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Mailed: January 13, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re S LLC, assignee of John Scott Dinsdale

Serial No. 78048188

Gregg Reed of Kluger, Peretz, Kaplan & Berlin, P.L. for
applicant.

Paula M. Mahoney, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Walters, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

The application involved herein was filed on February
13, 2001 by John Scott Dinsdale (a Canadian citizen,
residing in California) to register on the Principal
Register the mark GUARO for goods amended to read
"alcoholic spirits made from sugar cane, in the nature of
brandy and vodka" in International Class 33. The
application is based on Mr. Dinsdale's assertion of a bona
fide intention to use the mark in commerce.

The Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1), on the ground that applicant's mark GUARO, when used on applicant's goods, is merely descriptive thereof.

There is a second basis for refusal in the application. Specifically, registration has been refused based on applicant's failure to comply with the Examining Attorney's requirement for a "complete translation of the non-English word comprising the mark." (Office action dated March 18, 2003, p. 2.)

When the requirement for a complete translation of the mark and the refusal to register were made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

We consider first the issue of mere descriptiveness. The test for determining whether a mark is merely descriptive is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.* 24 USPQ2d 1757 (TTAB 1992); and *In re*

Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A term does not have to describe every quality, characteristic, function, ingredient, attribute or feature of the goods or services in order to be found merely descriptive; it is sufficient for the purpose if the term describes a single significant quality, feature, function, etc. thereof.

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

The Examining Attorney's position essentially is that the term GUARO identifies "an alcoholic beverage that is recognized by an appreciable segment of the American purchasing public as the name of a 'sugar cane brandy.'" (Brief, unnumbered page 8.)¹

In support of the descriptiveness refusal, the Examining Attorney has made of record several dictionary

¹ In her brief (unnumbered page 6), the Examining Attorney argued that "Many Spanish-speaking purchasers in the United States have immigrated from Central American countries and recognize the term to identify 'sugar cane brandy' when they see the mark in the U.S. Likewise, many individuals originally from the United States travel to Central America and will apply this connotation of the term to the applicant's goods." In its reply brief (pp. 4-5), applicant argued that the Examining Attorney's "new argument" should not be considered because applicant had no opportunity to present evidence in response to this argument and because the argument is wholly unsupported by any evidence regarding the numbers of people who immigrate and travel between the United States and Central America.

We do not agree with applicant that this is a new argument. For example, the Examining Attorney argued in her December 15, 2003 Final Office action (unnumbered page 2) that "As travel to Costa Rica and the surrounding areas has increased, so has potential purchasers' awareness increased to various products as they make their way to the U.S. market. These articles demonstrate descriptive use of the term in the United States for the applicant's goods." Moreover, the Examining Attorney has always argued generally that the purchasing public would understand the term "guaro" to refer to sugar cane brandy or liquor.

We do not agree with applicant that the record does not support the Examining Attorney's argument. While there are no specific statistics in the record about immigration and/or travel, the declarations (submitted by applicant) of several individuals clearly state that the individuals were born in Costa Rica or somewhere in Central America or South America and moved to the United States; and the declarations (with curriculum vitae) of others indicate that they have taken jobs at schools or businesses in other nations and/or they have lectured at several cities around the world. Thus, the general statement by the Examining Attorney is supported in this record. Applicant's request that this argument not be considered is denied.

definitions of the term "guaro," a few of which are reproduced below:²

- (1) 1. m. small parrot 2. (C. Am.) sugar cane brandy. Vox New College Spanish and English Dictionary (1984);
- (2) 1. m. a very talkative small parrot 2. m. (C.A.) sugar-cane liquor. Appleton's New Cuyás English-Spanish and Spanish-English Dictionary (1972); and
- (3) Central American spirit, a variant of aguardiente (q.v.). The Dictionary of Drink and Drinking (1965). (In this dictionary "aguardiente" is defined as "'Burning water', brandy or similar sprit of Spain, Portugal and South America.")

The Examining Attorney also submitted printouts of numerous stories retrieved from the Nexis database and some Internet websites³ to show that consumers understand the

² In her brief (footnotes 8 and 12), the Examining Attorney requests that the Board take judicial notice of an on-line dictionary of the term "guaro." Although the Board generally takes judicial notice of dictionary definitions, we have stated that we are reluctant to do so where it involves material from an online dictionary and it was not filed until after the appeal. See *in re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). The Examining Attorney's requests that we take judicial notice of this online dictionary definition are denied.

