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**THIS DISPOSITION
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Paper No. 12
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re David Amini

Serial No. 75/862,136

Myron Amer for David Amini.

Jason F. Turner, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before **Cissel**, Seeherman and Holtzman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 2, 1999, applicant, an individual who is a citizen of the United States and a resident of the state of New York, filed the above-identified application to register the mark "GIOIA" on the Principal Register for "jewelry," in Class 16. The application was based on applicant's claim of use of the mark in interstate commerce since November 1, 1997.

The Examining Attorney refused registration under Section 2(e)(1) of Lanham Act, 15 U.S.C. 1052(e)(1), on the

ground that the term sought to be registered is merely descriptive of the goods specified the application. In support of the refusal to register, he attached a copy of a page from Cassell's Italian Dictionary, Macmillen (1967), wherein the Italian word "gioia" is defined as "jewel."

Applicant amended the application to seek registration on the Supplemental Register.

The Examining Attorney refused registration on the Supplemental Register under Section 23 of the Lanham Act on the ground that the term applicant seeks to register is generic in connection with the goods specified in the application, and is therefore incapable of identifying applicant's goods and distinguishing them from similar products manufactured or sold by others.

Applicant responded to the refusal to register the mark on the Supplemental Register by amending the identification-of-goods clause to read as follows: "a decorative article of metal construction material worn on the person."

The Examining Attorney maintained the refusal to register the mark on the Supplemental Register. In support of the refusal, he quoted a dictionary definition of the English word "jewel," which is, as noted above, what "GIOIA" translates into, as meaning "a costly ornament of

precious metal or gems." The American Heritage Dictionary of the English Language, Third Edition, Houghton Mifflin Company, (1992).

Additionally, he held that the wording used in the amended identification-of-goods clause was unacceptable because it exceeded the scope of the original identification, and he suggested that applicant adopt the following, if it were accurate: "jewelry, namely, and(sic) ornamental article of precious metal worn on the person which attaches to the front of a garment using a safety pin connector," in Class 14.

Applicant responded by amending the clause to read "an ornamental article of precious metal worn on the person which attaches to the front of a garment using a safety pin connector." Applicant did not adopt the suggested reference to "jewelry," contending that "jewel" and "jewelry," are different words with different meanings. In support of his position, applicant included a definition of "jewel" from Webster's College Dictionary. The word is defined therein as "a fashioned ornament for personal adornment, esp. of a precious metal set with gems."

The Examining Attorney accepted the amended identification-of-goods clause, but made the refusal to register "GIOIA" on the Supplemental Register final with

his third Office Action. Submitted with this Action were copies of excerpts from published articles the Examining Attorney had retrieved in a search of the Nexis automated database of publications. He argued that these excerpts demonstrate that ornamental pins are considered to be jewels.¹

Applicant timely filed a Notice of Appeal, along with an appeal brief. The Examining Attorney also filed a brief, and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

A generic term is unregistrable on the Supplemental Register because it is incapable of identifying and distinguishing the goods which it names. Section 23 of the Act. The test for determining whether a term is generic, and therefore unregistrable on the Supplemental Register, has two parts. First, we must determine what the genus or class of goods is. The second part of the test is determining if the term sought to be registered is understood by the relevant purchasing public primarily to refer to that genus of goods. In re The Society of Reproductive Medicine, 188 F.3d 1341, 51 USPQ2d 1832 (Fed.

¹The articles do not provide clear evidence of the Examining Attorney's position, and we do not rely on them in reaching our decision herein. For example, one shows that pins can contain jewels, in the sense of gemstones, and another refers not to an actual jewel, but rather, to a plant.

Cir. 1999); H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Another important legal principle which is critical to our resolution of this appeal is that the foreign equivalent of a descriptive English word is itself considered descriptive. In re Geo. A. Hormel & Co., 277 USPQ 813 (TTAB 1985); In re Optica International, 196 USPQ 775 (TTAB 1977). Generic terms are considered to be the ultimate in descriptiveness, BellSouth Corp. v. DataNational Corp., 35 USPQ2d 1554 (Fed. Cir. 1995), and the foreign equivalent of a generic term is itself generic, and therefore is unregistrable. Weiss Noodle Co. v. Golden Cracknel & Specialty Co., 129 USPQ 411, 290 F.2d 845 (CCPA 1961).

In the case at hand, applicant has identified his goods as "an ornamental article of precious metal worn on the person which attaches to the front of a garment using a safety pin connector." The record clearly establishes that a jewel is an ornament of precious metal for personal adornment. The dictionary definition submitted by applicant himself shows that "jewel" is a generic term for applicant's identified goods. Moreover, Webster's Ninth New Collegiate Dictionary, 1985 edition (of which the Board

may take judicial notice), defines a "jewel" as an ornament of precious metal often set with stones or decorated with enamel and worn as an accessory of dress." Also, the Italian dictionary of record clearly establishes that "GIOIA" is the Italian equivalent of the word "jewel."

In view of the three dictionary definitions which we have quoted, it is clear that the relevant purchasers of applicant's goods would understand "jewel" to refer primarily to the genus or class of goods which includes precious metal ornaments worn on clothing. In other words, the word applicant seeks to register is the foreign equivalent of the generic term for his goods.

In *In re Analog Devices, Inc.*, 6 USPQ2d 1808 (TTAB 1988), aff'd 10 USPQ2d 1879, 871 F.2d 1097 (Fed. Cir. 1989), "ANALOG DEVICES" was held generic for electronic devices which have analog capabilities. The goods were a subset of the genus named by the mark. In the instant case, the same is true. "Jewel" names the genus. Notwithstanding the convoluted language adopted by applicant's attorney to identify applicant's goods, they are basically "ornamental pins made of precious metal," which the record establishes are a subset of the genus "jewels." "GIOIA," the Italian word for "jewel," thus names the product, but does not identify its source.

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As noted above, neither a generic term nor its foreign equivalent is registrable on the Supplemental Register because neither is capable of identifying applicant's goods and distinguishing them from similar goods produced and sold by others. As the foreign equivalent of the generic term for applicant's goods, "GIOIA" is unregistrable on the Supplemental Register.

DECISION: the refusal to register is affirmed.