

This Opinion is Not a
Precedent of the TTAB

Mailed:
February 27, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re William R. Nyborg

—
Serial No. 85661044

—
Wendy K. Buskop of Buskop Law Group C
for William R. Nyborg.

Tracy Cross, Trademark Examining Attorney, Law Office 109,
Dan Vavonese, Managing Attorney.

—
Before Seeherman, Bucher and Wellington,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

William R. Nyborg, an individual, has appealed from the final refusal of the Trademark Examining Attorney to register FLAT IRON TACO in standard characters on the Principal Register as a trademark for “tacos” in Class 30.¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act,

¹ Application Serial No. 85661044, filed June 25, 2012, based on Section 1(b) of the Trademark Act (intent-to-use).

15 U.S.C. § 1052(e)(1), on the ground that the mark is deceptively misdescriptive of the identified goods.

We affirm the refusal to register.

Procedural and Evidentiary Points

Before proceeding to the substantive issue on appeal, we must clarify some procedural points. Applicant failed to timely file his appeal brief and the Board therefore dismissed the appeal on April 23, 2014. That same day Applicant filed what he styled as a request for reconsideration, in which he asked the Board to reconsider its decision dismissing the appeal. Applicant filed his brief along with the request. Apparently the Examining Attorney misconstrued this paper as a request for reconsideration of the final refusal, because on May 30, 2014, the Examining Attorney denied the request for reconsideration, stating that “applicant’s analysis and arguments are not persuasive nor do they shed new light on the issues,” and she maintained the refusal made final in the August 1, 2013 Office action. To clarify what occurred, we confirm that Applicant did not file a request for reconsideration of the final Office action, and we have treated Applicant’s brief that was filed with the request for reconsideration of the dismissal of the appeal as Applicant’s appeal brief.²

² The Examining Attorney’s treating the April 23, 2014 filing as a typical request for reconsideration apparently misled the Board paralegal who, after the Examining Attorney’s denial of the “request for reconsideration,” allowed Applicant time to file a supplemental brief. No such brief was necessary, since there was no actual request for reconsideration and therefore there would have been no point in Applicant’s filing a supplemental brief directed to the “denial” of the non-existent request for reconsideration. Perhaps recognizing this, Applicant did not file a supplemental brief.

At the end of his brief, immediately before the Conclusion section, Applicant complains that the Examining Attorney refused to offer him “the opportunity to file an amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register,” and asserts that his mark “should at the minimum be reconsidered to be able to proceed under Trademark Section 2(f) or have the opportunity to amend the application to the Supplemental Register.” 5 TTABVUE 8. Applicant is referring to the fact that in the October 11, 2012 Office action the Examining Attorney made the comment that the applied-for mark appears to be generic, and therefore “neither an amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register can be recommended.” This was merely an advisory statement, explaining why the Examining Attorney was not suggesting an alternative method to proceed. However, this statement did not prohibit Applicant from amending his application; the fact that Applicant chose not to seek registration under Section 2(f) or on the Supplemental Register is not a valid basis for allowing Applicant to do so now. Thus, to be clear, we do not consider Applicant’s statement, buried in his brief, as constituting a request for remand. We also point out, as the Examining Attorney has noted, that normally a claim of acquired distinctiveness under Section 2(f) is based on use, and an amendment to the Supplemental Register requires that the mark be used in commerce; Applicant’s application is based not on use in commerce, but only on an asserted intention to use the mark.

We also note that in his brief Applicant makes the statement that “Applicant’s mark is therefore descriptive in the method that the tacos are produced.” 5 TTABVUE 8. Although this would appear to be an admission by Applicant that his mark is not registrable on the ground that it is merely descriptive under the provisions of Section 2(e)(1), we will not remand the application for further examination. The application had been refused registration on the ground of mere descriptiveness in the first Office action, when the Examining Attorney was still trying to determine whether Applicant’s tacos contained flat iron steak. Because this ground of refusal was previously considered and withdrawn, the Board does not have the authority to remand *sua sponte* the application for further consideration of whether registration should be refused on this basis. See Trademark Rule 2.142(f)(1) (“If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue *not previously raised* may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examiner for further examination...” (emphasis added)). Further, in her brief the Examining Attorney addressed Applicant’s comment that his mark is descriptive, and she did not request remand of the application to issue another ground for refusal. Thus, Applicant’s apparent admission that his mark is merely descriptive will receive no further consideration.

