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June 2, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Fonovisa, Inc. v. Aaron Lopez Valdovinos

Opposition No. 91150547 to Application
Serial No. 76236596 filed April 2, 2001

David A. Stall for Fonovisa, Inc.

Cheryl L. Hodgson for Aaron Lopez Valdovinos.

Before Seeherman, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Aaron Lopez Valdovinos (applicant) seeks to register in typed drawing form PUROS CORRIDOS MALANDRINES for a series of phonographic records, cassettes and compact discs containing music. The application was filed on April 2, 2001 with a claimed first use date of November 15, 1999. In his application, applicant stated that "the approximate English translation of the mark is 'Truly Scandalous Ballads.'" Applicant further stated that "one could also translate the term as 'Songs of the Good-for-Nothings.'"

Fonovisa, Inc. (opposer) filed a timely Notice of Opposition in which it stated that it "is a Spanish

language record label that has created, marketed and sold numerous ballads which are known as 'Corridos' in the Spanish language." (Notice of Opposition paragraph 3). Opposer further alleged that the purported Spanish mark PUROS CORRIDOS MALANDRINES "is merely descriptive of a type of ballad, and thus not entitled to registration as a United States trademark." (Notice of Opposition paragraph 2). While opposer did not make specific reference to Section 2(e)(1) of the Trademark Act, it is clear that this is the basis for the Notice of Opposition.

Applicant filed an answer in which he denied the pertinent allegations of the Notice of Opposition. Both parties filed briefs. Neither party requested a hearing.

The record in this case is described at pages 1 and 2 of opposer's brief, and at page 3 of applicant's brief. The parties agreed to present all testimony in the form of declarations. In this regard, opposer submitted the declaration of Dr. Milton Azevedo. Dr. Azevedo is a professor of Spanish and Portuguese at the University of California at Berkeley. Applicant submitted the declaration of Dr. Gerado Luzuriaga. Dr. Luzuriaga is Professor and Chair of the Department of Spanish and Portuguese at the University of California at Los Angeles.

Obviously, this case involves the "doctrine of foreign equivalents," where "foreign words are translated into English and then tested for descriptiveness or genericness." 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 11:33 at page 11-58 (4th ed. 2002). The issue before this Board is whether the Spanish mark PUROS CORRIDOS MALANDRINES, when translated into English, is merely descriptive of a series of phonographic records, cassettes and compact discs containing music.

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 forthwith with "one degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

The crux of the testimony of Dr. Luzuriaga is that "malandrines" is a "grammatically ambiguous word" in that "it can be both a noun and an adjective." Continuing, Dr.

Luzuriaga states that "to say 'corridos malandrines' is to say 'wicked ballads' but also 'bandits' ballads,' which is odd. It is an unusual syntactical construction." (Dr. Luzuriaga declaration pages 2 and 3). Dr. Luzuriaga concludes by saying that "the phrase 'puros corridos malandrines,' which can be translated as 'true wicked ballads' and 'bandits' ballads,' is a clever combination of words." (Dr. Luzuriaga declaration page 4).

Opposer's witness Dr. Milton Azevedo really does not dispute the key points of Dr. Luzuriaga's declaration. At page 3 of his declaration Dr. Azevedo states as follows: "In view of the above it is appropriate to interpret the phrase 'puros corridos malandrines' as meaning that the contents of a given CD are 'nothing but ballads about rouges,' or 'sheer roguish ballads,' or 'sheer rogue's ballads.'" (emphasis added). Thus, both Dr. Luzuriaga and Dr. Azevedo agree that applicant's mark can have two quite different meanings, namely, "truly wicked ballads" or "bandits' ballads." Of course, as previously noted, in his application applicant contended that when translated into English his Spanish mark would have two distinctly different meanings.

Not only do Dr. Luzuriaga and Dr. Azevedo agree that applicant's mark has at least two distinctly different

meanings, but in addition, both experts agree that applicant's mark "is a clever combination of words." (Dr. Luzuriaga declaration paragraph 4). In this regard, Dr. Azevedo states as follows at page 3 of his declaration: "Dr. Luzuriaga correctly points out that the phrase 'puros corridos malandrines' is 'a clever combination of words.' It could hardly be otherwise. One of the hallmarks of advertising language is precisely its appeal to the consumer, and consequently clever word combinations are exactly what one would expect to find on the label of any competitively marketed product."

Opposer had the burden of establishing that applicant's mark PUROS CORRIDOS MALANDRINES is merely descriptive. Opposer has simply failed to carry that burden. Not only has opposer's expert Dr. Azevedo conceded that applicant's mark, when translated into English, can have at least two very different meanings, but in addition opposer's own expert states that applicant's mark "is a clever combination of words." In short, applicant's mark when translated into English simply fails to convey an immediate idea of any quality or characteristic of applicant's goods with the required "one degree of particularity." TMS Corp. of the Americas, 200 USPQ at 59. A truly wicked ballad is quite distinct from bandits'

ballads. The former conjures up images of dirty songs, whereas the latter conjures up images of songs about bandits. While one would never purchase for a child a CD whose subject matter was the former, one might purchase for a child a CD whose subject matter was the latter. That is to say, songs or ballads about bandits may well be appropriate for a child. Accordingly, we find that applicant's mark is simply not merely descriptive.

Decision: The opposition is dismissed.