

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

Mailed:
August 10, 2012
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Grupo Bimbo, S.A.B. de C.V.

Serial No. 77798364

Scott J. Slavick and Joshua S. Frick of Brinks Hofer Gilson
& Lione for Grupo Bimbo, S.A.B. de C.V.

Tasneem Hussain, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Bucher and Taylor, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Grupo Bimbo, S.A.B. de C.V., a Mexican corporation,
seeks registration on the Principal Register of the term
BAGEL THINS (*in standard character format*) for "bakery
products, not including cookies" in International Class 30.¹

¹ Application Serial No. 77798364 was filed by Bimbo Hungria Zrt, a Hungarian corporation, on August 6, 2009, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. On May 6, 2010, applicant filed its Amendment to Allege Use. On January 1, 2011, the application was assigned to Grupo Bimbo, S.A.B. de C.V. as reflected in the Assignment Branch records of the United States Patent and Trademark Office, at Reel 4457/Frame 0304. No claim is made to the exclusive right to use the word "Bagel" apart from the mark as shown.

The Trademark Examining Attorney refused registration on the grounds that the term is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1); does not have the requisite degree of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f); or alternatively, the term is generic under Section 23 of the Act, 15 U.S.C. § 1091.

Applicant has clearly set out alternative positions in response to these various refusals, in each case conceding nothing about the alternate submissions. That is, applicant argues that its **BAGEL THINS** mark is inherently distinctive; or alternatively, that if deemed to be merely descriptive, the **BAGEL THINS** mark has acquired distinctiveness for applicant's goods; or alternatively, the term is entitled to registration on the Supplemental Register. See *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992).

After the Trademark Examining Attorney made the refusals final, applicant appealed to this Board.

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. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development*

Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). 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 those 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. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, 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." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); see also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). If, on the other hand, a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive. *In re MBNA*

America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

The Trademark Examining Attorney made of record dictionary definitions of the component parts of the involved term. Inasmuch as applicant's goods comprise slices of bagels, applicant has agreed, consistent with the dictionary definition of a "bagel," to disclaim this word:

bagel (noun) a glazed ring-shaped bread roll with a slightly chewy texture ²

The Trademark Examining Attorney also supplied a definition for the word thin, as an adjective and as a verb:

thin (adjective) ... 3. Slim: ...

thin (verb) make or become thinner ³

In the context of the involved record, there is no disputing that eight to twenty-four "thin" bagel slices comprise each package of goods applicant is marketing. Where the Trademark Examining Attorney and the applicant disagree is what proprietary rights applicant can assert in the specific construction of the word "Bagel" followed by the word "Thins." While the word "thin" is shown above as an adjective and as a verb, the pluralized form of the word,

² Encarta® World English Dictionary (North American Edition).

³ *Id.*

"thins," as used by applicant, seems to function more as a noun.

The Trademark Examining Attorney has pointed to examples of where others who are describing thinly-sliced bagels have adopted this exact construction:



Fiery Garlic Bagel Thins

" ... Slice bagels crosswise into fifths ..."

⁴

* * * *

Foodista

Recipe: **Bagel Thins**, Lo Cal, Lo Salt

" ... Step 1 Using a very sharp serrated knife, slice bagel into very thin rounds. "

* * * *



Baked Bagel Thins

" ... Slice each bagel into four crosswise slices... ."

* * * *

The New York Times

ONION BAGELS, YES- AND NOW SPINACH OR CHOCOLATE CHIP

" ... also made by Bagel Boss. Bags of "**bagel thins**," crisp, toasted thin bagel slices, are 79 cents each. If you buy two bags, the third one is free. "

⁷



... **Bagel Thins**.....

\$2.99/Each ⁸

* * * *

⁴ <http://www.bigoven.com/recipe/84440/Fiery-Garlic-Bagel-Thins>

⁵ <http://www.foodista.com/recipe/>

⁶ Recipe Rumble eCookbook, <http://www.fitnessandfreebies.com/>

⁷ <http://www.nytimes.com/1982/02/14/nyregion/>

⁸ <http://www.bagelcountry.com/fullmenu.asp> as viewed by the Trademark Examining Attorney on May 25, 2010.



