

This Opinion is Not a
Precedent of the TTAB

Mailed: January 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Chazak Kinder Inc.

v.

Mitzvah Kinder, Inc.

Opposition No. 91272685

Matthew De Preter and Sofia Quezada Hastings of Aronberg Goldgehn Davis &
Barmisa for Chazak Kinder Inc.

Brian Roffe of the Law Office of Brian Roffe for Mitzvah Kinder, Inc.

Before Johnson, Acting Deputy Chief Administrative Trademark Judge; Lykos, and
Coggins, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Mitzvah Kinder, Inc. (“Applicant”) seeks to register on the Principal Register the
standard character mark MENTCHEES for “Toy figures; Modeled plastic toy
figurines; Molded toy figures” in International Class 28:¹

¹ Application Serial No. 88918413, filed May 15, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging December 31, 2013 as the date of first use anywhere and in commerce.

Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Chazak Kinder Inc. (“Opposer”) opposes registration of Applicant’s proposed mark on the ground that it is merely descriptive of the identified goods under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and has not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).²

In its Amended Answer to the Notice of Opposition, Applicant admitted that “‘mentch’ is one spelling of a Yiddish word for ‘person’ and could be used colloquially for a good person or a person who is good to other people or a person of integrity and honor.”³ Otherwise, Applicant denied the salient allegations of the Notice of Opposition.⁴

The case is fully briefed.⁵ Opposer, as plaintiff in this proceeding, bears the burden of establishing its entitlement to a statutory cause of action and claims by a

Citations to the prosecution file of the opposed application refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system.

² Notice of Opposition ¶¶ 1-13, 15-16; 1 TTABVUE 3-4. Unless properly made of record during Opposer’s assigned trial period, none of the exhibits attached to the Notice of Opposition are properly of record. *See* Trademark Rule 2.123(k), 37 C.F.R. § 2.123(k) (evidence not obtained and filed in compliance with the rules of practice governing inter partes proceedings before the Board will not be considered).

³ Amended Answer ¶ 7; 5 TTABVUE 12.

⁴ Applicant couched as affirmative defenses various putative defenses which are not true affirmative defenses but rather amplifications of its denials. Amended Answer; 5 TTABVUE 5-8.

⁵ Opposer’s submission with its opening brief of printouts of each cited case in its brief was unnecessary.

Neither Opposer nor Applicant used the recommended record citation practice in their respective briefs which is to cite to the evidence in the trial record by referencing the TTABVUE entry **and page number**. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 801.01 (2024); *see also Turdin*, 109 USPQ2d at 1476 n.6 (recommended citation to the Board’s TTABVUE docket electronic database by the entry and page number (e.g., 1 TTABVUE 2)). The parties’ failure to use the recommended trial record citation practice in their briefs hindered the Board’s ability to promptly render an opinion.

preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007).

For the reasons discussed below, we sustain the opposition. In reaching our decision, we have not considered any statements made by either party in their briefs that are unsupported by evidence properly in the record. *See, e.g., Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010).

I. Trial by Implied Consent of Opposer's Genericness Claim

Opposer did not assert a genericness claim in the Notice of Opposition. However, Opposer argued throughout its brief that the record shows that Applicant's proposed mark MENTCHEES is generic for the identified goods.⁶ Applicant did not object and countered with substantive arguments that Opposer failed to prove this claim.⁷

We find that a claim of genericness was tried by implied consent under Fed. R. Civ. P. 15(b)(2).⁸ Therefore, we deem the pleadings amended to assert a claim that Applicant's proposed mark is generic for the identified goods under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127; or alternatively, that the

⁶ Opposer's Brief, 40 TTABVUE 40-42.

⁷ Applicant's Brief, 41 TTABVUE 34-35.

⁸ Fed. R. Civ. P. 15(b)(2), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), provides that when claims or issues not raised by the pleadings are tried by express or implied consent of the parties, an amendment of the pleadings may be made to cause them to conform to the evidence. "Implied consent to the trial of an unpleaded issue can be found only where the non-offering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue." TBMP § 507.03(b). *See also Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009).

proposed mark is merely descriptive under Section 2(e)(1) of Applicant's goods with an insufficient showing of acquired distinctiveness under Section 2(f).

II. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Applicant's application file.⁹

A. Opposer's Main Trial Period

Opposer submitted the testimony declarations of the following individuals with exhibits thereto:¹⁰

Yaacov Schwartz, Chief Executive Officer and owner of Opposer (21 TTABVUE 251-267);

Aaron Schwartz, an employee of Opposer (21 TTABVUE 269-274); and

Rabbi Amrom Fisher, identified as an expert under Fed. R. Civ. P. 26(a)(2) (21 TTABVUE 281-290).

Opposer also submitted a notice of reliance on the following:

The discovery deposition transcript of Applicant's President, Toby Horowitz, and exhibits thereto (22 TTABVUE 3-140);

⁹ Both parties improperly submitted testimony declarations under notice of reliance. *See* 37 C.F.R. § 2.122(d)(2), 37 C.F.R. § 2.122(e)(1), 37 C.F.R. § 2.122(e)(2), and 37 C.F.R. § 2.120(k). *See also* *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037-38 n.12 (TTAB 2018) (listing the types of documents that can be filed under notice of reliance). A testimony declaration and its exhibits should be individually identified and uploaded using ESTTA so that it appears as a discrete entry in TTABVUE, the Board's online docketing system.

¹⁰ Opposer also submitted the testimony declaration of Joseph Itzkowitz, owner of Toys 4 U, Inc. 21 TTABVUE 276-279. There are two signature pages to Itzkowitz's testimony declaration. The first page is unsigned and both are undated. As a result, we have not considered Itzkowitz's testimony declaration. *See* Trademark Rules 2.121(a), 2.123(a)(1) and 2.123(k); 37 C.F.R. §§ 2.121(a), 2.123(a)(1) and 2.123(k).

Online dictionary definitions and transliterations for the terms “mensch,” and “mentch” (24 TTABVUE); and

Printouts and screenshots from Applicant’s, Opposer’s and third-party websites (25 TTABVUE).

B. Applicant’s Trial Period¹¹

Applicant submitted the testimony declaration of its President, Toby Horowitz (26 TTABVUE 14-34). Applicant also submitted under notice of reliance:

Third-party registrations (26 TTABVUE 35-51);

The discovery deposition transcript of its President Toby Horowitz (26 TTABVUE 53-190);

Opposer’s responses to Applicant’s First and Second Sets of Interrogatories and First and Second Sets of Document Production Requests (26 TTABVUE 192-219); and

Documents purporting to be Internet printouts from Applicant’s and third-party websites (26 TTABVUE 219-274) which are discussed below.

C. Opposer’s Rebuttal Trial Period¹²

Opposer properly made of record the oral cross-examination testimony deposition of Applicant’s President, Toby Horowitz, with exhibits, during its rebuttal trial period (32 TTABVUE 7-232).

Opposer improperly submitted rebuttal evidence outside of its assigned rebuttal trial period. By consented motion, Opposer’s rebuttal disclosures were due November

¹¹ Applicant’s submission of its pretrial disclosures during its trial period was improper. *See* 32 and 33 TTABVUE. Applicant was required to serve pretrial disclosures on Opposer fifteen days prior to the opening of its assigned trial period. *See* Trademark Rule 2.121(e), 37 C.F.R. § 2.121(e).

¹² Opposer improperly captioned its evidence submitted during its rebuttal trial period as “Supplemental Rebuttal Disclosures.” 32 TTABVUE.

27, 2023 and its 15-day rebuttal trial period closed December 27, 2023.¹³ Opposer filed not only its rebuttal disclosures on November 27, 2023 but also three rebuttal testimony declarations with exhibits and a rebuttal notice of reliance on that same date,¹⁴ meaning that Opposer filed this evidence prior to the opening of its rebuttal trial period. The Board strikes Opposer's rebuttal testimony declarations and notice of reliance evidence filed prior to the opening of its assigned rebuttal period as not filed in accordance with Trademark Rule 2.121(a), which states that "[n]o testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board." *See also* Trademark Rule 2.123(k), 37 C.F.R. § 2.123(k) ("Evidence not obtained and filed in compliance with these sections will not be considered.").

