

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mexico 69 SRL¹

Serial No. 78361172

Nancy Dwyer Chapman of Lackenbach Siegel LLP for Mexico 69 SRL.

Nelson Snyder, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Hairston, Walters and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Mexico 69 SRL, applicant, has filed an application to register the mark DE PUTA MADRE (in standard character form) for "men's and women's jumpers, sweaters, t-shirts, shirts, trousers, hats" in International Class 25.²

¹ The assignment of the application from Simone Brizio, an Italian individual, to Mexico 69 SRL, an Italian Limited Liability Joint Stock Company, is recorded in the Office records at reel/frame 3095/0713.

² Application Serial No. 78361172, filed February 2, 2004, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. Applicant deleted the additional filing basis under Section 44(e) of the Trademark Act during the prosecution of the application. The application

Registration has been refused under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that applicant's mark comprises immoral or scandalous matter.

When the refusal was made final, applicant appealed and requested reconsideration of the final refusal. On January 27, 2006, the examining attorney denied the request for reconsideration and the appeal was resumed. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal.

As a preliminary matter, the examining attorney's objection to the evidence attached to applicant's brief which was not introduced into the record during the prosecution of the application is sustained and those exhibits have been given no consideration. Trademark Rule 2.142(d); TBMP §1203.02(e) (2d ed. rev. 2004). Applicant's request in the alternative that we take judicial notice of these "USPTO records" is denied. As described by applicant, the exhibits consist of USPTO documents regarding the status and file-wrapper contents of another pending application. The Board does not take judicial notice of third-party applications or registrations. In re Carolina Apparel, 48 USPQ2d 1542, n.2 (TTAB 1998); and

includes the following translation statement, "The English translation of the words De Puta Madre in the mark is 'Whore

Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986).³ We also decline to take judicial notice of the Internet printouts of online dictionaries attached for the first time to the examining attorney's brief. In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999) (Board will not take judicial notice of online dictionaries which otherwise do not exist in printed format).

The examining attorney contends that "DE PUTA MADRE, is a vulgar, slang expression equivalent to 'FUCKING GREAT' in English." Br. p. 3. In support of this contention the examining attorney has submitted declarations from the USPTO Technical Translator Steven M. Spar, with accompanying dictionary references for "de puta madre"; dictionary definitions of the words "fucking," "whore," "motherfucker," and "son of a bitch"; excerpts from websites that contain general commentary (www.roadkill.com, www.runswith.com, rmonico.blogspot.com, en.wikipedia.org); and an article retrieved from the Lexis/Nexis database.

Mother's' in the Spanish language."

³ We hasten to add that even if these documents had properly been made of record, they would not have changed the result we reach herein.

In traversing the refusal applicant contends that the mark is not considered vulgar in Spanish or as translated into English.⁴ Applicant argues that the mark translates "colloquially in English to the complimentary and clearly inoffensive terms 'very well,' 'well done,' and/or 'great'" (br. p. 4) and the word for word translation is "of whore mother," or "whore mother's" (br. p. 3). Applicant continues that "the mark DE PUTA MADRE would clearly be registrable given the number of marks on the Principal Register consisting at least in part of the word 'whore' or its equivalent." Applicant further posits that in a case "of reasonable ambiguity as to a mark's offensiveness, the Board should pass the mark to publication to give others the opportunity to object." Br. p. 4. In support of its position applicant has submitted Internet printouts from various websites; the affidavit of Judith Koehler as an expert in the Spanish and English languages; translations from Spanish to English for the words "de," "puta" and

⁴ Applicant's argument set forth in its brief concerning a co-pending application is moot in view of a similar refusal issued in that application. See App. Reply Br. p. 2. Moreover it is well settled that each case is decided on its own facts, and each mark stands on its own merits and prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); and *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994).

"madre" excerpted from Simon and Schuster's International Dictionary English/Spanish Spanish/English (1978); printouts retrieved from the Trademark Electronic Search System (TESS) of third-party registrations that include the words "whore," "puttana," and "ho"; excerpts from third-party online personal journals; and an excerpt from wikipedia.