...
Bagel Thins: Great for dips, spreads or just snacking. We make plain, onion, whole wheat, raisin and sea salt bagel thins. ⁹

* * * *

Barry Bagels

2515 Jackson Ave · Ann Arbor MI 48103 · (734) 662-2435

...
Bagel Thins (Garlic, Plain, Raisin or Berry) \$3.95 ¹⁰

* * * *

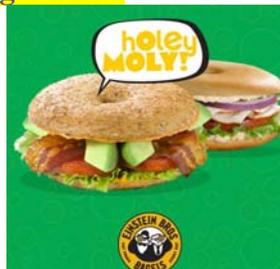


SAMPLE SUNDAY BRUNCH MENU

HEART HEALTHY SPA SPECIALS (COOKED WITH NO FAT - under 500 calories)
 3 EGGWHITE SPINACH & MUSHROOM OMELETTE with fat free garlic & chive schmear, served with **bagel thins** & apple butter 6.95 ¹¹

* * * *

B1G1 Einstein Bros New **Bagel Thins** Lunch Sandwich



I am loving the new Einstein Bros coupon on Facebook! If you “like” Einstein Bros on Facebook (Go [HERE](#)), click on the “Offers” tab and you can print out your Buy One Get One Free Turkey Bacon & Avocado, Tuna, or a Turkey **Bagel Thin** sandwich! Limit one coupon per person. Coupon is valid between 5/17 – 5/30! Go [HERE](#) to find an Einstein Bros near you! **While you are on Facebook, “Like” Addicted to Saving (go [HERE](#)) and never miss out on a deal! ¹²

* * * *

⁹ http://newyorkbagel-detroit.com/newyorkbagel-detroit_products.htm

¹⁰ <https://www.allmenus.com/> as viewed by the Trademark Examining Attorney on May 25, 2010.

¹¹ <http://www.delanceystreetfoundation.org/enterrestbrunchsun.php>

¹² <http://www.addictedtosaving.com/2010/05/20/blg1-einstein-bros-new-bagel-thins-lunch-sandwich/>

The Trademark Examining Attorney also supplied a copy of the placement of this term within the composite mark of a cancelled registration from the 1980s:



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According to the Trademark Examining Attorney, applicant's own website uses the term as a category of bagel products, not unlike "Mini Bagels" or "Traditional Bagels."



¹³ Registration No. 1432125 issued for "bagel chips and slices" on March 10, 1987, claiming use since at least as early as July 8, 1983; cancelled under Sec. 8 in September 1993. No claim is made to the exclusive right to use the words "Bagel Thins" apart from the mark as shown.

The Trademark Examining Attorney also points to applicant's trade dress that refers to "8 Thin Pre-Sliced" bagels in its package of "Bagel Thins."



However, applicant argues this Trademark Examining Attorney is taking a position that is totally inconsistent with decades of practice for similar marks. Applicant points to third-party registrations for goods in International Class 30 where the word "Thins" is not disclaimed for crackers or other snacks:

WHEAT THINS	for "crackers" in International Class 30; ¹⁴
VEGETABLE THINS	for "crackers" in International Class 30; ¹⁵
GOURMET THINS	for "crisp bread" in International Class 30; ¹⁶

¹⁴ Registration No. 1022799 issued on October 14, 1975; second renewal. No claim is made to the exclusive right to use the word "Wheat" apart from the mark as shown.

¹⁵ Registration No. 1244724 issued on July 5, 1983; renewed. No claim is made to the exclusive right to use the word "Vegetable" apart from the mark as shown.

¹⁶ Registration No. 1339385 issued on June 4, 1985; renewed.

