

THIS DECISION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

GCP

Mailed: August 31, 2015

Opposition No. 91212680 (**Parent Case**)
Opposition No. 91213587

Frito-Lay North America, Inc.

v.

Real Foods Pty Ltd.

**Before Quinn, Bergsman, and Wolfson,
Administrative Trademark Judges.**

By the Board:

Real Foods Pty Ltd. (“Applicant”) seeks to register the marks RICE THINS¹ and CORN THINS,² both in standard characters, for “crispbread slices predominantly made of rice” and “crispbread slices predominantly of corn,” respectively.

Frito-Lay North America, Inc. (“Opposer”) has opposed the registration of each of Applicant’s involved marks on the following grounds: (1) genericness, (2) mere descriptiveness and lack of acquired distinctiveness, and (3) the marks as a whole are so highly descriptive of the goods as to be incapable of acquiring distinctiveness.

¹ Application Serial No. 85820051, filed on January 10, 2013, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming 2007 as both the year of first use and the year of first use in commerce. The term RICE is disclaimed.

² Application Serial No. 79111074, filed on January 19, 2012, pursuant to a request for extension of protection under Section 66(a) of the Trademark Act based on International Registration No. 1111528 issued on January 19, 2012. The term CORN is disclaimed.

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On May 13, 2015, Applicant, pursuant to Board's approval of the parties' April 21, 2015, stipulation, filed amended answers to each of Opposer's notices of opposition denying the salient allegations asserted therein.

On September 9, 2014, Applicant filed an unconsented motion to amend the identification of goods for each of its involved applications. With regard to Application Serial No. 85820051 for the mark RICE THINS, Applicant seeks to amend the identification from "crispbread slices primarily made of rice" to "crispbread slices primarily made of rice, namely rice cakes." Similarly, with regard to application Serial No. 79111074 for the mark CORN THINS, Applicant seeks to amend the identification from "crispbread slices predominantly of corn" to "crispbread slices predominantly of corn, namely, popped corn cakes."

By order dated September 23, 2014, the Board deferred consideration of Applicant's unconsented motion to amend until final decision or until the case is decided upon summary judgment.

These consolidated proceedings now come before the Board for consideration of (1) Applicant's motion for summary judgment on Opposer's asserted grounds for opposition, and (2) Opposer's cross-motion on the ground that Applicant's involved marks are not inherently distinctive.³

³ On March 13, 2015, Opposer filed a motion for summary judgment regarding its standing, as well as Applicant's affirmative defenses of laches, waiver, acquiescence, and estoppel. By stipulation of the parties filed on April 21, 2015, the parties agreed that Opposer has standing; Applicant deleted its affirmative defenses from its answer; and Opposer withdrew its motion for summary judgment. Accordingly, the Board will give no further consideration to Opposer's motion for summary judgment filed on March 13, 2015.

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In support of its motion for summary judgment, Applicant argues that (1) its involved marks are suggestive of its identified goods because, in light of the all-natural, healthful, low calorie, gluten free and dietetic benefits of the products, the marks suggest that consuming them is compatible with a light, diet conscious and thinning diet; (2) there is no such thing as a “corn thin” or “rice thin” as neither a corn nor rice grain can be thinly sliced and served as a snack food; (3) there is no dictionary definition of the noun THINS; (4) survey evidence demonstrates that a majority of consumers understand the phrases RICE THINS and CORN THINS as designating Applicant’s own brand name products; (5) searches of USPTO records for marks including the term THINS covering goods in both Classes 29 and 30 demonstrate that the USPTO has consistently not required a disclaimer of THINS when an ingredient name is paired with the term, but, rather has only required disclaimer of the ingredient name; (6) the vast majority of probative results of Google® searches of the phrases RICE THINS and CORN THINS refer to these phrases as trademark references for Applicant and its identified goods; (7) Applicant’s website promoting its CORN THINS and RICE THINS brands enjoys good site traffic with thousands of visitors each year; (8) Applicant has received thousands of communications from satisfied consumers, including 16,000 Facebook “likes;” (9) Applicant’s products are featured on several popular blogs, and (10) not a single one of Applicant’s competitors has found any need to use RICE THINS or CORN THINS to refer to its products.

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To the extent that the Board finds that Applicant's involved marks are merely descriptive of its identified goods, Applicant maintains that its marks have acquired distinctiveness based upon Applicant's long-standing use and years of growing sales under the marks at issue. In particular, Applicant contends that its years of use and millions of dollars in sales under its CORN THINS and RICE THINS marks have, despite a relatively low marketing budget, resulted in Applicant's achieving the second largest share of the combined popped corn and rice cakes market in (1) natural food stores in the U.S., and (2) "natural" food aisles of mainstream supermarkets and drugstores. Additionally, Applicant maintains that evidence of consumer recognition of its brands demonstrated through instances of social media posts, website visitors, and consumer communications establishes that Applicant's marks have acquired distinctiveness.