D. The Parties' Failure to Inform the Board of Expert Disclosures

During the discovery period, both parties failed to identify witnesses as experts by either filing expert disclosures with the Board or informing the Board that each party intended to rely on expert testimony at trial.

During its initial trial period, Opposer filed under notice of reliance the "Expert Declaration of Rabbi Amrom Fisher."¹⁵ Opposer states that the declaration was previously served on Applicant pursuant to Fed. R. Civil P. 26(a)(2) on October 28,

¹³ 17 TTABVUE.

¹⁴ 28 TTABVUE. The rebuttal testimony declarations are from Joseph Itzkowitz, Yaacov Schwartz and Aaron Schwartz.

¹⁵ 20 TTABVUE 4 and 21 TTABVUE 281.

2022 via email.¹⁶ Fisher presented himself as an expert in the Yiddish language, testifying as to the meaning of the word “mentch,” “mench,” or “mensch” as well as to the diminutive spellings of the word.¹⁷ The declaration also includes Fisher’s testimony and documentation about his educational credentials and work experience with Yiddish and English.¹⁸

For its part, Applicant’s President Toby Horowitz, while not captioning her declaration as expert testimony, countered that she also speaks Yiddish, and offered her opinion about the use of plural endings in Yiddish and the meaning of the proposed mark MENTCHEES.¹⁹ She too testified as to her personal and work experience speaking Yiddish.²⁰ During Opposer’s oral cross examination of Horowitz, she also offered her opinion in writing of transliterations and translations of Hebrew words.²¹ Unlike Opposer, there is nothing in the record to suggest that during discovery Applicant properly served upon Opposer an expert disclosure as required by Trademark Rule 2.120(a)(2)(ii), 37 C.F.R. § 2.120(a)(2)(ii).

Opposer objects to Horowitz’s testimony on the basis that she was not proffered as an expert and is unqualified because she “purports to speak Hebrew and have a background in education and thereafter makes a number of pronouncements about

¹⁶ 20 TTABVUE 4.

¹⁷ Fisher Decl. ¶¶ 17-26; 21 TTABVUE 283-284.

¹⁸ Fisher Decl. ¶¶ 10-16; 21 TTABVUE 281-282 and 287-290.

¹⁹ Horowitz Decl. ¶¶ 13, 15-24, 26-53, 58 and 72; 26 TTABVUE 16-19.

²⁰ Horowitz Decl. ¶¶ 26-34; 26 TTABVUE 17-18.

²¹ 32 TTABVUE 234-238.

Hebrew, Yiddish, and English languages. [Her] highest level of education is high school, she has no credentials that could qualify her as an expert, she admits that any teaching she allegedly did was unlicensed, has no experience conducting surveys, and has no professional credentials in the study of linguistics or etymology.”²² Applicant counters that Horowitz’s testimony is not being offered as expert testimony; rather, her testimony to falls within the scope of Fed. R. Evid. 701 which governs the scope of lay witness testimony.²³

We disagree with Applicant’s characterization of certain portions of Horowitz’s testimony as a fact, not expert, witness. More troubling, however, is that both parties failed to follow Board rules and practice which makes clear that parties intending to call a testifying expert witness at trial must inform the Board during the discovery period thirty days prior to the close of discovery²⁴ of its plans and inform the Board that they have served the required expert disclosures on their adversary. *See RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 n.3 (TTAB 2013) (a party must notify the Board of its plan to use an expert, and that it has made required expert disclosures to adversary). Any expert who testifies at trial must be

²² Opposer’s Brief; 40 TTABVUE 46.

²³ Fed. R. Evid. 701 provides that “if a witness is not testifying as an expert, testimony in the form of an opinion is limited to one that is: (a) rationally based on the witness’s perception; (b) helpful to clearly understanding the witness’s testimony or to determining a fact in issue; and (c) not based on scientific, technical, or other specialized knowledge within the scope of [FRE] 702.”

