

This Opinion is not a
Precedent of the TTAB

Mailed: February 19, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Viromare Design LLC

Serial No. 87705193

Michael F. Snyder of Volpe and Koenig PC for Viromare Design LLC.

Aubrey Biache, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

Before Cataldo, Wellington and Lynch, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Viromare Design LLC, filed an application pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), seeking registration on the Principal Register of the mark POP PASTA THE ORIGINAL PASTA DONUT (in standard characters) in connection with “pasta, non-pastry, non-fried prepared pasta pressed in the shape of a donut and baked, hand-held non-pastry, non-fried prepared pasta product made by shaping and baking pasta” in International Class 30.¹

¹ Application Serial No. 87705193, filed on December 1, 2017. Applicant claims ownership of Reg. No. 1454570. In response to the Examining Attorney’s requirement discussed *infra*, Applicant submitted a disclaimer indicating no claim of the exclusive right to use “PASTA”

The Trademark Examining Attorney refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based upon Applicant's failure to comply with the requirement to disclaim "PASTA THE ORIGINAL PASTA DONUT" apart from the mark as shown. The Examining Attorney contends that this wording merely describes a characteristic of the identified goods. Trademark Act Section 2(e)(1); 15 U.S.C. § 1052(e)(1).

After the Examining Attorney made the refusal final, Applicant appealed. We affirm the refusal to register.

I. Materials Attached to Applicant's Brief

Applicant submitted numerous pages of evidence with its appeal brief.² To the extent this evidence is duplicative of evidence previously submitted during prosecution of its involved application, we need not and do not give this redundant evidence any consideration.³ Any of the evidence submitted with Applicant's appeal brief that was not previously submitted during prosecution is untimely and will not

or "THE ORIGINAL" except in the mark as shown (June 12, 2019 Request for Reconsideration at 2-3).

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal are to the Board's TTABVUE docket system.

² 21 TTABVUE 14-82.

³ We note that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a neither a courtesy nor a convenience to the Board. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether such attachments are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations were directly to the prosecution history. Applicant is advised to refrain from such practice in the future.

be considered.⁴ *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.02(e) and § 1207.01 and authorities cited therein.

We turn now to the merits of this appeal.

II. Disclaimer of “PASTA THE ORIGINAL PASTA DONUT”

A requirement under Trademark Act Section 6, 15 U.S.C. § 1056(a), for a disclaimer of unregistrable matter in a mark is appropriate when that matter is merely descriptive of the goods or services at issue. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). A disclaimer is a statement that the applicant does not claim the exclusive right to use a specified element or elements of the mark in a trademark application or registration. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013). “The effect of a disclaimer is to disavow any exclusive right to the use of a specified word, phrase, or design outside of its use within a composite mark.” *Id.* (quoting *In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662, 665 (CCPA 1979)). Merely descriptive or generic terms are unregistrable under Trademark Act Section 2(e)(1), and therefore are subject to a disclaimer requirement if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In re La. Fish Fry Prods., Ltd.*,

⁴ The proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also* TBMP § 1207.02 and authorities cited therein.

797 F.3d 1332, 116 USPQ2d 1262, 1266 (Fed. Cir. 2015); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of an ingredient, quality, characteristic, function, feature, purpose, or use of the goods or services with which it is used. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the possible significance that the mark is likely to have to the average purchaser encountering the goods or services in the marketplace. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1818, 1831 (Fed. Cir. 2007); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1473 (TTAB 2014); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods or services are will understand the mark to convey information about them. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1512 (TTAB 2016).

It is the Examining Attorney's burden to prove that a term is merely descriptive of an applicant's goods or services. *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2052 (TTAB 2012). The determination that a term is merely descriptive is a finding of fact and must be based upon substantial evidence. *Bayer Aktiengesellschaft*, 82 USPQ2d at 1831.

1. Whether “PASTA THE ORIGINAL PASTA DONUT” Is Descriptive

In its brief, Applicant frames the issue on appeal as follows: “The sole issue on Appeal is whether the term ‘DONUT’ is merely descriptive of Applicant’s Goods so as to require a disclaimer.”⁵ Applicant argues that “the phrase ‘PASTA DONUT’ is suggestive as a whole, and the disclaimer requirement for ‘DONUT’ should be withdrawn.”⁶ Applicant concedes that the previously disclaimed wording “PASTA” and “THE ORIGINAL” merely describes a characteristic or feature of its goods. *See In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014 n.4 (TTAB 1988) (“By its disclaimer of the word LITE, Applicant has conceded that the term is merely descriptive as used in connection with Applicant’s goods.”) (citing *State Oil Ref. Corp. v. Quaker Oil Corp.*, 161 USPQ 547 (TTAB 1969), *aff’d*, 453 F.2d 1296, 172 USPQ 361 (CCPA 1972)).

