

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 25, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Manufactura de Tabacos (MATASA) S.A.

Serial No. 75/141,061

Julie A. Greenberg of Gifford, Krass, Groh, Sprinkle,
Anderson & Citowski, P.C. for Manufactura de Tabacos
(MATASA) S.A.

Allison S. Berman, Trademark Examining Attorney, Law Office
104 (Sydney Moskowitz, Managing Attorney).

Before Cissel, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 22, 1996, applicant, a Panamanian corporation
doing business in the Dominican Republic, applied to
register the mark "DOMINICANOS RICOS" on the Principal
Register for "cigars," in Class 34. The basis for the
application was applicant's assertion that it possessed a
bona fide intention to use the mark on these goods in
commerce.

The original Examining Attorney cited a prior registration as a bar under Section 2(d) of the Lanham Act. He also inquired as to whether the mark has significance in the relevant trade, has geographical significance or has meaning in a foreign language. Further, he required a disclaimer of the descriptive word "DOMINICANOS." Attached to the first Office Action were copies of dictionary definitions showing that "rico" is a Spanish word for "rich," and "dominicano" is a Spanish word for "Dominican."

Applicant responded with argument that confusion with the cited registered mark was not likely. Additionally, applicant stated that the translation into English of the Spanish words which make up its mark is "Rich Dominicans" or "Rich Dominican Ones." Applicant amended the application to state that it makes no claim to the exclusive right to use "DOMINICANOS" apart from the mark as shown.

The Examining Attorney withdrew the refusal based on likelihood of confusion, instead refusing registration under Section 2(e)(1) of the Lanham Act on the ground that the proposed mark merely describes the goods identified in the application. He held that the mark would be understood as an indication of the quality and the geographical source of the cigars, i.e., that the mark, when considered in

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connection with applicant's goods, would immediately and forthwith convey the fact that they are rich Dominican cigars.

Submitted in support of this refusal were additional materials. A dictionary definition of the word "rich" includes "having great value or worth... magnificent... containing a large amount of choice ingredients..." Also submitted were a number of excerpts from printed publications retrieved from the Nexis® database. Some show that Dominican cigars are considered to be of high quality, and thus very desirable in this country. Other stories use the word "rich" descriptively in connection with cigars and the tobacco used in cigars. In addition, he submitted photocopies of pages from The Cigar Companion, A Connoisseur's Guide, second edition (1995), which also demonstrate that Dominican cigars are available and popular in this country.

Applicant responded to the refusal to register based on descriptiveness by arguing that translating its mark into English is not appropriate, citing In re Pan Tex Hotel Corp., 190 USPQ 109 (TTAB 1976). Further, applicant argued that even if the mark were to be translated, it still would not be merely descriptive of applicant's products within the meaning of Section 2(e)(1) of the Lanham Act.

The Examining Attorney was not persuaded by applicant's arguments, and responded to them by making the refusal to register final.

Applicant timely filed a notice of appeal, along with a request for reconsideration.

The present Examining Attorney was assigned to this case, and her response to applicant's request for reconsideration was to maintain the refusal to register. She attached to her Office Action additional evidence from the Nexis® database. These excerpts show that the term "Olor Dominicano" is used to identify a type of cigar tobacco; that the word "rich" is used descriptively in connection with cigars, including cigars made with Dominican tobacco; and that the cigar industry in the Dominican Republic appears to be flourishing.

Both applicant and the Examining Attorney filed briefs. Applicant attached additional evidence, namely copies of additional dictionary definitions, to its appeal brief. The the Examining Attorney objected to this evidence because, under Trademark Rule 2.142(d), the application record is complete upon the filing of a notice of appeal. The Board, however, may take judicial notice of dictionary definitions, so we have considered this evidence. In any event, it does not add much to the record

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already before us. The word "rico" is defined in essentially the same terms used in the definition submitted with the first Office Action, but the synonyms "delicious" and "tasty" are also listed. The term "dominicano" is translated into English as "Dominican."

