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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lico Brands, Inc.

Serial Nos. 75/006,142 and 75/006,355

Shirley J. Su of Howard, Rice, Nemerovski, Canady, Falk &
Rabkin for Lico Brands, Inc.

Cindy B. Greenbaum, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney)

Before Simms, Seeherman and Hanak, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Lico Brands, Inc. (applicant) seeks to register "REAL
ITALIAN" and THE REAL ITALIAN TOMATO COMPANY for "wholesale
distributorship services featuring tomato-based sauces and
canned tomato products." Application serial numbers
75/006,142 and 75/006,355. The applications were filed on
October 16, 1995 with the same claimed first use date of
October 30, 1989.

Ser No. 75/006,142 and 75/006,355

The Examining Attorney refused registration of both marks pursuant to Section 2(e)(1) of the Lanham Trademark Act on the basis that the marks are merely descriptive of applicant's services.

When the refusals to register were made final, applicant took separate appeals to this Board. Applicant filed a separate set of briefs (main and reply) in each of the appeals, and the Examining Attorney filed separate briefs in each of the appeals. Applicant requested an oral argument, and both appeals were heard at the same time on March 19, 1998, and we decide both in this opinion.

In determining whether either of applicant's marks is descriptive of its services, three propositions must be kept in mind.

First, as has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750,

Ser No. 75/006,142 and 75/006,355

1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

Second, section 2(e)(1) prohibits the registration of marks which are "merely descriptive" of the goods or services for which registration is sought. (emphasis added). As Professor McCarthy notes, "a mark that connotes two meanings -- one possibly descriptive, and the other suggestive of some other association -- can be called suggestive, as the mark is not 'merely' descriptive." 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:19 at page 11-26 (4th ed. 1998). See also In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968).

Finally, whether or not a mark is merely descriptive is, of course, to be determined from the point of view "of actual or prospective consumers of the applicant's particular goods or services." In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987). Thus, because applicant's services are wholesale distributorships services, our focus is not on the ultimate purchasers of applicant's tomato-based sauces and canned tomato products, but rather upon the intermediate users of its services, namely, retailers.

Ser No. 75/006,142 and 75/006,355

The Examining Attorney contends that applicant's marks are merely descriptive of its services because they "immediately, and without conjecture or speculation, describe a significant characteristic or feature of applicant's services, i.e., applicant is a company that distributes authentic, or real, Italian tomato products." (Examining Attorney's briefs page 3).

On the other hand, applicant contends that its marks project "more than one meaning and thus, [are] merely suggestive of the services offered under the mark[s]." (Applicant's brief page 6 in application serial no. 75/006,142 and applicant's brief page 7 in application serial no. 75/006,355). With regard to its mark "REAL ITALIAN," applicant essentially concedes part of the thrust of the Examining Attorney's argument by stating that "the mark could be suggestive of the type of products or an ingredient of the type of products -- Italian style tomatoes -- that applicant distributes." (Applicant's brief page 7 in application serial no. 75/006,142). Likewise, with regard to its mark THE REAL ITALIAN TOMATO COMPANY, applicant again acknowledges that this "mark could suggest that applicant is a company that deals with 'Italian tomatoes.'" (Applicant's brief page 7 in application serial no. 75/006,355). However, applicant

continues by arguing that both of its marks have a second meaning or connotation, which applicant articulates in both of its briefs in the following manner at pages 7-8:

Applicant's mark could suggest that Applicant's company offers what it terms "real Italian" services, suggesting that the consumer will be taken care of and treated as part of the company's "extended family." Applicant's advertisements are suggestive of this same idea, i.e., that customers, who are part of Applicant's extended family, will receive personal, caring and reliable service. The mark plays on the connotations of Italian culture as a generous, warm, and robust culture that enjoys both delicious, homestyle food and strong family loyalty. Consequently, the mark is suggestive of the high-quality products offered by Applicant as well as the special brand of customer service and loyalty Applicant provides. As such, Applicant's mark is not merely descriptive of its services, but rather, is suggestive of a quality or caliber of Applicant's services.

