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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pemobi Comercial Exportadora Ltda.

Serial No. 75/749,063

Edward A. Sokolski, Esq. for Pemobi Comercial Exportadora Ltda.

Raul Cordova, Trademark Examining Attorney, Law Office 114  
(Margaret Le, Managing Attorney).

Before Hohein, Hairston and Drost, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judges:

Pemobi Comercial Exportadora Ltda., a Brazilian  
corporation located in São Paulo, Brazil, has filed an  
application to register the term "GIALLO CALIFORNIA" as a  
trademark for goods identified as "granite stones".<sup>1</sup>

<sup>1</sup> Ser. No. 75/749,063, filed on July 13, 1999, which alleges a date of  
first use anywhere and in commerce of January 23, 1999. The word  
"GIALLO," which translated from Italian means "YELLOW," is disclaimed.

Registration has been finally refused under Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), on the ground that applicant's mark is primarily geographically deceptively misdescriptive of its goods.

Applicant has appealed. Briefs have been filed but an oral hearing was not requested. We affirm the refusal to register.

In order to establish a *prima facie* case for refusal on the ground that a mark is primarily geographically deceptively misdescriptive of an applicant's goods within the meaning of Section 2(e)(3) of the statute, the Examining Attorney must show that: (1) the primary significance of the mark is a generally known geographic place; and (2) purchasers would be likely to think or reasonably believe that the applicant's goods originate in or are connected with the geographic place identified by the mark, that is, they would make a goods/place association, when in fact the goods do not originate in or are not connected with the place identified by the mark. See, e.g., *In re Save Venice New York, Inc.*, No. 00-1458, slip op. at 3 (Fed. Cir. July 27, 2001); *In re Wada*, 194 F.3d 1297, 52 USPQ 1539, 1540 (Fed. Cir. 1999); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Loew's Theatres, Inc.*,

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769 F.2d 764, 226 USPQ 865, 867 (Fed. Cir. 1985); and In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889, 892-93 (CCPA 1982). However, "[a] mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods." In re Wada, supra, citing In re Nantucket, Inc., supra at 892.

Applicant submits that "the combination of GIALLO with CALIFORNIA makes for a composite mark which is no longer merely geographic or descriptive." In particular, applicant argues that because "California is known for high quality products and [is] a prestigious term which carries an aura of status," the primary significance of the composite term "GIALLO CALIFORNIA" is not geographical "but rather suggests or hints at some desirable aura" of applicant's granite stones.

Applicant, citing an excerpt which is of record from an article on California "which is taken from the online edition of the Encyclopedia Britannica," also maintains that "[i]t is well established and known by potential customers that California is not a source of granite." Such excerpt, in relevant part, states that "[i]n economic terms California is more aptly compared with nations than with states"; that "California supplanted New York in 1965 as the leading state in the export of manufactured goods; and that "[t]he state is dominant in aerospace (although the industry was declining in

the 1990s), agriculture, wine making, and the film and television industries." The excerpt further notes, with respect to mining, that "[g]old mining is now insignificant" and that "[o]ther production includes natural gas, cement, sand and gravel, borate, soda, and salt." In consequence of the omission therein of any reference to granite, and while admitting in its response to the initial Office Action that its goods "originate in Brazil" instead of California, applicant contends that "[t]here is no 'goods-place' association between granite and California to make the mark [primarily] geographically deceptively misdescriptive."

We agree with the Examining Attorney, however, that under the first prong of the test for whether a term is primarily geographically deceptively misdescriptive, the primary significance of the term "GIALLO CALIFORNIA," when considered as a whole, is a generally known geographic place, namely, the state of California. The sole meaning of the word "California," as shown by the dictionary definition of record from Webster's New Geographical Dictionary, is "[a] western state of U.S.A., bounded on N by Oregon, on E by Nevada and Arizona, on S by Mexican state of Baja California, and on W by Pacific Ocean; 3d state in area, 158,693 sq. m. ...; 1st state in population, (1980c) 23,667,902; \* [capital] Sacramento; 31st state admitted to the Union (1850)." Applicant does not contend to the

contrary and, as previously mentioned, has indicated in the application that the Italian word "giallo," which is disclaimed as merely descriptive of its goods, translates to "yellow."<sup>2</sup> We concur with the Examining Attorney that, when used in connection with granite stones, the term "GIALLO CALIFORNIA" "identifies the color and origin of a quarried stone." As the Examining Attorney persuasively asserts in his brief:

In trademarks, every word affects the commercial impression of the mark. The color addition of "giallo (yellow)" conveys the idea that the goods not only originate from California but that they represent a particular type of granite from the state. The color designation addition to the mark (which has been disclaimed) enhances the misconception of the [actual] origin of the goods by increasing the consumer perception of the geographic source of the goods. Customers will believe not only that the goods come from California but that the mark identifies one of several kinds of granite that come from the state. Mining products represent a type of good that when it is

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<sup>2</sup> We take judicial notice, in this regard, that granite comes in a variety of colors. For instance, A Field Guide to Rocks & Minerals (1996) at 23, under the topic of "Granite," states that:

Granites are usually light in color, with readily visible individual mineral grains. They may be gray, white, pink, black and yellow-brown.