The Examining Attorney states that the “issue on appeal is whether the wording ‘PASTA DONUT’, when used in connection with the recited goods in International Class 30, is merely descriptive and/or conveys information concerning a characteristic of Applicant’s goods.”⁷ We note that notwithstanding Applicant’s voluntary disclaimer of “THE ORIGINAL” and “PASTA”, the issue before us is whether the term PASTA THE ORIGINAL PASTA DONUT, as a whole, is merely descriptive of Applicant’s goods.

We turn then to the evidence of record.

⁵ 21 TTABVUE 4 (Applicant’s brief).

⁶ 21 TTABVUE 4.

⁷ 23 TTABVUE 5 (Examining Attorney’s brief).

The Examining Attorney submitted with her March 19, 2018 Priority Action the following definition of ORIGINAL – “preceding all others in time, first.”⁸

With her December 12, 2018 final Office Action, the Examining Attorney submitted the following definitions:

PASTA – paste in processed form (such as macaroni) or in the form of fresh dough (such as ravioli); a dish of cooked pasta;⁹ and

DONUT – less common spelling of DOUGHNUT, a small usually ring-shaped piece of sweet fried dough; something (such as a mathematical torus) that has a round shape like a doughnut.¹⁰

The Examining Attorney further submitted screenshots from third-party websites displaying and discussing donut-shaped food products other than doughnuts.¹¹ These include:

⁸ At 4. Definition retrieved on March 19, 2018 from ahdictionary.com, The American Heritage Dictionary of the English Language, 5th Ed. (2018).

⁹ At 7-14. Definitions retrieved on December 12, 2018 from merriam-webster.com, Merriam-Webster Dictionary.

¹⁰ *Id.*

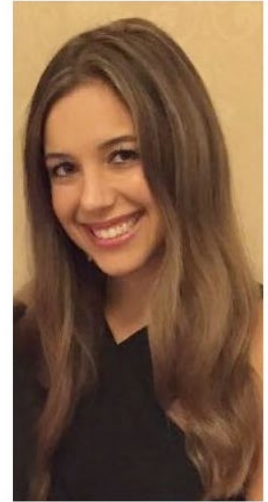
¹¹ All accessed on December 12, 2018.



HEALTHY DONUT-SHAPED APPLE SNACKS

October 11, 2016 by Leah Goldglantz

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Hi! Welcome to Leah's Plate! I am a health enthusiast, wife and mama. My blog focuses on embracing whole foods to nourish our bodies. I create recipes that are quick and easy to make proving that eating healthy doesn't have to be complicated. Find out more [About Me](#) and my personal journey to health. I hope these recipes inspire you to pursue a healthier life! If you have any questions please don't hesitate to email me at Leah@LeahsPlate.com

Search this website ... 

¹² At 33-40. Leahsplate.com.

FOOD NEWS

'Donugs', AKA Donut-Shaped Chicken Nuggets, Are The Newest Must-Try Food Hybrid



Constantine Spyrou

Jun 19, 2018

Fried chicken and donuts are the Romeo and Juliet of finger food, a true match made in foodie heaven. Putting them together in a donut should be illegal because of how indulgent it sounds, but somebody's gone and done it.



13

¹³ At 41-45. Foodbeast.com.

Healthy Eating / Meal Ideas

Instagrams That Prove Sushi Doughnuts Are the Best Thing Ever to Happen to Food

Individually, sushi and doughnuts are two of the best foods ever. Combine them? Mind (and...



By [Lauren Mazzo](#) | Jun 27, 2016

Topics: [sushi](#), [instagram](#)



Beautiful Simplicity



This [recipe](#) for sushi doughnuts is vegan and easy to DIY (even though it looks too beautiful to even attempt). All you need is a doughnut mold greased with coconut oil, cooled sushi rice, and black sesame. Ginger, wasabi, cashew mayo, and avocado serve as delicious decorations.

14

¹⁴ At 46-54. Shape.com.

Cultural Fusion



9 OF 10

ALL PHOTOS

As [this Instagram](#) user points out, sushi doughnuts are the ultimate East-meets-West food fusion. Plus, proof that delicious (and super aesthetic) food is universal. (Even in other galaxies... light saber chopsticks #FTW.)

PHOTO: @MYNAMEISISKA INSTAGRAM

"Frushi" Finish



#Frushi (fruit sushi) is a thing, you guys. So why not make it a "frushi" doughnut? Top with berries and melon, like in [this pic](#), or whatever else your heart (and taste buds) desires.

