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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BrandMark LLC

Serial No. 78726602

Antoinette M. Tease of Antoinette M. Tease, P.L.L.C. for
BrandMark LLC.

Hanno Rittner, Trademark Examining Attorney, Law Office 117
(Loretta C. Beck, Managing Attorney).

Before Bucher, Drost, and Zervas, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 4, 2005, applicant (BrandMark LLC) applied,
under the intent to use provisions of the Trademark Act (15
U.S.C. § 1051(b)), to register on the Principal Register the
mark ESPAÑA GROVE, in standard character form, for goods in
Class 32 ultimately identified as follows:

Non-alcoholic beverages, namely, drinking waters,
mineral and aerated waters, fruit drinks, fruit juices,
vegetable juices in beverage form, carbonated soft
drinks, energy drinks and hypertonic sports drinks;
fruit and vegetable concentrates for the mixing of
drinks; syrups for making fruit and carbonated
beverages; alcoholic beverages, namely, beer.

The examining attorney has refused to register applicant's mark on the grounds that the mark is primarily geographically deceptively misdescriptive and geographically deceptive under the provisions of Sections 2(e)(3) and 2(a) of the Trademark Act. 15 U.S.C. §§ 1052(e)(3) and (a). When the refusals to register were made final, applicant appealed to this board. In the examining attorney's appeal brief, the examining attorney withdrew the refusals as they applied to certain goods in the identification of goods. Therefore, the only goods that are now subject to the examining attorney's refusals are set out below:

Non-alcoholic beverages, namely, fruit drinks, fruit juices, fruit concentrates for the mixing of drinks; syrups for making fruit beverages.

We begin our analysis by looking at the record in this case. In response to the examining attorney's first Office action, applicant submitted the following statement: "The foreign wording in the mark translates into English as 'Spain.'" The examining attorney also included a definition of "España" as "Spain." *WordReference.com English-Spanish Dictionary*. At this point, we add that the word "España" in English is defined as the "Spanish name of Spain." *The*

Random House Dictionary of the English Language (unabridged)
(2d ed. 1987).¹

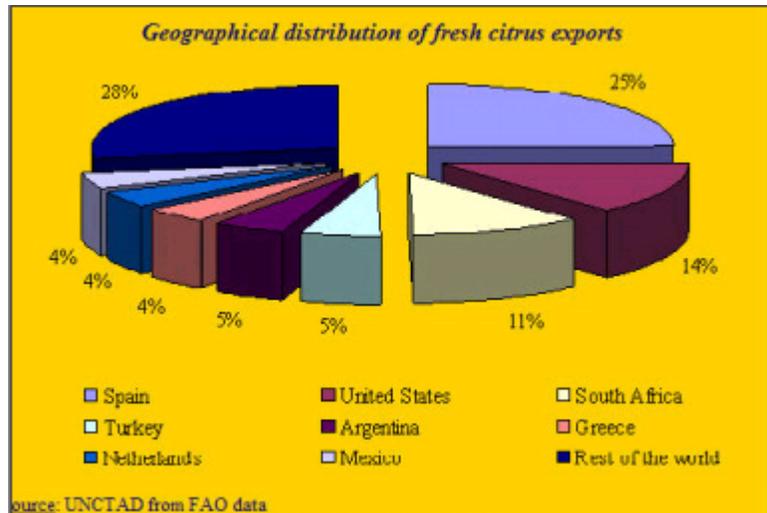
With the final refusal, the examining attorney included definitions of "grove" that included the following: "a group of trees planed and cultivated for the production of fruit or nuts: *an orange grove.*" Dictionary.com. Also, in response to an inquiry from the examining attorney, applicant² responded: "The undersigned counsel has been informed by the client that the identified goods are not and will not be manufactured, produced or sold in Spain, nor will they have any other connection with Spain." Response dated April 17, 2006 at 1.

