

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

Mailed: January 27, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re WhiteWave Services, Inc.
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Serial No. 86008622
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Betsy D. Proffitt and Larry H. Tronco of Holland & Hart LLP,
for In re WhiteWave Services, Inc.

Rudy R. Singleton, Trademark Examining Attorney, Law Office 102,
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Before Zervas, Taylor and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

WhiteWave Services, Inc. (“Applicant”) seeks registration on the Principal Register of the mark CLASSICMAC (in standard characters) for

Macaroni and cheese, in International Class 30.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(e)(1) of the Trademark Act on the ground that the mark is merely descriptive of Applicant’s goods. When the refusal was made final, Applicant

¹ Application Serial No. 86008622 was filed on July 12, 2013, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

I. Discussion

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *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 for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). The burden is on the United States Patent and Trademark Office to make a prima facie showing that the mark in question is merely descriptive. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1090 (Fed. Cir. 2005) (citing *In re Abcor Development*); *see also In re Merrill Lynch*,

Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

We need to analyze each portion of the composite mark to determine whether such portion is merely descriptive of the goods and then look at the composite mark in its entirety.

We look first at the term MAC. To establish that the term MAC is merely descriptive of an ingredient of Applicant's goods, the Examining Attorney has submitted copies of the following "third party registrations which demonstrate that the term 'mac' is the equivalent of macaroni and is descriptive of pasta foods and is commonly disclaimed because it describes macaroni products." Examining Attorney's Brief, unnumbered p. 8; 6 TTABVUE at 9.

Reg. No. 3091478 - INSTA MAC
Goods: Packaged entrees consisting primarily of pasta
Disclaimer: MAC
Status: Section 8 &15 accepted and acknowledged;

Reg. No. 3584788 - MEGA MAC
Goods: Macaroni and cheese mix
Disclaimer: MAC
Status: Registered;

Reg. No. 3079121 – SWIFT MAC
Goods: Dry macaroni and cheese
Disclaimer: MAC
Status: Section 8 &15 accepted and acknowledged;

Reg. No. 4128393 - SUPERGRAIN MAC & CHEESE
Goods: Packaged meal mixes consisting primarily of pasta
or rice
Disclaimer: MAC & CHEESE
Status: Registered;

Reg. No. 4332851 – JOE’S MAC & CHEESE
Goods: Macaroni and cheese
Disclaimer: MAC & CHEESE
Status: Registered; and



Reg. No. 4070157 -
Goods: Prepackaged macaroni and cheese meals
Disclaimer: THE SOUTHERN MAC & CHEESE TRUCK
Status: Registered;

Exhibits to Office Action dated October 11, 2013. These registrations support the Examining Attorney’s contention that the word “MAC” is considered descriptive by the USPTO when used in connection with pasta products. Third-party registrations can be used to demonstrate that a term may have a commonly accepted meaning. “Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.” *Institut National Des Appellations D’Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). *See also In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) (“Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry.”); Trademark Manual of Examining Procedure (TMEP) §§ 1213 and 1213.03(a) (January 2015) (disclaimers are required of unregistrable components, e.g., a merely descriptive term). Moreover, Applicant does not deny that MAC means macaroni.

Looking next at the term CLASSIC, the Examining Attorney defined CLASSIC as “of a well-known type; typical.”² In support of this position, she has submitted a number of recipes for dishes either called “Classic Macaroni and Cheese” or whose names include the term “Classic” and the terms “Macaroni and Cheese.” Examples of which are:

Classic Macaroni and Cheese

Author’s comment - “This is the classic baked Mac and Cheese of my childhood.”

Ingredients: Macaroni, cheddar cheese, butter, salt and pepper, evaporated milk;

Source: www.allrecipes.com;

Classic Macaroni and Cheese

Author’s comment: “Mac and cheese comes in endless variations. That might seem like an exaggeration, but consider the possibilities, from the shape of the pasta to the combination of cheeses. The addition of meats and vegetables adds even more variations while also making it a one-pot meal. There are so many possibilities, but the most popular way to make mac and cheese simply brings together elbow macaroni, béchamel, and cheddar. That’s an Italian noodle, a French sauce, and an English cheese. This unique combination of foods somehow results in a delicious dish, one that has become an enduringly popular and familiar comfort food. The recipe below will tell you how to make a classic mac and cheese.”

