

This Opinion is not a
Precedent of the TTAB

Mailed: April 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Fumari, Inc.
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Serial No. 88437933
—

Jonathan A. Paul of The Tech Law Group, P.C.,
for Fumari, Inc.

Robert Guliano, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

—
Before Greenbaum, English, and Casagrande,
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:¹

¹ As part of an internal Board pilot program to exploring broadening or altering acceptable forms of legal citations in Board cases, the case citations in this opinion vary from the citation forms recommended in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2023). This opinion will contain no citations to the United States Patents Quarterly (USPQ). Precedential decisions of the Court of Appeals for the Federal Circuit and the Court of Customs and Patent Appeals are cited only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). Decisions of the Board will cite to Westlaw (WL). Unless otherwise noted, only precedential Board decisions will be cited. In instances where cited Board decision is also available in the Board's electronic docketing system (TTABVUE), initial WL citations to Board decisions will include the proceeding or application number. Practitioners, however, should continue to adhere to the practice set forth in TBMP § 101.03 until further notice from the Board.

Fumari, Inc., seeks registration on the Principal Register of the proposed mark SPICED CHAI in standard characters in International Class 34 for goods identified as “Hookah tobacco; Tobacco; Tobacco pouches.”²

The Trademark Examining Attorney finally refused registration of Applicant’s proposed mark as merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and Applicant had failed to demonstrate acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).³ For the reasons explained below, we affirm the refusal to register.

I. Preliminary issue

This appeal involves an extensive prosecution history with multiple Office actions, two requests for reconsideration, and two requests for remand by the Examining Attorney, both of which the Board granted. After we remanded the case a second time, Applicant added its Section 2(f) claim, without any indication that the claim was made in the alternative. The Examining Attorney argues that we therefore should take mere descriptiveness as conceded.⁴ After it made its Section 2(f) claim, however: (1) Applicant continued, during prosecution, to argue the merits of the Section 2(e)(1)

² Application Serial No. 88437933 was filed on May 20, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on claimed dates of first use anywhere and in commerce of December 27, 2011.

³ See March 20, 2023, Continuation of Final Office Action. Please note that documents in the application record are accessible in the Trademark Status and Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”), and any citations to page numbers in the cited documents are to the page number(s) in TSDR.

⁴ See 20 TTABVUE 2. References to the briefs, other filings in the case, and the record cite the Board’s TTABVUE docket system. The number preceding “TTABVUE” represents the docket number assigned to the cited filing in TTABVUE and any number immediately following “TTABVUE” identifies the specific page(s), if any, to which we refer.

claim as well as whether its evidence of acquired distinctiveness is sufficient to overcome the Section 2(e)(1) refusal; (2) the Examining Attorney's last Office action maintained and continued the Section 2(e)(1) refusal as well as denying the Section 2(f) claim;⁵ and (3) Applicant's briefs address both the Section 2(e)(1) refusal⁶ and the sufficiency of the Section 2(f) evidence of acquired distinctiveness.⁷ In these circumstances, we will treat Applicant's Section 2(f) claim as having been made in the alternative, rather than as a concession that its proposed mark is merely descriptive.

II. Section 2(e)(1) refusal

Section 2(e)(1) of the Trademark Act excludes from registration any "mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive ... of them." 15 U.S.C. § 1052(e)(1). "A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Com. of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012) (citations omitted). In contrast, a mark is suggestive if the evidence shows that "imagination, thought and perception" are required to arrive at the feature(s), quality(ies), or characteristic(s) in question. *See, e.g., In re N.C. Lottery*, 866 F.3d 1363, 1367 (Fed. Cir. 2017); *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1378 (Fed. Cir. 2017).

⁵ See June 26, 2023 Request for Reconsideration.

⁶ See 8 TTABVUE 4.

⁷ See 18 TTABVUE.

“A mark need not recite each feature of the relevant goods or services in detail to be descriptive, it need only describe a single feature or attribute.” *Chamber of Com.*, 675 F.3d at 1300 (cleaned up; citation omitted). “[T]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *Earnhardt*, 864 F.3d at 1378 (cleaned up; citations omitted).

