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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re GBSI Management, Inc.

Serial No. 76376895

Joseph L. Strabala for GBSI Management, Inc.

Elizabeth A. Hughitt, Trademark Examining Attorney, Law
Office 111 (Craig D. Taylor, Managing Attorney).

Before Simms, Seeherman and Quinn, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

GBSI Management, Inc., a corporation of the
Philippines, has appealed from the final refusal to
register SARAPINOY for "cooked and uncooked meats and
poultry" (in International Class 29) and "pastries,
specifically cakes, cookies, pies, breads, rolls, and
tarts; [and] powdered mixes for bakery products" (in
International Class 30).¹ The application, as originally

¹ Application Serial No. 76376895, filed March 4, 2002, based on
an allegation of a bona fide intention to use the mark in
commerce.

filed, included the following statement: "SARAPINOY is Philippine for 'GREAT PHILIPPINE TASTE.'" Registration has been refused on the ground that applicant's mark, if applied to applicant's goods, would be merely descriptive thereof under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).²

Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney, relying on applicant's statement of the meaning of the term in the original application, asserts that the term SARAPINOY is a telescoped form of the two Filipino terms "SARAP" and "PINOY," and is properly translated to English as "great Filipino taste" or "delicious Filipino." According to the Examining Attorney, "the mark would be readily perceived by Filipino-speaking consumers as touting the applicant's 'delicious Filipino' foods or extolling the fact that the applicant's foods have a 'great Filipino taste.'" (brief, p. 16). Therefore, the Examining Attorney contends, the

² Earlier in the prosecution of the application, applicant submitted a proposed disclaimer of "great" and "taste" apart from the mark. The Examining Attorney noted that the disclaimer of part of the English translation was unacceptable because the mark at issue was the unitary foreign wording SARAPINOY and not the English words "GREAT PHILIPPINE TASTE." The Examining Attorney also noted that a disclaimer would have been unacceptable even if the disclaimed words were a separable element of the mark since the mark in its entirety is descriptive.

term sought to be registered is merely descriptive. In support of the refusal to register, the Examining Attorney submitted dictionary definitions of "great," "Filipino (Philippine)" and "taste," as well as of "sarap" and "Pinoy"; third-party registrations of marks showing the Office's treatment, as merely descriptive, of "great taste," "great tasting," and various terms referring to ethnic tastes and flavors; and articles retrieved from the NEXIS database showing usage of "Filipino (Philippine) taste(s)" and "Filipino (Philippine) flavor(s)" in the context of discussions about Filipino cuisine.³

In urging that the refusal to register be reversed, applicant asserts that the term SARAPINOY is not a Filipino word, but rather is a coined term not found in any dictionary of the approximately eighty languages of the Philippines, including the principal language Tagalog. Applicant goes on to state, however, that "the mark can be loosely translated as good/delicious ('sarap' in Tagalog) and Filipino ('pinoy' in slang)." (brief, p. 2).

Nonetheless, applicant maintains that "Philippine Taste" is

³ The term "Filipino" is defined as "of or relating to the Philippines or its peoples, languages, or cultures." The American Heritage Dictionary of the English Language (3d ed. 1992). Applicant and the Examining Attorney have used the terms "Filipino" and "Philippine" interchangeably.

"an illusion, an intangible, so it is not descriptive as no such 'taste' exists." (brief, p. 5).

Before proceeding to the merits of the refusal, we need to address an evidentiary matter. Three of the dictionary listings (for the terms "sarap," "Pinoy" and "delicious") were submitted for the first time with the Examining Attorney's appeal brief, and the Examining Attorney has requested that the Board take judicial notice of them. As a general rule, judicial notice may be taken of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §712.01. In the present case, however, the Filipino/English translations were retrieved from an on-line dictionary available over the Internet.⁴ In ruling on this type of submission in the past, the Board has stated that judicial notice will not be taken of definitions found only in on-line dictionaries and not available in a printed format; however, such definitions will be considered if made of record during the prosecution of the application.