It is settled that the Board may properly take judicial notice of entries in standard reference works, including encyclopedias, dictionaries and the like. See, e.g., *In re Hartop & Brandes*, 311 F.2d 249, 135 USPQ 419, 423 at n. 6 (CCPA 1962); *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

identified with a particular locale, the overall geographic significance of the source of the goods dominates since the consumer's expectation as to the provenance of the granite reflects a real plausibility.  
....

We find, therefore, that rather than hinting at or suggesting an aura of desirability, as urged by applicant, the primary significance of the term "GIALLO CALIFORNIA" is that of the state of California, which unquestionably is a generally known geographic place. The geographic significance of the word "CALIFORNIA" is not obscured or eliminated by the addition thereto of the descriptive Italian word "GIALLO," which means "yellow" and which meaning would not be lost or obscured as part of the term "GIALLO CALIFORNIA" when used in association with such goods as granite stones. See, e.g., In re Wada, supra at 1540-41 [primary significance of mark "NEW YORK WAYS GALLERY" for various kinds of leather bags, luggage, back packs, wallets, tote bags, and the like is that of generally known geographic place because term "NEW YORK" is not an obscure geographical term and such geographical significance is not lost by the addition thereto of the words "WAYS GALLERY"].

Inasmuch as the first prong of the test for whether a mark is primarily geographically deceptively misdescriptive has been satisfied, and since applicant, as to the second prong of such test, has admitted that, as indicated previously, its goods

emanate from Brazil instead of California," the sole issue remaining is whether, under the second prong of such test, customers for applicant's granite stones would make a goods/place association upon encountering the term "GIALLO CALIFORNIA" used in connection with those goods. While the Examining Attorney, in light of the absence of any mention of granite in the single encyclopedia excerpt submitted by applicant, has "stipulated for the record that California does not mine or quarry granite," the Examining Attorney nonetheless observes that "the record establishes that there is a mining industry in the state for oil, sand and gravel, lead, magnesium and gypsum."

Specifically, the Examining Attorney relies upon the above-noted definition of "California" from Webster's New Geographical Dictionary, which among other things sets forth as "[c]hief products: Vegetables, fruit, cotton, rice; oil, natural gas, lead, magnesium, gypsum; manufacturing; transportation equipment (esp. aircraft and parts), electrical machinery; lumber; food processing; film industry; [and] tourism," and upon the Encyclopedia Britannica excerpt furnished by applicant, which as previously indicated lists under the topic of "Mining" such "[o]ther production" as "natural gas, cement, sand and gravel, borate, soda, and salt." In view thereof, the Examining Attorney maintains that, "[g]iven that

California is world renowned for having a large diversified economy[,] including mining, it is reasonable to assume that buyers of applicant's slab stones are wont to believe that they originate from the place named in the mark," particularly since, as mentioned earlier, the encyclopedia excerpt furnished by applicant states that "[i]n economic terms California is more aptly compared with nations than with states."

The Examining Attorney, citing *In re Loews Theatres, Inc.*, supra at 868, further contends in this regard that, in order to establish a goods/place association, he must show only a reasonable basis for concluding that the public is likely to believe that the mark identifies the place from which the goods originate. Moreover, it should be pointed out that the Examining Attorney need not show the fame of the place for the goods at issue, but rather just the likelihood that the particular place will be associated with the specific goods. Id. See also *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1030 (TTAB 1985). Here, the Examining Attorney insists that "goods that are dug from ... granite mountains or quarries and are identified by a geographic term ... will inevitably lead customers think that there is a connection between the geographic place named in the mark and the goods, especially when the geographic location is as prominent as California. According to the Examining Attorney:

Mining products are different than manufactured products because they require an actual penetration of the ground which is necessarily located in a fixed geographic area. Naming a mined product after a geographic location creates an immediate association in the marketplace absent a counterweight due to the inherent nature of the goods.

