

**This Opinion is Not a
Precedent of the TTAB**

Mailed: December 17, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Steven DiFillippo

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Serial No. 85013002

Adam J. Bruno of Bay State IP LLC for Steven DiFillippo.

Linda M. Estrada, Trademark Examining Attorney, Law Office 104,
Chris Doninger, Managing Attorney.

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Before Kuhlke, Mermelstein and Shaw,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Steven DiFillippo (“Applicant”) seeks registration on the Supplemental Register of the mark SHRIMP COTIJA SPRING ROLLS (in standard characters) for “Dinner rolls, spring rolls and rolls containing shrimp, vegetables and cheese,” in International Class 30.

The Trademark Examining Attorney has refused registration of Applicant’s mark on the Supplemental Register under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c), on the ground that SHRIMP COTIJA SPRING ROLLS is generic as applied to the identified goods. In addition, the Examining Attorney has refused

registration on the Supplemental Register under Sections 23 and 45 of the Trademark Act, 15 U.S.C. §§ 1091 and 1127, because the proposed mark constitutes merely informational matter and does not function as a trademark.

PROSECUTION HISTORY

On April 13, 2010, Applicant filed an application for registration for his proposed mark on the Principal Register based on an intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). After the Examining Attorney issued a refusal under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground of mere descriptiveness, on November 16, 2011, Applicant filed an amendment to allege use as of May 10, 2010, and a request to amend the application to the Supplemental Register. The Examining Attorney accepted the amendment to allege use and issued an Office Action refusing registration on the Supplemental Register under Section 23 on the ground that the mark is generic. After the final refusal on this ground, Applicant requested reconsideration on January 8, 2013. On February 5, 2013, the Examining Attorney denied the request for reconsideration and on April 12, 2013, Applicant filed his appeal brief.

On June 18, 2013, the Examining Attorney requested remand in order to issue the additional refusal that the proposed mark is merely informational matter that fails to function as a trademark. The Board granted the request on June 28, 2013, and after examination of that refusal, the appeal was resumed. Applicant filed a supplemental brief on July 7, 2014, the Examining Attorney filed her brief on

September 4, 2014, and on September 24, 2014, Applicant filed a reply brief. We affirm the refusals to register.

GENERIC REFUSAL

When a proposed mark is refused registration as generic, the Examining Attorney has the burden of proving genericness by “clear evidence.” *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *see also In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). 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 or services in question. *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Making this determination “involves a two-step inquiry: 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?” *Ginn*, 228 USPQ at 530. Evidence of the public’s understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *Merrill Lynch*, 4 USPQ2d at 1143, and *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). “An inquiry into the public’s understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the

entire formulation does not add any meaning to the otherwise generic mark.” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005).

Genus

We find that the genus of goods at issue in this case is adequately defined by Applicant’s identification of goods, specifically, “Dinner rolls, spring rolls and rolls containing shrimp, vegetables and cheese.” This genus includes spring rolls containing shrimp and cotija cheese inasmuch as the word “cheese” in the identification of goods encompasses all types of cheese. *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (“[A] proper genericness inquiry focuses on the description of the [goods or] services set forth in the [application or] certificate of registration”). Moreover, registration is properly refused if the subject matter for registration is generic for any one of the goods for which registration is sought. *In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff’d without pub. op.*, 971 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

Relevant Public’s Understanding of Term

Turning to the second inquiry, we first find that because there are no limitations in Applicant’s identification of goods the relevant consumer would be a member of the general public who is a potential purchaser of such food items. Applicant’s argument limiting the relevant consumers to those “along the eastern seaboard” and those “who patronize Applicant’s establishments” and purchase “applicant’s goods” is misplaced. App. Supp. Br. p. 6. As noted above, we must make our

determination based on the goods as identified in the application and there are no such limitations in the identification of goods. *Magic Wand*, 19 USPQ2d at 1552.

Examining Attorney's Argument and Evidence

It is the Examining Attorney's position that the relevant customers would understand SHRIMP COTIJA SPRING ROLLS to refer to the genus of goods, arguing that the "cumulative evidence supports the finding that the proposed mark is comprised of generic terms that retain their generic meaning when combined." Ex. Att. Br. p. 8. For legal support, the Examining Attorney cites to *Gould*, 5 USPQ2d at 1111-12, and quotes the following passage from *In re American Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999), "if the compound word would have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic, then the compound word too has been proved generic. No additional proof of the genericness of the compound word is required." It appears the Examining Attorney believes this to be a compound term and the analysis set forth in *Gould* is the appropriate legal standard to apply.