⁴ There is no problem with taking judicial notice of the meaning of the English term "delicious" inasmuch as the definition also appears in a printed publication. The term "delicious" means "highly pleasing or agreeable to the senses, especially of taste or smell."

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See: In re Total Quality Group, Inc., 51 USPQ2d 1474, 1475-76 (TTAB 1999).

Notwithstanding the Board's general view, we find, in view of the very specific circumstances in this case, that the Examining Attorney's request to take judicial notice has merit. Firstly, applicant itself provided a translation ("SARAPINOY is Philippine for 'GREAT PHILIPPINE TASTE.'") of its mark in the original application. Prior to the appeal, the prosecution centered on the mere descriptiveness of the English translation of the mark as originally provided by applicant. It was not until after the appeal, in its appeal brief, that applicant backtracked somewhat from the translation which it furnished in the original application. Accordingly, the Examining Attorney, prior to her appeal brief, had no reason to introduce into the record any dictionary evidence. Secondly, the dictionary evidence submitted by the Examining Attorney does not suffer from any obvious credibility problem. The Examining Attorney has submitted a printout of the dictionary evidence, and applicant has not raised any objection thereto. The printout of the introduction to the on-line dictionary indicates that its contents are based on a printed publication, namely "Dr. Teresita V. Ramos' Tagalog Dictionary published by the University of Hawaii

Press, 1971." Thirdly, the dictionary evidence merely confirms essentially what applicant already provided as the translation.⁵

Accordingly, we grant the Examining Attorney's request to take judicial notice of the dictionary translations of "sarap" as "delicious," and "Pinoy" as "Filipino." Tagalog Dictionary (1971).

We now turn to the merits of the refusal grounded on mere descriptiveness. It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes a quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the

⁵ The Examining Attorney, in connection with her request to take judicial notice, indicated that she "confirmed with this Office's Translations Department that the terms 'sarap' and 'Pinoy' literally translate to English as 'delicious' and 'Filipino', respectively. However, because up-to-date, comprehensive Filipino (Tagalog) dictionaries are not readily available in printed form...the Translations Department recommended the use of more current online dictionaries." (appeal brief, p. 9, n. 7). Although we cannot take judicial notice of the Examining Attorney's report of the translation provided by the Translations Department, the Department's comment about why online dictionaries should be used provides further support for our taking judicial notice of the online dictionary translations in this case.

properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

More specifically with respect to the case at hand, laudatory terms are treated the same as other merely descriptive terms. See, e. g.: In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) [THE ULTIMATE BIKE RACK]; and In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001) [BEST and PREMIER]. Moreover, when considering mere descriptiveness under Section 2(e)(1), the foreign equivalent of a laudatory term is treated no differently from the English translation of that term. See, e .g., In re San Miguel Corp., 229 USPQ 617 (TTAB 1986) [SELECTA, which means "select," held merely descriptive of beer]; In re George A. Hormel & Co., 227 USPQ 813 (TTAB 1985) [SAPORITO, which means "tasty," held merely descriptive of sausage]; and In re Joseph Schlitz Brewing Co., 223 USPQ 45 (TTAB 1983) [KUHLBRAU, a combination of KUHL BRAU, which means "cold brew," held merely descriptive of beer]. That is to say, the foreign

equivalent of a merely descriptive English term generally is no more registrable than the English word itself. The test is whether, to those American buyers familiar with the foreign language, the term would have a descriptive connotation.