PHOTO: @SALTNPEPPERHERE INSTAGRAM

LAKEVIEW & WRIGLEYVILLE Food & Drink

Meet the Mars'halo, a Doughnut-Shaped Marshmallow That Fits Your Mug



By Janet Rausa Fuller | October 27, 2016 5:55am

| Updated on October 31, 2016 10:31am

@jrfull



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16

¹⁶ At 55-61. Dnainfo.com.

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Doughnut peaches – the new craze

Doughnut peaches taste too good to be true, says **Zoe Williams**




Zoe Williams
@zoesqwilliams
Tue 14 Jul 2009 19.05 EDT

f t e

17

The Examining Attorney also submitted with her July 10, 2018 denial of Applicant's Request for Reconsideration screenshots from third-party websites displaying and discussing donut-shaped food products other than donuts.¹⁸ These include:

¹⁷ At 62-66. Theguardian.com.

¹⁸ All accessed on July 9, 2019.

The Doughnut-Shaped, Savory Italian Wine Cookie Every Cheeseboard Needs



19

¹⁹ At 20-24. Winepair.com



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PB&J DONUT SANDWICHES

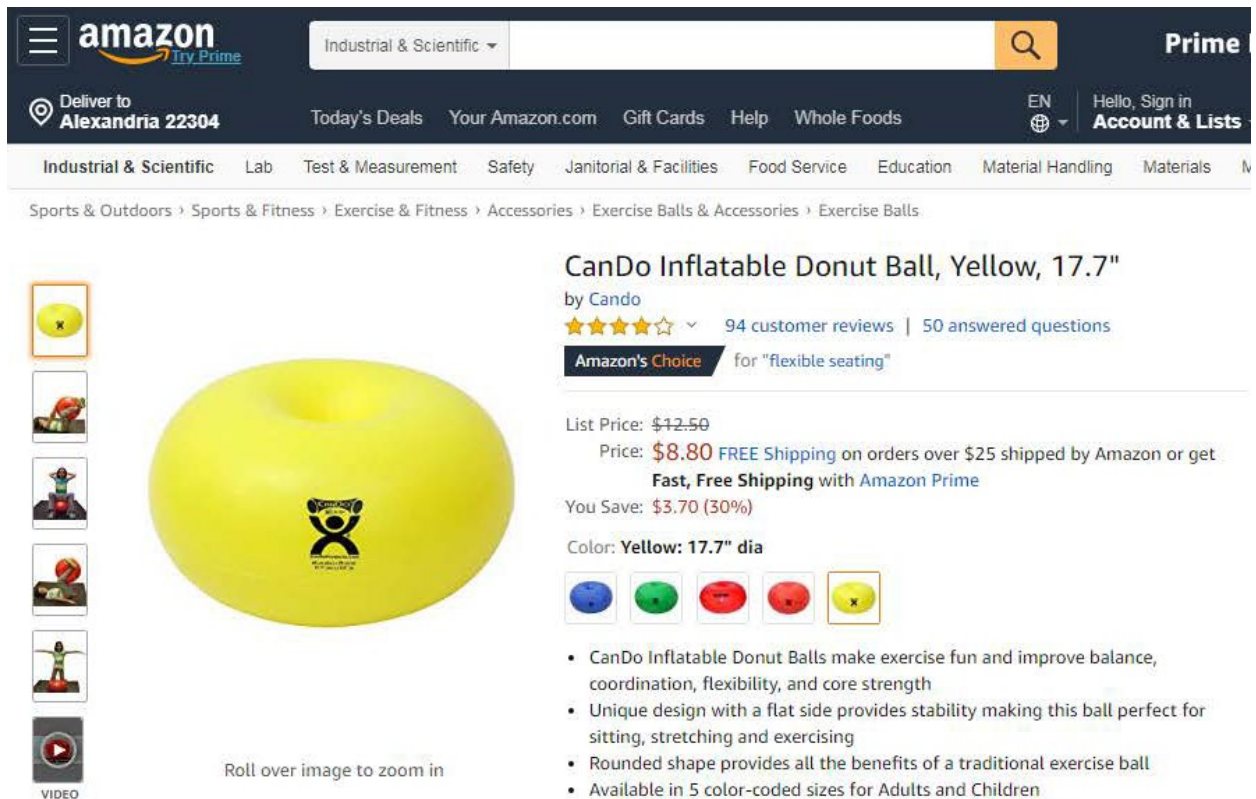
August 20, 2015 / by [Cara](#) / [4 Comments](#)

Do you have a crust-hater in your family? Then this is just the sandwich idea you need! See your kid's lunchbox differently and reconstruct the typical peanut butter and jelly same ol' by cutting your gluten free bread into the shapes of donuts and creating an inside out sandwich. And it's just an easy lunch idea to put together that you don't need outlandish artistic talent to recreate this! Anyone can do this and it doesn't take much time out of your day either. Oh, and the kiddos will love it. PB&J Donut Sandwiches topped with sprinkles? What was that? Did I just hear a win-win situation. Heck yes, I did.