GARDEN CHICKEN THINS	for "bread, pastries, biscuits, cakes, snack food products, namely, crackers" in International Class 30; ¹⁷
STONED WHEAT THINS	for "crackers" in International Class 30; ¹⁸
PITA THINS	for "flat bread" in International Class 30; ¹⁹
NUT-THINS	for "flour-based wafers with almonds or other nuts as an ingredient" in International Class 30; ²⁰
Soy Thins	for "soy-based snack foods" in International Class 30; ²¹
CORN THINS	for "corn cakes" in International Class 30; ²² and
RICE THINS	for "rice cakes" in International Class 30. ²³

Applicant concludes from these extant registrations (as well as many more now-cancelled/expired registrations) that the United States Patent and Trademark Office has long

¹⁷ Registration No. 1590093 issued on April 3, 1990; second renewal. No claim is made to the exclusive right to use the word "Chicken" apart from the mark as shown.

¹⁸ Registration No. 1718484 issued on September 22, 1992; renewed. No claim is made to the exclusive right to use the words "Stoned Wheat" apart from the mark as shown.

¹⁹ Registration No. 1982930 issued on June 25, 1996; renewed. No claim is made to the exclusive right to use the word "Pita" apart from the mark as shown.

²⁰ Registration No. 2143587 issued on March 10, 1998; renewed.

²¹ Registration No. 3044541 issued on January 17, 2006. No claim is made to the exclusive right to use the word "Soy" apart from the mark as shown.

²² Registration No. 3931827 issued on March 15, 2011. No claim is made to the exclusive right to use the word "Corn" apart from the mark as shown.

²³ Registration No. 3931828 issued on March 15, 2011. No claim is made to the exclusive right to use the word "Rice" apart from the mark as shown.

considered the pluralized noun "Thins," when appearing as the final word in a composite mark for crackers or other snacks, to be distinctive enough to carry a mark when combined with earlier generic or highly-descriptive matter.

Applicant acknowledges that the Patent and Trademark Office may well take a different tact with "cookies," and hence, has amended its identification to exclude cookies:



for "cookies, gingerbread biscuits, and biscuits" in International Class 30;²⁴

BLUE THINS

for "cookies, biscuits, crackers" in International Class 30;²⁵ and

NEWTON'S FRUIT THINS

for "cookies" in International Class 30.²⁶

Applicant has its own history of prosecuting applications for composite marks ending with the word "Thins" adopted in connection with bread and other bakery

²⁴ Registration No. 3568922 issued on February 3, 2009. No claim is made to the exclusive right to use the phrases "GINGER THINS DELGADITAS DE JENGIBRE" or "0 TRANS FAT" apart from the mark as shown.

²⁵ Registration No. 3870613 issued on November 2, 2010. No claim is made to the exclusive right to use the word "Thins" apart from the mark as shown.

²⁶ Registration No. 4043300 issued on October 18, 2011. No claim is made to the exclusive right to use the words "Fruit Thins" apart from the mark as shown.

products.²⁷ The United States Patent and Trademark Office has approved the following applications for publication without requiring a disclaimer of the word "Thins":

SANDWICH-THINS	for "bread" in International Class 30; ²⁸
GRILLIN' THINS	for "bread, namely, buns and rolls" in International Class 30; ²⁹
COUNTRY THINS	for "bakery products" in International Class 30; ³⁰
POCKET THINS	for "bakery goods" in International Class 30; ³¹
HOT DOG THINS	for "bakery products" in International Class 30; ³² and
MUFFIN THINS	for "bakery goods" in International Class 30. ³³
PARTY THINS	for "bakery products, excluding cookies, crackers and pretzels" in International Class 30; ³⁴

²⁷ In trying to understand the corporate relationships revealed by the ownership of these several registrations, we note from the declarations of record that applicant is the parent company of several companies, including Orograin Bakeries, Inc., which is one of the Bimbo Bakeries USA companies, and which also does business as Arnold Foods Company, Inc. (Rosas Decl. 1), and that Orograin Bakeries Inc. uses the term **BAGEL THINS** as a licensee of applicant. (Strazzella Decl. ¶1; Rosas Decl. ¶1.)

²⁸ Registration No. 3637950 issued on June 16, 2009.