The examining attorney also submitted evidence concerning Spain and fruit that indicates that Spain is a major producer of citrus fruits. "In the Mediterranean countries, citrus fruits are produced mainly for fresh fruit consumption. Spain is the leading producing country in the area." *InfoComm Market Information in the Commodities Area*. www.unctad.org. In a chart from the report concerning

¹ We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

² Applicant identifies itself as a Tennessee limited liability company located in Lakeland, Tennessee.

citrus production, Spain is identified as one of the leading exporters of citrus fruit:



Indeed, Spain is listed as a major, if not the leading, source of oranges, small citrus, lemons, limes, and grapefruit.

For the different types of citrus fruits, major exporting countries are the following, ranked as for 2003 FAO data:

Oranges	Spain, South Africa, United States, Greece, Morocco, Netherlands, Turkey, Egypt, Australia, Italy
Small citrus	China, Israel, South Africa, Cyprus, India, Netherlands, Pakistan, United States, Spain, Mexico
Lemons and limes	Spain, Argentina, Mexico, Turkey, United States, South Africa, Netherlands, Brazil, Italy, Greece
Grapefruit	United States, South Africa, Israel, Turkey, Netherlands, Belgium, Spain, Argentina, Cyprus, Bahamas

Other evidence discusses the reputation of Spain for citrus fruit. See *Citrus: Tastes So Sweet*, DoItYourself.com:

Blood oranges are old varieties of oranges that until recently were virtually unknown in the U.S. despite our huge citrus industries. The red color of the flesh and juice is the most obvious difference, but there's something more to the flavor as well. Americans

traveling in France, Italy or Spain would relish a glass of blood orange juice, sometimes believing it a mixture of regular orange juice with raspberry and other fruit juices...

"Sanguinelli" blood orange. This is a late-ripening blood orange from Spain. The flesh is usually a shade lighter than "Moro," but skin color is often a stunning cherry red...

Clementines

Perhaps the best-known Mandarin by name. Clementines have been popular for years, especially in the Eastern U.S. Their arrival in the markets is a cause for celebration... Most Clementines that reach the U.S. are grown in Mediterranean Europe and are seedless varieties.

Spain also is the second largest exporter of grape juice and grape juice concentrates to the United States.

www.cawg.com ("U.S. imports of grape juice and grape concentrate came from thirteen (13) countries in 1999. The top five exporters to the U.S. were Argentina (55.4%); Spain (11.2%); Mexico (8.4%); Brazil (6.7%) and Italy (4.4%)").

Spanish fruit is touted for its quality and diversity.

www.rentspain.com:

For thousands of years Spanish farmers have produced some of the finest fruits in the world, unsurpassed in both the variety and quality available. The diverse selection of fruits grown in the groves, vineyards and orchards across the Iberian Peninsula suite any taste or palate....

Spanish citrus fruits, particularly oranges, lemons and mandarins are grown under irrigation in the Mediterranean coastal provinces, which extends the growing season to cover the entire year and guarantees an extremely high standard of quality to the harvest.

For over a generation this has maintained Spain's status as the leading producer in Western Europe and the world's foremost exporter of citrus fruit.

The farmers of each district produce a large selection of fruit, often specializing in a regional variety for which they are most renowned. The most popular unique local specialties include giant strawberries of Huelva; the tasty winter tomatoes of Almeria; and the Chirimoyas, or custard apples from all across Andalusia.

However, the superb muscatel grapes grown in Malaga are often the most highly regarded of all Spain's fruit. These delicious grapes are destined to become the excellent wine and raisins of Malaga and benefit from the perfect agricultural conditions found in and around the capital of the Costa Del Sol.

Furthermore, an article refers to a store selling "Spanish juices, food and spices bought by Hispanics on the [Eastern] Shore." *Hispanic Trending*, juantornoe.blogspot.com. The website www.alibaba.com advertises numerous juices and juice and fruit products from Spain, e.g., "100% Fruit Juices and Nectars in Bottles," "Fruit Juices - Health and Energy Lines," and "Canned Peaches." Finally, the United States "has remained a net fruit importer. U.S. fruit imports grew during the last two decades and through the early 2000's, due in part to the growing ethnic population in the United States ... Western Europe is a major supplier of processed fruit such as wine and fruit juices." www.ers.usda.gov.

Applicant has submitted numerous printouts with its appeal brief to which the examining attorney has objected.

