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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lawrence Foods, Inc.

Serial No. 86937640

Alain Villeneuve of Vedder Price P.C.,
for Lawrence Foods, Inc.

Ty Murray, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Before Bergsman, Hightower, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Applicant Lawrence Foods, Inc. seeks registration on the Supplemental Register of the mark CHOCOLATE GLAÇAGE in standard characters for “icing and glaze for cakes, pies, donuts, and bakery goods,” in International Class 30.¹

The Trademark Examining Attorney refused registration on the ground that CHOCOLATE GLAÇAGE is generic and thus incapable of distinguishing Applicant’s

¹ Application Serial No. 86937640, filed March 11, 2016 based on claims of first use of the mark anywhere and in commerce as of April 2014 pursuant to Trademark Act Section 1(a), 15 U.S.C. § 1051(a).

goods as required by Trademark Act Section 23(c), 15 U.S.C. § 1091(c). In addition, Applicant failed to submit an English translation of the foreign word in the mark, GLAÇAGE, required by the Examining Attorney under Trademark Rule 2.32(a)(9), 37 C.F.R. § 2.32(a)(9).

After the refusal was made final, Applicant appealed. Both Applicant and the Examining Attorney filed briefs, and Applicant filed a reply brief.²

We affirm the refusal to register and the translation requirement.

“In order to qualify for registration on the Supplemental Register, a proposed mark ‘must be capable of distinguishing the applicant’s goods or services.’ 15 U.S.C. § 1091(c)). Generic terms do not so qualify.” *In re Emergency Alert Sols. Grp., LLC*, 122 USPQ2d 1088, 1089 (TTAB 2017). When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by clear and convincing evidence. *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016). 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 genus of goods in question. *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1196-97 (TTAB 1998) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

We note at the outset that, as both Applicant and the Examining Attorney discuss in their briefs, Applicant previously applied to register the same wording (with

² We grant the Examining Attorney’s objection and give no consideration to the evidence attached to Applicant’s appeal brief. Only evidence filed during examination is timely, Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), and it should not be resubmitted on appeal.

GLAÇAGE disclaimed) for nearly identical goods on the Principal Register.³ On March 3, 2016, the Board affirmed the refusal to register on the ground that CHOCOLATE GLAÇAGE is merely descriptive of the identified goods under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), but did not reach the issue of genericness. This application for registration on the Supplemental Register followed.

Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) 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? *Marvin Ginn*, 228 USPQ at 530. The relevant public's perception is the chief consideration in determining whether a term is generic. *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1833 (Fed. Cir. 2015). Evidence of the public's understanding of a term may be obtained from "any competent source, such as consumer surveys, dictionaries, newspapers and other publications." *Id.* at 1830 (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)).

With respect to the first part of the *Marvin Ginn* inquiry, we agree with Applicant that the genus is defined by the goods identified in the application: "icing and glaze for cakes, pies, donuts, and bakery goods." *See In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *Magic Wand Inc. v. RDB Inc.*, 940

³ *See, e.g.*, Appeal Brief at 1-2, 4 TTABVUE 6-7; Examiner's brief at 2, 6 TTABVUE 3. The goods in application Serial No. 86256664 were identified as "icing and glazes for cakes, pies, donuts, and bakery goods."

F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration).

The second part of the *Marvin Ginn* test is whether the term sought to be registered is understood by the relevant public primarily to refer to that genus of goods or services. The relevant public is the purchasing or consuming public for the identified goods. *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013). In this case, the purchasing or consuming public for “icing and glaze for cakes, pies, donuts, and bakery goods” would include bakers, both amateur and professional, and those who purchase cakes, pies, donuts, and bakery goods with icing and glaze. We carefully consider all of the record evidence concerning the relevant public’s understanding of the term CHOCOLATE GLAÇAGE.

The Examining Attorney introduced dictionary definitions of the noun “chocolate,” the first of which is “a food that is made from cacao beans and that is eaten as candy or used as a flavoring ingredient in other sweet foods.”⁴

We take judicial notice of the following definition of “glaçage” from the DICTIONARY OF FOOD: INTERNATIONAL FOOD AND COOKING TERMS FROM A TO Z: “glaçage (France): Icing or glazing with an egg wash.”⁵

⁴ April 1, 2016 Office Action at 4-5 (from merriam-webster.com/dictionary/chocolate).

