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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dakota Natural Foods, Inc.

Serial No. 77356614

Bruce H. Little of Linguist & Vennum, P.L.L.P. for Dakota Natural Foods, Inc.

Katina S. Mister, Trademark Examining Attorney, Law Office 104 (Michael Baird, Acting Managing Attorney).

Before Grendel, Holtzman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 20, 2007, applicant Dakota Natural Foods, Inc. applied to register the mark JUMBOZ in the form shown below on the Principal Register for "processed sunflower seeds" in Class 29. Serial No. 77356614.

Jumboz

The application contains a date of first use anywhere and in commerce of May 31, 2003. Color is not claimed as a feature of a mark.

The examining attorney has refused to register applicant's mark on the ground that "the mark is merely descriptive, and in fact a generic term, for a feature of the applicant's goods." Brief at 1.

After the examining attorney made the refusal final, applicant filed this appeal.

The examining attorney maintains that the "term JUMBO is defined as a 'large thing'.... When the term JUMBOZ is used in the context of the applicant's goods it immediately describes a feature of the goods, specifically that the sunflower seeds are 'large' sunflower seeds." Brief at unnumbered pp. 3-4. The examining attorney also cites a previous board decision involving applicant, *In re Dakota Natural Foods, Inc.*, Serial No. 78326818 (TTAB August 28, 2007). That case concerned applicant's earlier attempt to register the term JUMBOZ in standard character form on the Supplemental Register also for processed sunflower seeds. The board concluded:

[W]e find that the evidence of record clearly demonstrates that "jumbos" is a term used to refer to extra-large or jumbo sunflower seeds. Based on this evidence, we conclude that JUMBOZ, the legal equivalent of JUMBOS, is generic for applicant's

"processed sunflower seeds." As such, it is incapable of distinguishing applicant's goods and therefore is unregistrable on the Supplemental Register.

Id. at 4.

In addition, the examining attorney argues that "[b]ased on the previous adjudication of this mark, the issue of descriptiveness is now *res judicata*." Brief at 6. Regarding the stylization of applicant's current mark, the examining attorney describes it as "an ordinary, block font. The only thing stylized about the letters in the mark is the leaning letter J at the beginning of the mark which leans lightly to the left and the letter Z at the end of the mark that leans back to the right. Unfortunately, the degree of stylization is not particularly striking, unique or distinctive so as to create a commercial impression separate and apart from the unregistrable components of the mark." Brief at 7.

In response, applicant argues that its mark "is a play on the adjective 'jumbo'" (Brief at 6) and that:

Applicant is not seeking to register the term "JUMBOZ" merely as a word mark. Applicant seeks registration of the word "JUMBOZ" only in its stylized or design form, with the falling capital "J" at the beginning of the word and the bouncing lower case "Z" at the end...

First, in evaluating the distinctiveness of the design of the mark, the Board must not disregard the facts (a) that "JUMBOZ" is not an actual word in the English language; (b) that, if "JUMBOZ" were an actual word, it would not have a plural; and (c) that if it were an

actual word and had a plural form, it would not, using standard English, be pluralized with a "Z." Arbitrary and incongruous combinations of English words and foreign terms have been found to be registrable...

Second, the design of "JUMBOZ" is distinctive... Together, the falling capital "J" at the beginning of the word and the bouncing lower case "Z" at the end create a distinctive commercial impression.

Reply Brief at 1-3.

Applicant concludes that "the Board should permit registration of the mark 'JUMBOZ (stylized and/or with design)' with a disclaimer of the word 'JUMBOZ.'" Reply Brief at 4. In its response dated September 26, 2008 at 2, applicant first offered to "amend its application to disclaim the word 'JUMBOZ' apart from the mark as shown."

Both applicant and the examining attorney also refer to applicant's specimen, which is set out below.



We add that included with the examining attorney's definitions of "Jumbo" are two that indicate that the word has a noun form with the plural spelling indicated as "Jumbos." *Merriam-Webster Online* and www.bartleby.com.

Therefore, the issue in this case is whether applicant's mark is registrable on the Principal Register with a disclaimer of the term JUMBOZ. We agree that the term JUMBOZ is at least merely descriptive of processed sunflower seeds. The definitions support the examining attorney's argument that "jumbo" is a very large thing. Applicant's specimens indicate that its sunflower seeds are "BIG" and the specimen also contains the phrase "When size

matters." The definitions also specify that the term JUMBO can be used as a noun and its plural is spelled JUMBOS. Applicant's mark JUMBOZ is the phonetic equivalent of the term JUMBOS and as such it is also at least merely descriptive of applicant's goods. It has long been held that such slight misspellings do not overcome evidence of descriptiveness.

The word, therefore is descriptive, not indicative of the origin or ownership of the goods; and being of that quality, we cannot admit that it loses such quality and becomes arbitrary by being misspelled. Bad orthography has not yet become so rare or so easily detected as to make a word the arbitrary sign of something else than its conventional meaning....

Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446, 455 (1911). See also *Nupla Corp. v. IXL Mfg. Co.*, 114 F.3d 191, 42 USPQ2d 1711, 1716 (Fed. Cir. 1997) (CUSH-N-GRIP "which is merely a misspelling of CUSHION-GRIP, is also generic as a matter of law"); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 129 USPQ 411 (CCPA 1961) (HA-LUSH-KA held to be the generic equivalent of the Hungarian word "haluska").

A mark is merely descriptive if it immediately conveys "knowledge of a quality, feature, function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). To be "merely descriptive," a term need

only describe a single significant quality or property of the goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We do not determine the issue of descriptiveness in the abstract, but in relation to the particular goods or services for which registration is sought. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). In this case, we find that the term JUMBOZ is merely descriptive of applicant's goods because it identifies a feature or quality of the goods, i.e., that its sunflower seeds are "big" or larger than other sunflower seeds.

We add that the doctrine of res judicata also supports the examining attorney's argument that applicant's mark is at least merely descriptive. "A second suit is barred by res judicata if: (1) there is identity of parties (or their privies); (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first." TMEP § 1217 (5th ed. rev. September 2007). See also *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748, 1752 (Fed. Cir. 2007) ("In this case, however, there is no dispute that the same applicant, Bose, is involved in the prior and present proceedings and that there was a prior final judgment on the merits, i.e., the functionality, of the identical

design. Thus, the general prerequisites of res judicata have been satisfied. However, Bose contends that three facts and circumstances have changed and were not considered in the prior proceeding such that application of res judicata in this appeal is not appropriate").

In the present case, the parties are also the same and there has been a final judgment on the merits. Applicant does not contend that the circumstances have changed (except that it is now seeking registration of its mark in a stylized form with a disclaimer of the term). Thus, there is no dispute that the word JUMBOZ itself is at least merely descriptive of the goods and, if there were, the doctrine of res judicata would prohibit its relitigation. Therefore, the only issue remaining is whether the word JUMBOZ in stylized form is registrable on the Principal Register with a disclaimer of the word JUMBOZ.

Since applicant is seeking registration on the Principal Register, not the Supplemental Register, without relying on Section 2(f) of the Trademark Act, we must determine if the stylization of the mark is inherently distinctive.

Previously, marks with fairly minimal stylization have been held to be *capable* of registration on the Supplemental Register. For example, in *In re The Wella Corp.*, 565 F.2d

143, 196 USPQ 7 (CCPA 1977), the Court of Customs and Patent Appeals held that the term, in the display shown below, was registrable on the Supplemental Register, with the word "Balsam" disclaimed.

The word "balsam" is written in a large, black, cursive script. The letters are connected, with a prominent 'b' and a long, flowing 'a'.

Subsequently, the board found that the term YOGURT BAR displayed in the style shown below was also registrable on the Supplemental Register with a disclaimer of "Yogurt Bar." *In re Carolyn's Candies, Inc.*, 206 USPQ 356 (TTAB 1980).

The words "YOGURT BAR" are written in a bold, black, blocky font. The letters are thick and have a slightly irregular, hand-drawn appearance. The word "YOGURT" is larger than "BAR".

When "words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed, under Section 6." *In re Clutter Control, Inc.*, 231 USPQ 588, 589 (TTAB 1986). See also *In re Miller Brewing Co.*, 226 USPQ 666 (TTAB 1985) (LITE (stylized) for beer registrable of the Principal Register with a disclaimer of the word). However, even to be registrable on the Supplemental Register, a design must

not be ordinary. *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1227 (TTAB 1987) ("[I]t is our view that the presentation of applicant's mark simply does not possess the degree of stylization necessary to warrant allowance on the Supplemental Register"):

La Lingerie

When considering whether a design in a mark is inherently distinctive, the following test has been applied by the Court of Customs and Patent Appeals.

In determining whether a design is arbitrary or distinctive this court has looked to whether it was a "common" basic shape or design, whether it was unique or unusual in a particular field, whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or whether it was capable of creating a commercial impression distinct from the accompanying words.

Seabrook Foods, Inc. v. Bar-Well Foods Limited, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977) (footnotes omitted).

Some marks have been held to be registrable on the Principal Register when generic or merely descriptive words are combined with a distinctive stylization or design.

