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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Peace Mountain Natural Beverages Corp.

Serial No. 77326673

Mario G. Ceste, Esq. for Peace Mountain Natural Beverages Corp.

Mary D. Munson-Ott, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Quinn, Wellington and Ritchie, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Peace Mountain Natural Beverages Corp. filed, on November 11, 2007, an intent-to-use application to register the mark SKINNY CEREAL for "nutriceuticals for use as a dietary supplement in the form of cereal products and cereal-based snack foods" in International Class 5, and "breakfast cereal, snack food, namely, cereal based snack food, processed cereal-derived food products to be used as a breakfast cereal, snack food or ingredient for making food" in International Class 30.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, when used in connection with applicant's goods, is merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. We affirm.

The examining attorney maintains that the identification of goods, as worded, is broad enough to include diet foods in the nature of low-fat, low-calorie, and sugar-free foods. According to the examining attorney, the word "skinny" is a slang term meaning "low-fat" and, in this connection, the examining attorney relied upon a dictionary definition. The examining attorney also relied upon a dictionary definition of the word "cereal." In further support of the refusal, the examining attorney submitted excerpts of third-party websites showing the descriptive use of "skinny" in connection with diet foods and beverages. Based on the evidence of record, the examining attorney states that "consumers clearly understand 'skinny' to mean that the goods are lower in fat, lower in calories, or lower in some other ingredient

or attribute that has a negative connotation in today's weight-conscious society." (Brief, unnumbered p. 5).

Applicant states that its SKINNY CEREAL mark creates a new and different commercial impression from that engendered by the individual words, so that the combination is registrable. Applicant argues that there is no evidence in the record to support the examining attorney's statements that applicant's products are "presumably low-fat or low calorie," or that the products are for weight and appetite control. To the contrary, applicant points out that some weight management programs, such as Atkins, discourage low-fat and low-calorie products. In any event, applicant contends, its goods are vitamin-enriched food supplements having a medicinal effect on human health, not diet foods. Applicant also argues that the word "skinny" has multiple meanings and, with respect to the present mark, "the public cannot determine if applicant's mark is indicating a product which is low-fat, just slender, minimal or a thin product or a product which resembles skin." (Brief, p. 3). In this connection, applicant furnished dictionary definitions of the word "skinny."

A term is deemed to be merely descriptive of goods or services, within the meaning of 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. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (TTAB 2007); and *In re Abcor Development*, 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; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *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 used on or in connection with the 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. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). 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."

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In re Tower Tech Inc., 64 USPQ2d 1314, 1316-17 (TTAB 2002).

The "average" or "ordinary" consumer is the class or classes of actual or prospective customers of applicant's goods or services. *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

The examining attorney's dictionary evidence shows that the word "skinny" means, inter alia, "very thin; low-fat: made with skim milk (slang)." The word "cereal" is defined as "breakfast food: food made from cereal and eaten especially at breakfast, usually with milk." Encarta World English Dictionary (North American ed. 2007). The dictionary evidence furnished by applicant shows a variety of meanings of "skinny," including "very lean or thin; unusually low or reduced; meager; minimal." (www.dictionary.com).

Applicant also submitted a copy of an advertisement for its product sold under the mark SKINNY WATER. The advertisement states the following about the product: "0 calories 0 sugar 0 guilt."

The record includes the following excerpts retrieved from the Internet:

Here then are the Top Ten skinny foods for summer. Let this be your healthiest (and skinniest) summer ever!....There you go. The Top Ten Summer Foods--all 10 of them naturally

skinny foods, packed full of nutrients to make you healthy, wealthy and wise--enjoy!

(www.augustafreepress.com)

Skinny Foods

The secret to making any food a skinny food is in the ingredients...We'll teach you tricks that you can use to cook and eat yourself thin.

7 Age-Fighting Skinny Foods.

Try these recipes based on some of the Anti-Aging Skinny Foods.

(www.jennifertvshow.com)

[Planning is] an essential process for preventing hunger...and for always having healthy, skinny foods on hand.

(www.sugarfreemiracle.com)

Starbucks Latte and Mocha Offerings get a Skinny Makeover to Help Coffee Lovers Feel Great in 2008.

Just in time for the New Year, Starbucks helps customers keep their resolutions without sacrificing flavor with the introduction of the "Skinny" platform, a nonfat Latte made with sugar-free syrup...The Skinny platform is one of the ways Starbucks is committed to meeting customers' desire for healthier options in 2008.

(www.nationaldairyCouncil.org)

Low Calorie Recipe for Skinny Enchiladas.

(www.dietbites.com)

Magic Bullet Blender Recipe for Smooth Skinny Pudding.

There's a twist to our low calorie, low fat pudding recipe...

(www.dietbites.com)

6 Skinny Cheeses That Taste Creamy.

[T]here are lots of low-fat

varieties...
(www.shine.yahoo.com)

People tend to feel less guilty when they indulge in low-fat foods. And they eat more, even if the "skinny" versions don't taste as good as the originals.
(www.education.com)

Skinny Chicken Spinach Soup.
(www.sparkpeople.com)

Will Starbucks' "Skinny" lattes help keep you skinny?
(www.chicagotribune.com)

What are Skinny Mashed Potatoes?
[S]kinny mashed potatoes are made by substituting nonfat or low-fat milk...
(www.lowfatcooking.about.com)

Ideal as a base for making "Skinny" (low fat) milk shakes...
(www.frostyboy.com)

Based on the evidence of record, we conclude that SKINNY CEREAL is merely descriptive of applicant's cereal and cereal products. The individual merely descriptive words retain their descriptive character when combined to form the entirety of applicant's mark. The mark immediately informs prospective customers that applicant's cereal and cereal products are low-fat and/or low-calorie, or otherwise will allow the consumers of applicant's cereal and cereal products to achieve or maintain a skinny or thin body. In applicant's words, it "has created a family of healthy lifestyle products for weight and appetite

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control." (Response, June 25, 2008). No imagination is required to discern this feature and/or purpose of the goods.