²⁹ Registration No. 4013885 issued on August 16, 2011. No claim is made to the exclusive right to use the word "Grilling" apart from the mark as shown.

³⁰ Registration No. 4094572 issued on January 31, 2012.

³¹ Registration No. 4126741 issued on April 10, 2012. No claim is made to the exclusive right to use the word "Pocket" apart from the mark as shown.

³² Application Serial No. 85098572 published for opposition on June 7, 2011. No claim is made to the exclusive right to use the words "Hot Dog" apart from the mark as shown.

³³ Application Serial No. 85104981 published for opposition on February 8, 2011. No claim is made to the exclusive right to use the word "Muffin" apart from the mark as shown.

In divining the line between suggestiveness and mere descriptiveness, we find on this record that it takes no thought or imagination to go from "thinly-sliced bagels" to "Bagel Thins." The record shows that since at least the early eighties, bagel retailers from various parts of the country have used the term with lower case letters ("bagel thins") to describe thinly-sliced bagels. Based upon dictionary definitions and this generalized usage, we have no doubt but that the combination is merely descriptive.

On the other hand, at best, the evidence in this record, taken as a whole, presents a circumstance of mixed use. See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). While "Bagel Thins" is a compound term, the record in this case is different from *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987), where the evidentiary burden was satisfied because the Office "produce[d] evidence including dictionary definitions that the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to these words as a compound." Specifically, SCREEN named the object for which the WIPE was used. The counterpart in the instant

³⁴ Application Serial No. 85409296 published for opposition on February 14, 2012.

case might well be a hypothetical term, "Thin Bagels." Genericness is a fact-intensive determination, and the Board's conclusion must be governed by the record that is presented to it. Although we may have concerns about the genericness of applicant's designation, the record controls the determination, not our own subjective opinions.

Here, although the adjectival form of the word "Thin" (singular) is merely descriptive of a significant characteristic of these goods, the pluralized noun, "Thins," is not derived logically from the word "Thin," and it is nowhere defined as a noun in any dictionaries of record. While "Bagel Thins" may be an apt name for thinly-sliced bagels, aptness is insufficient to prove genericness. When a proposed mark is refused registration as generic, the Trademark Examining Attorney has the burden of proving genericness by "clear evidence" thereof. *See In re Gould*, 5 USPQ2d at 1111. When assessing the capability of a term, the critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). We

find in the present case, that the Office has failed to prove genericness by "clear evidence" thereof. Any doubts raised by the lack of evidence on the question of genericness must be resolved in applicant's favor. On a different record, such as might be adduced by a competitor in a cancellation proceeding, we might arrive at a different result on the issue of genericness.

Moreover, this conclusion is reinforced by the way in which the term "Thins" has been treated by the United States Patent and Trademark Office in the past in examining composite marks for crackers, snacks and other similar bakery products in International Class 30. *See In re Waverly Inc.*, 27 USPQ2d 1620, 1623 (TTAB 1993). In placing the term **BAGEL THINS** on the continuum of distinctiveness, while we have no doubt about our finding of mere descriptiveness, this record cannot support a finding that the term "Bagel Thins" is a generic designation. Hence, the refusal to register under Section 23 of the Act is reversed

Accordingly, the sole remaining question before us is whether the term **BAGEL THINS** is entitled to registration on the Principal Register under Section 2(f) of the Act, 15 U.S.C. § 1052(f) and 37 CFR § 2.41(b), based upon the sufficiency of applicant's showing of acquired distinctiveness.

On the Section 2(f) issue, applicant has the burden of proving that its designation has acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”). “[L]ogically that standard becomes more difficult as the mark’s descriptiveness increases.” *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988). As noted above, we find that “Bagel Thins” is an apt name for thinly-sliced bagels, and hence it is highly descriptive.

We consider factors such as: (1) advertising expenditures; (2) sales success; (3) duration of use; (4) extent and nature of use in commerce; and (5) unsolicited media coverage. *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009).