In the present case, we have applicant's statement, in the original application which was accompanied by a Trademark Rule 2.20 declaration by the president of applicant (a corporation of the Philippines), that "SARAPINOY is Philippine for 'GREAT PHILIPPINE TASTE.'" The dictionary evidence of record shows that the Philippine terms "sarap" and "Pinoy" mean "delicious" and "Filipino," respectively. In its appeal brief, applicant attempts to backtrack from its original translation, now arguing that the mark is a coined term; applicant nevertheless concedes that "the mark can be loosely translated as good/delicious ('sarap' in Tagalog) and Filipino ('pinoy' in slang)," and that while "[a]pplicant suggested to the Trademark Attorney that SARAPINOY might be 'great Filipino taste,' a better euphemism is 'delicious Filipino.'" (appeal brief, pp. 2-3).

We agree with the Examining Attorney that the literal translation and the translation originally offered by applicant are essentially synonymous: "delicious Filipino"

food products, and food products with a "great Philippine taste." Whether translated literally as "delicious Filipino," or loosely translated as "great Philippine taste," the mark SARAPINOY is merely descriptive of food products.

Applicant, in contending that its mark is "coined," relies on the fact that it has telescoped two recognized Philippine words, "sarap" and "Pinoy" to form "SARAPINOY," which is not found in any dictionaries. In the past, it generally has been held that the telescoping of two descriptive terms does not avoid a determination that the mark as a whole is merely descriptive. See, e. g., *In re BankAmerica Corp.*, 229 USPQ 852 (TTAB 1986) [PERSONALINE held to be merely descriptive of consumer loan services through which a personal line of credit is provided]; and *In re United States Steel Corp.*, 225 USPQ 750 (TTAB 1985) [SUPEROPE found to be merely descriptive of wire rope]. Here, applicant has merely deleted a space between the terms "sarap" and "Pinoy," and then has the terms share the common letter "P"--the last letter of the first term and the first letter of the second term overlap. However, telescoping the descriptive term "sarap pinoy," which literally means "delicious Filipino," into SARAPINOY does not take the term out of the merely descriptive category.

Applicant has not suggested that the telescoped term "SARAPINOY" has any other meaning in the context of food products. We find that consumers familiar with the Tagalog language would immediately recognize SARAPINOY as the equivalent of SARAP PINOY, and would understand it as describing a laudatory characteristic of applicant's goods.

In view of our finding that SARAPINOY would be translated as "delicious Filipino," there is no question, based on the clear meaning of these words alone, that the term has a laudatorily descriptive meaning. But the Examining Attorney has also submitted evidence in support of this conclusion. The ten third-party registrations submitted by the Examining Attorney show that the Office has routinely considered terms such as "GREAT TASTE" or "GREAT TASTING" to be merely descriptive when applied to food products. Although certainly not dispositive of this appeal, the evidence tends to show the descriptive meaning of these terms in the food industry. *Institut National des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992). An additional eight third-party registrations submitted by the Examining Attorney show the Office's descriptive treatment of references to various ethnic tastes or flavors (for example, "ITALIAN FLAVOR" and "ASIAN TASTE").

The Examining Attorney also submitted excerpts retrieved from the NEXIS database showing, not surprisingly, that there is an ethnic style of Filipino cuisine. The articles show the following representative uses in the context of Filipino cuisine:

Saltiness, the second dominant
Philippine taste after sourness....
(*Chicago Tribune*, September 20, 1990)

Dining here is a party of Filipino
flavors and hospitality.
(*The San Francisco Chronicle*, January
21, 1994)

Restaurant welcomes diners with
Filipino flavors.
(*Albuquerque Journal*, January 7, 2000)

This provides insight into Filipino
tastes, both traditional and modern.
(*Los Angeles Times*, January 26, 1989)

Based on the record before us, we find that the mark sought to be registered, SARAPINOY, is the readily recognizable telescoped form of SARAP PINOY, and that this mark is the foreign equivalent of "Delicious Filipino." The mark, when applied to applicant's food products, touts the products as being delicious Filipino foods, or, stated somewhat differently, as foods that have a delicious Filipino-style taste. Thus, the term SARAPINOY is merely descriptive of a characteristic or feature of the goods.

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Decision: The refusal to register under Section
2(e)(1) is affirmed.