Ingredients: Elbow macaroni, butter, flour, warm milk, salt and other seasonings, cheddar cheese, topping of your choice;

Source: <http://ezinearticles.com/?Classic-Macaroni-and-Cheese&id=7548525>;

Classic Macaroni and Cheese

Author’s comment: “This dish is a classic twice over – a classic recipe for a classic comfort food – good old-fashioned mac ‘n cheese!”

² Exhibit to Office Action dated October 11, 2013
<http://education.yahoo.com/reference/dictionary/entry/classic>).

Ingredients: Elbow macaroni, white onion, butter, flour, milk, salt, white pepper, hot pepper sauce, mustard, cheddar cheese, bread crumbs;
Source: www.cooksrecipes.com; and

Classic Creamy Macaroni and Cheese
Ingredients: Macaroni, sour cream, cheddar cheese, cottage cheese, salt, corn flakes, melted butter;
Source: Recipe.com.

Exhibit to Office Action dated March 2, 2014. Of note, is that while all of the recipes include “macaroni,” “cheddar cheese,” and “butter,” the other ingredients vary. Some include “evaporated milk,” while others include “milk,” “cream,” or “sour cream.” Some include “flour,” others do not. Other ingredients that are used in some of the recipes are: “seasonings and toppings,” “white onion,” “hot pepper sauce,” “mustard,” “cottage cheese” “bread crumbs,” and “corn flakes.” Thus, the evidence reflects no specific well-known type or typical recipe for macaroni and cheese.

To support its position that the term CLASSIC is not descriptive of macaroni and cheese, Applicant has submitted nineteen third-party registrations for marks consisting of or containing that the word CLASSIC (with no disclaimer of CLASSIC) to establish that the USPTO does not treat CLASSIC as a descriptive term when used in connection with food. In each of these registrations, the term CLASSIC is the distinctive portion of the mark. The other term(s) in the marks were disclaimed. As such, inclusion of the term CLASSIC in the marks was the reason the marks were not considered merely descriptive. See, for example:

Reg. No. 1568658 – CLASSIC CHEESECAKE
Goods: Cheesecakes
Disclaimer: CHEESECAKE
Status: Renewed – January 24, 2000;

Reg. No. 1768182 – CLASSIC HOAGIES
Goods: Sandwiches
Disclaimer: HOAGIES
Status: Renewed - November 17, 2012;

Reg. No. 2387597 – CLASSIC BREAD
Goods: Bakery goods and breads
Disclaimer: BREAD
Status: Renewed - September 22, 2010;

Reg. No. 2649146 – CLASSIC CANDIES
Goods: Candy
Disclaimer: CANDIES
Status: Renewed – November 29, 2012; and

Reg. No. 3169050 – CLASSIC TACO
Goods: Tacos
Disclaimer: TACO
Status: Registered.

While these registrations have probative value in determining how the USPTO has treated the term vis-à-vis the listed food items, they do not prove that the term is not descriptive in this case since each case must be decided on its own facts. Neither the USPTO – specifically, the Examining Attorney who examined the application here at issue – nor the Board, is bound by the decision of the Examining Attorneys who examined the prior applications. *See In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007); and *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

More significant is the meaning of term CLASSIC (of a well-known type; typical) combined with MAC. To this end, we note that while the evidence reflects that “macaroni and cheese” is frequently referred to as “mac and cheese,” there is no evidence, that “mac” alone means “macaroni and cheese.” Therefore, to conclude

that CLASSICMAC means either a well-known type or a typical macaroni and cheese dish, a consumer would need to engage in a multistage reasoning process whereby the consumer realizes that the MAC portion of the mark refers to macaroni *and* cheese, not just macaroni, and that [CLASSIC or “the CLASSIC portion of” with a deletion of “in”] in the mark means that the macaroni and cheese is the typical version of the dish, which is also a well-known type, which is likely not possible to prove, since, as discussed above, the evidence reflects no specific well-known or typical recipe for macaroni and cheese. If, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates, the mark is suggestive. *See, e.g., In re Abcor Development Corp*, 200 USPQ at 218 and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). In this case, because a multistage reasoning process must be applied to determine the attributes are indicated by the mark, the mark is suggestive. As such, the Examining Attorney has not met his burden of establishing that the mark is merely descriptive of macaroni and cheese.

Decision: The refusal to register Applicant’s mark CLASSICMAC is reversed.