

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: June 15, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re ProMark Brands Inc.

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Serial Nos. 77266099 and 77266087

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Carrie L. Kiedrowski and Timothy P. Fraelich of Jones Day  
for ProMark Brands Inc.

Kathleen H. Lorenzo, Trademark Examining Attorney, Law  
Office 109 (Dan Vavonese, Managing Attorney), for Serial No.  
77266099.

Inga Marie Ervin, Trademark Examining Attorney, Law Office  
111 (Craig D. Taylor, Managing Attorney), for Serial No.  
77266087.

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Before Walters, Bucher and Grendel, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

ProMark Brands Inc. has filed an application to  
register on the Principal Register the marks ORE-IDA STEAM

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N' MASH and STEAM N' MASH for "processed potatoes," in International Class 29.<sup>1</sup>

The examining attorney for Serial No. 77266099 (ORE-IDA STEAM N' MASH) has issued a final requirement for a disclaimer of the phrase STEAM N' MASH, under Section 6 of the Trademark Act, 15 U.S.C. §1056, on the ground that this phrase is merely descriptive in connection with the identified goods.

The examining attorney for Serial No. 77266087 (STEAM N' MASH) has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with the identified goods.

Applicant has appealed. Both applicant and the examining attorneys have filed briefs.

In view of the common questions of law and fact, we have considered the appeals in these two applications together and we issue a single opinion herein deciding both appeals.

The issue before us is whether STEAM N' MASH is merely descriptive in connection with processed potatoes.

The examining attorneys contend that STEAM N' MASH describes how the goods are prepared. Serial No. 77266099

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<sup>1</sup> Respectively, Serial Nos. 77266099 and 77266087, both of which were filed August 28, 2007, based on allegations of a bona fide intention to use each mark in commerce.

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contains the following definitions of "steam" and "mash" from *The American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000):

Steam - "to expose to steam, as in cooking."

Mash - "to convert into a soft pulpy mixture: *mashed potatoes*."

Serial No. 77266087 contains the following definitions of "steam" and "mash" from the *Encarta World English Dictionary*, North American edition, [www.encarta.msn.com](http://www.encarta.msn.com):

Steam - "to cook something in the steam of boiling water; or to be cooked in this way."

Mash - "crush or grind something."

In both applications, the examining attorneys submitted excerpts from numerous websites that use the words "steam" and/or "mash" as part of a description of how to prepare potatoes or in reference to a machine for steaming potatoes and other foods, and then suggestions for mashing potatoes. The record also includes an excerpt from applicant's website referring to its STEAM 'N MASH processed potatoes with text describing how easy it is to steam and mash its processed potatoes.

Applicant contends that the examining attorney in each case improperly dissected the mark, arguing that the phrase/mark STEAM 'N MASH when considered in its entirety is suggestive at most. Applicant submitted copies of third-

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party registrations for marks that include the word "steam" and argues that its mark should likewise be registrable. Applicant also submitted excerpts from Internet websites and the results of a search using the Google Internet search engine, all of which refer to potatoes as well as numerous other foods that can be steamed and mashed. In view of this evidence, applicant contends that the phrase STEAM 'N MASH is not merely descriptive in connection with applicant's processed potatoes. Applicant also submitted copies of other registrations it owns and third-party registrations that include the word "steam" and/or "mash," some of which do not include disclaimers of claims of acquired distinctiveness, and argues that its mark is likewise registrable.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single,

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significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We agree with the examining attorney that the phrase STEAM 'N MASH merely describes the preparation method for the identified goods, processed potatoes, as evidenced, in particular, by applicant's own website's description of the ease of preparation of mashed potatoes using the identified product. Additional third-party website excerpts in both applications clearly demonstrate that steaming and mashing potatoes is a common preparation method. Moreover, we do not consider the mark in the abstract, but necessarily consider the identified goods. Thus, the fact that other foods may also be steamed and mashed is irrelevant.

We remind applicant that each case must be decided on its own facts and the noted registrations do not compel a different result herein. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to

[applicant's] application, the USPTO's allowance of such prior registrations does not bind the Board or this court."]. However, third-party registrations can be used as a form of a dictionary definition to illustrate how the term is perceived. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987). In this regard, it is clear from both these registrations and the Internet evidence that "steam" and "mash" have commonly understood meanings in connection with food preparation, particularly potatoes. Moreover, in the context of the phrase STEAM 'N MASH, there is no question that "'N" is an abbreviation of "and," and applicant does not contend otherwise.

In conclusion, when applied to applicant's goods the phrase STEAM N' MASH immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, as discussed above. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the phrase STEAM N' MASH as it pertains to applicant's goods.

*Decision:* The refusal under Section 2(e)(1) of the Act in Serial No. 77266087 is affirmed. The application will be abandoned in due course.

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The requirement for a disclaimer under Section 6 of the Act in Serial No. 77266099 is affirmed. If, within twenty days of the date of this decision, applicant submits a disclaimer of STEAM 'N MASH in proper form, this decision will be set aside and the application will proceed to publication in due course.