RELATED: [10 Kid Friendly Lunchbox Ideas](#)



The Examining Attorney additionally submitted with her July 10, 2018 denial of Applicant's Request for Reconsideration screenshots from third-party websites displaying and discussing non-edible donut-shaped goods.²¹ These include:



22

²¹ All accessed on July 9, 2019.

²² At 38-44. Amazon.com

chewy

Find the best for your pet...

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Dog

Toys

Fetch Toys

Discs



KONG AirDog Donut Dog Toy

By KONG

★★★★☆ 79 Reviews | 2 Answered Questions

Was: ~~\$6.39~~

Price: **\$5.99** FREE 1-2 DAY SHIPPING OVER \$49

You Save: **\$0.40 (6%)**

In stock

Size: Large

Small

Medium

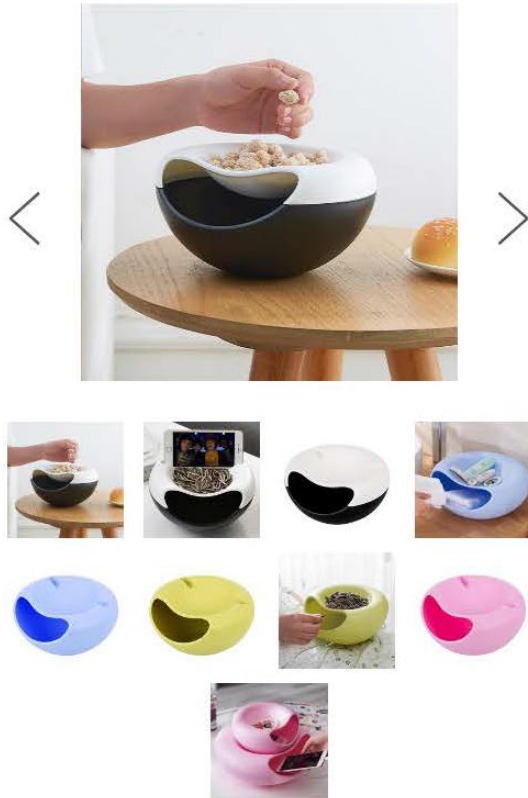
Large

23

²³ At 45-50. Chewy.com

- 16 -

Serial No. 87705193



Donut Storage Bowl

★★★★★ 4 customer reviews

List Price: ~~\$50.00~~

Price: **\$24.97** FREE Shipping

You Save: **\$25.03 (50%)**

Color: **Black**

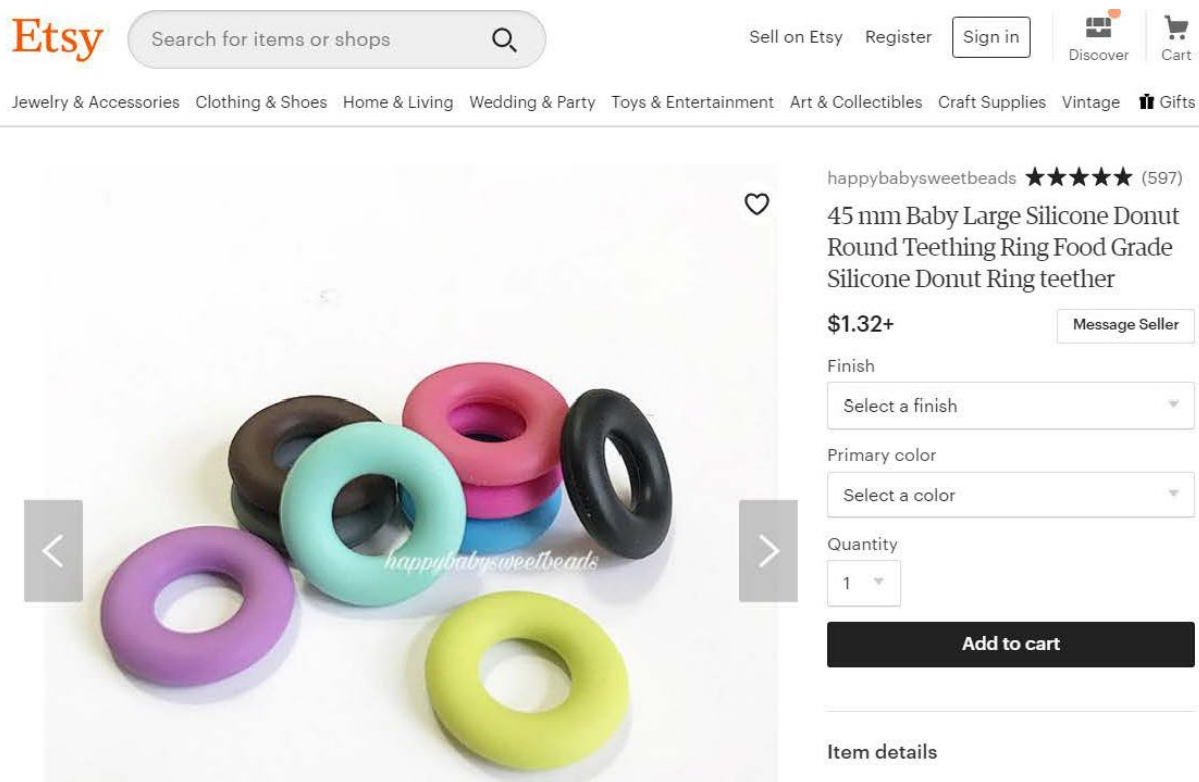
Qty: **1**

 **Add to Cart**

Not sold in stores.

This **Donut-Shaped Storage Bowl** is decorative as well as functional! Fill the inner bowl with peanuts, nuts, pistachios, candies, condiments, coins, jewelry, office supplies, or pretty much anything you want! *Choose from four stylish colors; black, blue, green and pink.*

Mobile phone support: Place your cellphone on the bowl and watch your favorite shows.



25

Finally, with her February 19, 2020 denial of Applicant's Request for Remand and Reconsideration, the Examining Attorney submitted yet more screenshots from third-party websites displaying and discussing non-edible donut-shaped goods.²⁶ These include:

²⁵ At 54-57. Etsy.com

²⁶ All accessed on February 19, 2020.

Shop BHC / Home Medical Equipment / Aids for Daily Living / Household Aids / Nova Foam Comfort Ring Cushion



Nova Foam Comfort Ring Cushion

\$27.95

- 1 +

Add to cart


The Nova Foam Comfort Ring Cushion conforms to the body contours to provide comfort support when sitting for long periods of time. It provides comfort and support when sitting for an extended period of time. The molded foam donut shape helps reduce pressure on the back and tailbone and comfortably conforms to body contours. The center hole is discreetly hidden by the fabric cover making it ideal to take with you wherever you need pressure relief. The cushion has a fleece cover for additional comfort.