⁵ CHARLES SINCLAIR, DICTIONARY OF FOOD: INTERNATIONAL FOOD AND COOKING TERMS FROM A TO Z (2d ed. 2005). From search.credoreference.com/content/entry/acbdictfood/gla%C3%A7age/0 (last visited July 19, 2017). The mark (,) under the letter “c” in “glaçage” is a cedilla and pronounced as the letter “s.” Dictionary.com Unbridged (based on the Random House Dictionary (2017)). From dictionary.com/browse/cedilla?s=t (last visited July 19, 2017). The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format or have regular fixed editions. *E.g.*, *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 n.10 (TTAB 2015).

The Examining Attorney submitted examples of use in recipes and on menus of the disputed phrase “chocolate glacage” to designate chocolate icing or glaze for the identified goods, primarily cakes. These include:

1. A recipe for “Steamed Chocolate Cake With Chocolate Glacage” on the Eileen’s Cookery blog.⁶
2. A video tutorial titled “How to Make Chocolate Glacage Glaze Frosting” posted on the Radiant Chocolate website.⁷
3. A recipe, along with what appears to be the same video listed immediately *supra*, for chocolate glacage for use on cake or entremets posted on the website How to Cook That.⁸ The same recipe and video also appear on the Noodle.com website under the title “how to make chocolate glacage glaze frosting for dessert.”⁹
4. A recipe for “Chocolate Glacage.”¹⁰
5. Another recipe for “Chocolate Glacage” on a blog stating: “This is a glaze that is a little bit thicker consistency then [sic] ganache that you enrobe with, but not quite as thick as fondant. It should be of a spreading consistency and should give a nice flat gloss to a dessert.”¹¹
6. Recipes and a discussion on the Cake Central forum titled “Chocolate Glacage,” starting with a post from “baldmansbakery” asking: “Does anyone have a good recipe for chocolate glacage? I attempted to make one and it didn’t seem to turn out so I used a mirror chocolate glaze instead. The glaze just doesn’t seem to have the same shine or smooth finish as a glacage.”¹²

⁶ April 1, 2016 Office Action at 30-33 (from eileenscookery.blogspot.com/2012/09/steamed-chocolate-cake-with-chocolate.html).

⁷ *Id.* at 13-17 (from radiantchocolate.com/tag/how-to-make-chocolate-glacage-frosting/).

⁸ *Id.* at 21-26 (from howtocookthat.net/public_html/chocolate-glacage-glassage-chocolate-mirror-glaze/). We take judicial notice that “entremets” is a noun defined as “dishes served in addition to the main course of a meal; *especially* DESSERT.” From the Merriam-Webster online dictionary, merriam-webster.com/dictionary/entremets (last visited July 19, 2017).

⁹ *Id.* at 27-29 (from noodle.com/learn/details/89971/how-to-make-chocolate-glacage-glaze-frosting-for-dessert-ann-reardon-how-to-cook-that-ep009).

¹⁰ *Id.* at 36-37 (from sarahspuredecadencefolio.weebly.com/chocolate-glacage.html).

¹¹ *Id.* at 40-42 (from winterculinaryschool.blogspot.com/2011/06/chocolate-glacage.html).

¹² September 15, 2016 Final Office Action at 19-23 (from cakecentral.com/index.php/forum/t/737097/chocolate-glacage).