With regard to applicant's mark THE REAL ITALIAN TOMATO COMPANY, we find that said mark does have two meanings or connotations, one of which is descriptive of applicant's services and one of which is, at most, suggestive of applicant's services. Accordingly, we find that said mark is not "merely descriptive" of the services. To elaborate somewhat, we find it plausible that applicant's retail customers could view applicant's mark THE REAL ITALIAN

Ser No. 75/006,142 and 75/006,355

TOMATO COMPANY in either one of two ways. First, applicant's retail customers (as opposed to ultimate consumers) could view the mark in such a way that the three words REAL ITALIAN TOMATO form a unit which modifies the final word COMPANY. Viewed in this manner, applicant's mark is descriptive in that it describes the products which are or could be the subject of applicant's wholesale distributorship services, namely, real Italian tomatoes or real Italian-style tomatoes. However, applicant's retail consumers could also view applicant's mark THE REAL ITALIAN TOMATO COMPANY in a manner such that the words REAL ITALIAN modify the words TOMATO COMPANY. When viewed in this manner, applicant's mark is not descriptive, but only suggestive in that it vaguely indicates the nature, quality or level of services as articulated by applicant in the above passages quoted from applicant's briefs. Because applicant's mark THE REAL ITALIAN TOMATO COMPANY has two meanings or connotations, one of which is descriptive and one of which is suggestive, it cannot be said that applicant's mark is "merely descriptive." Accordingly, the refusal to register this mark is reversed.

However, with respect to applicant's mark "REAL ITALIAN," we find that this mark projects only meanings which are descriptive of applicant's "wholesale

Ser No. 75/006,142 and 75/006,355

distributorship services featuring tomato-based sauces and canned tomato products." As applied to such services, applicant's mark "REAL ITALIAN" indicates that applicant's tomato-based sauces (which could be canned) and canned tomatoes either are made from or are genuine Italian tomatoes which have been imported from Italy, or are Italy-styled tomatoes in terms of their varieties or methods of preparation. Whichever particular meaning applicant's retail customers attach to the mark "REAL ITALIAN," said meaning is descriptive (and not suggestive) of applicant's services in that it forthwith conveys information about a key characteristic of the products which are the subject of applicant's wholesale distributorship services. Stated somewhat differently, we do not believe that applicant's mark "REAL ITALIAN" per se could be viewed by applicant's consumers as referring to a company or to a level or type of service. Obviously, the words TOMATO COMPANY or even COMPANY do not appear in applicant's mark "REAL ITALIAN."

DECISION: The refusal to register applicant's mark "REAL ITALIAN" (application serial no. 75/006,142) is

Ser No. 75/006,142 and 75/006,355

affirmed. The refusal to register applicant's mark THE REAL
ITALIAN TOMATO COMPANY (application serial no. 75/006,355)
is reversed.

E. J. Seeherman

E. W. Hanak
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Simms, Administrative Trademark Judge, dissenting:

I disagree with the disposition reached by the majority. I would remand these applications to the Examining Attorney for further examination. In order to explain my position, it is necessary to recite more of the prosecution history of these cases. For purposes of simplicity, I focus on the application to register the mark "REAL ITALIAN".

In the first and final refusal, the Examining Attorney refused registration because the asserted mark was merely descriptive under Section 2(e)(1) of the Act. In the final refusal, this is what the Examining Attorney said:

In the present case, the designation REAL ITALIAN immediately, and without conjecture or speculation, describes a significant characteristic or feature of applicant's services, namely, that applicant distributes authentic, or real, Italian products. Applicant's original specimens tout the tomato-based sauces and tomato products which applicant distributes as "the very best authentically Italian tomato products" (emphasis in the original). The plain and readily understood meaning of the term, as shown by the evidence from the Nexis/Lexis® News/Curnws Research database attached hereto, and applicant's definition of the word "real" indicates that, as used in connection with applicant's services, there is nothing which is indefinite, incomplete or incongruous about the designation REAL ITALIAN. Clearly, if something is described as "real," it means that the item is the

genuine, authentic article, not an imitation. Moreover, present and prospective customers of distributorships featuring tomato-based sauces and canned tomato products would require no imagination, cogitation or gathering of further information to perceive the merely descriptive significance of the designation REAL ITALIAN. [Footnotes omitted.]