We turn then to the Strazzella and Rosas Declarations to determine the extent to which applicant has promoted its **BAGEL THINS** bakery products. (Strazzella Decl. ¶¶5, 6, 7, 13, 14, 15, 16, 17; Rosas Decl. ¶¶5, 6, 7, 8, 14, 15, 16, 17, 18.) Applicant claims to have made extensive use of its **BAGEL THINS** term in connection with bakery products since January 2010. (Strazzella Decl. ¶2; Rosas Decl. ¶2.) Its **BAGEL THINS** products are available nationwide at major food

retailers. Applicant spent more than five million dollars in 2010 promoting its **BAGEL THINS** bakery products. Sales of **BAGEL THINS** products in the United States generated over \$61 million in retail sales in 2010 (Strazzella Decl. ¶3; Rosas Decl. ¶¶3, 4.)

Applicant markets its **BAGEL THINS** products through its **THOMAS'** brand website. (Strazzella Decl. ¶5; Rosas Decl. ¶5.) The **BAGEL THINS** portion of this website attracted over 93,000 discrete visits in a recent twelve-month period. (Rosas Decl. ¶5.) Between March 14 and April 4, 2011, applicant ran an advertising campaign on www.facebook.com that delivered more than 11 million impressions.

Advertisements promoting applicant's **BAGEL THINS** products have appeared and continue to appear in prominent publications including: (1) *People*; (2) *Martha Stewart Living*; (3) *O (the Oprah Magazine)*; (4) *Every Day with Rachael Ray*; (5) *Real Simple*; (6) *Cooking Light*; (7) *Fitness*; (8) *Food Network*; (9) *Health*; (10) *Prevention*; (11) *Shape*; (12) *More*; (13) *Weight Watchers*; (14) *Women's Health*; and (15) *Family Fun* magazines, which combined, have resulted in over 90 million impressions. Advertisements promoting applicant's **BAGEL THINS** products have also appeared on prominent websites such as: (1) <http://www.timeinc.com/>; (2) <http://www.aol.com/>; (3) <http://www.oprah.com/>; (4)

www.weightwatchers.com/; (5) <http://www.marthastewart.com/>;
(6) <http://www.rachaelraymag.com/> (Every Day With Rachael Ray); (7) <http://www.saveur.com/digitalfeast/> (Digital Feast); (8) <http://www.everydayhealth.com/> (Everyday Health); and (9) <http://allrecipes.com> websites, which combined, have resulted in over 206 million impressions. (Strazzella Decl. ¶6; Rosas Decl. ¶6.)

Applicant has placed over four thousand in-store displays and more than 1,300 point-of-sale advertisements in food retail stores. Applicant routinely distributes retail coupons for its **BAGEL THINS** products. (Strazzella Decl. ¶14, and Exhibit J.) Applicant has organized sampling events for its **BAGEL THINS** products in retail stores that sell applicant's **BAGEL THINS** products, including such sampling events at over a hundred Costco stores. (Strazzella Decl. ¶15; Rosas Decl. ¶17.) Applicant sponsored a Healthy Living Summit in Chicago, Illinois in August 2010 where it heavily promoted its **BAGEL THINS** products to the attendees. (Strazzella Decl. ¶16, Exhibit L.) Applicant sponsored the More[®] Magazine Fitness[®] Magazine Women's Half-Marathon, which took place in New York City on April 3, 2011, where it heavily promoted its **BAGEL THINS** products during the race and the related events. (Rosas Decl. ¶14 and Exhibit G.) Applicant sent samples of its

BAGEL THINS products to the magazine editors of: (1) *Self*, (2) *Glamour*; (3) *Every Day with Rachael Ray*; (4) *Good Housekeeping*; (5) *InStyle*; (6) *O* (the Oprah Magazine); (7) *Martha Stewart Living*; (8) *Men's Fitness*; (9) *Men's Health*; (10) *More*; (11) *Parenting*; (12) *Prevention*; (13) *Real Simple*; (14) *Redbook*; (15) *SHAPE*; (16) *Family Circle*; (17) *First*; (18) *Fitness*; (19) *Food Network Magazine*; (20) *Health*; (21) *Ladies' Home Journal*; (22) *Woman's Day*; (23) *Women's World*; (24) and *Women's Health*, on four consecutive weeks in the summer of 2010. (Strazzella Decl. ¶17).