“The major reasons for not protecting [merely descriptive] marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods [or services]; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products [or services].” *In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (CCPA 1978) (citation omitted).


Refusals for mere descriptiveness, like other refusals, are based on evidence bearing on public perception of the mark. *See, e.g., In re Slokevage*, 441 F.3d 957, 960 (Fed. Cir. 2006); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001). “Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 974 (Fed. Cir. 2018) (cleaned up; citation omitted). An applicant’s use of the term sought to be registered on labels, packages,

and advertising “is probative of the reaction of prospective consumers to the mark,” *Abcor Dev. Corp.*, 588 F.2d at 814, as is “evidence of third parties that use the term ... to describe [goods or] services that are similar to those identified in [the] application.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1378 (Fed. Cir. 2012); accord *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675 (Fed. Cir. 1984) (“The Board found that the evidence of third-party use and registration shows that the word “spice” has descriptive significance when used in conjunction with spiced teas. We agree. Third-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade.”) (citations omitted).

The record in this case overwhelmingly shows Applicant and the media referring descriptively to SPICED CHAI as one of Applicant’s tobacco flavors. Applicant’s uses include:


- A webpage (depicted immediately below) on Applicant’s website describing SPICED CHAI as a flavor, graphically displaying a cup of chai tea and its component spices: “Drink in **the flavor of Spiced Chai** through fluffy clouds of smoke. A Fumari team favorite, **this hookah tobacco flavor** is a creamy blend of sweet, smooth vanilla with complex aromas of cinnamon, nutmeg, and cardamom (emphasis added).”⁸

⁸ Aug. 13, 2019, Nonfinal Office Action, at TSDR 5.

 [TOBACCO](#) [COAL](#) [HOOKAHS](#) [PARTS](#) [GEAR](#)

SPICED CHAI

(22) [WRITE A REVIEW](#)



Drink in the flavor of Spiced Chai through fluffy clouds of smoke. A Fumari team favorite, this hookah tobacco flavor is a delicious creamy blend of sweet, smooth vanilla with complex aromas of cinnamon, nutmeg, and cardamom.

\$11.00

OR BUY ANY THREE 100 GRAM POUCHES FOR \$25.
No limit. No code needed.

Don't forget to try our latest release [Caribbean Colada](#).

WARNING

Choose a Tobacco Weight:

<https://www.fumari.com/spiced-chai>

- A webpage (depicted immediately below) on Applicant’s website with the heading “FEATURED FLAVOR: SPICED CHAI,” and text that goes on to state: “Known far and wide as THE epitome of what a spiced chai latte represents in regards to hookah tobacco, Spiced Chai has always remained at the forefront of our flavor lineup and customer’s taste buds alike.”⁹

⁹ Feb. 8, 2023, Response to Office Action, at TSDR 17; *see also* Nov. 16, 2020, Nonfinal Office Action, at TSDR 23.



FEATURED FLAVOR: SPICED CHAI

By Rob Pecoraro (@dudewheresmyhookah)

Hello #FumariFamily, and welcome back to our monthly series where we highlight flavors destined to reinvigorate your love for all things Fumari. In this month's spotlight, **Spiced Chai** welcomes us to the Fall season of 2020.

Known far and wide as THE epitome of what a spiced chai latte represents in regards to hookah tobacco, Spiced Chai has always remained at the forefront of our flavor lineup and customer's taste buds alike. With a stronger focus on cream and chai itself, we set out to create the ode to sweater weather and the holidays that is always within arms reach and just for this month we are offering a FREE Fumari Beanie with all Spiced Chai purchases to celebrate that!

- A webpage on Applicant's website detailing different types of mixtures of different flavors of Applicant's tobacco products, including one mixture entitled "CHAI APPLE PIE," identifying SPICED CHAI and two other flavors and instructions to "blend up all of these flavors" in the proportions indicated;¹⁰ and
- Applicant's ad featuring SPICED CHAI with a woman model described as "Miss Spiced Chai" sitting on a mound of exaggerated-sized cinnamon sticks surrounded by exaggerated-sized depictions of the other spices that go into chai tea with accompanying text saying: "Drink in the flavor of Spiced Chai through fluffy clouds of smoke. It's a delicious creamy blend of sweet, smooth vanilla with complex aromas of cinnamon, nutmeg, and cardamom."¹¹

¹⁰ Feb. 8, 2023, Response to Office Action, at TSDR 19.