In support of her position, the Examining Attorney submitted, *inter alia*:

Printout from the third-party website Epicurus listing cotija as a Mexican cheese, (Office Action, July 26, 2010, TSDR pp. 2-4);¹

Dictionary definitions for the word "shrimp" as "any of several small, long-tailed, chiefly marine crustaceans of the decapod suborder Nataria, certain species of which

¹ TSDR citations to the record refer to the Trademark Status and Document Retrieval database available on the USPTO website.

are used as food” from the RANDOM HOUSE DICTIONARY (2010) and the term “spring rolls” as “hot or cold pastry roll, especially one made with a meat and vegetable filling and fried until crisp and golden” from MSN Encarta (*Id.*, TSDR pp. 5-10);

Wikipedia entry for Cotija, Michoacan describing it as a municipality in Mexico and known for its cheese (*Id.*, TSDR pp. 11-13);

Printout from the third-party website Boston Chefs showing Applicant’s menu (*Id.*, TSDR pp. 14-18);

Wikipedia entry for “spring roll” (*Id.*, TSDR pp. 19-20);

A printout from the Epicurious website showing a recipe for “Shrimp and Cotija Enchiladas with Salsa Verde and Crema Mexicana” and from the website Simply Recipes for a recipe for “Baked Shrimp with Tomatillos” that has cotija cheese and shrimp as listed ingredients (Office Action, May 16, 2011, TSDR pp. 2-4, 6);

Printout from www.cheese.com listing cotija and noting “[i]t is a Hispanic-style cheese, known as the ‘Parmesan of Mexico’.” (*Id.*, TSDR p. 9);

Printout from Cacique website listing cotija cheese and describing it as a “flavorful artisan cheese ... used as an accent cheese due to its abundant flavor.” (*Id.*, TSDR p. 11);

An article from SFGate.com discussing cotija cheese named for a Michoacan town in Mexico (*Id.*, TSDR pp. 13-14);

Excerpt from Fine Cooking website describing cotija cheese as “an aged, crumbly, slightly salty Mexican cheese traditionally made from cow’s milk.” (*Id.*, TSDR pp. 15-16);

Printout from Food Network website describing cotija cheese as “a popular Mexican cheese named after Cotija de la Paz, a town in the state of Michoacan ... now also being produced in the United States” and listing recipes that contain Cotija cheese, e.g., “Cumin Crusted Chicken with Cotija” (*Id.*, TSDR p. 20-21);

Printout from Food Network website listing various recipes with shrimp as an ingredient (*Id.*, TSDR pp. 22-26);

Listing for “shrimp” on Yahoo Education website (*Id.*, TSDR p. 27-28);

Printout from Mayo Clinic website listing recipe for “Fresh spring rolls with shrimp” (*Id.*, TSDR p. 29-32);

Excerpt from Whole Foods website showing “shrimp lettuce wraps and spring rolls” (Office Action, December 9, 2011, TSDR p. 2);

Excerpt from Food Network website showing recipe for “Shrimp Spring Rolls with Cucumber-Yogurt Dip” (*Id.*, TSDR p. 6-8);

Excerpt from Phillips website offering “Crab & Shrimp Spring Rolls” as appetizers (*Id.*, TSDR pp. 9-10);

Excerpt from Cooking Channel website listing recipe for “Spicy Shrimp Spring Rolls” (*Id.*, TSDR pp. 11-12);

Excerpt from Specialty Cheese Company, Inc. describing cotija as “the ‘Parmesan of Mexico’ this cheese is strongly flavored, firm, and perfect for grating ... In the U.S. it is increasingly popular on pasta.” (*Id.*, TSDR p. 16);

Definitions for the term “spring roll” as “a Chinese food consisting of a small roll of pastry filled with meat or fish and vegetables, cooked in hot oil and eaten hot or cold” and “shrimp” as “a small shellfish with a lot of legs” from MACMILLAN DICTIONARY (2012) (Office Action, July 11, 2012, TSDR p. 2, 7);

Definition for the word “cotija” from the Wordnik website as “a popular hard, dry, cheese from Mexico” which includes several examples of use from various online publications, e.g., “start with the corn-on-the-cob, which is coated in cotija cheese, mayonnaise and chili powder,” *The Wall Street Journal*, and “We moved on to the Mexican corn, grilled with aioli, lime and topped with plenty of cotija cheese,” *The Huffington Post* (*Id.*, TSDR pp. 11-12);

Excerpt from the website RecipeBridge showing four “shrimp cotija recipes” from three recipe websites (*Id.*, TSDR p. 14);

Excerpt from Zagat website showing menu from a restaurant offering Chile con Queso with cotija and Chihuahua cheese and shrimp cotija cheese quesadillas (*Id.*, TSDR pp. 16-17);

Excerpt from All Menus showing menu from a restaurant offering shrimp enchiladas stuffed with grilled shrimp and cotija cheese, and house salad, grilled potato and tacos al carbon all with cotija cheese (*Id.*, TSDR pp. 25-26);

Excerpt from Restaurant Week NH website showing a menu from a restaurant offering “Jerry Garcia’s Favorite Sandwich (Fajita chicken, sun-dried tomatoes, spinach ... and topped with cotija cheese)” (*Id.*, TSDR p. 28);

An article from the website Inside Sonoma referencing a restaurant’s “rock shrimp and cotija tostada” (*Id.*, TSDR p. 32);

The online menu for Desert Fire listing two different tacos that have shrimp and cotija as ingredients (*Id.*, TSDR p. 36);

The Wikipedia entry for “spring rolls” describing them as “a large variety of filled, rolled appetizers ... found in East Asian and Southeast Asian cuisine. The kind of wrapper, fillings and cooking technique used, as well as the name, vary considerably within this large area” (*Id.*, TSDR p. 40);