These printouts include detailed statistics from the U.S. Census Bureau's website on the Hispanic population of the United States and printouts of several U.S. trademark registrations. We agree that this evidence is untimely. 37 CFR § 2.142(d). See also In re N.V. Organon, 79 USPQ2d 1639, 1640 n.2 (TTAB 2006) ("Additional evidence filed after appeal normally will not be considered"). Moreover, we do not take judicial notice of registrations in the USPTO. In re Carolina Apparel, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) ("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record").³

In light of the evidence of record, the examining attorney argues that "because Spanish groves are renowned for production of the finest citrus fruits in the world and in

³We add that registrations involving such terms as COLUMBIA (a term with numerous meanings in the United States) and ARIZONA ICED TEA SUN BREWED STYLE would have little, if any relevance, to this proceeding. Also, "[e]ven if some prior registrations had some characteristics similar to [the] application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Furthermore, the evidence about the exact size of the Hispanic population in the United States appears to have little significance to the facts of this case. The fact that there is a large Spanish-speaking population in the United States is suggested by the examining attorney's evidence. See also In re Thomas, 79 USPQ2d 1021, 1024 (TTAB 2006) ("[A]pplicant's own evidence shows that of the foreign languages with the greatest number of speakers in the United States, French is ranked second only to Spanish"). We add that even if all of applicant's untimely evidence were considered, it would not change the result.

the absence of counter-evidence, it is 'likely' that a consumer forms a mistaken belief that the origin of the fruit in the goods [is] from Spain." Brief at unnumbered p. 12. The examining attorney also maintains (Brief at unnumbered p. 13) that consumers "are materially influenced to buy fruit juices and citrus fruit products marked as originating from a 'grove of Spain' because 1) a principal product of Spain is fruit juice and citrus fruits and 2) Spanish fruit and fruit juices are an added value to consumers."

Applicant argues (Reply Brief at 2) that:

Contrary to the assumption upon which the examiner's argument appears to be based, the term "Hispanic" or "Spanish" does not mean that something *comes from Spain*. See the attached definition of the term "Spanish," which means not only "of or pertaining to Spain, its people, or their language" but also "the Spanish people collectively" and "the language of Spain, standard in most of Latin America except Brazil." The term "Hispanic" is synonymous with "Spanish" (see attached dictionary definition). It also means "Latin American" or "an American citizen or resident of Spanish or Latin American descent."

The examiner's argument assumes that consumers will see the word "ESPAÑA" and assume that the product originates from Spain, when that is not the case. The terms "Spanish" and "Hispanic" have a much broader meaning and are associated with parts of the globe other than Spain itself.

We begin by responding to this argument of applicant by noting that both definitions applicant references are from online dictionaries that were not previously of record, and

unlike print dictionaries, we do not take judicial notice of online dictionaries. In re Total Quality Group, Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). Second, it appears that applicant has overstated the relationship between "Spanish" and "Hispanic." Undoubtedly, there is some overlap between the terms but they cannot possibly be synonyms (a word having the same or nearly the same meaning as another in the language). Applicant has presented no evidence that there are interchangeable references such as the "Hispanic Army/Spanish Army," the "Hispanic countryside/Spanish countryside" or "Hispanic King/Spanish King." Third, applicant's own argument makes it clear that "Spanish" means "of or pertaining to Spain, its people, or their language." There is no evidence that products that are not from Spain are referred to as "Spanish" because they come from Latin America. Finally, we emphasize that the term at issue is not "Hispanic" or even "Spanish" but "España." Applicant itself translates the term as "Spain" and the dictionary of record confirms that translation. Indeed, even the English dictionary defines "España" as the Spanish name for Spain. We are unaware of any other translation that the term can have besides "Spain" and applicant has not even suggested one. It is not clear why any Spanish-speaking person or even

many non-Spanish speaking residents of the United States with even a passing familiarity with the country of Spain would have any question that the term ESPAÑA unambiguously means Spain.