¹¹ *Id.* at 37.

Third-party reviews and other third-party publications also reflect the understanding that SPICED CHAI is one of Applicant's flavors:

- A third-party review of Applicant's SPICED CHAI product stating "one of our seasonal **flavor** favorites here at South Smoke is the Fumari Spiced Chai (emphasis added);"¹²
- A review (at b2hookah.com) of two hookah tobacco producers' "Chai flavors," including Applicant's SPICED CHAI product;¹³
- An article (at masonshishaware.com) entitled "13 Fall Flavors That Need To Be In Your Collection" discussing Applicant's Spiced Chai product, describing it as a flavor;¹⁴
- A review (at hookahfly.com) of Applicant's Spiced Chai product, saying "this Fumari flavor really hits the spot" and "this complex shisha flavor is sure to warm you up";¹⁵
- A third-party review (at icedsmokingpro.com) of Applicant's Spiced Chai product, listing it is one of their "top 10 hookah flavors";¹⁶
- A review by mojo-hookah.com of Applicant's Spiced Chai product, describing Fumari as the "brand" and "Spiced Chai" as a flavor;¹⁷ and
- A review (at hookah-shisha.com) of Applicant's Spiced Chai product, describing it as a flavor.¹⁸

Third-party sellers of tobacco and other smoking products use "Spiced Chai," "Spice Chai," "Chai Spice," "Chai," and similar terms to designate their products:

¹² Aug. 13, 2019 Nonfinal Office Action at TSDR 20-21.

¹³ Oct. 31, 2019, Final Office Action, at TSDR 9.

¹⁴ *Id.* at 19-20.

¹⁵ *Id.* at 25.

¹⁶ *Id.* at 26-27.

¹⁷ *Id.* at 36.

¹⁸ May 26, 2020, Denial of Reconsideration, at TSDR 5.

- A heavenleaf.com webpage promotes “Chai Spice” flavor tobacco and describes it as “[b]lended cinnamon, ginger, and clove with hints of pepper and cardamom”;¹⁹
- An Amazon.com webpage for Hydro Herbal’s herbal tobacco-substitute hookah mix in “Spice Chai” flavor;²⁰
- Puff’s liquid flavor additive for hookah use called “Spiced Chai”;²¹
- Hookah Company’s webpage featuring “Spiced Chai” flavored tobacco;²²
- Bliss’s webpage offering “Spiced Chai” flavored hookah tobacco;²³
- ecigexpress.com webpage offering “Chai Tea” flavor for vaping devices;²⁴
- electRICTobacconist.com webpage offering Chai Tea flavor for vaping devices;²⁵
- Zomo’s offering of SPICED CHAI tobacco flavor;²⁶
- anabhookahcatering.com webpage offering “AHMAD CHAI” flavor and describing it as having a “SPICED CHAI taste is truly a unique flavor based on the popular creamy spiced tea drink. Expect a creamy mix of cinnamon, nutmeg, and black tea”;²⁷
- adalyatobacco.com webpage selling a “Spiced Chai”-flavored hookah tobacco and describing it as “the wind of spices and cinnamon”;²⁸
- HookahFox webpage offering “Spiced Chai”-flavored hookah tobacco;²⁹

¹⁹ Aug. 13, 2019, Nonfinal Office Action, at TSDR 7; *see also* June 15, 2021, Denial of Reconsideration, at TSDR 19.

²⁰ *Id.* at 9.

²¹ *Id.* at 17.

²² *Id.* at 30.

²³ Oct. 31, 2019, Final Office Action, at TSDR 10.

²⁴ *Id.* at 17.

²⁵ *Id.* at 18.

²⁶ May 26, 2020, Denial of Reconsideration, at TSDR 9.

²⁷ Nov. 16, 2020, Nonfinal Office Action, at TSDR 6.

