

Hearing:  
Sept. 14, 2004

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed:  
Oct. 27, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re *Nuova Castelli S.p.A.*

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Serial No. 76365834

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*James V. Costigan* of *Hedman & Costigan, P.C.* for *Nuova Castelli S.p.A.*

*Brendan D. McCauley*, Trademark Examining Attorney, Law Office 101 (*Margaret Le*, Managing Attorney).

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Before *Hohein, Walters and Bottorff*, Administrative Trademark Judges.

Opinion by *Bottorff*, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark TIRAMISÙ (in typed form, including the diacritical mark) for goods identified in the application, as amended, as "cheese, milk and milk beverages containing coffee."<sup>1</sup> At issue in this appeal is the Trademark Examining

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<sup>1</sup> Serial No. 76365834, filed February 1, 2002. The application is based on applicant's asserted bona fide intention to use the mark in commerce.

Attorney's final refusal to register the mark on the ground that it is merely descriptive of applicant's goods. See Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). The appeal has been fully briefed, and applicant's attorney and the Trademark Examining Attorney presented arguments at an oral hearing on September 14, 2004. We affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is

being (or intended to be) used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

The evidence of record establishes that "tiramisu" is an Italian dessert.<sup>2</sup> The Merriam-Webster Online Dictionary

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<sup>2</sup> Applicant's mark, as depicted on the drawing page, includes a diacritical mark over the final letter. We note that in each of the numerous references to "tiramisu" which appear in the evidence of record, the word is depicted without any diacritical mark. Similarly, when referring to "tiramisu" products in their briefs, both applicant and the Trademark Examining Attorney omit any use of the diacritical mark. The significance of the diacritical mark in applicant's depiction of its mark is not apparent. In any event, applicant has not argued that the diacritical mark affects the commercial impression created by applicant's mark, or our mere descriptiveness analysis, in any

defines "tiramisu" as "a dessert made with ladyfingers, mascarpone, chocolate, and espresso."<sup>3</sup> Also of record is a printout from the website "www.heavenlytiramisu.com" (introduced by the Trademark Examining Attorney, but specifically relied on by applicant as well). The website informs its visitors, in pertinent part, that "Tiramisu is a cool, refreshing Italian dessert that once tasted, leaves an indelible impression on you"; that "[t]he basic ingredients are eggs, mascarpone cheese, ladyfingers, cream, espresso coffee, liquor - brandy, marsala, rum are some of the spirits used - and a little bit of sugar, and cocoa or shaved chocolate"; and that "today, Tiramisu can be found in restaurants throughout the [United States]."

The Trademark Examining Attorney also has submitted

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way. Indeed, in all papers applicant has filed during prosecution of the application, including its main appeal brief and its reply brief, applicant has referred to its mark as TIRAMISU, without the diacritical mark. In view thereof, and in the absence of any contrary evidence, we deem applicant's mark TIRAMISÛ (with the diacritical mark) to be legally equivalent to TIRAMISU (without the diacritical mark). We also deem the evidence of record which refers to "tiramisu" (without the diacritical mark) to be probative evidence on the question of the mere descriptiveness, *vel non*, of applicant's mark TIRAMISÛ (with the diacritical mark).

<sup>3</sup> The Trademark Examining Attorney submitted a printout of this online dictionary definition with his appeal brief and requested that we take judicial notice thereof. Applicant has not objected, and has treated the definition as being of record. Accordingly, we shall as well. The Board may take judicial notice of dictionary definitions. *See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

excerpts of articles from the NEXIS electronic database which show that tiramisu is a dessert known to Americans.

See, for example, the following:

With a meal such as that, none of us would have wanted appetizers. However, I couldn't resist ordering a tiramisu dessert (\$5.50) to celebrate the birthday of GH. Our waitress was most willing to bring extra plates and forks so that we could all taste it.

(Grand Forks Herald, March 27, 2002);

... minestrone soup, then diners select an entrée from three offerings (chicken cacciatore, grilled calamari skewers or lasagna Bolognese). Tiramisu is the dessert finale.

(The Daily News of Los Angeles, August 29, 2001);

At meal's end, we sampled café latte and vanilla cappuccino, both of which were on the weak side. With the exception of tiramisu, desserts are not made in-house, though they are from small, quality purveyors.