With his appeal brief Applicant submitted for the first time four exhibits. Trademark Rule 2.142(d) provides that the record must be complete as of the filing of the appeal, and therefore the exhibits attached to the appeal brief are manifestly

untimely. However, in her brief the Examining Attorney mentions Applicant's references to "flat iron" being used in connection with hair care products. 10 TTABVUE 9-10. Because the Examining Attorney did not specifically object to the exhibits relating to flat iron hair care products, and discussed the references in her brief, we deem her to have stipulated to the inclusion of Applicant's Exhibits A and B into the record. See TBMP § 1203.02(e).

Deceptively Misdescriptive Refusal

Section 2(e)(1) of the Trademark Act prohibits the registration of a mark which, when used on or in connection with the goods of the applicant is ... deceptively misdescriptive of them. In determining whether a mark is deceptively misdescriptive, we consider two prongs: 1) Is the term misdescriptive of the character, quality, function, composition or use of the goods? and 2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods? *In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).³ For a term to misdescribe goods, the term must be merely descriptive of a significant aspect of the goods which the goods could plausibly possess but in fact do not. *In re White Jasmine LLC*, 106 USPQ2d 1385,1392 (TTAB 2013). *See also, Anheuser-Busch Inc. v. Holt*, 92 USPQ2d 1101, 1108 (TTAB 2009) ("In order for a mark to be found deceptively misdescriptive ... it must immediately

³ A third prong set forth in *Budge*, is the misdescription likely to affect the decision to purchase, relates to whether a mark is deceptive under Section 2(a), and therefore is not applicable to the present case.

convey an idea about the goods or services, but that idea, though plausible, must be false”).

We therefore consider whether FLAT IRON TACO describes a significant aspect of tacos. Clearly TACO is a generic term for tacos, the identified goods. As for FLAT IRON, the Examining Attorney has shown that this is a term that describes a particular cut of steak. See entry for “Flatiron” in Wikipedia, stating it may refer to “Flat iron steak, a cut of beef.” Office action mailed August 1, 2013, p. 2. Flat iron steak is described as:

the American name for the cut known as butlers’ steak in the UK and oyster blade steak in Australia and New Zealand. It is cut with the grain, from the shoulder of the animal, producing a cut that tastes good, but is a bit tougher because it’s not cross grain.

Wikipedia, Office action mailed August 1, 2013, p. 3. The Examining Attorney has also submitted evidence to show that flat iron steak is used as a primary ingredient in prepared taco dishes, e.g., recipes for “Flat-Iron Steak Tacos” from MarthaStewart.com (Office action mailed October 11, 2012, pp. 4-11); “Mini Flat Iron Steak Tacos” from Omaha Steaks (*Id.* at 11-12); “Flat Iron Steak Tacos” from Spark Recipes (Office action mailed August 1, 2013, pp. 33-34); and “Flat Iron Steak Tacos” from Ortega (*Id.* at pp. 35-36).

Finally, the Examining Attorney has shown that “flat iron” is used to describe tacos with flat iron steak fillings, and that such tacos are referred to as “flat iron tacos.” See, for example, the following, submitted with the August 1, 2013 Office action:

Flat Iron Tacos [heading, with photograph showing individual ingredients, including slices of steak, and text], “Liv was working late last night so I cooked dinner for myself: grilled flat iron steak tacos. The flat iron cut is FULL of beefy flavor....”
Squirrelsbeer.blogspot.com, pp. 13-18

Menu for My Fit Foods in Kingwood, TX lists as an item “Flat Iron Taco,” described as “Fresh corn tortillas filled with flat iron steak, black beans and pico de gallo.
Foodoozle.com, pp. 19-23, also listed on grubhub.com, pp. 27-32

