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PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Farr's Fresh, Inc.

Serial No. 77762425

Brian C. Kunzler of the law firm Kunzler & McKenzie for Farr's Fresh, Inc.

Michael A. Weiner, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Quinn, Bucher, and Lykos, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Farr's Fresh, Inc. ("applicant") filed an application to register the mark FARR'S FRESH for "retail frozen dessert store services" in International Class 35.¹ Registration has been finally refused in light of applicant's failure to comply with the examining attorney's requirement for a disclaimer of the word "FRESH," pursuant to Trademark Act § 6(a), 15 U.S.C. § 1056(a), on the ground that the term is merely descriptive of a feature of the identified services.

Upon final refusal of registration, on October 5, 2010, applicant concurrently filed a timely request for reconsideration and notice of appeal. The examining attorney denied applicant's request for reconsideration on October 26, 2010. The Board then resumed proceedings herein on November 5, 2010. Both applicant and the examining attorney filed briefs.

For the reasons discussed herein, the Board affirms the refusal to register.

I. *Objection to Evidence - Third-Party Registrations*

As a preliminary matter, we will address the examining attorney's objection to copies of printouts of third-party registrations applicant submitted with its request for reconsideration filed October 5, 2010. For the reasons set forth below, the examining attorney's objection is overruled.

In denying applicant's request for reconsideration, the examining attorney objected to this evidence on the basis that it consisted merely of portions of a search report obtained from a commercial database. See Denial of Request for Reconsideration dated October 26, 2010. The examining attorney argues that it is clear from the printouts of the third-party registrations on their face that they are not from USPTO's

¹ Serial No. 77762425, filed June 17, 2009, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intent to use the mark in commerce.

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Trademark Electronic Search System ("TESS") website, but from another source. The examining attorney relies on the fact that none of the registrations include the TESS website address on either the top or bottom of the pages, and that the registrations appear in a different format.

In its appeal brief, applicant affirmatively states that the third-party registrations were obtained directly from the USPTO's TESS website at <http://tess2.uspto.gov/> as opposed to a private commercial database. Appeal Brief, p. 3.

It is well established that the mere submission of third-party registrations from a private company search report does not make such registrations part of the record. *See, e.g., In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996). To make third-party registrations part of the record, an applicant must submit either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office during prosecution of the application. *E.g., In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP § 1208.02 (3d ed. rev. 2011).

In the face of the examining attorney's objection, we have applicant's unequivocal statement that it directly obtained the third-party registrations from TESS. Based on the Board's

knowledge of the TESS system, it appears that applicant cut and pasted the third-party registrations from TESS records into another document, which in turn was then submitted with its Request for Reconsideration. This would explain why none of the registrations includes the TESS website address and all appear in a different format. Thus, in an abundance of caution, the Board is considering the registrations.²

The examining attorney's objection is therefore overruled; the third-party registrations submitted in connection with applicant's request for reconsideration have been considered.

II. ***Disclaimer Requirement***

Next we turn to the substantive issue on appeal. An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859

² That being said, it would have been preferable for applicant to have either submitted the original TESS printouts of the third-party registrations or submit a declaration explaining the process under which the information was directly transferred from TESS to another word processing document. This would have obviated any questions regarding the authenticity of the third-party registrations.

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(Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant 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 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 a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Based on the evidence of record, we find that the term FRESH describes a significant feature of applicant's services, namely that the frozen desserts sold in applicant's retail stores are "fresh" or recently made. The online dictionary definitions submitted by the examining attorney define the word "fresh" as:

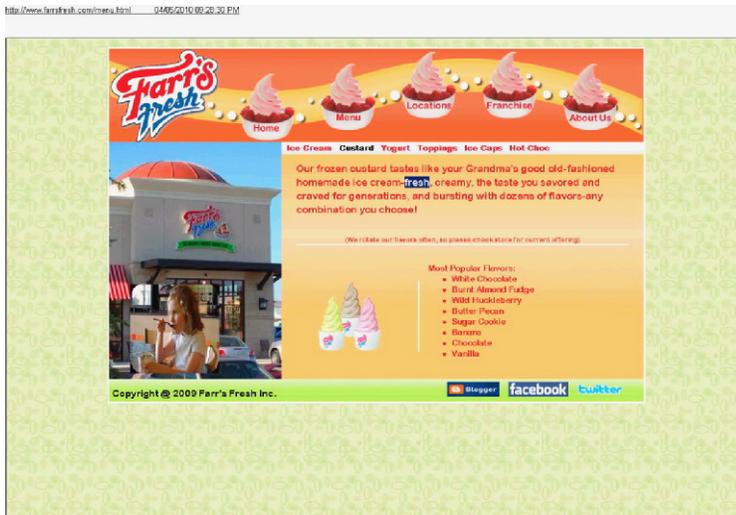
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3. Recently made, produced or harvested; not stale or spoiled: *fresh bread*. www.educationyahoo.com and www.credoreference.com.

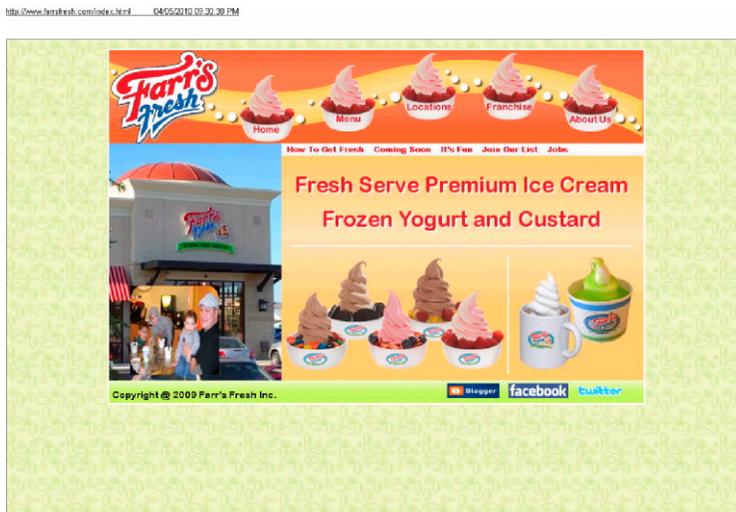
Applicant's website describing its retail stores services emphasize the "fresh" nature of the frozen desserts it sells.

Note the following excerpts:

"Our frozen custard tastes like your Grandma's good old-fashioned homemade ice cream - fresh."



"Fresh Serve Premium Ice Cream"



"You can be confident in knowing nothing is fresher than Farr's - after all we MAKE the product ourselves."

<http://www.farrsrah.com/franchise.html> 04/05/2010 10:24:10 PM



Applicant contends that the term "FRESH" is at most suggestive because it does not immediately describe applicant's services. Specifically, applicant maintains that "[t]o journey from encountering the term "FRESH" to the concept of the service of frozen desserts, a consumer's mind must first associate the term "FRESH" with food instead of newness or novelty, then with frozen desserts instead of non-processed foods." Applicant's Appeal Brief, p. 3. Applicant further asserts that because there are multiple definitions of the word "fresh" outside of food items, the term is suggestive and not descriptive. These arguments are not persuasive. It is well-settled that descriptiveness is considered in relation to the relevant goods and/or services, and not in a vacuum. The fact that a term may

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have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Within the context of retail store services featuring frozen desserts, prospective consumers will perceive the term "fresh" as describing a quality of the desserts items for sale. The dictionary definition of "fresh" noted above, coupled with applicant's own website touting the "fresh" or newly made quality of its frozen desserts, directly show that prospective consumers are not required to make a mental leap to draw the conclusion that the frozen desserts sold in applicant's retail stores are "fresh," or recently made.