(The Record (Bergen County, NJ), May 4, 2001);

The tortellini di Stefano is a standout, so is the dentici (snapper) alla Barese. Tiramisu is the dessert of choice.

(The Orlando Sentinel, January 21, 2001); and

Signature dishes include an appetizer of bruschetta with Portobella mushrooms, sauteed shrimp with herbs and linguini and the award-winning tiramisu dessert.

(Chicago Daily Herald, June 9, 2000).

Based on this evidence, we find that "tiramisu" is the name of a dessert, and that the term would be recognized as such by the relevant purchasing public.

We also find that "tiramisu" is the name of a flavor which is used in other types of food and beverage products. That is, the evidence of record shows that the dessert known as tiramisu has a recognized and desirable flavor, and that such flavor has been incorporated into a variety of different food and beverage products such as ice cream, candies and, of particular relevance in this case, coffee and cheese. See, for example, the following NEXIS references:

HEADLINE: A FLAVORED ITALIAN CHEESE IS MADE FOR DESSERT LOVERS

...

BODY:

What: Fresh Mascarpone Cheese With Tiramisu Flavor

Maker: BelGioioso (bel-joy-oso) Cheese Inc.

...

PHOTO: BelGioioso Fresh Mascarpone Cheese With Tiramisu Flavor provides an easy ingredient for the popular dessert as well as a quick spread for bread.

(The Philadelphia Inquirer, October 4, 2000);

Recognizing the popularity of classic Italian desserts, BelGioioso Cheese introduces Mascarpone with Tiramisu Flavor.

(Dairy Foods, August 1, 2000);

That favorite Italian dessert, tiramisu, is easier to make thanks to a new cheese from Wisconsin's BelGioioso Cheese Inc.: Mascarpone with Tiramisu Flavor.

(Milwaukee Journal Sentinel, July 30, 2000);

...Market, the holiday trade show for the area's home decorating industry, were flavored cheese balls, after-dinner lollipops, tiramisu coffee

and peanut butter-filled dark chocolate truffles.

(The Advocate (Baton Rouge, LA), September 9, 1999);

The company has brilliantly combined the taste of the Italian classic tiramisu dessert with coffee. Tiramisu Coffee is sold in 1.4-oz. Bags for 99 cents. Each bag yields 12 cups of coffee.

(Gorman's New Product News, August 11, 1997);

The truffle is filled with tiramisu-flavored buttercream, coated with dark chocolate and crumbled amaretti (cookies).

(The Seattle Post-Intelligencer, December 4, 2002);

Haagen-Dazs frozen dessert gelato (je-LAH-toh) - Italian for ice cream - is now available in pints in some grocery stores. ... Taste testers swooned over the samplings of chocolate, cappuccino, coconut, raspberry and tiramisu flavors. Gelato is also available in hazelnut.

(Detroit Free Press, Feb. 13, 2001);

Flavors of the freshly made gelato change, but favorites include tiramisu (a combination of espresso, chocolate and marsala wine flavors), bittersweet (like the chocolate), spumoni, apple cinnamon and seasonal flavors, ...

(Chicago Tribune, September 29, 1996);

Ms. Ang points out that the three most popular choices however are the warm chocolate cake with a scoop of tiramisu ice cream...

(Businessworld, December 13, 2001);

Fall: Pumpkin Spice Ice Cream, Maple Walnut Ice Cream, Cranberry Ice.

Winter: Tiramisu Ice Cream, Egg Nog Ice Cream, Peppermint Ice Cream.

There are also the classics: Vanilla, Chocolate Chip Cookie Dough, Rocky Road and...