Menu for “TacoRita Tuesday” at The Pearl Hotel, San Diego, CA, lists “Brandt Beef Flat Iron Taco” as one of the choices
Sandiego.eventful.com, pp. 24-26

Recipe for “Grilled Flat Iron Tacos with Sweet Pickled Onions” from Seasonal & Savory
Seasonalandsavory.com, pp. 40-44

Flat Iron Tacos [heading]
In a taco mood tonight and decided steak tacos were in order. Went to the freezer for a rib eye and spied a package of flat irons, good choice. [photo shows the ingredients before tacos are assembled, including slices of steak]
The Q Joint, theqjoint.com, pp. 47-57

Prime Flat Iron Drum Seared Tacos [heading for recipe; this is also the title used for various comments]
Drum Smoking.Com
DrumSmoking.com, pp. 53-58

In addition, the October 11, 2012 Office action has the following references to “flat iron tacos”:

Biba Cocina
Braised Flat Iron Taco with pickled peppers, onion, queso, sour cream cilantro. 2 for \$4.
Twitter.com, p. 31

Our Family Adventures [heading]
... we had lunch at Raspberry’s. ... I had a flat iron taco salad....
Mkmradventures.blogspot.com, p. 32

Yelp review of restaurant Tinga
...I ordered the Elote Especial, Pechuga taco, and the Flat Iron taco.
Yelp.com, p. 29

We find, based on the foregoing evidence, that when the terms “flat iron” and “taco” are combined in the mark FLAT IRON TACO, the mark immediately conveys information about a characteristic of the goods, namely, that they are tacos with a flat iron steak filling. We recognize that many of the references listed above come from blogs and other personal reviews, but this does not lessen their probative value. On the contrary, they show that the public, *i.e.*, ordinary consumers of the goods, refer to tacos with flat iron steak as “flat iron tacos.” Thus, FLAT IRON TACO is merely descriptive of a significant aspect of the goods which the goods could plausibly possess.

Applicant has acknowledged that his tacos are not made with flat iron steak (“Applicant is not currently planning on including flat-iron steak as an ingredient in Applicant’s taco offerings”; “Applicant submitted pictorial evidence showing the method of creating a ‘FLAT IRON TACO,’ pointing out the lack of flat-iron steak as an ingredient.”) Brief, 5 TTABVue 6. Because FLAT IRON TACO plausibly describes a characteristic (indeed a type of taco) that the goods do not possess, the mark misdescribes the goods, and the mark is deceptively misdescriptive under Section 2(e)(1).

Applicant has argued that FLAT IRON TACO is not misdescriptive because “flat iron” can be used to describe items other than steak. Applicant points to Exhibit A to his brief, showing that “flat iron” is used as a generic term for a hair

straightener, and Exhibit B, Registration No. 4317794 for FLAT IRON PERFECTOR for spray for hair styling. Applicant contends that the registration shows that the Examining Attorney considering that mark concluded that the mark does not misdescribe the goods or that consumers are likely to believe the misrepresentation, or both. We are not persuaded by this argument. Whether or not “flat iron” for a hair straightener or hair styling spray is or is not merely descriptive or deceptively misdescriptive is irrelevant to the issue before us, since this question must be decided 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 the 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. *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).⁴

Applicant also asserts that the Office has failed to show that consumers are likely to believe the misrepresentation because, “if a consumer were to order a shredded chicken variant of Applicant’s ‘FLAT IRON TACO’ it would be hard to believe that the consumer in question would expect ‘flat-iron steak’ to be contained therein.” Brief, 5 TTABVUE 7. However, Applicant again misapplies the test. Clearly if a customer orders a chicken taco he or she will not be expecting to get a steak taco. However, a consumer might well order a FLAT IRON TACO believing

⁴ As an aside, we note that the words FLAT IRON in this registration were disclaimed, thus indicating that the term was considered merely descriptive or possibly deceptively misdescriptive.

that he or she will be getting a taco filled with flat iron steak, and therefore the mark will misrepresent a characteristic of the goods.

Decision: The refusal to register Applicant's mark FLAT IRON TACO is affirmed.