

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

Mailed:  
June 7, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Donsuemor, Inc.

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Serial No. 78393418

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H. Michael Brucker of Law Office of H. Michael Brucker for  
Donsuemor, Inc.

Susan Billheimer, Trademark Examining Attorney, Law Office  
101 (Ronald R. Sussman, Managing Attorney).<sup>1</sup>

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Before Seeherman, Holtzman and Cataldo, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Donsuemor, Inc. (applicant) initially applied to  
register THE MADELEINE COOKIE COMPANY on the Principal  
Register for "bakery goods, namely madeleines."<sup>2</sup> After the

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<sup>1</sup> Responsibility for this application was assigned to the  
present Examining Attorney at the time the appeal brief had to be  
written. A different Examining Attorney examined the  
application.

<sup>2</sup> Application Serial No. 78393418, filed March 30, 2004,  
pursuant to Section 1(b) of the Trademark Act (intent-to-use).

Ser No. 78393418

Examining Attorney issued a final refusal of registration on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act, on the basis that the mark is merely descriptive of the identified goods, applicant, on March 9, 2005, filed an amendment of its application to the Supplemental Register, and also submitted an amendment to allege use, asserting first use and first use in commerce on August 9, 2004. The Examining Attorney thereupon refused registration on the Supplemental Register on the basis that the proposed mark is generic. In that action, the Examining Attorney stated that THE MADELEINE COOKIE COMPANY is "generic for a kind of cookie produced by a company and thus incapable of distinguishing the applicant's goods." She also stated that "the mark immediately informs consumers that the goods are madeleine cookies produced by a company," and cited *In re Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988), stating that decision held that PAINT PRODUCTS CO. was "so highly descriptive as to be incapable of becoming distinctive; even assuming the term could function as a mark, applicant's evidence deemed insufficient to establish acquired distinctiveness." After applicant responded to this Office action, the Examining Attorney issued a final refusal, again stating that the proposed mark is:

generic for a kind of cookie produced by a company and thus incapable of distinguishing the applicant's goods. The mark THE MADELEINE COOKIE COMPANY names the applicant's "bakery goods, namely madeleines." The mark immediately informs consumers that the goods are madeleine cookies produced by a cookie company.

It is from the refusal of registration on the Supplemental Register that applicant has filed the instant appeal. The appeal has been fully briefed.

As a preliminary matter, we note that the Examining Attorney has objected to the recital in applicant's appeal brief of a list of third-party registrations. The Examining Attorney notes that these registrations were untimely, since they were not made of record during the prosecution of the application and that, in any event, a mere listing of registrations is not sufficient to make them of record. With its reply brief applicant submitted copies of the registrations taken from the USPTO's records, and has requested that the Board take judicial notice of them.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. Thus, the listing of the registrations in applicant's appeal brief, or the submission of copies of those registrations with its reply brief, is manifestly

untimely, and the registrations cannot be treated as of record. With respect to applicant's request that the Board take judicial notice of the registrations, it is well-established that the Board does not take judicial notice of registrations that reside in the Patent and Trademark Office. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Accordingly, we have not considered the third-party registrations.<sup>3</sup>

The Examining Attorney has submitted with her brief dictionary definitions of "the" and "company," and has requested that we take judicial notice of them. Because dictionary definitions are subject matter of which the Board takes judicial notice, see *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), we grant this request.

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<sup>3</sup> Even if we had considered the registrations, they would not change the result herein. The third-party registrations are for marks which are not analogous to the mark herein. For example, Registration No. 1452689 is for THE FLOOR STORE for retail store services in the field of floor coverings. The fact that FLOOR and STORE rhymes gives the mark an effect that is more than simply the meaning of the words. Similarly, the term SUPPLY ROOM in Registration No. 3078956 for THE SUPPLY ROOM COMPANIES for retail store services featuring various office supplies is not the generic term for office supplies, but only identifies where such supplies may be stored. We will not burden this opinion with a discussion of the other registrations, since they are not of record, but we consider them to be distinguishable as well.

