadmissible hearsay under Fed. R. Evid. 801. There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals. While certain of the principles embodied in the Federal Rules of Evidence are applied by the Board in evaluating the probative value of evidence in ex parte appeals (see TBMP §101.02), the Board generally takes a more permissive stance with respect to the introduction and evaluation of evidence in ex parte appeals. In addition, the Court of Appeals for the Federal Circuit has acknowledged that the PTO has limited resources for acquiring evidence. See TBMP §1208, and the cases cited therein. All of the Examining Attorney's evidence is admissible at the very least for what it shows on its face, namely, the manner in which the term is used within the story.

crime, and several excerpts use the term to refer specifically to Italian organized crime. (This includes several excerpted articles about various media, such as television and movies, and even novels which are about the secret organized society of Sicily.) Several excerpted articles report that some Italian Americans are sensitive to stereotyping of Italian Americans as "Mafia."⁵

Applicant contends that the term "Mafia" is not inherently offensive, and in fact, the term has a more universal meaning than as a reference only to Italians or Italian Americans, specifically "any small, powerful or influential group in an organization or field, e.g., an 'office mafia'" (brief, p. 3); that applicant (whose name makes the acronym MAFIA) consists of first generation Italian Americans who would not adopt and would not use a mark which is offensive or disparaging to Italian Americans; that applicant has used the mark for these goods

⁵ 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 cannot be presumed that such stories have appeared in any publication available to the consuming public. Similarly, we have no evidence concerning the possible circulation in the United States of the foreign publications from which to infer the possible impact on the perceptions of the relevant public in this country. See *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986).

since 1984 with no objection to the use of said mark, or to applicant's federal registration⁶; and that the Examining Attorney has not met the burden of proof necessary to establish the mark "MAFIA BRAND" is scandalous, or disparages or brings Italian Americans into contempt or disrepute, especially in relationship to the involved goods, various food products.

In support of its position, applicant has submitted a photocopy of its registration and a printout of a page from a website on a movie titled "MAFIA!" from 1998.⁷

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

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.

⁶ Registration No. 1,371,531, issued November 19, 1985, and was cancelled pursuant to Section 8 in 1992.

⁷ The Examining Attorney objected to applicant's submission of the website page with its supplemental brief. The objection is not well taken because applicant was allowed to respond to evidence submitted by the Examining Attorney with his second final refusal Office action in accordance with the Board orders dated May 8, 1998, October 14, 1998 and December 1, 1998.

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 mark "MAFIA BRAND", 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:

A. 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.

B. 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 the term "Mafia" in news articles 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 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, "MAFIA BRAND", and in connection with applicant's goods. Applicant's specimens of record simply show the mark "MAFIA BRAND" in red lettering appearing above an old-fashioned (i.e., "turn of the century") type of gold-framed, black and white photograph of a couple with the man seated and the woman standing next to him with her hand placed on his shoulder. Based on the record before us, we find that the Examining Attorney has not established whether the connotation of "MAFIA BRAND", as used on applicant's identified goods, refers to any of the indicated meanings of "Mafia" or whether it refers to something entirely different. 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 indicated 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

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any of the indicated meanings of the term or by the appearance of the term "Mafia" in the context of applicant's mark, "MAFIA BRAND", as used on applicant's identified goods.

Thus, we conclude that the Examining Attorney has not established that the mark "MAFIA BRAND", as used by applicant on the identified goods, is scandalous or may disparage Italian Americans or bring them into contempt or disrepute.

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

P. T. Hairston

B. A. Chapman

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board