²⁸ *Id.* at 9-10.

²⁹ June 15, 2021, Denial of Reconsideration, at TSDR 21.

- Sweet Smoke webpage offering “Spiced Chai”-flavored hookah tobacco;³⁰
- Zumerret webpage offering “Spiced Chai”-flavored hookah tobacco;³¹ and
- A webpage selling Starbuzz-brand “Exotic Spiced Chai” hookah tobacco.³²

This evidence, from Applicant’s own website, from third-party reviews of Applicant’s SPICED CHAI product, and from other tobacco and smoking sellers’ offerings of “Spiced Chai” and similarly-named flavors, reflects that consumers of tobacco and other smoking-products perceive “Spiced Chai” as describing a particular flavor of tobacco reminiscent of chai tea, a beverage whose ingredients include black tea, honey, spices, and milk.³³ Indeed, we find the evidence to show that the term is highly descriptive.

Applicant’s initial brief makes several arguments against the Section 2(e)(1) refusal.³⁴ We find none persuasive.

First, Applicant says it “does not sell tea” and argues that the proposed mark is suggestive because “[c]onsumers encountering the SPICED CHAI mark have to exercise a significant amount of ‘imagination, thought, and perception to reach a conclusion’ about what Applicant actually sells. ... SPICED CHAI evokes thoughts of

³⁰ *Id.* at 23.

³¹ *Id.* at 26.

³² Mar. 20, 2023, Continuation of Final Office Action, at TSDR 4.

³³ *See* Aug. 13, 2019, Nonfinal Office Action, at TSDR 6 (Merriam-webster.com dictionary definition of “chai”).

³⁴ Applicant’s initial brief also argues against the failure-to-function refusal that existed at that time, *see* 8 TTABVUE at 8-9, but that refusal was later withdrawn. *See* Mar. 1, 2022, Priority Action. The initial brief further seeks a ruling that its mark is not generic, *see* 8 TTABVUE 3-4, but no genericness refusal was ever made.

flavored tobacco only after a ‘measure of imagination and mental pause.’³⁵ But this argument has a flawed premise. The question is not whether consumers who see SPICED CHAI can determine “what Applicant actually sells.” “The question is whether someone who is presented with the mark in connection with the goods or services would understand that the mark describes the goods or services.” *In re TriVita, Inc.*, 783 F.3d 872, 874 (Fed. Cir. 2015); *see also Earnhardt*, 864 F.3d at 1378 (“For descriptiveness, [t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.”) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254 (Fed. Cir. 2012)).

Applicant likens this case to the 1983 Board decision in *In re Shutts*, 1983 WL 51780 (TTAB 1983).³⁶ There, the mark was SNO-RAKE for a snow removal hand tool” that was “without prongs.” *Id.* at *1. Because no one “rakes” snow and the tool lacked the prongs characteristic of a rake, consumers would not immediately grasp any descriptive connotation from the mark, which was coined by the applicant and “hitherto unused and somewhat incongruous.” *Id.* at *2. *Shutts* thus presented a case with almost nothing in common with the evidence in the record here. Here, the evidence shows that Applicant uses SPICED CHAI descriptively to connote a tobacco product that smells and tastes like chai tea, with its characteristic spices, that many

³⁵ See 8 TTABVUE 5.

³⁶ See 8 TTABVUE 5-6.

other tobacco and smoking-product sellers use “spiced chai” or similar terms to describe their similarly-flavored products, and that media reviews of Applicant’s product perceive SPICED CHAI as the flavor of Applicant’s product.

Applicant also seeks shelter under the Board’s nonprecedential decision in *In re DPC Pet Specialties LLC*, Ser. No. 86093164, 2015 WL 7307941 (TTAB 2015) (nonprecedential),³⁷ but, even if it were precedential, we don’t think it covers Applicant. There, the issue was whether SOUP BONES was merely descriptive of pet treats. *See id.* at *1. Unlike in this case, however, the applicant’s SOUP BONES products contained other terms to identify the various flavors of the products, such as “Real Beef & Barley Flavor,” “Real Chicken & Veggies Flavor” and “Real Turkey & Rice Flavor.” *See id.* at *2. By contrast, in this case the evidence shows that SPICED CHAI is the flavor, and Applicant’s webpages refer to it as the flavor and go on to discuss what the flavor smells and tastes like. In addition, here there is evidence that the tobacco-consuming public understands that SPICED CHAI refers to a tobacco flavor, in the form of reviews of Applicant’s product referring to it as a flavor and in the form of third-party use of the same or similar terms for their own flavored tobacco and smoking-related products.