This brings us to the substantive ground for refusal, namely that THE MADELEINE COOKIE COMPANY is not registrable on the Supplemental Register. Section 23 of the Trademark Act, 15 U.S.C. §1091, provides, in part, that a mark may be registered on the Supplemental Register if it is "capable of distinguishing the applicant's goods or services." The question we must decide, then, is whether applicant's mark has this capability.

If a mark is generic, it is not capable of distinguishing the applicant's goods. In determining genericness, we look to the two-part test set out in *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986): "First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" Such sources as purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers, and other publications may be used to show the relevant public's understanding of a term. In *re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1570, 4 USPQ2d 1141 (Fed. Cir. 1987).

Applicant has identified its goods as "bakery goods, namely madeleines." Thus, madeleines, or madeleine

cookies, are the genus of goods. Moreover, there is no real question that the term MADELEINE COOKIE is generic for applicant's goods, and that consumers would perceive MADELEINE COOKIE as referring to the genus of goods. Applicant concedes that MADELEINE is an "admittedly generic term." Brief, p. 5. Applicant implicitly also acknowledges that MADELEINE COOKIE is generic: "even if the phrase 'MADELEINE COOKIE' is viewed as a generic term" id.; "It is self evident that 'madeleine cookies' and THE MADELEINE COOKIE COMPANY do not have identical meanings and one is not the generic term for the other." Reply brief, p. 2. In any event, the evidence of record clearly demonstrates the generic nature of the individual words and the phrase. The Examining Attorney has submitted dictionary definitions showing that "madeleine" means "a small, rich cake, baked in a shell-shaped mold" and "cookie" means "a small, usually flat and crisp cake made from sweetened dough."<sup>4</sup> She has also submitted excerpts of articles from the Nexis database, and web pages, that reference "madeleine cookies," including the following:

Recipe in Kitchen Emporium.com for  
"Madeleine Cookies,"  
www.kitchenemporium.com;

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<sup>4</sup> The definitions are taken from The American Heritage Dictionary of the English Language, 3d ed. © 1992.

Listing in La Belle Cuisine for  
"Madeleine Cookie Mold,"  
www.cooksite.com, which refers to  
madeleines as "French tea cookies";

Near the beginning of the masterpiece  
In Search of Lost Time, Proust's  
narrator dunks a madeleine cookie into  
a cup of tea...

"The Dallas Morning News," August 2,  
2004

...the shape of the madeleine cookie,  
taken from a shell that pilgrims wore  
on their hats.

"Chicago Tribune," March 14, 2004

The dispute arises over whether the additional words  
in the mark, THE and COMPANY, affect the generic meaning of  
MADELEINE COOKIE so that, according to applicant, the  
phrase THE MADELEINE COOKIE COMPANY is not a generic term  
for cookies; or whether, according to the Examining  
Attorney, these words have no source-indicating value, such  
that the addition of incapable material to a generic term  
does not create a registrable mark. In this connection,  
the Examining Attorney has made of record excerpts of  
articles from the Nexis database that show "cookie company"  
is used to designate an entity that makes or sells cookies.  
See, for example:

The Stampers cookies, which started  
selling on the Internet in May, are  
part of the Cookie Club of America  
Inc., a San Diego cookie company.  
"The Washington Times," November 6,  
2004

...G.E.T. Cookies, a Colorado-based cookie company...  
"Billings (Montana) Gazette," June 25, 2004

The Rubins are also the owners of Claudia's Kitchen, a gourmet cookie company that sells to the specialty food industry.  
"Dairy Foods," March 1, 2004

He launched Famous Amos, which has become one of the world's premier cookie companies.  
"Northwest Florida Daily News," February 26, 2004

In *In re G. D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), aff'd. 360 F.2d 650, 149 USPQ 619 (CCPA 1966), the Board considered the effect of the addition of the definite article THE on the registrability of a word that is otherwise a common descriptive term for the goods. In that case, the applicant attempted to register "the pill" for "pharmaceutical preparations in tablet form containing norethynodrel." The Board stated, at 143 USPQ 222-23:

If we were to give any weight to applicant's arguments concerning the "unique" effect created by the utilization of the article "THE" in association with the mark "PILL" and by the use of quotation marks around the unitary phrase, it would seem to follow that an automobile manufacturer could register the designation "THE AUTOMOBILE" or an appliance manufacturer the phrase "THE REFRIGERATOR". Manifestly, the utilization of the article "the" and of



quotation marks cannot convert a simple notation comprising ordinary words of the English language used in their ordinary sense into a registrable trademark.

See also *In re The Computer Store, Inc.*, 211 USPQ 72 (TTAB 1981), in which the Board held that THE COMPUTER STORE is the common descriptive name of the "computers and computer book outlet services" offered by applicant, and therefore cannot distinguish such services as those of any single proprietor. The Board specifically discussed whether use of the definite article, "The", converted the merely descriptive term into a registrable service mark, and also considered an argument similar to that made by applicant herein, namely, that "the article 'THE' lends the phrase the connotation of uniqueness (*The one*), while the word 'COMPANY' lends the concept of a business entity," so that, "taken together, the words of the mark elicit in the minds of consumers a preeminent business entity for baked goods in the form of madeleines." Brief, p. 5. The Board was not persuaded by such arguments in *The Computer Store*, and found that the word THE simply limited the noun STORE to the application specified by the adjective COMPUTER. In the present case, the analogy is that THE simply limits the word COMPANY to a specific type of company, namely, one which sells madeleine cookies.

With respect to the inclusion of the word COMPANY in applicant's mark, it has long been held that the addition of an entity designator, such as COMPANY, will not make an unregistrable term registrable. As far back as 1888, the Supreme Court, in *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888), held:

[P]arties united to produce or sell wine, or to raise cotton or grain, might style themselves Wine Company, Cotton Company, or Grain Company; but by such description they would in no respect impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have a right to deal in such articles, and to publish that fact to the world. Names of such articles cannot be adopted as trade-marks, and be thereby appropriated to the exclusive right of any one; nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to use of the name.<sup>5</sup>

This same principle has been reiterated in subsequent cases. In *In re E. I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984), in which the applicant sought to register OFFICE MOVERS, INC. for moving services, including the moving of office facilities, the Board found that the addition of the

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<sup>5</sup> In *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005), the Court acknowledged this language of the Supreme Court, although it distinguished it from the situation where a top level domain name (TLD), as opposed to the word COMPANY, appears in the mark.

term INC. to OFFICE MOVERS did not add any trademark significance:

Office movers move offices. Any dictionary can tell us this much. The addition of the term "INC." does not add any trademark significance to the matter sought to be registered. The complete term "OFFICE MOVERS, INC." is so highly descriptive that it is incapable of distinguishing applicant's services.<sup>6</sup>

The case that is perhaps most similar to the present situation is *In re Paint Products Co.*, supra, in which applicant sought registration on the Principal Register, under the provisions of Section 2(f), for "PAINT PRODUCTS CO." for "interior and exterior paints and coatings, namely, alkyd, oil, latex, urethane and epoxy based paints and coatings." Registration was refused on the basis that "applicant's mark is so highly descriptive of the goods to which it is applied that it cannot function to identify and

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<sup>6</sup> At the time this decision issued the Board generally used the phrase "so highly descriptive" for refusals of registration on the Principal Register for proposed marks that were generic or were not capable of functioning as a trademark. It was not until 1992, in *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876 (TTAB 1992), that the Board made clear that the phrase "so highly descriptive that it is incapable of acting as a trademark" should not be used, and that, where an applicant seeks registration on the Principal Register, the Examining Attorney may refuse registration under Section 2(e)(1) of the Act on the basis that the mark sought to be registered is generic. When registration is sought on the Supplemental Register, of course, the standard is whether the proposed mark is "capable" of distinguishing applicant's goods or services from those of others.