The Examining Attorney therefore reiterates that "there is a reasonable basis to conclude that the public will believe that the [applicant's] goods originate from California based on the size and varied economy of the state and the fact that granite, being a common stone sold in mass, would be viewed as originating from a large geographic area that is identified on the product."<sup>3</sup>

As applicant accurately observes, the *Loews Theatres* case "involved the mark DURANGO for chewing tobacco and it was shown that the city of Durango was in fact a place where tobacco is grown and produced." However, in this case, we nonetheless agree with the Examining Attorney that, even if California is not famous or known for granite stones, such a product is a closely related common building material to cement, sand and gravel, which the record reveals the state's mining industries do in fact produce. Such evidence, along with the demonstrated

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<sup>3</sup> We judicially notice, as implicitly requested by the Examining Attorney in his brief, that the electronic version of The American Heritage Dictionary of the English Language (3rd ed. 1992) defines "granite" as "[a] common, coarse-grained, light colored, hard igneous

fact that California has a large diversified economy, is sufficient to establish a *prima facie* showing that purchasers for applicant's goods, who according to applicant "are not casual customers but rather professional discriminating purchasers such as companies in the construction or building industries," would reasonably believe that granite stones bearing the term "GIALLO CALIFORNIA" are a natural expansion of the state's mining industries and hence originate in California. See, e.g., In re Save Venice New York, Inc., supra at 5 ["from the consumer's perspective, we ... find no reason to believe that the public strictly limits its association of a place to the geographic region's traditional products or services"; instead, "[b]ecause ... consumers may assume that geographic regions, like other commercial actors, are likely to expand from their traditional goods or services into related goods or services, we hold that the registrability of a geographic mark may be measured against the public's association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there"] and In re Broyhill Furniture Industries, Inc., \_\_\_ USPQ2d \_\_\_, \_\_\_ (TTAB 2001) [mark "TOSCANA," which is Italian term for

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rock consisting chiefly of quartz, orthoclase or microcline, and mica, used in monuments and for building."

Tuscany, held primarily deceptively misdescriptive of furniture which does not originate in Tuscany region of Italy].

Moreover, and in any event, we take judicial notice that, contrary to the negative inference from the evidence offered by applicant, California does indeed produce granite. For example, as set forth in the article on "Granite" in 13 The Encyclopedia Americana (int'l ed. 1998) at 172:<sup>4</sup>

Various countries such as Sweden, Finland and Canada have been leading producers of granite. In the United States, large quarries exist in Georgia, North Carolina,

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<sup>4</sup> In fact, California has been a significant producer of granite for many years. For instance, 7 World Book Encyclopedia (1960) at 303 states, under the subject of "GRANITE," that California ranks tenth among the "TEN LEADING GRANITE STATES" in terms of "tons of granite for building purposes" and indicates, under the heading "Where It Is Found," that:

Granite for building stone is quarried in 10 states. Granite used for monuments is quarried in Vermont, Minnesota, Wisconsin, Massachusetts, California, Georgia, Rhode Island, North Carolina, New Hampshire, and Maine. Many of the western states produce granite, but it is used only locally because its heavy weight makes transportation costs high. ....

That California has a significant granite industry is also confirmed by the article on such state in 3 World Book Encyclopedia (1960) at 35, which in the subheading of "*Minerals*" under the topic of "Natural Resources," reports that:

The chief gold deposits lie along the western side of the Sierra Nevada. Silver, copper, granite, marble, and roofing slate are also taken from the Sierra Nevada. ....

Similarly, in the subheading of "*Other Minerals*" under the topic of "Mining," the same article indicates that "California also produces clays, diatomite, granite, gypsum, lead, magnesium, marble, molybdenum, perlite, pumice, pyrites, silver, strontium minerals, sulfur and talc." Id. at 43.

the northern New England states, Minnesota,  
and California.

In fact, we judicially notice that according to an article entitled "Stone, Dimension" from the U.S. Geological Survey Minerals Yearbook--1999 at 73.1, "[d]imension stone" is "defined as natural rock material quarried for the purpose of obtaining blocks or slabs that meet specifications as to size (width, length, and thickness) and shape," of which "the principal rock types are granite, limestone, marble, sandstone, and slate." Such article, under the heading of "Production," indicates in relevant part that:

**Granite.**--Dimension granite was produced by 41 companies operating 75 quarries in 19 states. Production was 437,000 t valued at \$115 million. .... The top five producing States, in descending order by tonnage, were Georgia, Massachusetts, North Carolina, California, and South Carolina. ....

Id. at 73.2. There is simply no doubt, in view thereof, that a *prima facie* case exists that the purchasing public for applicant's goods, which are a type of dimension stone, would make a goods/place association in that they would reasonably think or believe that granite stones bearing the mark "GIALLO CALIFORNIA" originate in California when in fact such goods do not.

**Decision:** The refusal under Section 2(e)(3) is affirmed.