See In re Jackson Hole Ski Corp., 190 USPQ 175, 176 (TTAB 1976) (Applicant argued, and the board agreed, that a mark

consisting of a geographical designation and "the letters 'JH' displayed in a distinctive and prominent fashion so as to create a commercial impression in and of themselves... [and] the letters 'JH' are twice the size of the other letters; that unlike any of the other letters, they are partly joined together, creating the visual impression of a monogram; and that they are set down from the rest of the letters, which positioning has the effect of highlighting the 'JH couplet'" was distinctive); and *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977) (Mark shown below with the word "pipe" and the representation of the pipe disclaimed had acquired distinctiveness):

the pipe

See also In re Grand Metropolitan Foodservice, 30 USPQ2d 1974, 1976 (TTAB 1994) ("In view of the nature of applicant's inventive and somewhat stylized mark, being an obvious play on the word 'muffin' and the word 'fun,' we believe that the meaning or commercial impression of applicant's mark will be more than that simply of the word 'muffins.' Therefore, applicant's mark is not merely descriptive").

However, "a display of descriptive, generic or otherwise unregistrable matter is not registrable on the

Principal Register unless the stylization of the words or the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves." *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002). See also *In re Behre Indus.*, 203 USPQ 1030, 1032 (TTAB 1979) ("[T]he distinctive display of descriptive or otherwise unregistrable components of a mark cannot bestow registrability upon the mark as a whole unless the features are of such a nature that they undoubtedly would serve to distinguish the mark in its entirety in the applicable field or it can be shown through competent evidence that the unitary mark as a whole displayed in the asserted distinctive manner does in fact create a distinctive commercial impression separate and apart from and above the descriptive significance of its components").

The following stylized marks were held not to be inherently distinctive. *In re Guilford Mills Inc.*, 33 USPQ2d 1042 (TTAB 1994):

The image shows the word "microdenier" in a highly stylized, hand-drawn font. The letters are interconnected, with the 'o' and 'd' being particularly prominent and overlapping. The 'm' has a small crossbar, and the 'i' has a dot. The overall style is informal and sketchy, typical of a trademark drawing for a legal proceeding.

In re Pollio Dairy Products Corp., 8 USPQ2d 2012, 2014 (TTAB 1988) ("In the absence of any evidence to convince us otherwise and since we quite agree with the Examining Attorney that there is nothing unusual or even different in the formation of the letters which would cause this presentation of the word, LITE, to stand out from any other such presentation"):

The word "Lite" is written in a cursive script font. The letters are slanted to the right, and the 'L' and 'A' are capital letters. The word is centered on the page.

In another case, the board found that "the slightly slanted letters and capitalization of the letters 'C' and 'A' in applicant's mark [shown below] are insufficient to render applicant's mark as distinctive in style." *In re Couriaire Express Int'l, Inc.*, 222 USPQ 365, 366 (TTAB 1984):

The word "CouriAire" is written in a bold, slanted, sans-serif font. The letters are slanted to the right, and the 'C' and 'A' are capital letters. The word is enclosed in a rectangular border.

See also *In re Project Five, Inc.*, 209 USPQ 423, 425 (TTAB 1980) ("Considering the highly descriptive nature of the literal components of applicant's mark, we are not persuaded, in the absence of any evidentiary showing, that the degree of distinctiveness of the design features of applicant's mark is such that the mark as a whole does in fact create a distinctive commercial impression separate and apart from the descriptive significance of its components");



United States Lines, Inc. v. American President Lines, Ltd., 219 USPQ 1224, 1227 (TTAB 1982) ("The displays of applicant's marks [one shown below] in the instant cases are even less distinctive, we believe, than was the applicant's mark in *Project Five*. We conclude that the terms sought to be registered do not create distinctive commercial impressions separate and apart from the descriptive significance of their components. Applicant's

admittedly descriptive marks are not entitled to registration on the Principal Register with disclaimers");

ThruService

and *In re Grande Cheese Co.*, 2 USPQ2d 1447, 1449 (TTAB 1986) ("We conclude, then, that the designations sought to be registered do not comprise inherently distinctive lettering styles and/or background displays such that they would create separate commercial impressions apart from the generic significance of the disclaimed words")

MOZZARELLA

ITALIAN CHEESES

In this case, applicant's mark is basically a block form drawing with its first and last letters depicted at a slight angle. This slight variation is not sufficient to create a distinctive mark. As the cases above demonstrate, there is no rule that a word with some letters that are not uniform results in an inherently distinctive mark. The board has indicated that for the stylization of the words in an otherwise descriptive mark to be registrable on the Principal Register the stylization must be more than simply a little different or unusual.

Here, the slight angles to the first and last letters in applicant's mark case do not create an inherently distinctive mark. These slight differences from block style printing are hardly noticeable and there is no evidence that purchasers would understand that this stylization distinguishes applicant's goods from those of others. Applicant's mark is also much less distinctive than other designs that were determined to not be registrable on the Principal Register when the words in the mark were not distinctive. Therefore, even if the word "Jumboz" was disclaimed, applicant's mark is merely descriptive.

Decision: The refusal to register applicant's mark JUMBOZ (stylized) on the Principal Register for processed sunflower seeds on the ground that it is merely descriptive is affirmed.