distinguish applicant's products from the like products of others."<sup>7</sup> Although registration was sought on the Principal Register, the language of the refusal, that the mark cannot function to distinguish applicant's products from those of others, mirrors the language of a refusal on the Supplemental Register. The Board recognized, 8 USPQ at 1865, that:

when confronted with marks consisting of generic or highly descriptive terms coupled with entity designations such as "Inc.", the Board has found the resulting designations incapable of functioning as service marks. In re Industrial Relations Counselors, Inc., 224 USPQ 309 (TTAB 1984) [INDUSTRIAL RELATIONS COUNSELORS, INC. held so highly descriptive of "educational services, namely, conducting seminars and research in the field of industrial relations" as to be incapable of exclusive appropriation and registration as a service mark]; In re E.I. Kane, Inc., 221 USPQ 1203 (TTAB 1984) [OFFICE MOVERS, INC. for "moving services, namely the moving of office facilities, warehouse facilities, industrial plant facilities (etc.)" held so highly descriptive as to be incapable of distinguishing applicant's services in commerce]."

The Board also agreed with the Examining Attorney's contention that "the abbreviation 'CO.', standing for the

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<sup>7</sup> As noted in footnote 6, this language for refusals was used prior to 1992. The decision makes clear that the issue of whether PAINT PRODUCTS CO. is generic was not before the Board.

word 'COMPANY', when added to the words 'PAINT PRODUCTS', does not serve to create a mark which can serve to identify and distinguish the source of applicant's paints and coatings any more than it could serve to identify and distinguish retail paint store services, because 'PAINT PRODUCTS CO' is 'clearly applicable to any company which sells or produces paint products.'" Id. The Board found that the evidence of record in that case, combined with the obvious significance of the abbreviation "Co.", was sufficient to establish that purchasers encountering the words "PAINT PRODUCTS CO." on the goods for which registration was sought would view those words not as a trademark, but in their ordinary dictionary sense: a company that sells paint products. The Board also stated that, because the phrase describes the goods of any company selling such products, it should remain available for applicant's competitors, citing *In re Phone Co., Inc.*, 218 USPQ 1027 (TTAB 1983) [highly descriptive term "THE PHONE COMPANY" "would ... equally describe [telephone] equipment emanating from one of applicant's competitors."].

The Board further held, 8 USPQ2d at 1866, that:

"PAINT PRODUCTS CO." is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by

such a company. Cf. In re Wickerware, 227 USPQ 970 (TTAB 1985) [mark "WICKERWARE" held not capable of functioning as a service mark for mail order distributorship services in the field of wicker products, the Board finding "WICKERWARE" is as incapable of distinguishing the services of selling wicker as of distinguishing goods made of wicker]; In re Bonni Keller Collections, Ltd., 6 USPQ2d 1224 (TTAB 1987) [mark "LA LINGERIE" (French equivalent of English "lingerie") held incapable of functioning as either a trademark for undergarments or a service mark for retail clothing store services]; In re Half Price Books, Records, Magazines, Inc., 225 USPQ 219 (TTAB 1984) [mark "HALF PRICE BOOKS RECORDS MAGAZINES" held apt descriptive term for retail store services featuring the sale of goods at half price and less]. We distinguish the present case from In re Failure Analysis Associates, supra,<sup>8</sup> in that the word "ASSOCIATES" was not shown there to be a common entity designation such as the designation "Co." in the mark now before us.