Applicant's **BAGEL THINS** products have been featured in articles that appeared in newspapers and magazines throughout the United States, including: (1) *People*; (2) *SELF*; (3) *Health*; (4) *Fitness*; (5) *Women's Health*; (6) *OK Weekly*; (7) *Parents*; (8) *Women's Day*; (9) *The Times-Picayune* (New Orleans, LA); (10) *Desert Sun* (Palm Springs, CA); (11) *Detroit Free Press* (Detroit, MI); (12) *Arkansas Democrat-Gazette* (Little Rock, AK); (13) *Asbury Park Press* (Asbury Park, NJ); (14) *Pittsburgh Tribune Review* (Pittsburgh, PA); (15) *New Haven Register* (New Haven, CT); (16) *Las Vegas Review-Journal*; (17) *Shelby Report of the West*; (18) *Supermarket Savvy*; (19) *Los Angeles Daily News*; (20) *Fairfield County Weekly*; (21) *New Haven Advocate*; (22) *Farms Independent*; (23) *The Daily Sentinel*; (24) *Bethpage*

Newsgram; (25) *Syosset Advance*; (26) *The Brunswick News*; (27) *Garden City News*; (28) *Mid-Island Times*; (29) *Jericho Syosset New Journal*; and (30) *Port Arthur News*, which combined, resulted in over 28 million impressions. (Strazzella Decl. ¶9 and Exhibit F; Rosas Decl. ¶10 and Exhibit E.)

Since November 23, 2010, applicant's **BAGEL THINS** products have been featured in articles that appeared in online news sources including: (1) <http://www.cbsnews.com/> (2) <http://www.self.com/>; (3) <http://www.health.com/health/>; (4) <http://panews.com/>; (5) <http://www.dailynews.com/>; and (6) <http://www.examiner.com/>, which combined, resulted in over 11 million impressions. (Rosas Decl. ¶11 and Exhibit E.)

Applicant's **BAGEL THINS** products have been featured in television and radio news broadcasts throughout the United States in cities such as: (1) Chicago, IL; (2) San Francisco, CA; (3) Las Vegas, NV; (4) Rochester, NY; (5) Norfolk, VA; (6) Salisbury, MD; (7) Ft. Myers, FL; (8) Omaha, NE; (9) Flint, MI; (10) Oklahoma City, OK; (11) Oakland, CA; (12) Minneapolis/St. Paul, MN; (13) Columbus, OH; (14) Wichita, KS; (15) Raleigh and Durham, NC; (16) Colorado Springs, CO; (17) Cincinnati, OH; and (18) Denver, CO. (Strazzella Decl. ¶10.) Additionally, since November

26, 2010, applicant's **BAGEL THINS** products have been featured on both national and local television, including on: (1) The Today Show (NBC); (2) The Early Show (CBS); (3) KNBN-TV in Rapid City; and (4) News 12 Bronx, resulting in over five million impressions. (Rosas Decl. ¶12.)

This type of promotional and sales data should be considered when analyzing whether applicant's **BAGEL THINS** mark has acquired distinctiveness in the minds of consumers. *General Foods Corp. v. MGD Partners*, 224 USPQ 479, 486 (TTAB 1984) (concluding applicant's substantial sales and advertising activities "must be credited as pertinent to the ultimate issue of achievement of acquired distinctiveness"); *Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 166 USPQ 34, 39 n.10 (CCPA 1970).

In short, the record shows that through widespread promotional activities, applicant has experienced extensive sales of its **BAGEL THINS** product. This has resulted in substantial media coverage and Internet exposure for this product.

As to applicant's claim to have been successful in policing its **BAGEL THINS** mark, we acknowledge the June 2011 agreement from Einstein Bros. June 15, 2011, p 195 of 803.