7. A recipe for “2012 Halloween - Oreo Bat Cave Cake with Chocolate Glacage.”¹³
8. A posting on the FAMECo website under the heading “Glaze & Glacage,” stating in part: “And for all your choux but also plated **desserts, toppings** and **ice cream**, our **WHITE & DARK CHOCOLATE GLACAGE** will do the fine!” [sic].¹⁴
9. Cakes listed on the website for Heregthy patisserie including “Paris Cake” and “Majorca” and “London” cakes, each finished with “chocolate glacage.”¹⁵
10. A menu posted on Zomato.com from Satura Cakes in Palo Alto for a “Classic Chocolate” cake described as “milk and dark chocolate mousse layered between a soft flour sponge, coated with a chocolate glacage and toasted diced almonds.”¹⁶

In addition, Applicant submitted a printout of the first page of results of a search for “chocolate glacage” on Google; the results appear to consist of recipes and instructions for making chocolate glacage for cakes and entremets.¹⁷ After the results, the printout lists “Searches related to ‘chocolate glacage,’” including “chocolate glacage how to make” and “chocolate glacage recipe (mirror glaze).”¹⁸

¹³ *Id.* at 102-13 (from rockdavinci.blogspot.com/2012/11/2012-hallowwen-oreo-bat-cave-cake-with.html).

¹⁴ April 1, 2016 Office Action at 18-20 (from fameco.co/glacage/glaze-glacage/).

¹⁵ *Id.* at 38-39 (from heregthy.com/pastry.php).

¹⁶ *Id.* at 43-45, 49-51 (from zomato.com/palo-alto-ca/satura-cakes-palo-alto/menu#tabtop).

¹⁷ August 8, 2016 Response to Office Action at 135 (from google.com). Generally, the submission of printouts from a list retrieved by a Google search is not particularly persuasive because it does not include printouts of the pages from the listed websites, and it is often difficult to understand the context in which the retrieved phrase is used. *See, e.g., In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007). In this instance, however, we find that the printout of the Google search results submitted by Applicant is sufficient to determine the nature of the use of the phrase “chocolate glacage” in the context of the corresponding websites. Moreover, we note that printouts from websites associated with some of the search results were made of record by the Examining Attorney.

¹⁸ *Id.* at 136.

The record shows that the compound term CHOCOLATE GLAÇAGE is understood by the relevant public – that is, bakers and buyers of cakes, pies, donuts, and bakery goods with icing and glaze – primarily to refer to the genus of Applicant’s goods. The genericness of the phrase, considered as a whole, is established by the clear and convincing evidence discussed *supra*. See, e.g., *In re American Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999) (addressing assessment of meaning of disputed phrase as a whole); see also *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1464 (TTAB 2015) (“An inquiry into the public’s understanding of a mark requires consideration of the mark as a whole.”); *In re Recorded Books Inc.*, 42 USPQ2d 1275, 1280 (TTAB 1997) (finding “the combination of the two words ‘recorded’ and ‘books’ results in a designation that has a plain and readily understood meaning when used in connection with the type of category of product sold by applicant, namely, prerecorded audio tape cassettes featuring books”).

Applicant advances several arguments against the refusal to register. These include Applicant’s contention that the evidence cited by the Examining Attorney “is minor and very obscure,” while Applicant “looked at relevant websites and offered rebuttal evidence showing that no important website uses the words” CHOCOLATE GLAÇAGE. Reply Brief at 5, 7 TTABVUE 10. The websites Applicant searched include BettyCrocker.com, Walmart.com, and Amazon.com, among others. Appeal Brief at 7-10, 4 TTABVUE 12-15. Applicant also relies on its search for “chocolate glacage” on Google.com that returned 7,840 results, which “is actually evidence of low use” and fewer hits than searches for other two-word phrases beginning with

“chocolate.” Reply Brief at 5-7, 7 TTABVue 10-12. Applicant further argues that the Examining Attorney “must prove that the expression [chocolate glaçage] is widely used,” while Applicant “offers evidence that the term is in very limited use and that very few websites use the term.” *Id.* at 8, 7 TTABVue 13.

Whether a term is widely used or appears on certain websites, however, is not the test for genericness. Even if an applicant is the first and only user of a generic designation, registration is not justified if the only significance conveyed by the term is that of the category of goods. *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010). Rather, as our primary reviewing court has emphasized: “The test is not only whether the relevant public would itself *use* the term to describe the genus, but also whether the relevant public would *understand* the term to be generic.” *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009)).