Printout from Food Network website showing recipes for “Pork and Shrimp Spring Rolls,” “Shrimp Spring Rolls with Spicy Apricot Mustard dip,” “Chicken Spring Rolls,” “Lobster Spring Rolls with a Citrus-Chili dipping sauce,” “Turkey Spring Rolls,” “Conch Spring Rolls” and “Crab Spring Rolls with Pink Grapefruit, Avocado and Toasted Almonds” (*Id.*, TSDR pp. 44-46);

Several third-party websites referencing recipes for “shrimp spring rolls” (Office Action, February 5, 2013, TSDR pp. 2-15);

Excerpt from Wisconsin Cheese website describing cotija as “the Parmesan of Mexico. It is widely used as an ingredient, a seasoning and a garnish ... Cotija rates as one of Mexico’s most recognized cheeses. Because of the popularity of Mexican foods throughout the United States, skilled Wisconsin cheesemakers have been producing this ethnic cheese in American’s Dairyland for many years” and from Real California Milk website listing cotija cheese (*Id.*, TSDR pp. 20, 23);

Excerpt from the online magazine Culture Cheese describing cotija as “one of the oldest cheeses to come from Mexico” (*Id.*, TSDR p. 25);

Excerpt from Igourmet.com noting “in the U.S.” cotija “is increasingly popular on pasta ... handmade in Wisconsin, yet full of authentic Mexican flavor” and with comments from various individuals across the United States, dating back to 2009 (*Id.*, TSDR p. 27);

Excerpt from online cheese store Cheese Supply offering cotija cheese for sale, listing it as made in the USA (*Id.*, TSDR p. 36);

Article from Chicago Foodies website published in 2008, discussing cotija cheese (*Id.*, TSDR p. 38);

A recipe on the Central Market website for “shrimp and cotija cheese stuffed hatch chiles” (*Id.*, TSDR p. 53);

Recipe from the New York Times online for “corn con cotija” (*Id.*, TSDR p. 55);

Online menu from Chevy’s restaurant offering fresh fish tacos, listing cotija cheese as one of the ingredients (*Id.*, TSDR p. 59);

Menu from Zagat for Escorpion restaurant in New York City listing cotija cheese as an ingredient in an appetizer (Office Action, July 25, 2013, TSDR p. 2);

Article from the online publication TexasMonthly listing a restaurant in Dallas that serves a Southwestern Caesar with grilled shrimp, cotija cheese, and roasted corn (*Id.*, TSDR p. 7);

Online Menu from Lupe Taqueria listing shrimp and cotija quesadillas (*Id.*, TSDR p. 13);

Online catering menu from El Cholo Cafe listing a roasted pepper stuffed with shrimp and cotija cheese (*Id.*, TSDR p. 36); and

Online menu for Mexicali restaurant in Los Angeles, CA, listing chicken breast topped with shrimp and cotija cheese (*Id.*, TSDR p. 39).

Applicant's Argument and Evidence

It is Applicant's position that "the mark is not understood by the public to refer primarily to the genus of goods and services as the genus of the goods at issue should be viewed in combination with the specific market of the product; the mark is unique; and, the Office has failed to provide any evidentiary matter illustrating the mark used in its entirety outside of applicant's use." App. Br. p. 3. In addition, Applicant references his other marks "comprising structures identical to applicant's 'SHRIMP COTIJA SPRING ROLLS' mark" that the USPTO has allowed to register and, therefore, the USPTO should allow registration of this proposed mark. *Id.*

Applicant contends that SHRIMP COTIJA SPRING ROLLS is a phrase not a compound term and, therefore, the Office wrongly applied the *Gould* standard. App. Supp. Br. p. 7. Applicant submits that the appropriate standard to apply is the one set out in *American Fertility* inasmuch "as the words shrimp, cotija and spring rolls are not united in order to form one compound word, such as 'Screenwipe.'" *Id.* Applying the standard set out *American Fertility*, Applicant concludes that there is not clear evidence that the relevant public understands SHRIMP COTIJA SPRING ROLLS to be a common name "describing the genus of the applicant's goods" and

other than Applicant's use, there is not "even one instance of applicant's mark SHRIMP COTIJA SPRING ROLLS used in its entirety." App. Br. pp. 4-5.

Because Applicant categorizes the proposed mark as a phrase, he asserts that the dictionary definitions and other evidence of the individual words are not sufficient in that "basic dictionary definitions of individual components cannot represent, nor encompass, the purchasers' ability to recognize the mark in its entirety." App. Supp. Br. p. 4. As to the other evidence, Applicant argues that it does not "represent the restaurant-going public's opinion of SHRIMP COTIJA SPRING ROLLS." App. Supp. Br. p. 4.

Applicant particularly focuses on the word COTIJA and argues that even if we view the term as a compound the evidence does not support a finding that the term is generic. Applicant does not deny that cotija is the name of a type of cheese but argues "that the average American citizen does not know that 'COTIJA' is a cheese, and does not know of the cheese's place of origin, Cotija, Mexico." App. Br. p. 6. Applicant submitted search results from several dictionaries, including Spanish language dictionaries, showing no result for the word "cotija" and argues that "[w]hen all the main dictionaries that Americans use do not contain a definition for the term in question, it can be assumed that this reflects the public's lack of knowledge of the term and that they are unfamiliar with its meaning." App. Supp. Br. p. 10. Applicant questions the probative value of the online reference evidence (Wordnik and www.cheese.com) regarding consumer understanding of the term "cotija" arguing that www.cheese.com "is not for the average consumer, but rather

for specialists and cheese connoisseurs” and Wordnik “draws its content from Wiktionary, [an] open-source creative common that allows anyone with access to the Internet to add and define words as they see fit ... it would seem obvious that such an open and uncontrolled source would not hold much weight as evidence.” App. Supp. Br. p. 11.

