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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Victor Shteinberg

Serial No. 75/796,259

Harold L. Novick of Nath & Associates PLLC for Victor Shteinberg.

Zhaleh S. Delaney, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney).

Before Seeherman, Hanak and Hairston, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Victor Shteinberg to register FINA as a trademark for "jewelry made of precious metal, namely rings, pins, necklaces, earrings and brooches."¹

¹ Serial No. 75/796,259 filed September 9, 1999, which alleges a date of first use of November 13, 1993 and a date of first use in commerce of August 1996.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of his identified goods. In addition, the Examining Attorney has required that applicant submit an appropriate translation of FINA.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Section 2(e)(1) Refusal

The Examining Attorney maintains that "fina" is a Spanish word which means "fine" in English; that the word "fine" when applied to jewelry means of superior quality or containing pure metal in a specified portion or amount; and thus the mark FINA is merely descriptive of applicant's jewelry which is made of precious metal.

Applicant, in urging reversal of the refusal to register, maintains that he adopted the FINA mark to honor his mother; that "fina" has meanings other than "fine" in Spanish; and that Spanish speakers do not use "fina" in describing jewelry.

Applicant does not dispute that the word "fine," when used in connection with jewelry, is merely descriptive thereof.² Moreover, the evidence submitted by the Examining Attorney in the form of NEXIS excerpts and "hits" from a search of the Internet establish that the word "fine" has descriptive significance as applied to jewelry. The following are representative NEXIS excerpts:

There are few stronger brand names than Tiffany, the retailer best known for its ***fine jewelry***.

(Kiplinger's Personal Finance Magazine, February 2001);

Service Merchandise has changed its business to become a specialty retailer focusing on ***fine jewelry***, gifts and home-décor products.

(The Detroit News, January 11, 2001); and

Prices run from %5,000 to \$5 million for ***fine jewelry***, silver and oil paintings that generally predate 1950.

(Fort Lauderdale Sun-Sentinel, January 11, 2001).

Included among the hits in the Examining Attorney's search of the Internet are "Borsheim Fine Jewelry;" "Dia Star Fine Jewelry;" "The Dallas Fine Jewelry Show by Midas;" and "Petrozello Fine Jewelry."

Further, in support of her position that the word "fina" means "fine" in Spanish, the Examining Attorney

² Applicant's brief, p. 5: "It is not controverted that the English word "fine" is merely descriptive with respect to jewelry."

submitted the statement of a Technical Translator at the USPTO that: "The primary meaning of the word *fina* in Spanish is "fine" when applied to jewelry."³ In addition, the Examining Attorney points to the examination history of the application. In the first Office action, the Examining Attorney refused registration of applicant's mark on the ground that it was primarily merely a surname. Applicant, in his response to this Office action, argued that purchasers would not view FINA primarily merely as surname. Rather, applicant maintained that "the present mark to the public has a significance with respect to the goods, which is jewelry made of precious metal, of being of good quality." (Response, p. 2). Also, applicant submitted the following excerpt from the Spanish-English dictionary VOX Diccionario Manual (1971) wherein "***fina***" is defined as: "fine [of high quality; pure, refined]; thin, slender; polite, well-bred, affectionate, true, shrewd; subtle, nice; sharp [polite, sense]." Further, applicant submitted

³ We note that applicant objected to the initial statement of the translator on the ground that it was not verified. The Examining Attorney submitted a verified statement with her brief on the case, thus curing any potential defect.

an excerpt from The American Heritage Dictionary (3d 1994) (electronic version) wherein "***fine***" is defined at 3(b) as: "*Metallurgy*. Containing pure metal in a specified proportion or amount: *gold 21 carats fine.*"

We find that the record in this case supports the Examining Attorney's position that FINA is merely descriptive of applicant's goods. We recognize that the word "fina" has several meanings, but descriptiveness must be considered in relationship to the goods, and as applied to applicant's jewelry made of precious metal, it clearly means superior quality jewelry with a certain metal content. Although applicant argues that Spanish speakers do not use the word "fina" to describe jewelry, applicant offered no evidence to support this contention. In fact, applicant himself has asserted that his FINA mark has the significance of precious metal. Also, applicant's argument is directly contradicted by the verified statement of the PTO's translator. Further, applicant's intent in adopting his mark is simply irrelevant in determining mere descriptiveness.

Translation requirement

Applicant submitted the following translation of his mark: "The English translation of 'FINA' is "sophisticated, refined, slender, fine, good, or pleasant."

The Examining Attorney maintains that the translation should list the primary meaning of the word "fina" first, which according to the Spanish-English dictionary is "fine." The Examining Attorney has proposed the following translation: "The translation of the Non-English language term FINA is fine [of high quality; pure, refined], thin, slender, polite or well bred."

Trademark Manual of Examining Procedure §809.01 states that "[t]he translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language." In this case, the primary significance of "fina" as applied to jewelry is "fine." Thus, we agree with the Examining Attorney that, at the very least, this meaning should be listed first in the translation. The Examining Attorney's requirement for an acceptable translation is well taken.

Decision: The refusal to register under Section 2(e)(1) and the requirement for an acceptable translation are affirmed.