EXHIBIT 1

June, 10, 2011

Applicant: Grupo Bimbo, S.A.B. DE C.V.
 Mark: BAGEL THINS
 Serial No.: 77798,364
 Filed: August 6, 2009
 Law Office: 105
 Examiner: Tasneem Hussain

Dear Examiner:

I am Rhonda Parish (signatory's name), Chief Legal Officer & Secretary (signatory's position) of Einstein Noah Restaurant Group, Inc., ("Einstein") of 555 Zang Street, Suite 300 Lakewood, Colorado 80228. Einstein previously briefly used the term "bagel thins". After being contacted by Grupo Bimbo, S.A.B. DE C.V. ("Grupo Bimbo"), the owner of U.S. Trademark Application, Serial No. 77798,364 for the BAGEL THINS mark, Einstein and Grupo Bimbo reached an agreement whereby, among other things, Einstein agreed not to use the term "bagel thins" in its advertising or marketing. Any on-line exhibits purporting to show use of the term "bagel thins" by Einstein are not current.

Einstein is aware that Grupo Bimbo produces a line of products called BAGEL THINS.

Einstein has agreed not to use or register, and not to cause someone else to use or register, a domain name, trademark, service mark, trade name or business name that consists of or incorporates the term "bagel thins".

Sincerely,

 Name: <u>Rhonda Parish</u> Title: <u>Chief Legal Officer & Secretary</u> Date: <u>6/10/11</u> Einstein Noah Restaurant Group, Inc.	 Name: <u>Tasneem Hussain</u> Title: <u>IP MANAGER</u> Date: <u>6/22/11</u> Grupo Bimbo, S.A.B. DE C.V.
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The difficult issue before us then is acquired distinctiveness, and whether the evidence herein is sufficient to establish this conclusion. We have reviewed carefully the Declarations of Mr. Strazzella and Ms. Rosas and the exhibits thereto, illustrating applicant's wide-spread promotion and sales of its **BAGEL THINS** products along with the extensive media coverage of applicant's **BAGEL THINS** products. This reflects an impressive burst of promotional efforts by applicant. However, for a term that appears to be an apt descriptive name of the involved goods, we find the evidence in its entirety to be inadequate to prove acquired distinctiveness for this term.

A point on which applicant's evidence of acquired distinctiveness is weak is the relatively short period of time that the term has been in use. At the time the record in this case was closed, applicant had little more than a year of promotional activities and product sales.

Most of the evidence in the record is also fairly indirect on the question of consumer perceptions. For example, in much of applicant's advertisements, we cannot be sure how prospective consumer will perceive the applied-for term compared, for example, with applicant's house mark, **Thomas'**. It is entirely possible that much of the packaging and promotional efforts will effectively reinforce this house mark rather than creating trademark awareness for an apt descriptive name of the product.

As to gross sales, we have no idea where this might peg applicant's market share, i.e., whether these sales figures are miniscule or overwhelming compared with others in the retail market for packages of thinly-sliced bagels.

Finally, there is no direct evidence that applicant's efforts to create distinctiveness for its source identifier, as recently adopted, have been successful. We have no declarations or consumer surveys demonstrating that it is recognized as a trademark for applicant's goods. To the extent that third parties have continued some usage of this

exact term, an absence of "substantially exclusive use" further weakens applicant's claim that this term has acquired distinctiveness. See, e.g., *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966); and *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009). As such, applicant's **BAGEL THINS** mark is not entitled to registration on the Principal Register under Section 2(f) of the Lanham Act.

On the other hand, having determined that this term is capable of achieving distinctiveness, we reverse the refusal of the Trademark Examining Attorney to permit this term to issue on the Supplemental Register.

Decision: We affirm the Trademark Examining Attorney's refusal to register applicant's alleged mark, **BAGEL THINS**, on the Principal Register. The term is merely descriptive under Section 2(e)(1) of the Lanham Act, and applicant has failed to provide sufficient evidence of acquired distinctiveness under Section 2(f) of the Act. Nonetheless, we reverse the refusal grounded on genericness, and this application will be forwarded for issuance on the Supplemental Register in due course.