The Board has addressed such concerns with collaborative content websites, noting that “the Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information ... [t]he better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources....” *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032-33 (TTAB 2007). Here the evidence was timely provided and indeed Applicant responded with other evidence in the form of dictionary results to question the probative value of the online reference evidence. We find the Examining Attorney’s evidence probative to the extent that the relevant consumer here includes those members of the general public interested in cheese and because many consumers today obtain information from or are exposed to information from the Internet. In addition, the record includes several menus that list “cotija” cheese as an ingredient in various dishes. This evidence serves to corroborate the Wordnik entry and is evidence of restaurant consumers being exposed to this term as a type of cheese included in a particular dish. The cumulative weight of the evidence supports a finding that a substantial number of

consumers have been exposed to the term “cotija” as a type of cheese, and, therefore, would understand it to be the name of a type of cheese, despite the absence of the word from the various dictionaries accessed by Applicant.

Applicant also argues that the average restaurant patron or grocery shopper “is unlikely able to pinpoint the specific ingredients of a spring roll, which tend to blend together” and the “perception of the phrase as a whole is that it is suggestive or descriptive of the overall taste and ornamental design of the spring roll and that it is available only at Applicant’s place of business.” App. Supp. Br. p. 6. However, with the wording SHRIMP COTIJA SPRING ROLLS there is no need to pinpoint the ingredients as they are already listed for the customer.

In addition, Applicant argues that his proposed mark is unique and distinctive due to its tri-cultural nature because the “concept of spring rolls plainly derives origin from Asian cuisine, while the cheese is of Mexican origin, and the entire product itself is created at a high-end Italian restaurant.” App. Supp. Br. p. 12.

First, Applicant arrives at a “tri-cultural” characterization by including the fact that the goods are served in an Italian restaurant; however, our analysis is bounded by the identification in the application which does not limit the goods to those sold in Italian restaurants. For our analysis, at most, we may consider the bi-cultural nature of the goods “cotija” being a Mexican cheese (to do so we must find consumers know the origin of this type of cheese, which Applicant argues against) and “spring rolls” being known as coming from Asian cuisine. Even if this is so, it is not uncommon in the food industry to combine different cuisine styles and potential

purchasers are accustomed to such combinations. *See, e.g.*, menu for Timothy's offering miso-glazed Atlantic salmon marinated in teriyaki sauce, barbequed baby back ribs coated with Asian glaze, and pasta carbonara with smoked applewood bacon (Office Action, July 25, 2013, TSDR pp. 90-94); menu for Latin Soul offering chicken taquitos and mango spring rolls (*Id.*, TSDR p. 112); and menu for Brooklyn Fish Camp offering Hamachi crudo with citrus coconut nage, grilled calamari with Punjabi chickpea and yogurt, fried green tomatoes with jalapeno buttermilk dressing, grilled shrimp tacos cumin slaw and cotija, soy glazed loch duart salmon with saffron Israeli cous-cous (*Id.*, TSDR pp. 120-121). In view thereof, we find that the listing of a Mexican cheese, cotija, with spring rolls, which may be characterized as Asian cuisine, does not present an incongruous or catchy combination such that it removes the clear and obvious meaning from the list of ingredients.

Finally, Applicant argues this proposed mark should be granted the same protection its other identically-structured marks have received. App. Supp. Br. p.

13. Applicant's following marks are registered on the Supplemental Register:

Reg. No. 3858570, issued on October 5, 2010, for BUFFALO CHICKEN SPRING ROLLS (CHICKEN SPRING ROLLS disclaimed) for dinner rolls, spring rolls and rolls containing chicken, cheese and hot sauce;

Reg. No. 3773801, issued on April 6, 2010, for CHICKEN PARM SPRING ROLLS (SPRING ROLLS disclaimed) for dinner rolls, spring rolls and rolls containing chicken, cheese and hot sauce; and

Reg. No. 3328054, issued on October 30, 2007, for PHILLY CHEESE STEAK SPRING ROLLS (SPRING ROLLS disclaimed) for dinner rolls, spring rolls and rolls containing steak and cheese.

The record also includes a third-party's Supplemental Registration, Reg. No. 3137318, issued on August 29, 2006, for DOUBLE STUFFED POTATO SPRING ROLLS for food products, namely, processed potato pieces served as an appetizer.

In support of his argument, Applicant submitted:

Results from the Trademark Electronic Search System (TESS) showing live and dead registrations that contain the word COTIJA (App. Response, April 25, 2011, TSDR p. 2);²

Results from a search on the Google search engine for "shrimp cotija spring rolls" all referencing Applicant (App. Response, January 8, 2013, TSDR p. 2);

Excerpts from online dictionaries (both English and Spanish) showing no results for COTIJA (App. Response, January 27, 2014, TSDR pp. 2-16);

Printouts from TESS of his registrations on the Supplemental Register noted above (*Id.*, TSDR pp. 17-22); and

A printout from TESS of a third-party registration on the Supplemental Register noted above (*Id.*, TSDR p. 23).