The correct inquiry thus is whether the relevant public would understand, when hearing or reading the term CHOCOLATE GLAÇAGE, that it refers to “icing and glaze for cakes, pies, donuts, and bakery goods.” The record demonstrates such an understanding among bakers and buyers of cakes and other bakery goods with icing and glaze. *Cf. Northland*, 227 USPQ at 963-64 (affirming refusal to register generic name BUNDT and discussing recipes referring to “bundt” cake); *Krey Packing Co. v. Williams Food Prods., Inc.*, 163 USPQ 495 (TTAB 1969) (considering cookbook evidence in cancelling registration of SLOPPY JOE as generic for barbecue sauce).

Crucially, our analysis is unchanged by the availability of more common terms for the genus of Applicant’s goods because goods may have more than one generic name.

In re Nat'l Shooting Sports Found., Inc., 219 USPQ 1018, 1020 (TTAB 1983) (citing *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970) (Rich, J., concurring)). As Judge Rich wrote in *Sun Oil*: “All of the generic names for a product belong in the public domain.” *Id.*; see also *In re Trek 2000 Int'l Ltd.*, 97 USPQ2d 1106, 1109 (TTAB 2010) (“It is well established that the availability of other words for competitors to use does not, by itself, transform a generic term into capable matter.”).

Finally, after agreeing with the Examining Attorney that the doctrine of foreign equivalents does not apply in this case, Applicant argues that “glacage” does not mean “icing” in French. See, e.g., Appeal Brief at 3, 11-14, 4 TTABVue 8, 16-19. The evidence demonstrates, however, that the relevant public understands the phrase CHOCOLATE GLACAGE to refer to icing and glaze for cakes and bakery goods without translation.

We have considered all the arguments and evidence of record as a whole, including any not specifically discussed. While we must resolve doubt on the issue of genericness in Applicant’s favor, *In re Tennis Industry Ass’n*, 102 USPQ2d 1671, 1674 (TTAB 2012), we have no doubt that the applied-for matter is generic for the identified goods.

Turning to the required translation statement of “glacage,” Applicant argues:

The term has many meanings as shown above by the own translation of the Office. In one context, it is used as “façade” in a description of a movie. The Office no longer makes the argument that via the doctrine of foreign equivalence, the word is in fact perceived as “icing” but instead says that the word “glacage” is generic in English while of foreign origin. . . . In fact, if a term is generic, there can be no issue with a translation; everyone should know

what the word means. *Dictionary definitions have been given and in the context of bakery product, the terms do have a first (of numerous) meaning as icing and glazes.*

Reply Brief at 10-11, 7 TTABVUE 15-16 (emphasis added). Consistent with the final sentence immediately *supra*, Applicant's previously abandoned application to register CHOCOLATE GLAÇAGE included the following translation statement:

The English translation of "GLAÇAGE" in the mark is either "icing", "glazing" or "frosting".¹⁹

Applicant's position in this appeal confuses the doctrine of foreign equivalents with the requirement for a translation, and incorrectly assumes that if the doctrine of foreign equivalents does not apply, a translation is unnecessary. To the contrary, one is not dependent on the other. Application of the doctrine of foreign equivalents is a matter of substantive trademark law, while the requirement for translation of the wording in the mark is an administrative requirement for registration under Rule 2.32(a)(9). Applicant's argument also puts the cart before the horse: The translation of foreign wording in the mark usually must be considered before determining whether the relevant public would "stop and translate" it when considering the mark.

The meaning of words is of critical importance in a trademark application. A translation made part of the application provides public notice of the meaning of the words in applied-for matter, allowing third parties to assess the scope of an applicant's or registrant's rights. Accordingly, the requirement for submission of a translation of GLAÇAGE for the record was appropriate.

¹⁹ Printout of application Serial No. 86256664, attached to September 15, 2016 Final Office Action at 2-3.

Decision: The refusal to register CHOCOLATE GLAÇAGE on the Supplemental Register is affirmed on the ground that it is generic for the goods identified in the application under Section 23(c) of the Act. The requirement for a translation of the foreign wording GLAÇAGE also is affirmed.