³ Applicant requests (brief, p. 9, footnote 3) that the Internet websites attached to the Examining Attorney's December 15, 2003 Final Office action not be considered by the Board because "Applicant had no opportunity to address them..." Applicant's request is denied. After appeal, if an applicant desires to introduce additional evidence, it may request a remand under Trademark Rule 2.142(d) to suspend the appeal and remand the application for further examination. Applicant chose not to do so in this case. (We note that after a Final Office action an

term "guaro" to refer to alcoholic beverages made from sugar cane. Examples of these materials are reproduced below:⁴

Headline: Calm, Cozy and Costa Rica
... If you prefer a briefer sea-and-sun experience, try the touristy but relaxing one-day jungle cruise from Puntarenas to Tortuga Island in the Gulf of Nicoya. The 50-foot Calypso glides through peaceful blue waters, past islets and a derelict onetime Staten Island ferryboat, before mooring off Isla Tortuga. The trip is enlivened by rounds of guaro (sugarcane liquor) with fruit punch and marimba music. ... "Newsday," January 31, 1988;

Headline: Book Review Desk The Wolves Are at the Door
... Argueta's second novel, "Little Red Riding Hood in the Red Light District," a kaleidoscopic tale of El Salvador in the 1970's, has finally been published in North America... To most North Americans, for whom Central America was merely a sort of provincial theater in the larger drama of the cold war, the novel serves as a vivid reminder of the terror and hope of wartime San

applicant may request reconsideration under Trademark Rule 2.64(b), and applicant did utilize this procedure after the Examining Attorney issued the first Final Office action on June 13, 2002.)

⁴ Applicant requests (reply brief, p. 3) that the Board disregard the Examining Attorney's reference in her brief to articles attached to her June 13, 2002 Final Office action because that Final Office action was expressly withdrawn and was superceded by the Examining Attorney's Office action dated March 18, 2003. Applicant is advised that the Board has not considered the evidence attached to the June 13, 2002 Final Office action because the Examining Attorney did, in fact, specifically withdraw the June 13, 2002 Final Office action and she stated that the March 18, 2003 Office action was "issued in place of" and "supercedes" the prior Final Office action. (March 18, 2003 Office action, p. 1.)

Salvador. ... Argueta uses this book lovingly to depict the particulars of life in the poor districts of El Salvador in the 1970's: the sound of the clarinero bird, the scent of the maquilishuat tree, the manic energy of the clandestine press, the late nights of drinking guaro liquor in a rundown café. ... "The New York Times," January 17, 1999;

Headline: Revived Contra Bands Afflict Costa Rican Villages

... While four armed men stood guard outside, the assailants robbed the [storekeeper] of \$1700, including \$375 being held for the village school. Then they moved into the attached dry goods store and helped themselves to sardines, cigarettes, powdered milk, batteries and a few bottles of guaro, the local firewater, before escaping down the Sarapiquí River in a stolen outboard. ... "The Washington Post," July 31, 1991;

Headline: Costa Rica: Jungles, Volcanoes and the Deep, Blue Sea

... We stop briefly at a building that, inexplicably, has a giant toucan on its roof. I buy a bottle of the traditional sugar-cane liquor known as guaro and a collection of fired clay ocarinos made by the Bri Bri Indians. The Indians have been making these tiny sculptures since pre-Columbian times, ... Later, back in my room and surrounded by rich tropical woods, I take my own tour into Costa Rican tradition, testing the guaro and coaxing a haunting whistle from an ocarino shaped like a dream bird with gothic fins. ... "Sun-Sentinel (Fort Lauderdale)," April 18, 1993;

Headline: Island Ideas

... Costa Rica's harshest-tasting local liquor is guaro. Sip it with caution and a little water on the side. ... "Chicago Tribune," June 16, 1991;

Headline: Diverse Costa Rica

... Like anyplace else, Costa Rica has its idiosyncrasies, some of which can confuse the unwary traveler. In the interests of wariness, we offer the following information:

...

--Drink: You can drink the water. But why bother? Costa Rican beer is superb. So is the coffee, which is strong and usually taken with milk. For the truly adventursome and economy minded there is also a powerful, inexpensive drink called guaro, a sugar cane hooch. ... Disconcertedness in Costa Rica is easily dispelled, however. Simply arrange for a trip to the rain forests, the mountains or the beach. Or have a guaro. ... "Chicago Tribune," July 30, 1989;

Headline: ... A Nation of Pacifists Fights an Image Problem

... The Costa Rican government, to fight its image problem, has mounted a campaign to coax Americans down for a visit, perhaps even for a lifetime. (The incentives for American businesses and retirees to settle in Tico-land -- tax breaks, cheap labor, fine weather... ..Ticos take whiskey as an aperitif and drink milk or sugar cane moonshine called guaro or -- incredibly -- Coke with their meals, even at elegant restaurants. ... "Chicago Tribune," February 26, 1986;