Discussion

Having determined that U.S. consumers are sufficiently exposed to the term cotija as a type of cheese and any possible bi-cultural nature of the proposed mark does not make it unique or incongruous, we turn to the question of whether the

² We first note that the TESS search results alone do not make the registrations of record. The registration record would need to be submitted, not merely the search result list that only provides the mark and the application or registration number. In addition, three of the examples are dead registrations and as such are of no probative value, even if the registration were of record. *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006). *See also In re Hartz Hotel Servs. Inc.*, 102 USPQ2d 1150, 1152 n.5 (TTAB 2012) (Board did not consider four cancelled third-party registrations submitted by applicant). In addition, the registration number referenced by Applicant in the reply brief which was not previously submitted is untimely. Trademark Rule 2.142(d). Nonetheless, we note in each live registration, the term COTIJA is disclaimed.

combined terms SHRIMP COTIJA SPRING ROLLS would be understood to be a generic name for spring rolls containing shrimp and cotija. Before we begin our analysis, we must first determine the applicable evidentiary standard. Under the *American Fertility* standard, if the term is deemed a phrase, dictionary definitions of the individual terms are not sufficient to make a finding of genericness as to the whole. *American Fertility*, 51 USPQ2d at 1837 (“The correct legal test for genericness of phrases, as set forth in *Marvin Ginn*, requires evidence of ‘the genus of goods or services at issue’ and the understanding by the general public that the mark refers primarily to ‘that genus of goods or services.’”) “Phrase” is defined as “a sequence of two or more words arranged in a grammatical construction and acting as a unit in a sentence” or “a sequence of two or more words that does not contain a finite verb and its subject or that does not consist of clause elements such as subject, verb, object, or complement, as a preposition and a noun or pronoun, an adjective and noun, or an adverb and verb.” RANDOM HOUSE DICTIONARY (2014) retrieved from www.dictionary.com.³

We find the facts of this case do not fall squarely within either *Gould* or *American Fertility*. It is not a phrase to the extent that it is not “in a grammatical construction and acting as a unit in a sentence”; however, it could be viewed as “a sequence of two or more words.” RANDOM HOUSE DICTIONARY (2014). On the other hand, it is comprised of two components, the form of the good “spring rolls” and the

³ We take judicial notice of the RANDOM HOUSE DICTIONARY definition of the word “phrase.” *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (Board may take judicial notice of dictionary definitions). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

primary ingredients “shrimp cotija” and to that extent resembles a compound term. However, it is not precisely a compound term in that it includes a list of items in a particular good. Nonetheless, even if SHRIMP COTIJA SPRING ROLLS may be viewed as a phrase, we do not read *American Fertility* to suggest that an applicant could take a clearly generic term “SPRING ROLLS” for spring rolls and add to it the clearly generic terms “SHRIMP COTIJA” for the main ingredients, shrimp and cotija, in those spring rolls and thereby create a registrable trademark simply because it is a phrase rather than a compound term. *Cf. In re Wm. B. Coleman Co., Inc.*, 93 USPQ2d 2019 (TTAB 2010) (addition of non-source identifying term “company” to ELECTRIC CANDLE does not create a trademark).

We also find the circumstances of this case different from those in *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001), wherein the Court noted “that telephone numbers consist of only seven numbers and typically can be used by only one entity at a time, a competitor of a business that has obtained a telephone number corresponding to a ‘mattress’ mnemonic for all practical purposes is already precluded from using and promoting the number. A rule precluding registerability merely shifts the race from the Trademark Office to the telephone company.” Here, we are not dealing with a mnemonic and unlike a telephone number assigned to one entity, SHRIMP COTIJA SPRING ROLLS for spring rolls containing shrimp and cotija, has no such restriction.⁴

⁴ While not cited by the Examining Attorney or Applicant, we find the circumstances of this case distinguishable on its facts from *In re McDonald’s Corp.*, 199 USPQ 490, 492 (TTAB 1978) where the applicant sought registration of TWOALLBEEFPATTIESSPECIALSAUCELETTUCECHEESEEPICKLESONIONSONASES

In *Dial-A-Mattress* the Court explained that the USPTO “must produce evidence of the meaning the relevant purchasing public accords the proposed mnemonic mark ‘as a whole.’” *Dial-A-Mattress*, 57 USPQ2d at 1811. In that case, the Court held that there “is no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as ‘1-888-M-A-T-R-E-S-S.’” However, in *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009), the Court clarified that it is not necessary that the public *uses* the term to refer to the genus; the correct inquiry is whether the relevant public would *understand* the term to be generic.