Applicant cites—and tries to distance itself from—the Federal Circuit’s decision in *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987).³⁸ In *Gyulay*, the issue was whether APPLE PIE was merely descriptive of the scent of a potpourri product. *See id.* at 1216.

³⁷ See 8 TTABVUE 7.

³⁸ See 8 TTABVUE 6-7.

There, the applicant argued that it did not sell apple pie, *see id.* at 1217, just as Applicant here insists it does not sell tea. But the Court agreed with the Board that did not matter. More important was the evidence, from the applicant's own catalog, that APPLE PIE was listed as "one of eight exclusive scents that stimulate those unforgettable aromas shown below." *See id.* at 1216. Applicant's website in this case similar describes SPICED CHAI as a flavor. On a page promoting SPICED CHAI as a "FEATURED FLAVOR," Applicant went on to say: "Known far and wide as THE epitome of what a spiced chai latte represents in regards to hookah tobacco, Spiced Chai has always remained at the forefront of our flavor lineup."³⁹ Another webpage on Applicant's website was even more explicit about the flavor of SPICED CHAI: it graphically displayed a cup of chai tea and its component spices alongside the term SPICED CHAI and then said: "Drink in the flavor of Spiced Chai through fluffy clouds of smoke. A Fumari team favorite, this hookah tobacco flavor is a creamy blend of sweet, smooth vanilla with complex aromas of cinnamon, nutmeg, and cardamom."⁴⁰ In addition, in this case, there is evidence that corroborates that the tobacco-consuming public understands that SPICED CHAI refers to a tobacco flavor, in the form of reviews of Applicant's product referring to it as a flavor and in the form of third-party used of the same or similar terms for their own flavored tobacco and smoking-related products. Contrary to Applicant's view, we think *Gyulay* supports the Section 2(e)(1) refusal here.

³⁹ Feb. 8, 2023, Response to Office Action, at TSDR 17; *see also* Nov. 16, 2020, Nonfinal Office Action, at TSDR 23.

⁴⁰ Aug. 13, 2019, Nonfinal Office Action, at TSDR 5.

Pivoting, Applicant explains that the USPTO allowed it to register WHITE GUMMI BEAR and RED GUMMI BEAR as marks for tobacco products, raising no descriptiveness issues. Applicant says that, because those two marks are like SPICED CHAI in that they are “vaguely evocative” of a flavor, these two registrations are “evidence” that we should do the same for SPICED CHAI.⁴¹ There is no need to rummage through the evidence and arguments in these other two files to determine if they present circumstances similar or dissimilar to this case. Not only are these files not of record, but even if they were, it is well-settled that these sorts of consistency arguments are legally irrelevant. *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, including non-genericness, even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (“The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.”); *Nett Designs*, 236 F.3d at 1342 (“The Board must decide each case on its own merits. Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”) (citations omitted); *see also In re Ala. Tourism Dep’t*, Ser. No. 87599292, 2020 WL 2301221, at *14 (TTAB 2020) (“While we recognize

⁴¹ See 8 TTABVUE 8.

that consistency is highly desirable, consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules.”) (cleaned up; citations omitted).

We find that SPICED CHAI, at minimum, merely describes a flavor of the identified goods under Section 2(e)(1) of the Trademark Act. Moreover, as discussed above, the evidence supports a finding that SPICED CHAI is highly descriptive of the identified goods.