It is ideal after childbirth, for hemorrhoid sufferers or for those with lower back pain.

- + High-density foam retains shape through repeated use
- + Reduces pressure on back and tailbone
- + Ring donut shape comfortably conforms to body contours
- + Center hole is hidden by fabric making it discreet enough to take anywhere
- + Fleece cover
- + 250 lbs. weight capacity

27


²⁷ At 31-33. Bellevuehealth.com



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Home > Orthopedics > Donuts




⊕ Hover to zoom

Donuts

In Stock

You need to be a registered customer to order this product. Please [Login to your account](#) or [click here to Register](#).

 EMAIL A FRIEND

DESCRIPTION

A donut pillow is shaped in the form of a donut, with a hole in the middle. This back support pillow has been designed for patients with a problem in their tailbone area.

Fundamentally, the hole in the pillow annihilates the force on the tailbone by absorbing the gravitational pull.

28

In support of its position that “PASTA DONUT” is suggestive, Applicant submitted evidence with its June 12, 2019 Request for Reconsideration consisting of third-party reviews of its goods under the involved mark. These include the following illustrative examples:²⁹

²⁸ At 40-41. Chiro1source.com

²⁹ All accessed on June 11-12, 2019.

Pop Pasta

Fantastic execution of a fun idea. Pop Pasta does pasta donuts right (not that anyone else was doing it wrong).



Mac & Cheese Donut

I must say, I was pretty skeptical about Pop Pasta. Sure, it's a gimmick, but I don't really have a problem with that. A lot of gimmicky things end up working out. But a pasta "donut" didn't seem like one of them, mostly because it didn't seem that anyone who would craft pasta into that shape would care to focus on the taste, instead relying only on the coolness factor. That assumption turned out to be wrong and I'm really happy about that!

The inspiration behind the creation is the Neapolitan "frittata di spaghetti" or spaghetti pie. Spaghetti pie generally consists of pasta leftovers mixed with eggs and cheese. It is then fried and formed into a pie shape and cut into slices. Pop Pasta instead makes these into the shape of a donut, making each a single serving and easy to eat. If you get past the oddness of having pasta in a donut shape, the convenience really can't be beat!