Headline: The Poor Man's Viagra

... The crowd in the café applauded, and Ricky downed another shot of guaro (sugar-distilled alcohol, resembling

clear tequila.)... "The Weekly Standard,"
April 26, 1999;

Headline: The Price of Lobster
Thermidor

... a kilo--and can make over \$200 in a
two-week diving stint, six months'
income for many Hondurans. But much of
the money goes on drink, mainly guaro,
sugar-cane alcohol. ... "The Economist
(U.S. Edition)," August 23, 1997;

Headline: Costa Which? A Rare Glimpse
of Costa Rican Cuisine

...The native Costa Rican alcoholic drink
is guaro, a sugar cane spirit that is
especially good in Cuba Libre
cocktails, she says. Typical desserts
are flan, arroz con leche (rice
pudding) and sweets made with tropical
fruits. ... "Los Angeles Times," October
18, 2000;

Frommer's

... The national drink is guaro, a rough,
clear liquor made from sugar cane. The
most popular brand is Cacique, which
you'll find at every liquor store and
most supermarkets. Costa Ricans drink
their guaro straight, or mixed with
club soda or Fresca. ...
www.frommers.com/destinations/sanjoseco
starica;

University of California, Education
Abroad Program

Student Guide for Costa Rica

Food-Costa Rica

Costa Rica produces very good beer and
guaro, a strong white rum made from
sugar cane.

www.usc.edu/dept/education/global;
and

Central America Costa Rica

...Food and drink: ... There is a local
specialty called 'guaro' which is a

distilled liquor made from sugar cane -
- it is strong! ...
www.traveleye.com/centralamerica/costarica/customs.

Applicant describes the issue herein as follows: "the relevant question of fact is whether the term 'guaro' has meaning within the United States sufficient to trigger application of the foreign equivalents doctrine. The sole issue on appeal is therefore whether the examining attorney has met her burden of proving that 'guaro' is a recognized Spanish word in the United States." (Brief, pp. 4-5.)⁵

Applicant urges reversal arguing generally as follows (brief, p. 2):

Applicant's mark GUARO is not merely descriptive of the goods covered by the Application ("alcoholic spirits made from sugar cane, in the nature of brandy and vodka") because the word "guaro" has no meaning in the United States, whether in English, Spanish or otherwise. The fact that the word "guaro" has a meaning in Costa Rica cannot support a descriptiveness objection, as trademark law is territorial, and foreign translations not recognized in the United States are not subject to the doctrine of foreign equivalents. The examining attorney does not dispute that law, and has failed to show facts that can support a descriptiveness refusal in the face of it.

⁵ We disagree. The question of the issue before the Board is discussed later herein.

Applicant acknowledges that the word "guaro" means "sugar cane brandy" in Costa Rica (brief, p. 2). But, applicant argues that the word has no meaning as Spanish is spoken and used in the United States as shown by (i) the declarations of twelve individuals who are expert and/or fluent in the Spanish language as used and spoken in the United States, and who all aver as such; (ii) the fact that there are Spanish/English dictionaries which do not include any listing of the word "guaro"; (iii) the dictionary definitions in the record show that the word is an obscure translation of the word "parrot"; (iv) the dictionary definitions in the record show that the word is limited in its application to Central America; (v) the Nexis database stories are irrelevant as nearly all were written with a dateline in or near Costa Rica or they reference the word "guaro" only in the context of how the term is used in Costa Rica, and thus, these stories are not probative of the United States public's perception of the word; and (vi) the Internet websites are all from entities operating in Costa Rica and/or use the word "guaro" solely for the purpose of discussing overseas travel.

Both applicant and the Examining Attorney have made extensive arguments about the doctrine of foreign equivalents and translating the word "guaro" from Spanish

to English.⁶ Several of the citations in the record before us refer to the doctrine of foreign equivalents in the context of the issue of likelihood of confusion.

The issue before the Board in this appeal is that of mere descriptiveness under Section 2(e)(1) of the Trademark Act. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:34 (4th ed. 2001) and cases cited therein. However, the doctrine of foreign equivalents does not apply for the reason that the Examining Attorney has established that the term itself (without translation) is understood by consumers in the United States.