We find the record here to have some similarity to the record in *1800Mattress.com*, where the Court found the “entire formulation does not add any meaning to the otherwise generic mark.” *1800Mattress.com*, 92 USPQ2d at 1684. In *1800Mattress.com*, the record included examples of the applied-for term MATTRESS.COM to be incorporated in the website addresses of third parties (e.g., www.bestmattress.com, www.futonmattress.com and www.sofa-bed-mattress.com). *In re Dial-A-Mattress Operating Corp.*, Slip Op. 78976682 (November 13, 2008). The Court ruled that “reliance [on such evidence] is permissible to illuminate what services the relevant public would understand a website operating under the term

AMESEEDBUN for restaurant services. We first observe that the application for registration was for restaurant services not goods. Second, in reversing the refusal, the Board found that “applicant’s slogan is something more than just a list of ingredients for a sandwich sold in applicant’s restaurants; that is, it is a unique and somewhat catchy arrangement and combination which in its entirety creates a commercial impression quite different from that of the individual words as they are ordinarily used.” *McDonald’s Corp.*, 199 USPQ at 492. Here, contrary to Applicant’s position, there is no “catchy arrangement” or something unique about Applicant’s proposed mark to create a commercial impression quite different from the individual words, as they are ordinarily used.

‘mattress.com’ to provide.” *Id.* Similar to the website cases, while this record does not include examples of third-parties using Applicant’s exact formulation, it does include many examples of various parts of SHRIMP COTIJA SPRING ROLLS being used together to name the offered dish or the ingredients therein.

We are also not persuaded by Applicant’s reliance on *Merrill Lynch* because this record does not present the “mixed record” of usage referenced in *Merrill Lynch*, 4 USPQ2d at 1144 (“The mixture of usages unearthed by the NEXIS computerized retrieval service does not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term.”) All uses of the terms “shrimp,” “cotija” and “spring rolls” are clearly generic. In addition, all uses of the combinations “shrimp cotija” and “shrimp spring rolls” are clearly generic. Applicant simply combines the ingredients, shrimp and cotija, with the food item, spring rolls. The evidence in the record shows it is standard practice in recipes and menus to list ingredients with the food item. Therefore, there is evidence that the public understands this type of word structure, listing of ingredients with the food item, simply names the good, i.e., the genus. Accordingly, the fact that Applicant may be the only one to use this list of ingredients with this food item does not obviate the genericness refusal, because here the whole is not greater than the sum of its parts. *See American Fertility*, 51 USPQ2d at 1837.

In *American Fertility*, the Court noted the USPTO “failed to provide any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE,

has acquired no additional meaning to the relevant public than the terms ‘society’ and ‘reproductive medicine’ have individually.” *American Fertility*, 51 USPQ2d at 1837. Here, there is evidence of similar formulations and structures to list these ingredients and name the food item. This record is therefore qualitatively different from *Gould* where the Board rested its decision primarily on dictionary definitions. To find otherwise would prohibit others from making shrimp cotija spring rolls and letting the customer know what it is. Applicant does not have the right to prevent others from making this food item, and consequently should not have the right to prevent others from calling it what it is. The fact that there may be other ways to call for such goods, e.g., spring rolls with shrimp and cotija filling, is not dispositive. *1800Mattress.com*, 92 USPQ2d at 1685 (there can be more than one term for a particular genus of goods).

In addition, the fact that the SHRIMP COTIJA portion may be viewed as modifying the SPRING ROLLS portion, does not remove a term from being generic when it is used in connection with Applicant’s spring rolls. When a word or term is the name of a key ingredient, characteristic or feature of the goods it can be generic for those goods and thus incapable of distinguishing source. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970) (CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) (PASTEURIZED generic for face cream); *In re Reckitt & Colman, N. America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers).

The absence of examples of competitor or public use of this exact set of words in the record does not obviate the refusal. The fact that an applicant may be the first and only user of a term in connection with its specific goods does not justify registration if the only significance conveyed by the term is that of the category of goods. *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1084 (TTAB 2010). *Cf. Gould*, 5 USPQ2d 1110 (fact that generic designation not found in dictionary not controlling on the question of registrability). *See also In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983) (The fact that applicant may be the first and only user of this generic designation is not dispositive on the issue of genericness). As explained by the Examining Attorney, the USPTO must show that the relevant public would understand the applied-for mark as a whole to have generic significance, not that they use it in that manner. *1800Mattress.com*, 92 USPQ2d at 1685.

The evidence of generic use of various parts of this proposed mark, “shrimp,” “cotija,” “shrimp cotija,” “spring rolls,” and “shrimp spring rolls,” evidences the public understanding that these are generic words for food items that are sometimes prepared and served together. The many examples of these words, separately and paired, serve to underscore how the relevant purchasers would perceive SHRIMP COTIJA SPRING ROLLS in connection with applicant’s spring rolls. The submitted specimens of record also serve as evidence to understand how the public would perceive the matter sought to be registered. *Gould*, 5 USPQ2d at 1019 (“Gould’s own submissions provided the most damaging evidence [that the

word is generic]”); *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1197 (TTAB 1998).

The menu shown below lists the spring rolls in similar fashion to other menu items.



This listing is very similar to third-party menus or recipes listing spring rolls with various ingredients.



⁵ Chevy's restaurant menu (Office Action February 5, 2013, TSDR p. 59).