(Green Bay Press-Gazette, March 5, 2000);

The winning dessert for me is Young's version of profiteroles, crisp chocolate cream puffs filled with tiramisu ice cream and sauced with espresso custard and warm chocolate. (The San Francisco Examiner, November 19, 1999);

...tower of decadence married with mousse and ringed with Grand Marnier crème anglaise, and - oh, mercy - a dish of Olympic Mountain's tiramisu ice cream. (Seattle Weekly, April 8, 1999);

The chocolate souffle, topped with tiramisu ice cream, is a wicked way to finish up. (Phoenix New Times, September 24, 1998);

Not only can patrons satisfy their cravings for vanilla walnut fudge, malt truffles and homemade tiramisu ice cream, but they're also treated to... (Chicago Tribune, July 30, 1995); and

Back then, every self-respecting eatery from SoHo to Santa Monica, Calif., rushed tiramisu onto its menu, and such variations as tiramisu ice cream, tiramisu yogurt, tiramisu sundaes, Tiramisu liqueur, tiramisu muffins and tiramisu milkshakes were close behind. (The Orlando Sentinel, August 26, 1993).

Based on this evidence, we find that "tiramisu" is a recognized flavor, like "hazelnut" or "cappuccino," which can be and has been used in a variety of other food and beverage products, including cheeses and coffees. There is nothing incongruous or indefinite about referring to such food products as being tiramisu-flavored, when they are designed to taste like the dessert known as tiramisu.

Applicant's goods, as identified in the application, are "cheese, milk and milk beverages containing coffee." Although the identification of goods does not specifically state that the goods are or will be tiramisu-flavored, neither does the identification of goods preclude the presence of such flavoring in applicant's goods. Indeed, in view of the absence of any limitation in the identification of goods, we must presume that applicant's cheese, its milk, and its milk beverages containing coffee are or will be tiramisu-flavored. Applicant's argument to the contrary, i.e., that we should not assume that applicant's goods will be tiramisu-flavored because they are not identified that way in the application, simply is incorrect as a matter of law. Nor is applicant's argument persuasive as a factual matter, given the nature of the mark itself. As the court noted in addressing a similar set of facts in *In re Andes Candies Inc.*, 478 F.2d 1264, 1267, 178 USPQ 156, 157 (CCPA 1973) "We think the only possible reaction of purchasers, upon being presented with CRÈME DE MENTHE chocolate wafers, is the expectation that the wafers will have mint taste something like that of crème de menthe liqueur. Surely, the purchasers would not

expect to find a cherry or rum or butterscotch flavor in the candies."<sup>4</sup>

TIRAMISÙ, the mark applicant seeks to register, is merely descriptive of applicant's goods because it directly and immediately informs purchasers of this key characteristic of the goods, i.e., that they have a tiramisu flavor. It is irrelevant that applicant's goods are not themselves tiramisu, i.e., the dessert. "It is sufficient to preclude registration that the mark merely describes the flavor characteristic" of the goods. *In re Andes Candies Inc. supra*, 478 F.2d at 1267, 178 USPQ at 157 (CRÈME DE MENTHE merely descriptive of chocolate mint candy squares). *See also In re Gyulay, supra* (APPLE PIE merely descriptive of characteristic of potpourri, i.e., its scent); and *In re International Salt Co.*, 171 USPQ 832 (TTAB 1971)(CHUNKY CHEESE merely descriptive of cheese-flavored salad dressing).

Contrary to applicant's argument, we find nothing indefinite or incongruous about TIRAMISÙ, as applied to applicant's goods. The evidence of record establishes that at least one other company already sells tiramisu-flavored

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<sup>4</sup> In any event, if applicant's goods in fact are not tiramisu-flavored, then the mark TIRAMISÙ obviously would be deceptively misdescriptive of the goods and thus would still be unregistrable under Section 2(e)(1).

cheese, and that it markets the product as such. Although there is no evidence that anyone has yet marketed tiramisu-flavored "milk" or tiramisu-flavored "milk beverages containing coffee," that fact is not dispositive. We find that purchasers who encounter such goods sold under the designation TIRAMISÙ, being familiar with the dessert and with the existence of other tiramisu-flavored products on the market (including such related products as milkshakes and coffee), will immediately understand that the word TIRAMISÙ merely describes the flavor or taste of the products. Indeed, it is hard to imagine that they would understand the term to mean anything else, as applied to the identified goods.

In summary, we find that the evidence of record establishes that TIRAMISÙ is merely descriptive of applicant's goods, and that registration of applicant's mark therefore is barred under Trademark Act Section 2(e)(1).

**Decision:** The refusal to register is affirmed.