We now move to the merits of the refusals. The question then is whether ESPAÑA GROVE is primarily geographically deceptively misdescriptive or geographically deceptive for applicant's fruit drinks, juices, concentrates, and syrups. In In re California Innovations Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003), the Federal Circuit explained the new relationship between Sections 2(e)(3) and 2(a), as a result of the amendments to the Trademark Act:

§ 1052 no longer treats geographically deceptively misdescriptive marks differently from geographically deceptive marks. Like geographically deceptive marks, the analysis for primarily geographically deceptively misdescriptive marks under § 1052(e)(3) focuses on deception of, or fraud on, the consumer. The classifications under the new § 1052 clarify that these two deceptive categories both receive permanent rejection. Accordingly, the test for rejecting a deceptively misdescriptive mark is no longer simple lack of distinctiveness, but the higher showing of deceptiveness.

The TMEP (Section § 1210.05(a)(4th ed. 2005) (emphasis added)) has explained the effect that this has had on USPTO practice:

Prior to the amendment of the Trademark Act by the NAFTA Implementation Act, the test for determining whether a mark was primarily geographically deceptively

misdescriptive under §2(e)(3) of the Trademark Act differed from the test for determining whether a mark was deceptive under §2(a) of the Act, 15 U.S.C. §1052(a). To establish that a mark was primarily geographically deceptively misdescriptive under §2(e)(3), the examining attorney had to show that the primary significance of the mark was geographic, that purchasers would be likely to believe that the goods or services originated in the place named in the mark, and that the goods or services did not originate in that place. In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982). An additional showing of "materiality" was required to establish that a mark was deceptive under §2(a), i.e., a showing that a goods/place or services/place association made by purchasers was "material" to the decision to purchase the goods or services. Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp., 6 USPQ2d 1610 (TTAB 1988); In re House of Windsor, Inc., 221 USPQ 53 (TTAB 1983), recon. denied, 223 USPQ 191 (TTAB 1984).

Current Practice. The Court of Appeals for the Federal Circuit has held that with the NAFTA amendments, §2 of the Act "no longer treats geographically deceptively misdescriptive marks differently from geographically deceptive marks," and that a showing of public deception is required to establish that a mark is unregistrable under §2(e)(3). In re California Innovations Inc., 329 F.3d 1334, 1339, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003), reh'g denied, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003). Thus, *the test for determining whether, post-NAFTA, a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is now the same as the test for determining whether a mark is deceptive under §2(a).* Id., 329 F.3d at 1340, 66 USPQ2d at 1857.⁴

⁴In addition, TMEP § 1210.05 provides that:

Although the test for determining whether a mark is primarily geographically deceptively misdescriptive under § 2(e)(3) is now the same as the test for determining whether a mark is deceptive under § 2(a), the statutory provisions with respect to registrability on the Supplemental Register and on the Principal Register under § 2(f) are different... [B]ecause the statute expressly prohibits registration of deceptive marks on the Supplemental Register or on the

Therefore, as a result of these changes, we will discuss the primarily geographically descriptive refusal although our discussion is equally applicable to the geographically deceptive refusal. As discussed above, this type of refusal requires the examining attorney to show that:

1. The primary significance of the mark is geographic;
2. That the consuming public would likely believe that the place identified by the mark indicates the origin of the goods when the goods do not originate in that place; and
3. That the misrepresentation would be a material factor in the purchaser's decision to buy the goods.

See In re Les Halles de Paris J.V., 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (restaurant services) and California Innovations, 66 USPQ2d at 1858.

Regarding the first factor, we have already discussed the term "España" and we have no doubt that the term has an unambiguous meaning of "Spain" in Spanish and also to a large number of English speakers. Also, adding the term "Grove" does not create a non-geographically descriptive term. The goods in this case are various types of fruit-based products.

Principal Register under § 2(f), the examining attorney will initially refuse registration of geographically deceptive marks under both §§ 2(a) and 2(e)(3). If the applicant alleges use in commerce prior to December 8, 1993 and amends to the Supplemental Register, or establishes that the proposed mark acquired distinctiveness under § 2(f) before December 8, 1993, the examining attorney will withdraw the § 2(e)(3) refusal, but will not withdraw the §2(a) refusal.