Registration of a mark which consists of or comprises immoral or scandalous matter is prohibited under Section 2(a) of the Trademark Act. Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has noted that the burden of proving that a mark is scandalous rests with the USPTO. *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1339, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003) citing *In re Mavety Group, Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994). Further, the court stated as follows:

In meeting its burden, the PTO must consider the mark in the context of the marketplace as applied to the goods described in the application for registration. [citation omitted] In addition, whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes, [citation omitted], keeping in mind changes in social mores and sensitivities.

In re Boulevard Entertainment, Inc., 334 F.3d 1336, 1339, 67 USPQ2d 1475, 1477. See also *In re McGinley*, 660 F.2d 481, 485, 211 USPQ 668, 673 (CCPA 1981).

The examining attorney must demonstrate that the mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; ...giving offense to the conscience or moral feelings; ...[or] calling out [for] condemnation." *In re Mavety*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994) citing *In re Riverbank Canning Co.*, 95 F.2d 327, 37 USPQ 268 (CCPA 1938). Dictionary evidence alone can be sufficient to satisfy the USPTO's burden, where the mark has only one pertinent meaning. *Boulevard, supra*, 67 USPQ2d at 1478.

The question that must be answered is whether the evidence of record is sufficient to show that a substantial composite of the general public finds use of the term DE PUTA MADRE in connection with applicant's clothing "scandalous" within the meaning of Section 2(a). As previously noted, we must make this determination not in isolation, but in the context of the goods in the marketplace and in view of contemporary attitudes.

It cannot be, nor has it been, disputed that a substantial portion of the general public in the United States speaks Spanish. All of the Spanish dictionary definitions of record for the entire phrase DE PUTA MADRE

indicate that it is "rude," "offensive" or "vulgar."⁵ These references were submitted under the declaration of Steven M. Spar a USPTO technical translator. He states the following:

1. I am fluent in the Spanish language and have been translating Spanish for twenty years.
2. I have been certified in Spanish-English translation by the American Translators Association.
3. I am a Technical Translator for the United States Patent and Trademark Office, where I have worked for ten years.
- ...
6. The wording, *de puta madre* is a vulgar, slang expression equivalent to "fucking great" in English.
7. The web site www.diccionarios.com covers the text of the *Diccionario Anaya de la Lengua Española*. The entry for *de puta madre* appears as a subheading under the definitions of *madre* and is preceded by the notation *malsonante*, which means "rude" or "offensive" in Spanish.
8. The monolingual Spanish dictionary found at www.wordreference.com, which covers the text of the *Diccionario de la Lengua Española*, published in 2005 by Espasa Calpe, S.A., gives the notation *loc. Adv. Vulg.* Before the idiomatic phrase *de puta madre*, appearing as a subheading under the definitions for *madre*. This notation indicates that it is a vulgar adverbial phrase.
9. The monolingual Spanish dictionary found at <http://diccionarios.elmundo.es>, which is part of the website for the Spanish newspaper *El Mundo*, gives the notation *loc. Adv. Vulg.* Before the

⁵ Applicant's argument that the notation "vulg." means "common (or colloquial)" rather than vulgar as used in the dictionary notations is not supported by timely evidence; the Internet dictionary reference attached to its brief is untimely. Moreover, the argument is undermined by the dictionary excerpts submitted by applicant where the Spanish word for "son of a bitch" is noted as "vulg." and the Spanish word for "go whoring" is noted as "coll." In addition, applicant has not disputed the meaning of "malsonante" as rude or offensive.

idiomatic phrase *de puta madre*, which appears as a subheading under the definitions for madre. This notation indicates that it is a vulgar adverbial phrase.

The vulgar or offensive connotation of this phrase is further supported by the excerpts from various websites. For example the rmonico.blogspot.com excerpt includes the following:

The clothing brand De Puta Madre was very controversial because of its name. But what most people don't know is *de puta madre* is slang for fucking good as in *Este Fiesta es de puta madre* (this party was fucking good). Using strong themes such as Drugs, Weapons, and Sex and slogans such as Fuck Barbie or Will Fuck for Coke, the brand has become very popular around the clubbing scene.⁶

See also, www.roadkill.com ("...The new Alice in Chains album is 'de puta madre' (in spanish), it's to say, fucking great.")