30

³⁰ At 17-18. Theurbanscoop.com



Pop Pasta Stand and Selection

Pop Red Sauce – spaghetti, parmesan, eggs, tomato puree, olive oil, and salt
Pop Carbonara – spaghetti, parmesan, eggs, bacon, black pepper, and salt
Pop Mac & Cheese – spaghetti, parmesan, eggs, cheddar, butter, flour, milk, black pepper, and salt

I really wanted to try to Pop Red Sauce as spaghetti pomodoro is my favorite pasta dish, but they were sold out. Not being a fans of carbonara, we went with the mac & cheese. Mac and cheese is often ruined when people turn it into a tasteless vat of fat. This one was actually really tasty. Though it's undeniably heavy, as all of them would be, it's still not TOO heavy. Plus, the parmesan flavor and the black pepper elevate the mac and cheese beyond many others. The donut is really densely packed, so it does make for a substantial snack. And it is so easy to eat on the go or to take home.

While it's not gourmet top of the line pasta a la Scarpetta(<http://www.theurbanscoop.com/scarpetta/>) or Ai Fiori(<http://aiflorinyc.com/>), it's a fun, unique, and tasty snack. Go to Pop Pasta and get yourself a great pasta donut.

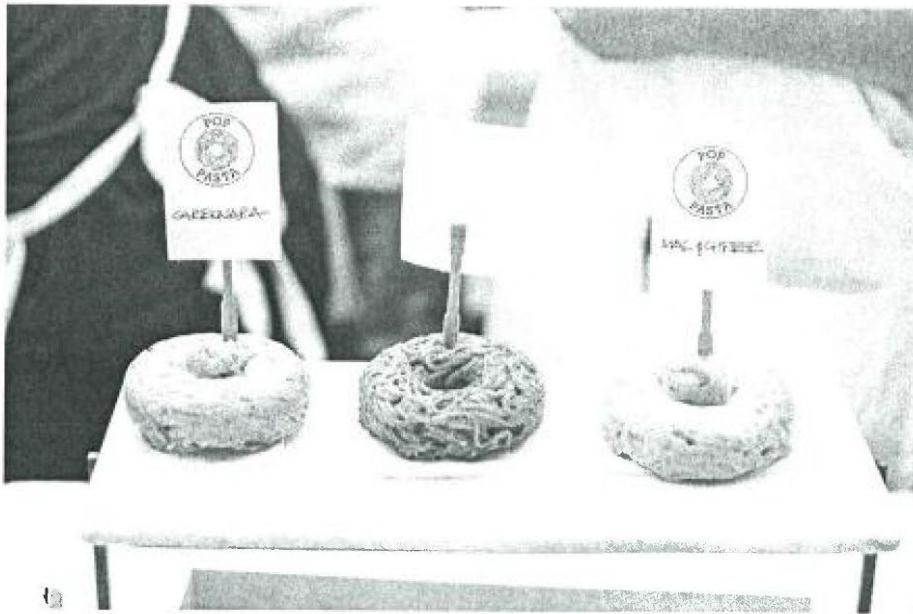
And festival it is: every Saturday all summer, an estimated 20,000 people descend on the Williamsburg waterfront, seeking nourishment and novelty alike. While many come for hearty bites, Smorgasburg's runaway success was built on more outrageous fare: **Pasta Donuts**, Brunch on a Stick, and whatever's in "Raindrop Cake" have turned "good eatin'" into "too good to be true." These wild foods definitely make for a colorful experience, but on a 90 degree Saturday, you (and 20,000 of your closest neighbors) won't have all day to decide which foods vindicate your sunburn.

In short: if you want the colorful experience to stay off your neck, you'll need a guide.

With your best interests in mind, we sent two of our interns (Alex and Brandon) off to see which foods made the cut. Nursing both sunburns and food comas, here's their bite-by-bite guide to Smorgasburg:

PASTA DONUTS

(COST: \$6, FROM POP PASTA)



BRANDON: A spaghetti donut is perhaps the most unique yet daring combination I've ever heard of. Even if this turned out to be the best thing since sliced bread it begs the question, but why? That being said I strategically 32

³² At 20-21. Theplaybook.com

ose the mac & cheese flavor. It was the equivalent of mac & cheese balls
it in doughnut form. I am still perplexed on how this is made and how it
ayed together but if you're looking for the great taste of pasta on the go, look
further.



ALEX: I draw the short straw and am soon staring down the barrel of a Red
Sauce donut. It's 90 degrees out, my "donut" is hotter than air, and after 30
seconds of jeering and Snapchats, I take bite #1. It's, uh... *not for me*. On the
Autobahn, a pass this hard is a showing of disrespect. That being said: props
for novelty. I may not have loved **the pasta donut**, but I both bought it and
'grammed it.