The burden is on the Examining Attorney to establish a prima facie case that the mark is merely descriptive. See *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003), and cases cited therein. Here we find that the evidence proves prima facie that the term "guaro" would be understood in the United States to refer to a regional drink from Costa Rica specifically, or Central America generally. The dictionary definitions clearly indicate that the word "guaro" refers to a sugar cane brandy or more generally a sugar cane liquor. Applicant's goods include a

⁶ It was applicant who first characterized the Examining Attorney's refusal as "presumably based on the 'doctrine of foreign equivalents,' ..." (citing to McCarthy's treatise, the section on the doctrine as it relates to likelihood of confusion cases). Applicant's response filed February 5, 2002, pp. 5-6.

clear, brandy-like liquor, which is what "guaro" is. The fact that the word can also mean "parrot" is not relevant in the context of applicant's identified goods. The uses of the term in United States publications read by English speaking consumers clearly indicate that the term stands for this sugar cane brandy or liquor and it would be so understood by consumers--without translating the word from Spanish to English. (An analogous term would be "sake," which presumably consumers in the United States understand without a translation thereof.) Even if many of the Nexis database stories and the websites on the Internet are about Costa Rica or from Costa Rica, they are in English and are aimed at United States consumers either in terms of news stories involving Costa Rica, or travel stories directed to the reading audience who might travel as tourists to Costa Rica. In addition to English-speaking people exposed to the articles about Central America, the term "guaro" would have a descriptive meaning to Spanish-speaking people from Costa Rica (or Central America) who now live in the United States. The word "guaro" is how United States consumers would ask for or refer to this sugar cane brandy or liquor.

Moreover, and importantly, of the twelve total declarations, several of which are by Spanish language experts, two of those declarants specifically recognized

that "In Costa Rica the term 'guaro' refers to a locally produced beverage" See the declarations of Ms. Martha Fernandez (Berlitz instructor of the Spanish language, born in Costa Rica, living in the United States for over 20 years; and Mr. Carlos Miranda, Ambassador of Costa Rica to Canada. Thus, these two linguistic experts, one being an official of the Costa Rican government, acknowledge that the term refers to a Costa Rican beverage (presumably these experts know that it is specifically sugar cane liquor), just as it is referred to in stories from the Nexis database and from Internet websites.

In light of the overall evidence, we are not persuaded by applicant's argument that the dictionaries indicating "C. Am." or "C.A." with reference to the "sugar cane brandy" definition apply to usage in Central America only.

We agree with the Examining Attorney that the asserted mark, GUARO, immediately describes a significant characteristic or feature of the goods on which applicant intends to use the mark. The term immediately informs consumers that applicant's goods, "alcoholic spirits made from sugar cane, in the nature of brandy and vodka," are some type of sugar cane-based alcoholic spirit. Thus, the record establishes that consumers will view the term, at the very least, as merely descriptive of these goods. Such

purchasers or prospective purchasers will not need to engage in even the slightest degree of cogitation or reasoning to understand the significance of this term when used in conjunction with the product. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994); and *In re State Chemical Manufacturing Co.*, 225 USPQ 687 (TTAB 1985).

Inasmuch as the record establishes that the term "guaro" unquestionably projects a merely descriptive connotation with regard to "alcoholic spirits made from sugar cane, in the nature of brandy and vodka," we believe that competitors have a competitive need to use the term. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994); and 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2001).

Turning next to the question of the translation of the mark, in the March 18, 2003 Office action, the Examining Attorney first required a "complete translation of the non-English word comprising the mark." In response thereto, applicant offered the following statement: "The word 'guaro' has no translation as Spanish is spoken and used in

the United States." (Applicant's response dated September 15, 2003, p. 5.)

The Examining Attorney then argued that "while translation may not be an exact science, when viewed in [the] context of the applicant's goods, the term GUARO is properly translated as 'sugar cane brandy.' The applicant must submit a proper translation of the mark in [the] context of the goods." (December 15, 2003 Final Office action, unnumbered page 3.) Applicant responded thereto arguing in its brief that the translation statement provided is accurate and acceptable because it relates to the English meaning of the term in the United States; and that there is no requirement to translate words from dead or obscure languages, citing TMEP §§809 and 809.01 (3d ed. 2002).⁷

The Examining Attorney argued in her brief that the term must be translated in the context of applicant's goods and that Spanish is not an obscure or dead language.

Because we have found herein that the term "guaro" has a meaning in the United States which is understood without

⁷ We presume that applicant intends this argument to be that the word "guaro" has an obscure translation into English of "parrot"; not that Spanish is an obscure or dead language.

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translation, we find that applicant need not submit a translation of the term.

Decision: The refusal to register based on the requirement for an English translation of the mark is reversed; the refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.