Seta taco
Houillacoche, portobello mushroom, corn, poblano, cotija

6

QUESADILLAS

Queso 7.00
Chihuahua cheese, queso fresco

Maiz, setas y poblano 9.00
Grilled corn, roasted poblano peppers, mushrooms, Chihuahua cheese

Tinga de Pollo 9.00
Ancho chile braised chicken, Chihuahua and jack cheese

Camarón 12.00
Shrimp, cotija cheese

7



8

Oaxaca Dinner Menu

\$25.95 per guest

Appetizers

Bean and Cheese Gorditas

Vegetable and Cheese Empanadas with Ancho Chile Sauce

First Course

Ambiente Salad

Entrées

Breast of Chicken with Oaxacan Mole Sauce

Roasted Poblano Pepper Stuffed with **Shrimp and Cotija** Cheese

Steak Fajitas Marinated with Onions, Tomato and Bell Pepper

9



10

⁶ Online menu for Escorpion restaurant in New York City (Office Action July 25, 2013, TSDR p. 2).

⁷ Online menu from Lupe Taqueria in Atlanta, GA (Office Action July 25, 2013, TSDR p. 13).

⁸ Online menu for Three Degrees bar and grill in Portland Oregon (*Id.*, TSDR p. 15).

⁹ Online catering menu for El Cholo Cafe in Pasadena, CA (*Id.*, TSDR p. 35-36).

Pho Basil Sampler - \$12.99

A sampling of a few of your favorites - pok pok wings, egg rolls, **shrimp spring rolls**, grilled meat spring rolls, fried meatballs and fried dumplings. Served with lettuce, bean sprouts, carrots and dipping sauce.

11

<p>Shrimp Spring Rolls Shrimp with vermicelli noodles fresh vegetables, mint, bean sprouts & chives wrapped in rice paper</p>
<p>Shrimp & Pork Spring Rolls Shrimp & Poached Pork with vermicelli noodles fresh vegetables, mint, bean sprouts & chives wrapped in rice paper</p>
<p>Chicken Spring Rolls Roasted Chicken with vermicelli noodles fresh vegetables, mint, bean sprouts & chives wrapped in rice paper</p>
<p>Grilled Pork Spring Rolls Grilled Pork with vermicelli noodles fresh vegetables, mint, bean sprouts & chives wrapped in rice paper</p>
<p>Pork Patty (Nem Nuong) Spring Rolls</p>

12

Appetizers

Crab & Shrimp Spring Rolls



Pork and Shrimp Spring Roll (Goi...
By: Emeril Lagasse

13



14

Shrimp and Cotija Cheese Stuffed Hatch Chiles

Author: Chef Dean Liesenfelt, Central Market Cooking School Manager
08/17/2011

Healthy yet robust in flavor, this might become your favorite Hatch recipe!

15

¹⁰ Online menu for Mexicali restaurant in Los Angeles, CA (*Id.*, TSDR p. 39).

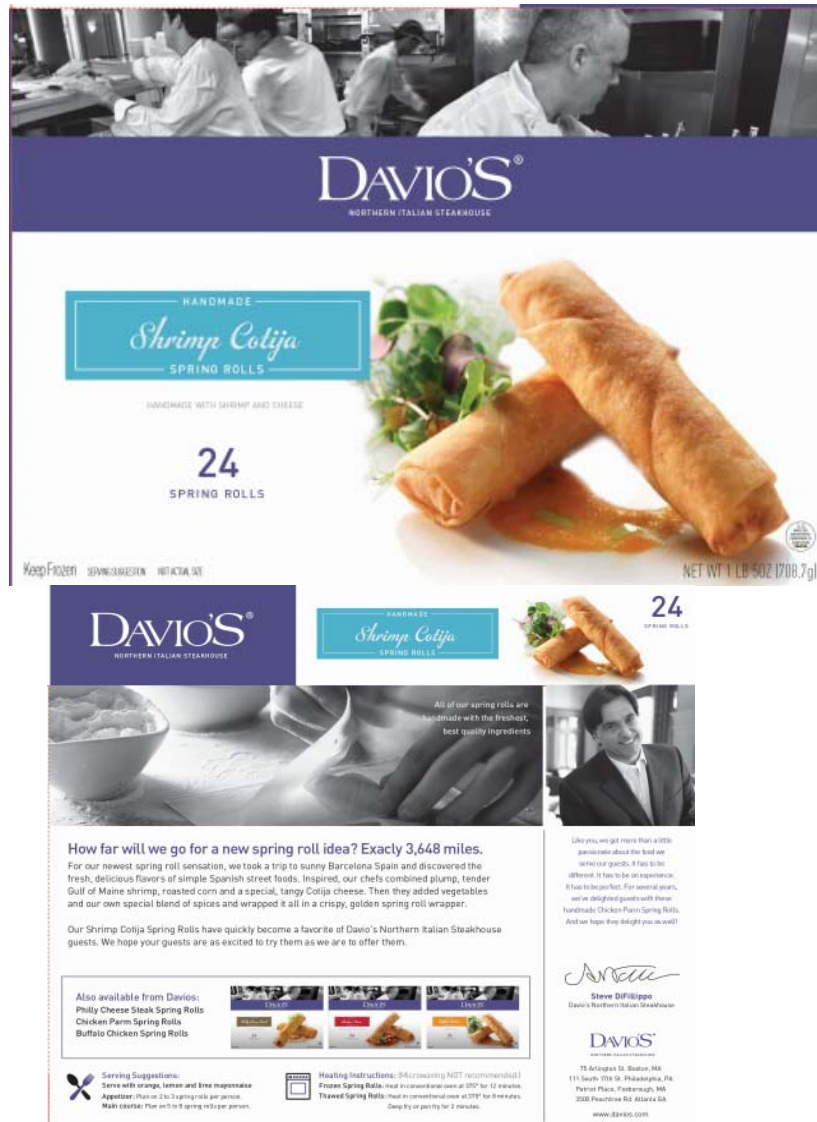
¹¹ Online menu for Pho Basil in Houston, Texas (*Id.*, TSDR p. 43).