OVERALL: Unique, for better or for worse. Three handheld noodles out of five. ³³

³³ *Id.*

Arrive Hungry

There are many market stalls at Smorgasburg, selling handcrafted products, antiques and everything in between. However, the real heart of this weekly event is the food on offer. Rather than gorge on a large meal from one stall, make sure you eat little and often throughout the day. This way, you'll be able to sample a multitude of flavors from around the world.

For example, order a pasta donut from Pop Pasta for around \$6 as a starter, then an hour or so later (after lots of browsing), try a mini pulled-pork sandwich from Mighty Quinn's BBQ – which should set you back around \$10.

Smorgasburg opens at 11:00 a.m. on Saturdays and Sundays, so what better way to start your day than with a spot of brunch. Head to Brunch-On-A-Stick, and buy a hearty brunch you can carry around in one hand. Try the quail egg brunch stick, which also includes bacon, sausage, pesto and cheese.

34

Smorgasburg!

If you haven't been to Smorgasburg (<https://www.smorgasburg.com>) yet, you are missing out! Smorgasburg is the largest open air food market in America. It takes place in Industry City in Brooklyn every Saturday and Sunday. There are over 100 vendors present, including Destination Dumplings, Dulcinea Churros, Pop Pasta (which sells pasta donuts!), Rutte's Dutch Waffles, and Ube Kitchen (featuring a delicious Ube ice cream over an Acai bowl). Spend a day in Brooklyn filled with unique fusion foods without having to leave the comfort of the indoors (the outdoor Williamsburg market doesn't reopen until the weekend after break).

35

³⁴ At 26-28. Gosur.com

³⁵ At 37-40. Columbiaspectator.com

About Pop Pasta



Pop Pasta is everything street food should be, and more. Let us explain. It's a fusion first and foremost, combining the Napoli spaghetti pie with the classic all American donut. Yup, you read that right. A pop up spaghetti cart serving the all original spaghetti donut, and you're only getting 'em in New York, NY.

At Pop Pasta, you'll find a myriad of mouthwatering pasta donuts to partake in. Luigi Fiorentino, a Naples expat, is responsible for these new hearty Italian specialties, sticking to traditional preparation methods updated for the modern foodie scene. Each spaghetti donut features your favorite pasta molded and shaped into that handheld form, dressed and pressed with fresh flavors and ingredients you won't find just anywhere. From the classic red sauce featuring tomato puree and olive oil to carbonara and the beefiest of bolognese, rest assured there's a palate pleasing Pop Pasta for all to enjoy here. So why wait? Find Pop Pasta in New York, NY, or have 'em out to cater your next event. It's high time you try something new for a change, and Pop Pasta is just the ticket.

36

Considering all the evidence of record, we make the following findings:

“ORIGINAL” describes a thing that is first, preceding all others in time;

“PASTA” describes paste processed in the form of macaroni or dough;

³⁶ At 47-49. Roaminghunger.com

“DONUT” describes both a small piece of sweet fried dough and other things, both edible and non-edible, that are shaped like a fried donut;

“DONUT” describes food items, such as sushi, fruit slices, chicken nuggets, bread, peaches and marshmallows that are shaped like a donut;

“DONUT” also describes non-food items, such as seat cushions, exercise rings, teething rings, dog toys and storage bowls that are donut-shaped;

Applicant’s goods consist of baked pasta pressed in the shape of a donut;

“PASTA DONUT” merely describes pasta prepared and served in the shape of a donut;

Third parties use the term “pasta donut” to describe Applicant’s goods in addition to indicating their source;

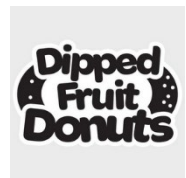
The wording “PASTA THE ORIGINAL PASTA DONUT” merely describes Applicant’s goods, namely, pasta in the form of the first donut-shaped baked pasta.

Applicant argues that because its “Goods are not traditional donuts (e.g., a dough-based pastry product that is fried)”³⁷ the term “PASTA DONUT” is suggestive, rather than descriptive of its goods. We note, in that regard, that Applicant’s current identification of goods specifies its goods are neither fried nor pastry, i.e., not donuts per se. However, Applicant’s argument relies upon the first definition of “DONUT” as a fried, dough-based pastry product to the exclusion of the second definition of something, like Applicant’s goods, that is not a donut, but is shaped like a donut.

³⁷ 21 TTABVUE 4.

Descriptiveness is considered in relation to the relevant goods. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). “That a term may have other meanings in different contexts is not controlling.” *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *5 (TTAB 2019) (citing *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018)). “It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive.” *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)). The term “PASTA DONUT” does not become suggestive merely because Applicant’s goods are not fried donuts. Rather, the term “PASTA DONUT” is merely descriptive because Applicant’s goods are made of pasta and shaped to resemble donuts.