III. Applicant’s Section 2(f) claim

Merely descriptive terms can qualify for registration upon proof that they have acquired distinctiveness. *See* Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). As we noted earlier, Applicant asserted a claim under Section 2(f), which we will now address. Section 2(f) provides:

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant **which has become distinctive of the applicant’s goods in commerce**. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

15 U.S.C. § 1052(f) (emphasis added). This means that, if it can be proved that a term describing an aspect of tobacco products “become[s] distinctive of the applicant’s goods,” then it is registrable. This is called “acquired distinctiveness” or, sometimes, “secondary meaning.” *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769

(1992) (“This acquired distinctiveness is generally called ‘secondary meaning.’”); *Galperti, Inc. v. Galperti S.r.l.*, 17 F.4th 1144, 1148 (Fed. Cir. 2021) (same). When a mark “become[s] distinctive of the applicant’s goods,” that means it “has come through use to be uniquely associated with a specific source.” *Two Pesos*, 505 U.S. at 766 n.4; *see also Textron, Inc. v. ITC*, 753 F.2d 1019, 1023 (Fed. Cir. 1985) (“an association in buyers’ minds between the alleged mark and a single source of the product”).

“The applicant ... bears the burden of proving acquired distinctiveness.” *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005)); *see also In re Hollywood Brands, Inc.*, 214 F.2d 139, 140 (CCPA 1954) (“There is no doubt that Congress intended that the burden of proof [under section 2(f)] should rest upon the applicant for registration”). “An evidentiary showing ... adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner’s method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.” *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125 (Fed. Cir. 1985). To determine whether a mark has acquired distinctiveness, the Board may consider a wide range of evidence, including advertising expenditures and sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies. *E.g., La. Fish Fry*, 797 F.3d at 1336; *Coach Servs.*, 668 F.3d at 1379; *see also Converse, Inc. v. ITC*, 909 F.3d 1110, 1120 (Fed. Cir. 2018) (“the considerations to be

assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.”).

“[W]here a mark sits on a sliding scale of descriptiveness impacts the burden a proposed registrant must bear with respect to its claim of acquired distinctiveness.” *Id.* at 979 (cleaned up; citation omitted). Specifically, “the applicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.” *Steelbuilding.com*, 415 F.3d at 1300 (citation omitted). Here, we found that the evidence we described in detail in the preceding section analyzing the Section 2(e)(1) refusal shows that SPICED CHAI is highly descriptive of Applicant’s goods. Therefore, Applicant’s burden is correspondingly high.

In this case, Applicant relied on several types of evidence to show SPICED CHAI has acquired distinctiveness for the identified goods. It submitted a declaration averring that “[t]he mark has become distinctive of the goods/services through the applicant’s substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement”⁴² It also submitted:

⁴² See July 11, 2022, Response to Priority Action, at TSDR 3.

- 3 Instagram posts depicting packages of SPICED CHAI;⁴³
- A webpage from Applicant’s website encouraging consumers to “Buy Spiced Chai Hookah Tobacco Flavor Online” and stating “Drink in the flavor of Spiced Chai through fluffy clouds of smoke. A Fumari team favorite, this hookah tobacco flavor is a delicious creamy blend of sweet, smooth vanilla with complex aromas of cinnamon, nutmeg, and cardamom,” depicting a package of SPICED CHAI flavor tobacco with a cup of tea and depictions of spices placed in front of it obscuring the word “chai”;⁴⁴
- A list of Google search results for the terms “spiced chai hookah tobacco” where 7 of the 8 results are for Applicant’s SPICED CHAI tobacco;⁴⁵
- The declaration of Rima Khoury (General Counsel of Applicant), averring that Applicant:
 - Began using SPICED CHAI in December 2011;⁴⁶
 - Sold 600,000 pounds of SPICED CHAI tea since 2011;⁴⁷
 - Made unquantified “large scale” ad expenditures⁴⁸.

The later-filed Khoury declaration also attached several exhibits:

- examples of Applicant’s blog/social media posts,⁴⁹ including:
 - One calling SPICED CHAI a “featured flavor”;⁵⁰
 - Another referring to SPICED CHAI as a “flavor” suitable for blending with other “flavors”;⁵¹

⁴³ See *id.* at 7-9.

⁴⁴ See *id.* at 10-11.

⁴⁵ See *id.* at 16.