¹² Online menu for K sandwiches in San Diego, CA (Office Action March 9, 2014, TSDR p. 15).

¹³ Recipe from Emeril's website (Office Action December 9, 2011, TSDR p. 8).

¹⁴ *Id.*, TSDR p. 9.

The printer's proof of Applicant's packaging shown below describes the contents as "24 spring rolls" and the ingredients as "handmade with shrimp and cheese" and as "Handmade Shrimp Cotija Spring Rolls." It further describes the goods as containing "tender Gulf of Maine shrimp, roasted corn and a special tangy Cotija cheese ... all in a crispy golden spring roll wrapper."



¹⁵ Recipe from Central Market online (Denial Req. for Recon., February 5, 2013, TSDR p. 53).

Based on this record, the Examining Attorney clearly established that SHRIMP COTIJA SPRING ROLLS is generic for the identified goods, or, more precisely, under the language of Section 23, is not “capable of distinguishing the applicant’s goods or services.” 15 U.S.C. § 1091(c).

With regard to Applicant’s registrations for other “spring roll” marks, in addition to recognizing that each case must be decided on its own facts, the Examining Attorney argues as to two of Applicant’s prior registrations that they “evoke something more than just a list of the primary ingredients and are thus distinguishable from the case at hand-both PHILLY CHEESE STEAK and CHICKEN PARM name actual sandwiches, unlike SHRIMP COTIJA, which simply identifies the two main ingredients.” Ex. Att. Br. p. 12.

Applicant interprets this argument as a concession by the USPTO that SHRIMP COJITA SPRING ROLLS is unique because unlike PHILLY CHEESE STEAK and CHICKEN PARM, SHRIMP COTIJA does not name a sandwich. Applicant concludes that this “illustrates the creative and unique nature of the mark which confirms the lack of use of the mark by the competitors, but also the mark is not used in any other context, like how PHILLY CHEESE STEAK names a sandwich.” App. Reply Br. p. 9.

Although consistency is a goal of the USPTO, it is well settled that the decisions of previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us. *In re Nett*

Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Rodale Inc.*, 80 USPQ2d 1696 (TTAB 2006).

Applicant correctly asserts that doubt must be resolved in his favor. *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993). As we recognized above, the facts of this case fall between the facts of *Gould* and *American Fertility* and the evidence reflects this difference containing more than dictionary definitions, but not the exact combination used in the applied-for mark. Based on this record and under the facts of this case, we have no doubt that Applicant's proposed mark SHRIMP COTIJA SPRING ROLLS simply names specific goods included within its genus, namely, spring rolls with shrimp and cotija.

FAILURE TO FUNCTION AS A MARK

The Examining Attorney argues that consumers will not perceive SHRIMP COTIJA SPRING ROLLS as a source indicator but merely as informational matter, informing the customer what the ingredients are in that particular spring roll. She contends that:

[T]he evidence of record indicates that the wording in the proposed mark is commonly used by third parties in the food industry to inform consumers of ingredients and the nature of the food provided through their goods and services. Because consumers are accustomed to seeing these terms used in this manner, when it is applied to applicant's goods, consumers will perceive this wording merely as informational matter indicating the nature of food provided by applicant as well as the ingredients.

Ex. Att. Br. pp. 13-14.

The Examining Attorney highlights the menus and advertising from online food stores (set out above) wherein the various combinations of the words "shrimp and

cotija” and “shrimp spring rolls” are used to inform the consumer of the contents of the dish or product for sale. The Examining Attorney also points to Applicant’s specimen of use contending that the wording in the menu “is used as informational matter to inform consumers of the ingredients of a menu item.”

Echoing its arguments against the genericness refusal, Applicant argues that the USPTO “has provided no evidence of applicant’s mark in use in the industry, let alone common use.” App. Reply Br. p. 1.

In determining whether a designation functions as a mark, the analysis focuses on consumer perception. In making our determination, we may look to the manner in which Applicant uses his mark. *In re T.S. Designs Inc.*, 95 USPQ2d 1669, 1670 (TTAB 2010) (CLOTHING FACTS does not function as a mark for clothing). The generic nature of the wording combined with the manner of use in Applicant’s menu weighs towards a finding that it will not be perceived as a source identifier, but rather as informational matter. The record is replete with examples of menus wherein the generic type of good is listed with its ingredients in similar manner to Applicant’s menu. In view thereof, we find Applicant’s proposed mark is merely informational and, therefore, fails to function as a mark.

Decision: The refusal to register SHRIMP COTIJA SPRING ROLLS on the Supplemental Register based on genericness under Section 23 is affirmed. The refusal to register Applicant’s mark for failure to function as a mark as merely informational under Sections 23 and 45 is affirmed.