The dictionary of record makes it clear that "groves" are "a group of trees planed and cultivated for the production of fruit or nuts: *an orange grove.*" The mark ESPAÑA GROVE as a whole would be likely to be perceived as indicating the geographic origin of applicant's fruit-related products and, therefore, the primary significance of the mark is geographic for fruit products grown in groves in Spain. See, e.g., In re Wada, 194 F.3d 1297, 52 USPQ2d 1539, 1540-41 (Fed. Cir. 1999) (Federal Circuit affirmed the board's finding that the "primary geographic significance is not lost by the addition of WAYS GALLERY to NEW YORK"). Accord In re Budge Manufacturing Co. Inc., 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988) (LOVEE LAMB for automotive seat covers not made from lambskin held to be deceptive).

Concerning the next factor, we conclude that the purchasers would be likely to believe that applicant's goods originated in "España" or Spain.⁵ Spain is a major source of many types of citrus fruits including oranges, lemons, limes, and grapefruit. It is also the second largest exporter of grape juice and grape juice concentrates to the United

⁵While the Federal Circuit has noted that in "a case involving goods, the goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product," Les Halles, 67 USPQ2d at 1541, the evidence shows that Spain is not only a known source for fruit products but one of the leading sources of various fruit products.

States. Inasmuch as Spain is a major producer and exporter of fruit and fruit-based products, potential purchasers are likely to believe that the goods originate in Spain.

Furthermore, we note that applicant has unequivocally stated that its goods "are not and will not be manufactured, produced or sold in Spain, nor will they have any other connection with Spain." See also Brief at 3 (Applicant "does not dispute that its products will not originate from Spain"). We add that applicant is a Tennessee company that is likewise located in that state. Therefore, while the application involved in this appeal is an intent to use application, it is clear that there is no dispute that the goods will not originate in Spain.

The last issue is whether the misrepresentation is a material factor in a consumer's decision to purchase applicant's goods. "For goods, the PTO may raise an inference in favor of materiality with evidence that the place is famous as a source of the goods at issue." Les Halles, 67 USPQ2d at 1542. As evidence of the materiality, the examining attorney has included evidence that Spain is one of the leading, if not the major exporter of oranges, small citrus, lemons, limes, and grapefruits. Spain is also the second leading source of grape-related exports to the

United States. In addition, as the previously discussed evidence indicates, Spain's fruit is touted for its high standard of quality, its long growing season, and its diversity. Rentspain.com. More specifically, "Americans traveling in France, Italy or Spain would relish a glass of blood orange juice." One of these blood oranges is the Sanguinelli, "a late-ripening blood orange from Spain." Doityourself.com. Clementines, which are very popular in the eastern United States "are grown in Mediterranean Europe." Id. We simply cannot agree with applicant's argument that "there is no evidence that [the consumers'] assumption [that the goods come from Spain] would be a material factor in their decision to purchase the applicant's goods." Reply Brief at 2. Obviously, it would be a rare case in which the Office would find evidence that expressly says that "the reason consumers buy Product A is because it comes from Geographical Area X, which is noted for Product A." Therefore, it is not surprising that the examining attorney has not presented that type of evidence in this case. Instead, the examining attorney has demonstrated that Spain is a major producer of various fruits, a factor that is entitled to some weight. Furthermore, consumers are described as "relishing" blood orange juice while in Spain,

and celebrating the arrival of Clementines from Mediterranean Europe in the Eastern U.S. In addition, Spain has been touted as a source of "some of the finest fruits in the world, unsurpassed in both the variety and quality available." It is reasonable to assume that consumers, aware of these statements and claims about Spanish fruit, would be materially influenced in their decisions to purchase goods of applicant's type identified by the term ESPAÑA GROVE. We add that applicant has offered no evidence that undercuts the evidence of materiality of the term "Spain" or "España."

Therefore, we conclude that the term ESPAÑA GROVE, when it is used on non-alcoholic beverages, namely, fruit drinks, fruit juices, fruit concentrates for the mixing of drinks; and syrups for making fruit beverages, would be primarily geographically deceptively misdescriptive of those goods that do not originate in Spain. Furthermore, inasmuch as the standards are the same, the term would also be geographically deceptive of the same goods.

Decision: The refusals under Sections 2(a) and 2(e)(3) of the Trademark Act are affirmed.