⁴⁶ See Feb. 8, 2023, Response to Office Action, at TSDR 8.

⁴⁷ See *id.*

⁴⁸ See Feb. 8, 2023, Response to Office Action, at TSDR 8.

⁴⁹ See *id.* at 17-29.

⁵⁰ See *id.* at 17.

⁵¹ See *id.* at 19.

- examples of third-party reviews, including a listing in “Best Hookah Flavor of 2020”⁵² and one where reviewer “Mr. Aficionado” refers to it as a flavor: “There aren’t too many flavors I could smoke back to back, but spiced chai could go for hours no problem”;⁵³
- A screenshot of a video review on YouTube including a textual description urging viewers that “if you’ve smoked Fumari Spiced Chai flavor, please take a few moments and share your own review with everyone else too”;⁵⁴
- A 2018 ad featuring SPICED CHAI with a woman model described as “Miss Spiced Chai” sitting on a mound of exaggerated-sized cinnamon sticks surrounded by exaggerated-sized depictions of the other spices that go into chai tea with accompanying text saying: “Drink in the flavor of Spiced Chai through fluffy clouds of smoke. It’s a delicious creamy blend of sweet, smooth vanilla with complex aromas of cinnamon, nutmeg, and cardamom.”⁵⁵

We find this showing to fall far short of establishing acquired distinctiveness, i.e., that consumers have come to perceive the highly descriptive term SPICED CHAI as an indicator of a unique source of Applicant’s tobacco products. Most significant to us is that the evidence shows that Applicant’s use of SPICED CHAI is far from exclusive. A purported trademark must both “identif[y] and distinguish[].” *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 163-64 (1995); *see also USPTO v. Booking. com BV*, 140 S. Ct. 2298, 2302 (2020) (“A trademark distinguishes one producer’s goods or services from another’s.”); *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (trademarks allow consumers “to distinguish among competing producers”). Use by others can severely undermine the ability of a proposed mark to distinguish among sources and thus present an impediment to proving acquired

⁵² See *id.* at 11, 14.

⁵³ See *id.* at 31.

⁵⁴ See *id.* at 32.

⁵⁵ See *id.* at 37.

distinctiveness. “When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term ..., an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.” *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403 (Fed. Cir. 1984), *quoted in Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, Opp. No. 91211014, 2016 WL 4474509, at *13 (TTAB 2016); *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 1298 (CCPA 1972) (evidence that the opposer and a third party had used SUPER BLEND was “strong evidence militating against a finding” of acquired distinctiveness) (quoting Board decision); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 863 (CCPA 1962) (finding that owner of alleged trademark “at the time it filed its application and for at least two years prior thereto, was not the exclusive user of [SUDSY] ... alone should have been sufficient to support a finding of lack of distinctiveness”) (cleaned up); *see also Galperti*, 17 F.4th at 1148 (“Any use ..., whether begun prior or subsequent to applicant’s, and whether in a descriptive context or in the manner of a mark, may be sufficient to defeat the applicant’s claim that the term is distinctive of its goods or has become distinctive thereof with the meaning of section 2(f) of the Lanham Act.”) (citations omitted).

The apparently common use by others in the marketplace of the term in which Applicant seeks exclusive rights not only fatally undermines Applicant’s claim, but shows that granting Applicant exclusive rights would potentially inhibit competition by restricting competitors’ freedom to (continue to) use the term to describe their

version of this flavor of tobacco. *See, e.g., Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1360 (Fed. Cir. 2001) (“descriptive terms are in the public domain and should be free for use by all who can truthfully employ them” to describe their goods or services) (citation omitted); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320 (CCPA 1981) (prohibition of exclusive rights in descriptive terms “is thus concerned with the prevention of harassment, based on a registration, under which an exclusive right could be claimed in a term which does not identify source.”) (citations omitted); *Abcor Dev. Corp.*, 588 F.2d at 813 (exclusion of protection for descriptive terms serves: “(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”) (citation omitted).