We are not persuaded by Applicant’s argument that because the Trademark Office



allowed third-party application Serial No. 87766830 for the mark (“DIPPED FRUIT” disclaimed) for cut fruit pieces coated with toppings to register,³⁸ withdrawing an earlier requirement for a disclaimer of “DIPPED FRUIT DONUTS,”³⁹ the term “DONUTS” in the involved mark is not merely descriptive. As stated many times, we simply are not bound by the decisions of another examining

³⁸ Applicant asserts in its brief, 21 TTABVUE 4, n.1, that application Serial No. 87766830 subsequently issued as a registration.

³⁹ Applicant’s January 8, 2020 Request for Remand at 8-144.

attorney in a prior case. The Board must make its own findings of fact, and that duty may not be delegated by adopting the conclusions reached by an examining attorney. *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986).

Applicant also argues that “Prior to Applicant’s use of the phrase, there was no such thing as a ‘PASTA DONUT.’ That coined phrase is unique to Applicant, and not merely descriptive.”⁴⁰ However, there is no need to demonstrate that others have used the mark at issue or that they need to use it, although such proof might be highly relevant to an analysis under Section 2(e)(1). *Fat Boys Water Sports*, 118 USPQ2d at 1515. The fact that Applicant may be the first or only user of a term does not render that term distinctive if it otherwise meets the standard set forth in *In re Gyulay* and *In re Chamber of Commerce*. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) (trademark law does not countenance someone obtaining “a complete monopoly on use of a descriptive term simply by grabbing it first”) (citation omitted); see also *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (CCPA 1960) (even novel ways of referring to a product may nonetheless be merely descriptive); *In re Phoseon Tech. Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012). Moreover, and as noted above, third parties use the term “PASTA DONUT” to describe Applicant’s goods, even if Applicant is the first user of the term.

We further find no incongruity in the term “PASTA DONUT.” Based upon the evidence of record, “PASTA DONUT” readily describes pasta prepared and served in

⁴⁰ 21 TTABVUE 5.

the shape of a donut, i.e., Applicant's goods. Such a meaning presents no incongruity. *Cf., e.g., In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978); *In re Shutts*, 217 USPQ 363, 364–5 (TTAB 1983); *In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967); and *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966).

We similarly are not persuaded that “PASTA DONUT” is a double entendre. As discussed above, Applicant's goods are donut-shaped food items made of pasta. We find no evidence that consumers will view “PASTA DONUT” as having several connotations. *Cf. In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976); and *In re Del. Punch Co.*, 186 USPQ 63 (TTAB 1975).

2. Whether Applicant's Mark Is Unitary

We now consider whether Applicant's POP PASTA THE ORIGINAL PASTA DONUT mark creates a unitary whole such that no disclaimer is necessary.

In order to be considered unitary, the elements of a mark must be so integrated or merged together that they cannot be regarded as separable. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983); *In re EBS Data Processing*, 212 USPQ 964, 966 (TTAB 1981). Although Applicant's mark creates some alliteration due to the wording POP PASTA THE ORIGINAL PASTA DONUT, we find that consumers would not view the terms as inseparable from one another or creating an additional meaning beyond that of the component terms. Rather, each component in the mark retains its descriptive significance in relation to the identified goods, and the combination of “PASTA THE

ORIGINAL PASTA DONUT” results in a composite that is itself descriptive. *See Duopross*, 103 USPQ2d at 1757 (SNAP SIMPLY SAFER merely descriptive for “medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes”); *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111–1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to pre-moistened antistatic cloths for cleaning computer and television screens); *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1955 (TTAB 2018) (MECHANICALLY FLOOR-MALTED merely descriptive of malt for brewing and distilling and processing of agricultural grain); *Cf. In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products).

In summary, we find that the term “PASTA THE ORIGINAL PASTA DONUT” is descriptive and Applicant’s POP PASTA THE ORIGINAL PASTA DONUT mark is not unitary. Therefore, the term “PASTA THE ORIGINAL PASTA DONUT” is subject to the disclaimer requirement.

Decision: The requirement for a disclaimer of “PASTA THE ORIGINAL PASTA DONUT” and the refusal of registration based on Applicant’s failure to submit such disclaimer, are affirmed. However, in the event that Applicant submits the

required disclaimer within thirty days from the date of this decision, this requirement will be met, and the disclaimer will be entered.⁴¹

⁴¹ Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). If the disclaimer is submitted, the wording will read as follows: No claim is made to the exclusive right to use “PASTA THE ORIGINAL PASTA DONUT” apart from the mark as shown.