In response, Opposer initially objects to certain declarations submitted in support of Applicant's motion for summary judgment. Specifically, Opposer objects to the information contained in Michael Movitz' declaration, as well as to paragraphs 6 and 21 of Michael Pels' declaration which summarizes the information contained in Mr. Movitz' declaration regarding Applicant's market share. Opposer also objects to the declaration of Jessie Roberts to the extent that Ms. Roberts has provided legal conclusions or legal opinions regarding trademark registrability and the registration practice.

With regard to the Movitz and Pels declarations, Opposer further contends that Mr. Movitz was not identified in Applicant's initial disclosures nor was he identified

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in response to Opposer's written discovery. As such, Opposer requests that the Board give no consideration to Mr. Movitz' declaration or paragraphs 6 and 21 of Mr. Pels' declaration pursuant to Fed. R. Civ. P. 37(c)(1) which provides that a party who fails to provide required disclosures or information responsive to a discovery request is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at trial.

Turning to the merits of Applicant's motion, Opposer argues that Applicant has failed to establish that there are no genuine disputes of material fact that its involved marks are not generic or that they have acquired distinctiveness. Specifically, Opposer maintains, *inter alia*, that (1) survey evidence demonstrates that the term THINS is used generically for many crispbread and other cracker products and, when combined with the generic terms CORN and RICE, the combination has no new or different meaning in relation to Applicant's identified goods; (2) according to dictionary definitions, "crispbread" is a type of "cracker," and a "cracker" is "a dry thin crispy baked bread product, which is consistent with how Applicant markets its products to consumers by noting in advertisements that its product is a cracker or used as a cracker; (3) third-party manufacturers and the media use the phrase THINS generically for cracker products; (4) Applicant itself, as well as its consumers, use the term THINS generically to refer to Applicant's products or similar products; (5) USPTO records demonstrate that several recent registrations issued on the Principal Register and Supplemental Register for crackers, chips, and baked goods that include the term THINS, with a disclaimer of

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the term; (6) in correspondence with Applicant, companies interested in selling or provided Applicant's products have often used "corn thins" and "rice thins" generically, i.e., "thank you for your donation of 250 samples of corn thins," "your corn thins product," "we found the rice thins a good sub for bread," etc., and (7) other snack food manufacturers produce cracker or crispbread products that they refer to as "Corn Thins" or "Rice Thins," and their websites and packaging prominently use those designations to refer to the kind of product rather than a brand.

With regard to the issue of whether Applicant's involved marks have acquired distinctiveness, Opposer maintains that (1) Applicant has little to no market share and brand awareness in the United States, (2) Applicant's sales are declining, (3) Applicant has spent less than \$74,000 total in advertising since 1998 and therefore Applicant's advertising budget is too small to support efforts to create brand awareness and secondary meaning, and (4) Opposer's survey results regarding the phrase CORN THINS illustrate that such phrase lacks acquired distinctiveness with regard to Applicant's identified goods.

Opposer also contests the probative value of the survey relied upon by Applicant to demonstrate that consumers understand the phrases RICE THINS and CORN THINS as designating Applicant's own brand name products on the ground that the survey suffers serious and fatal flaws in both its design and in the analysis of its results.

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In support of its cross-motion for summary judgment that Applicant's involved marks are not inherently distinctive, Opposer argues that the marks immediately tell consumers (1) the primary ingredient of its products, i.e., rice and corn, and (2) a primary feature of its products, namely, "thin" crispbread slices. Finally, as part of its cross-motion for summary judgment, Opposer requests that the Board, pursuant to Fed. R. Civ. P. 56(g), enter an order that the following material facts are not in dispute: (1) CORN is a generic term, and (2) RICE is a generic term, presumably for the food products corn and rice, respectively.⁴

In its reply, Applicant (1) reiterates its arguments that its involved marks are not generic but suggestive, (2) maintains that if the Board finds that its marks are merely descriptive of the identified goods, the marks have nonetheless acquired distinctiveness, (3) argues that Opposer improperly identifies the genus of Applicant's goods as "crackers" when in fact Applicant's goods are popped corn cakes and rice cakes, (4) contends that Opposer's reliance on third-party usage of the phrase CORN THINS is not probative of genericness since none of these references concerns the use of CORN THINS on any food product being sold in the United States.

With regard to Opposer's reliance on its secondary meaning survey of the phrase CORN THINS, Applicant maintains that the survey is inadmissible because the universe of the respondents was overbroad, rendering the survey of no value. Even if Opposer had included the correct universe, Applicant argues that the survey

⁴ The Board notes that Opposer failed to identify the genus of goods for which these terms are generic.

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design was patently misleading and designed to produce the outcome desired by Opposer. As to Opposer's objections to the declarations of Mr. Movitz and Mr. Pels, Applicant contends that two of Opposer's own declarations and exhibits thereto submitted in support of its response should also be excluded, i.e., the declarations of Jeannette Zimmer⁵ and Diana Rausa, because these two individuals were also not identified by Opposer in its own initial disclosures. With regard to Ms. Roberts' declaration, Applicant maintains that Opposer's characterization of Ms. Roberts, and her role in rebutting the declaration of one of Opposer's experts, is misleading and false since her declaration was submitted solely based upon her technical background, as a former high level USPTO administrator specializing in the identification of goods and services, and therefore she is uniquely qualified to render an expert rebuttal.