And, in her appeal brief, 3-4, the Examining Attorney stated:

In the present case, the trademark examining attorney submits that the designation "REAL ITALIAN" immediately, and without conjecture or speculation, describes a significant characteristic or feature of applicant's services, i.e., applicant is a company that distributes authentic, or real, Italian tomato products. The dictionary evidence of record defines "real" as "genuine and authentic, not artificial or spurious. . . ." The American Heritage College Dictionary, 1137 (3rd Ed. 1993). In addition, applicant's own specimens tout the tomato-based sauces and canned tomato products which applicant distributes as "authentically Italian tomato products." Further, the evidence from the Nexis/Lexis® News/Curnws Research database attached to the December 12, 1996 Office Action (and incorporated by reference herein) indicates that, as used in connection with applicant's services there is nothing remotely indefinite, incomplete or incongruous about the designation "REAL ITALIAN". This Nexis/Lexis® evidence contains voluminous references to various real Italian products, such as real Italian food, real Italian tomato sauce, real Italian ice cream, etc. Clearly, if an item is described as "real," that item is the genuine, authentic article, and not an imitation. Moreover, present and prospective customers of distributorships featuring tomato-based sauces and canned

tomato products would require no imagination, cogitation or gathering of further information to perceive the merely descriptive significance of the designation "REAL ITALIAN". [Footnote omitted.]

Reading this refusal and the reasoning as a whole, it is clear to me that the Examining Attorney is refusing registration because she believes that applicant's mark describes the fact that the products applicant distributes come from Italy--they are "authentic, or real, Italian products." It is also clear that applicant has so construed the Examining Attorney's refusal. See applicant's Request for Reconsideration, filed March 14, 1997 ("According to the Examining Attorney, the mark REAL ITALIAN merely describes a significant characteristic of Applicant's services, namely, that Applicant distributes authentic or real Italian products.") and applicant's brief, 3 ("The Examining Attorney determined that the mark REAL ITALIAN merely describes a significant characteristic of Applicant's services, namely, that Applicant distributes authentic or real Italian products.") To the extent that the majority believes that the Examining Attorney is refusing registration because the products applicant distributes are made from the variety of tomatoes known as Italian tomatoes, and merely descriptive because of that

fact, I believe they have misread the refusal and quoted the Examining Attorney out of context. She has not refused on this basis. If she were refusing on this reasoning, I do not understand her inclusion in this record of Nexis excerpts showing such "hits" as "real Italian prosciutto," "real Italian sausage," "real Italian olives," etc. Rather, the support for such a refusal might be evidence that there is a domestic variety of tomato known as the "Italian tomato" and that the relevant public would know of such a fact.

Now, if the Examining Attorney is refusing registration because she believes that applicant's mark describes the fact that the products it distributes come from Italy, the proper refusal is Section 2(e)(2)--that applicant's mark is primarily geographically descriptive of its services. However, because it appears from statements made in applicant's reply brief¹ and at the oral hearing

¹ In its reply brief, 1-2, 3, applicant states:

Applicant's tomatoes are not Italian, either with respect to where the tomatoes are grown or the variety of tomato. Applicant's tomatoes are grown exclusively in California and, if there is such a thing as an "Italian" tomato, Applicant does not use such a variety in its tomato products. As such, Applicant's mark clearly does not refer to "real Italian" tomatoes, as Applicant's products and services have nothing to do with any supposed "real Italian" tomatoes. [Footnote continued on next page]

Ser No. 75/006,142 and 75/006,355

that the goods applicant distributes do not in fact come from Italy and are not made from ingredients grown there, the refusal should be under Section 2(e)(3) (and perhaps under Section 2(a)), if the Examining Attorney believes that applicant's mark "REAL ITALIAN" misleads people into believing that applicant distributes products emanating from Italy.