In urging that the refusal be reversed, applicant points to the existence of its "portfolio" of subsisting registrations of the following marks: SKINNY WATER ("WATER" disclaimed) (Reg. No. 2557075 issued April 2, 2002) for "nutriceuticals for use as a dietary supplement, nutriceuticals in concentrate form for use as a dietary supplement; isotonic drinks, isotonic drinks in concentrate form, drinking water"; SKINNY SHAKE ("SHAKE" disclaimed) (Reg. No. 2743268 issued July 29, 2003) for "dietary meal replacement in powder, liquid or concentrate form"; SKINNY COLA ("COLA" disclaimed) (Reg. No. 2650352 issued November 12, 2002) for "colas"; SKINNY TEA ("TEA" disclaimed) (Reg. No. 2657057 issued December 3, 2002) for "tea, namely, tea not made with non-fat milk"; SKINNY JUICE ("JUICE" disclaimed) (Reg. No. 2657083 issued December 3, 2002) for "nutriceuticals for use as a dietary supplement; nutriceuticals in concentrate form for use as a dietary supplement; isotonic drinks; juice; concentrates or powders used in the preparation of juice drinks"; and SKINNY CAPS ("CAPS" disclaimed) (Reg. No. 3316575 issued October 23, 2007) for "dietary and nutritional supplements." Applicant

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also has received notices of allowance for its marks SKINNY SMOOTHIE ("SMOOTHIE" disclaimed) (Ser. No. 77145760, third extension to file SOU granted) for "nutriceuticals for use as meal replacements and dietary supplements, nutriceuticals in ready-to-drink or concentrate form for use as a dietary supplement, nutritional drink mix for use as a meal replacement; dairy based beverages, yogurt based beverages, soy-based beverage used as a milk substitute; shakes in the form of mixes for making yogurt-based blended beverages or ready-to-drink yogurt-based blended beverages; smoothie drinks, or concentrates and powders used in the preparation of smoothie drinks; soy-based beverages not being milk substitutes"; and SKINNY JAVA ("JAVA" disclaimed) (Ser. No. 78734027, fifth extension to file SOU granted) for "dietary food supplement, made with coffee products or coffee extracts, namely a liquid or concentrate containing coffee, coffee flavoring, espresso or caffeine activated ingredients; nutriceuticals in concentrate or liquid form, containing coffee, espresso, coffee flavoring or caffeine, for use as a dietary supplement; ready to drink soft drinks containing coffee, coffee flavoring, espresso or caffeine activated ingredients; isotonic drinks containing coffee, coffee flavoring, espresso or caffeine activated ingredients; liquid, concentrate or powdered mix

used to make isotonic drinks containing coffee, coffee flavoring, espresso, or caffeine activated ingredients; drinking water containing coffee, coffee flavoring, espresso or caffeine activated ingredients." In response, the examining attorney states that "trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought." (Brief, unnumbered p. 8).

As pointed out by the examining attorney, trademark rights are not static, that is, such rights do not remain constant over time. As the late Judge Rich observed: "Rights in this field do not stay put. They are like ocean beaches; they shift around. Public behavior may affect them." Rich, "Trademark Problems As I See Them-- Judiciary," 52 Trademark Rep. 1183, 1185 (1962). In this case, we suspect that the use of the word "skinny" for foods and beverages, as evidenced by the recent descriptive use in the food and beverage industry in connection with low-calorie and/or low-fat consumables, has evolved over time.¹ Notwithstanding the status of the word "skinny" in

¹ Although not argued by applicant, we do not view the present refusal to register as an impermissible collateral attack on applicant's prior, incontestable registrations. The present mark and listed goods differ from applicant's marks and goods set forth in its prior registrations. It is settled that a

the past, the Internet and dictionary evidence demonstrates that the term has taken on a merely descriptive meaning today when used in connection with foods and beverages, that is, that the food or beverage is low-calorie and/or low-fat. Or stated somewhat differently, that consumption of applicant's cereal and cereal products will assist a consumer of the goods to achieve or maintain a "skinny" or thin body.

Moreover, each case must be decided on its own facts. We are not privy to the files in applicant's registrations and applications. In any event, we are not bound by the prior actions of examining attorneys. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court.").

We conclude that the designation sought to be registered by applicant is merely descriptive of

"registered mark is incontestable only in the form registered and for the goods or services claimed." See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1779, 1782 (Fed. Cir. 2001), quoting *In re Merrill Lynch, Pierce, Fenner and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). See also *In re Outdoor Group*, 81 USPQ2d 1392, 1398 (TTAB 2006); *In re Best Software*, 63 USPQ2d 1109, 1113 (TTAB 2002); and *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986).

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applicant's goods in each class.

Decision: The refusal to register in each class is affirmed.