Decision

Summary judgment is an appropriate method of disposing of cases that present no genuine disputes of material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

⁵ Applicant maintains that Ms. Zimmer was also not identified in Opposer's pretrial disclosures.

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Each moving party has the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to judgment as a matter of law, with respect to the claims asserted in its motion. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The mere fact that cross-motions for summary judgment have been filed does not necessarily mean that there are no genuine disputes of material fact, and that a trial is unnecessary. *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389-90 (TTAB 1994).

Having considered the parties' arguments and evidentiary submissions, including the conflicting surveys, expert reports and declarations,⁶ we find that the record establishes that genuine disputes of material fact exist as to Opposer's asserted claims of genericness, mere descriptiveness, and lack of acquired distinctiveness. At a minimum, genuine disputes of material fact remain as to whether (1) the relevant public understands either RICE THINS or CORN THINS to be the generic name of Applicant's identified goods, (2) Applicant's involved marks are inherently distinctive or merely descriptive of the goods, and (3)

⁶ With regard to the objections to certain declarations submitted in support of each of the parties' filings, the Board notes that it appears that both parties failed to identify the declarants in their disclosures or during discovery. As such and in the interest of fairness, the Board has given these declarations whatever probative value they deserve. With regard to Jessie Roberts' declaration, the Board notes that it has not considered any legal opinions or legal conclusions proffered by Ms. Roberts in her declaration in its determination herein inasmuch as determinations of conclusions of law are solely within the province of the Board. *See Fed. R. Evid. 702* ("A witness who is qualified as an expert ... may testify in the form of an opinion or otherwise if: (a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue.").

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Applicant's marks have acquired distinctiveness. *See Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015).

In view thereof, Applicant's motion for summary judgment and Opposer's cross-motion for summary judgment are hereby **DENIED**. Furthermore, the Board, in its discretion, declines to entertain Opposer's request that the Board enter an order under Fed. R. Civ. P. 56(g) that the terms RICE and CORN are generic and will leave Opposer to prove such facts during its assigned testimony period.

Because the Board has not resolved this case on summary judgment, consideration of Applicant's motions to amend the identification of goods for each of its involved applications remains deferred until final decision.⁷ Moreover, since this proceeding is on the verge of trial, the parties are hereby **precluded from filing any further motions for summary judgment in this matter.**

Accelerated Case Resolution

We note that the legal issues presented in this proceeding appear to be limited and that the parties are well-acquainted with the relevant facts. Accordingly, the parties may wish to stipulate to resolution of this proceeding by means of the Board's accelerated case resolution ("ACR") procedure, on summary judgment briefs and incorporating the current record pursuant to an agreement to proceed under ACR with respect to Opposer's asserted claims. *See e.g., Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (parties agreed that evidence

⁷ The parties are allowed until **ten (10) days** from the mailing date of this order to file Opposer's consent to Applicant's proposed amendments, failing which this consolidated case will proceed to final decision or to ACR, if so stipulated to by the parties, based upon the current identification of goods as well as Applicant's proposed amendments to the identification of goods.

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and arguments submitted with Opposer's motion for summary judgment and Applicant's response could be treated as the final record and briefs). *See also* TBMP § 528.05(a)(2) (2015) and authorities cited therein. In the event the parties agree to ACR using summary judgment briefs and incorporating the current evidence, including any supplementation of evidence they may agree would be appropriate, they will need to stipulate that the Board may determine any genuine disputes of material fact the Board may find to exist.⁸ *See* TBMP § 702.04 (2015) for more information.

The parties are therefore encouraged, within **FIFTEEN DAYS** of the mailing date of this order, to jointly contact the Board's interlocutory attorney responsible for this proceeding by telephone to discuss the possibility of ACR, any necessary stipulations, and an agreed schedule for proceeding under ACR.

If the parties determine not to proceed via ACR the proceeding will continue on the schedule as set below.

Trial Schedule

These consolidated proceedings are hereby RESUMED. Discovery is closed.

Remaining trial dates are reset as follows:

⁸ However, absent such an agreement, the parties should note that the evidence submitted in connection with Applicant's motion for summary judgment and Opposer's cross-motion for summary judgment is of record only for consideration of these motions. To be considered at final hearing, any such evidence must be properly introduced during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. *See e.g., Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998).

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Plaintiff's 30-day Trial Period Ends	10/28/2015
Defendant's Pretrial Disclosures Due	11/12/2015
Defendant's 30-day Trial Period Ends	12/27/2015
Plaintiff's Rebuttal Disclosures Due	1/11/2016
Plaintiff's 15-day Rebuttal Period Ends	2/10/2016

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.