With respect to the mark "REAL ITALIAN", the majority states:

As applied to such services, applicant's mark "REAL ITALIAN" indicates that applicant's tomato-based sauces (which could be canned) and canned tomatoes either are made from or are genuine Italian tomatoes which have been imported from Italy, or are Italy-styled tomatoes in terms of their varieties or methods of preparation. Whichever particular meaning applicant's retail customers attach to the mark "REAL ITALIAN," said meaning is descriptive...

Now, to the extent the majority is affirming the refusal under Section 2(e)(1) because applicant's mark describes the fact that the goods applicant distributes come from Italy, I believe this is legal error, as explained above. Section 2(e)(2) is the proper statutory section for that kind of refusal. However, as noted above,

...In Applicant's case, on the other hand, the term "Real Italian" is not used to directly and immediately describe a product, service, or way of preparing tomatoes that is from Italy. Further, Applicant's

Ser No. 75/006,142 and 75/006,355

the products applicant distributes do not come from Italy, so affirmance under Section 2(e)(2) would also be incorrect. Rather, the proper refusals would be under Section 2(e)(3) and/or 2(a).

Finally, to the extent the majority is affirming the refusal because the products applicant distributes may be made from Italian tomatoes, a variety of tomato grown in this country, the Examining Attorney never argued this as a reason for her refusal. Moreover, as noted above, applicant has stated that the products it distributes are not made from the variety known as Italian tomatoes. To affirm on this basis is, therefore, also legal error. If anything, the proper refusal would be under the deceptive misdescriptive part of Section 2(e)(1), if the Examining Attorney believes that applicant's mark indicates that applicant distributes products which are made from Italian tomatoes (the variety) when they are not.

I also believe that, when properly considered, it is likely that the same result should prevail in both cases. To explain this, let me use an example. An applicant seeks to register the marks REAL AMERICAN and REAL AMERICAN BEEF COMPANY for beef. Assume that applicant's beef does not

tomatoes are not Italian tomatoes, and Applicant does not use its mark to describe its tomatoes.

Ser No. 75/006,142 and 75/006,355

come from this country. The Examining Attorney refuses registration under Section 2(e)(3) because the marks are primarily geographically deceptively misdescriptive. It seems to me that if REAL AMERICAN is properly refused under Section 2(e)(3), the phrase REAL AMERICAN BEEF COMPANY should also be refused under this section. The additional words BEEF COMPANY, under our decisional law, add only generic matter to the words REAL AMERICAN. They do not detract from the primary geographically deceptively misdescriptive nature of the mark. See, for example, In re Hiromichi Wada, 48 USPQ2d 1689 (TTAB 1998)(NEW YORK WAYS GALLERY held primarily geographically deceptively misdescriptive of various accessories). See also In re Cambridge Digital Systems, 1 USPQ2d 1659 (TTAB 1986). Although I do not believe it necessary to decide this question now (because this case should be remanded), one could reasonably argue that the secondary connotation that the majority sees in the expression REAL ITALIAN TOMATO COMPANY is too remote, tenuous or speculative, especially in the absence of evidence from applicant, who could have shown that its mark actually has had such a connotation in the marketplace, to detract from the geographic nature of the mark.

Ser No. 75/006,142 and 75/006,355

I would remand these cases to the Examining Attorney so that she may consider refusals under Sections 2(e)(3) and 2(a). To the extent that I may have misinterpreted what the Examining Attorney has said, remand is also appropriate for clarification.

R. L. Simms
Administrative
Trademark Judge,
Trademark Trial
and Appeal Board

Ser No. 75/006,142 and 75/006,355