Applicant also maintains that consumers do not immediately associate the term FRESH in connection with frozen desserts, but rather with non-processed food items such as fruits and vegetables. This argument is belied, however, by the record evidence discussed above on applicant's own website describing its services. Furthermore, the examining attorney has submitted several examples of third-party usage of the term FRESH in the frozen dessert retail store industry to describe the recently made nature of frozen dessert items. By way of illustration, see the websites below from other companies in the frozen dessert industry:

"Fresh, premium, made to order."



"Cold Stone Creamery® offers super-premium ice cream and sorbet, made fresh in every store, every day."



The evidence above also supports a finding that competitors need to, and indeed, use the term "fresh" in connection with retail store services featuring frozen desserts. *In re Ruffin Gaming, LLC*, 66 USPQ2d 1924 (TTAB 2002) (competitors would be disadvantaged if the applicant is given exclusive right of ownership in a mark that immediately informs the prospective consumer of a famous landmark in a particular city). This factor weighs in favor of finding that the term "fresh" is descriptive.

Applicant also argues that because its soft-serve frozen dessert comes out of a machine where it has been formulated from a pre-made mix shipped from a remote centralized location, it will not be perceived by prospective consumers as "fresh." Applicant maintains that in this context, the term FRESH merely suggests that applicant's desserts are different from a frozen dessert such as ice cream that is shipped frozen in a container to a retail store. However, the record evidence noted above demonstrates that the term "FRESH" used in connection with retail services featuring frozen desserts unambiguously refers to dessert items which are newly-made.

Lastly, we consider the third-party registrations applicant submitted with its Request for Reconsideration with no disclaimer of the word FRESH. It is well established that third-party registrations are not conclusive on the question of descriptiveness, and each case must be decided upon its own record. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Nonetheless, we have considered the third-party registrations submitted by applicant, and have determined that they show the Office's inconsistent treatment of "fresh" as a suggestive or inherently distinctive term when used in connection with applicant's identified services.

At the outset we note that since none of the third-party registrations involve retail frozen dessert services, they are

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of little, if any probative value. See e.g., Registration. No. 3685486 for the mark "ACAI FRESH" for "herbal dietary supplements containing acai" in International Class 5.

In addition, many of the third-party registrations consist of unitary marks where a disclaimer of FRESH is not required. One subcategory involves compound word marks consisting of an unregistrable component (the term "FRESH") and registrable component. See e.g. Registration. No. 3260182 for the mark "SILKYFRESH" and Registration. No. 3647925 for the mark "BAKEFRESH." Such marks clearly are registrable without a disclaimer of FRESH. See also e.g., *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006) (the Board, in considering a third-party registration, remarked "Reg. No. 2881792 for the mark ENERGYSOLUTIONS is a compound word where a disclaimer would not be required."). By contrast, here we are presented with a word mark consisting of two separate terms "FARR'S" and "FRESH." Therefore, these registrations are of no probative value.

A second sub-category of unitary marks consist of slogans. See e.g., Registration No. 3765150 for the mark "TASTE THE FRESH"; Registration No. 3744361 for the mark "MIMIS CAFÉ FRESH & FIT"; Registration No. 3688738 for the mark "THE ALL DAY FRESH CAFÉ"; and Registration No. 3677645 for the mark "MARKET FRESH. MONEY SMART." A registrable slogan is considered unitary and should not be broken up for purposes of requiring a disclaimer.

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See In re Hunter Fan Co., 78 USPQ2d 1474 (TTAB 2006) (“...the mark in the prior registration appears to be a unitary slogan, and an examining attorney has discretion to not require a disclaimer of a descriptive term when it appears in such a slogan.”). As such, these registrations do not provide an apt comparison for the mark at issue in this case.

Thus, although we have considered the third-party registrations submitted by applicant, they have little, if any, probative value.

Decision: Based on the record evidence discussed above, we conclude that the phrase FRESH is merely descriptive of a significant feature applicant's goods. The refusal to register in the absence of a disclaimer of FRESH is therefore affirmed.

However, this decision will be set aside if, within thirty (30) days of the mailing date of this order, applicant submits to the Board a proper disclaimer of “FRESH.” See Trademark Rule 2.142(g); Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1218 (3d ed. rev. 2011).