Though we find that the evidence of third-party use of the term SPICED CHAI (or very similar terms) to describe their competing products to fatally undermine Applicant’s Section 2(f) claim, we further note other deficiencies in Applicant’s attempt to prove acquired distinctiveness. For one thing, Applicant’s own evidence of use shows that Applicant uses it to describe a flavor of tobacco, not as a source identifier. Not all use by an applicant counts as use as a source identifier (i.e., as a trademark or brand). *See, e.g., In re Andes Candies Inc.*, 478 F.2d 1264, 1267 (CCPA 1973) (denial of Section 2(f) claim affirmed “where appellant has so employed the mark” CREME DE MENTHE “as a flavor designation for candy”); *In re J. Hungerford*

Smith Co., 279 F.2d 694, 695 (CCPA 1960) (claim of acquired distinctiveness properly denied where the applicant “has not used ‘Burgundy’ as a trademark for a soft drink syrup, but only as a flavor designation”); *see also* 2 J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:52 (5th ed. 2024) (“[u]se of a term in its descriptive sense or in a nontrademark sense is not evidence of secondary meaning”) (footnotes omitted).

For another, its averments concerning sales revenues and advertising efforts are not limited to the United States market, which is the only market that matters for proving acquired distinctiveness to support registration in the United States. *See, e.g., In re Etablissements Darty et Fils*, 759 F.2d 15, 18 (Fed. Cir. 1985) (proper inquiry is acquired distinctiveness in the United States); *In re Standard Elektrik Lorenz AG*, 371 F.2d 870, 871 (CCPA 1967) (same); *In re Brouwerij Bosteels*, Ser. No. 77357895, 2010 WL 3501476, at *10 (TTAB 2010) (evidence of use outside the United States is “not probative of whether the alleged mark has acquired distinctiveness among purchasers in the United States”); *In re Howard Leight Indus., LLC*, Ser. No. 76439661, 2006 WL 1968605, at *12 n.12 (TTAB 2006) (same). And even if this averment concerning sales had been limited to the United States, Applicant failed to give us any evidence of how they compare to others’ sales. This sort of contextual evidence is important because it allows us to determine the probative value of an applicant’s sales and advertising figures.⁵⁶ *See, e.g., Mini Melts, Inc. v. Reckitt*

⁵⁶ Applicant, in fact, declined to quantify its advertising expenditures at all, let alone provide evidence to put such expenditures in the context of the marketplace at issue. *See* Feb. 8, 2023, Response to Office Action, at TSDR 8.

Benckiser LLC, Opp. No. 91173963, 2016 WL 3915987, at *19 (TTAB 2016); *AS Holdings, Inc. v. H&C Milcor, Inc.*, Opp. No. 91182064, 2013 WL 4397045, at *11 (TTAB 2013); *Target Brands, Inc. v. Hughes*, Opp. No. 91163556, 2007 WL 4287253, at *6 (TTAB 2007); *In re Gibson Guitar Corp.*, 2001 WL 1631369, at *3, *4 (TTAB 2001).

Applicant’s supplemental brief, though ostensibly directed to the denial of its Section 2(f) claim, does not address the deficiencies we identified above. Nor does it address any of the other acquired distinctiveness factors identified in *Converse, Inc. v. ITC*, 909 F.3d at 1120. Instead, Applicant points to its LEMON MINT “companion application,” which registered under Section 2(f)—but was not filed until after SPICED CHAI had been refused—as support for its argument that SPICED CHAI should likewise have been registered under Section 2(f).⁵⁷ As explained above, registration of other marks in allegedly similar circumstances has no bearing on whether SPICED CHAI is registrable on the record before us because each application is decided on its own evidentiary record. TMEP § 702.03(a)(iii), on which Applicant relies, is not to the contrary and, in addition, is inapplicable because SPICED CHAI is not a “companion application” of the LEMON MINT application in the sense that “companion applications” is used in that section.

In sum, we find that Applicant has failed to prove acquired distinctiveness under Section 2(f).

⁵⁷ See 18 TTABVUE.

Decision: The refusal to register SPICED CHAI under Section 2(e)(1) on the ground that the proposed mark is merely descriptive of the goods and has not acquired distinctiveness under Section 2(f) is affirmed.