Applicant argues that the Paint Products case is distinguishable from the present situation, asserting that the Board, because of the concluding language in that opinion, leaves "the door open to providing evidence of distinctiveness" and "necessarily qualifies the mark for

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<sup>8</sup> 1 USPQ2d 1144 (TTAB 1986); FAILURE ANALYSIS ASSOCIATES held registrable for "consulting services in the field of mechanical, structural, metallurgical, and metal failures, fires and explosions; engineering services in the field of mechanical design and risk analysis" and "consulting engineering services in the metallurgical field."

registration on the Supplemental Register." Brief, pp. 8-9. We disagree. The concluding language to which applicant refers is as follows:

Even had we found applicant's mark not so highly descriptive that it cannot function as a trademark, we would nonetheless affirm the refusal to register on the ground that the evidence submitted in support of the Section 2(f) claim is insufficient to convince us that such a highly descriptive term has become distinctive through use in commerce. While there has been use of the term on applicant's products since 1957 and not insubstantial sales and advertising of goods bearing the words "PAINT PRODUCTS CO.," such use alone does not convince us that ordinary purchasers of applicant's goods have come to view "PAINT PRODUCTS CO." as a trademark. The affidavit evidence from ten of applicant's customers, while certainly evidence tending to show acquired distinctiveness as a trademark, must be weighed against the highly descriptive nature of the words that compose the mark. To put the matter simply, that ten of applicant's customers through many years of doing business with applicant, have come to recognize applicant's trade name "PAINT PRODUCTS CO." as a trademark for paints and coatings is less persuasive evidence on the issue of distinctiveness than is the inherently descriptive nature of applicant's mark. Assuming "PAINT PRODUCTS CO." could function as a trademark, a good deal more evidence than that offered here would be necessary to establish the distinctiveness of such a term.

It is clear from the language preceding this paragraph (e.g., purchasers encountering the words PAINT PRODUCTS CO. on the goods for which registration is sought would view those words not as a trademark; the phrase should remain available for applicant's competitors; PAINT PRODUCTS CO. is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company) that the Board considered PAINT PRODUCTS CO. as not capable of distinguishing the applicant's goods from those of others. Rather, the final paragraph was included in order to render a complete opinion that considered both the issues that were before the Board. But the fact that the Board addressed this secondary issue in no way suggests that the Board believed that PAINT PRODUCTS CO. was capable of functioning as a trademark, and could be registrable upon the submission of additional evidence.<sup>9</sup>

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<sup>9</sup> Applicant makes a similar argument with respect to The Computer Store case, asserting that the last line of the opinion "implicitly qualifies the mark for registration on the Supplemental Register." Brief, p. 7. We are not persuaded by applicant's argument. The Board clearly stated, at 211 USPQ 75, that "the phrase 'THE COMPUTER STORE' is the common descriptive name of the services offered by applicant, wherefore it cannot distinguish such services as those of any single proprietor." The following, and last line of the opinion, is "We further decide that even could this phrase be capable of functioning as a mark, the record here is clearly insufficient to show that it has become distinctive as to applicant's services." We view this sentence, on which applicant relies, as reiterating the Board's



Applying the principles set out in the case law to the record in the present application, we find that the evidence shows that "madeleine" and "madeleine cookie" are generic terms for that type of cookie. We further find that "cookie company" is a commonly used phrase to refer to a company that makes cookies, and that, as in the PAINT PRODUCTS CO. case, the phrase should remain available to applicant's competitors. Moreover, as the Supreme Court has held, one cannot obtain the right to the use of the name of an article simply by including the word "company" with that name. Finally, the inclusion of the word THE, as discussed in the G.D. Searle and The Computer Store opinions, does not add any source-identifying significance.

Thus, the additional words THE and COMPANY in applicant's mark do not serve to remove the generic significance of MADELEINE COOKIE. The mark as a whole is without source-identifying significance and is therefore incapable of distinguishing applicant's goods.

We note that applicant and the Examining Attorney have disputed whether the issue of genericness should be analyzed according to *In re American Fertility Society*, 188

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view that the proposed mark is incapable, but, as in *Paint Products*, the Board has also addressed the issue of acquired distinctiveness in order to render a complete opinion.

**Ser No.** 78393418

F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) or In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). However, the real question here is whether the addition of the words THE and COMPANY, which have no source-indicating significance, to clearly generic terms, results in a term that has the capability of distinguishing applicant's goods from those of others. As we have said, it does not.

Decision: The refusal of registration is affirmed.