We do not find the evidence presented by applicant sufficient to rebut the examining attorney's prima facie case. Applicant's expert, Judith Koehler, stated by way of affidavit:

1. I am an acknowledged expert in connection with formal and colloquial Spanish and English languages and have acted as an expert in connection with translations between Spanish and English in the past.

⁶ Applicant stated in its brief that it is not clear whether this clothing brand is referring to the applicant. Whether or not it refers specifically to applicant is not the point, rather, it is an example of how the phrase in issue, DE PUTA MADRE, is understood.

...

4. The direct translation of the phrase DE PUTA MADRE is: "from/of whore/prostitute mother."

5. ...the equivalent, alternative, slang or other related expression of the term DE PUTA MADRE is not 'Fucking Great.' Indeed, the slang equivalent of DE PUTA MADE is Really Great or 'Really Cool' and is a positive phrase, not considered vulgar in either Spanish or the English equivalent.

6. I state and assert with certainty that "DE PUTA MADRE" is not considered offensive by the Spanish speaking community, could never be directly or indirectly translated into "Fucking Great" or would there be an accepted alternative or universally understood connotative equivalence to "Fucking Great."

These statements are not supported by any documentary evidence and are, in fact, contradicted by the Spanish dictionary entries. Applicant's other evidence does not serve to corroborate its assertion that the phrase is not vulgar. Indeed, some of the evidence submitted by applicant supports the examining attorney's position. For example, the excerpt from the wikipedia website states "The name De Puta Madre is Spanish for 'son of a bitch'..." and the excerpt noting the meaning of de puta madre as "Great well done" is from a website titled Spanish Swearing. In another excerpt retrieved from the Internet the meaning of "de puta madre" is discussed as meaning very well but the same passage places the phrase in the context of a vulgar expression, "This is a strange expression used in Spain to mean 'very well'...The camera crew was from Spain, and they

enjoyed teaching me Spanish expressions, especially the vulgar ones..." Only one submission from applicant could be characterized as in accord with the declaration. In an excerpt on a page of Spanish slang from the Discovery Sevilla website the phrase is given a G rating. Finally, applicant's translations of the separate parts of the phrase are not probative. In contrast, the listings of the entire phrase in the Spanish dictionary provide an understanding of how the phrase is viewed by Spanish speakers.

The fact that DE PUTA MADRE has a positive meaning does not take away from the fact that the phrase is a vulgar expression as evidenced by the dictionary entries attached to Mr. Spar's declaration and considered to be a form of swearing as evidenced by the Internet printout submitted by applicant. A vulgar term may be used with a positive or negative meaning but that does not remove it from offensive speech. For example, in The American Heritage Dictionary of the English Language (4th ed. 2000) "fucking" is listed as vulgar slang used as an intensive. See www.bartleby.com attached to the first Office action. Thus, "really great" and "fucking great" both have the same positive meaning but one expresses that meaning in an inoffensive manner and the other expresses it in a vulgar

manner. We do not view this positive meaning as another meaning for the phrase such that it would remove it from a Section 2(a) prohibition. See *In re Mavety*, supra, 31 USPQ2d at 1928. "Fuck" also has an innocuous meaning "to treat somebody unjustly or harshly," encarta.msn.com, but it is referenced as highly offensive. Here, DE PUTA MADRE is referenced as offensive, rude, and vulgar in the Spanish dictionaries while it means "very good." We agree with applicant that the Internet printouts from personal journals are of limited probative value as to how a substantial composite of the U.S. public would view this phrase. However, they do corroborate the vulgar reference attached to this phrase in the Spanish dictionaries and Mr. Spar's translation.

Finally, while applicant argues that if the Board has doubts as to whether the examining attorney has established that the mark is scandalous or immoral, any such doubt should be resolved in favor of applicant, based on this record, we have no such doubt.

Decision: The refusal to register under Section 2(a) is affirmed.