Applicant did not request an oral hearing before the Board. Accordingly, we have decided this appeal based on the written arguments and the record in the application before us.

A mark is merely descriptive under section 2(e)(1) of the Trademark Act if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). In assessing the descriptiveness of a mark, the Examining Attorney must consider whether it is merely descriptive in relation to the identified goods, rather than making this determination from consideration of the mark in the abstract. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ2d 215 (CCPA 1978).

As the Board noted in In re Joseph Schlitz Brewing Co., 223 USPQ 45 (TTAB 1983): "It is well established that normally no distinction can be made between English terms and their foreign equivalents with respect to

registrability, and that the foreign equivalent of a merely descriptive English term is no more registrable than the English term itself despite the fact that the foreign term may not be commonly known to members of the general public in the United States." See also In re Zaggara, 156 USPQ 348 (TTAB 1967).

In the instant case, applicant has provided us with the English translation of its mark as "Rich Dominicans," and "Rich Dominican Ones," and applicant has conceded the descriptiveness of the term "Dominicans" by disclaiming it under Section 6 of the Lanham Act. The evidence submitted by the Examining Attorney makes it clear that the term "rich" is also merely descriptive of cigars because it immediately and forthwith conveys information about their characteristics, i.e., that contain a large amount of choice ingredients and/or that they are tasty. We agree with the Examining Attorney that the mark applicant seeks to register would, if used in connection with cigars, immediately inform prospective purchasers that applicant's cigars are rich Dominican cigars. The refusal to register under Section 2(e)(1) of the Act is therefore appropriate.

Applicant's arguments to the contrary are not persuasive. The principal argument applicant makes in support of registrability is based on the Pan Tex Hotel

case cited above. In that case, however, the issue was not mere descriptiveness under Section 2(e)(1) of the Lanham Act, but rather whether the term sought to be registered was the name of the services with which it was used, and therefore was unregistrable on the Supplemental Register. The Board found that the mark in that case, "LA POSADA," which could be literally translated as "the inn," was nevertheless registerable on the Supplemental Register for lodging and restaurant services. The Board took into account the manner in which the term was used by the applicant and concluded that the mark and its English translation created different commercial impressions, in view of the fact that the record established that the Spanish word carried the added implication of a home or dwelling, and therefore had a "connotative flavor which is slightly different from that of the words 'the inn.'"

In the case now before us, applicant's arguments based on that case are not well taken. In the instant case, applicant has applied to register its mark on the Principal Register, rather than the Supplemental Register. The issue is not whether the proposed trademark is capable of identifying the source of applicant's cigars and distinguishing them from cigars made by other manufacturers. Applicant has not established that the term

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sought to be registered has even been used as a trademark. Contrary to the situation in the Pan Tex case, applicant has not shown that the mark and its English translation would create different commercial impressions in connection with the specified goods because the different implications or shades of meaning these words have would result in different "connotative flavors."

Applicant also argued a number of prior decisions where literal translations were found not to be appropriate, but these other cases involved not whether the mark sought to the registered was merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act, but rather whether confusion with other marks was likely within the meaning of Section 2(d) of the Act. The mental steps between making a translation and determining whether the translated mark is so similar to another mark that confusion is likely can be more complicated than simply determining whether the English equivalent of a word is merely descriptive.

Applicant has not established that any good reason exists in the case at hand for failing to follow the established rule that the descriptiveness of a foreign language mark is determined by resolving whether the English translation of the mark is descriptive of the goods

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in question. Applicant has conceded in the descriptive nature of "DOMINICANOS" in connection with cigars. The Examining Attorney has submitted evidence which establishes that "RICOS" means "rich," and that "rich" is merely descriptive of a desirable characteristic of cigars. We are presented with no evidence that the combined term "DOMINICANOS RICOS" would have anything other than descriptive significance if applicant were to use it in connection with cigars.

Accordingly, the refusal to register under Section 2(e)(1) of the Lanham Act is affirmed.

R. F. Cissel

C. E. Walters

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial & Appeal Board

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