²⁴ The Board may reset the deadline for making pretrial expert disclosures with the caveat that “an expert disclosure deadline must always be scheduled prior to the close of discovery.” MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

disclosed to the Board in a timely manner so that the Board can suspend proceedings to allow the adverse party the opportunity to take limited discovery of the testifying expert. Trademark Rule 2.120(a)(2)(iii), 37 C.F.R. § 2.120(a)(2)(iii), further explains the parties' obligations and Board procedure with regard to expert testimony:

Disclosure of expert testimony must occur in the manner and sequence provided in Rule 26(a)(2) of the Federal Rule of Civil Procedure, unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.

See also Fed. R. Civ. P. 26(a)(2) (“Disclosure of Expert Testimony”).

Under Fed. R. Civ. P. 26(a)(2) consulting experts, i.e., an expert who merely advises counsel and does not testify at trial, are shielded from discovery and do not have to be disclosed in pretrial disclosures. *See Ate My Heart, Inc. v. GA Jeans Ltd.*, 111 USPQ2d 1564, 1567 (TTAB 2014) (explaining the differences between testifying and non-testifying consulting experts). By contrast, an expert who testifies at trial must be disclosed in pretrial disclosures so that the Board can suspend proceedings to permit the adverse party the opportunity to take limited discovery of the testifying expert. *Id.*

Since neither party informed the Board of its intent to call testifying expert witnesses at trial, we will disregard all of Fisher and Horowitz's “expert” opinion

testimony. We decline, however, to strike the Fisher and Horowitz testimony declarations in their entirety and exhibits to Horowitz's oral cross-examination deposition. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (the Board does not ordinarily strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony at final hearing); *Krause v. Krause Publ'ns Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (same); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (same). Rather, we have considered the probative value of each witness' trial testimony as fact witnesses. For example, we have disregarded any opinion testimony regarding whether Applicant's mark is Yiddish or the ultimate disposition of the claims asserted herein. *See, e.g., Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *2 (TTAB 2019) (sustaining objection to portion of testimony declaration where witness opined on the ultimate disposition of the claim); *see also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (same); *The Mennen Co. v. Yamanouchi Pharm. Co.*, 203 USPQ 302, 305 (TTAB 1979) (same). We have also weighed the probative value of their testimony against any potential bias, hostility or animus given that the parties are competitors. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014). Consistent with our practice, "[w]here we have relied on testimony to which respondent objected, it should be apparent to

the parties that we have deemed the material both admissible and probative to the extent indicated in the opinion.” *Krause*, 76 USPQ2d at 1907.

E. Opposer’s Objections to the Testimony Declaration of Applicant’s President Toby Horowitz

1. Attorney Prepared

Opposer objects to the entirety of Applicant’s testimony declaration of its President, Toby Horowitz, on the ground that her attorney prepared the declaration on her behalf.²⁵ This objection goes to the probative value of the Horowitz Testimony Declaration and not to its admissibility. Opposer’s objection is overruled.

2. Applicant’s Failure to Disclose Identity of Person Referenced in Horowitz Declaration in Pretrial Disclosures

Opposer objects to Paragraph Nos. 59-60 of the Horowitz Testimony Declaration on the ground that they include “statements that Applicant collaborated with another person to create her products, but Applicant never identified the other person, either in the declaration or in any Rule 26(a) disclosures, thereby preventing Opposer from deposing that person and developing contravening evidence, particularly regarding the supposed dates on which the alleged activities occurred.”²⁶ The objected-to paragraphs are as follows:²⁷

59. The artwork for each MENTCHEES is drawn and created by me and/or one or more artists and designers employed by or under a contract with the Applicant.

²⁵ Opposer’s Brief; 40 TTABVUE 45.

²⁶ Opposer’s Brief; 40 TTABVUE 45.

²⁷ 26 TTABVUE 20.

60. To create each MENTCHEES, I instruct the artist or designer about what is desired for the toy figure.

We overrule the objection as frivolous and having no bearing on any of the substantive claims before us. Horowitz was merely describing the creative process for designing and manufacturing her products.

3. Hearsay

Opposer objects to Paragraph Nos. 15-25, 107-120, 122-128, 129-140 and 142-149 of the Horowitz Declaration on the ground that the statements constitute hearsay under Fed. R. Evid. 801 and 802. We address each of Opposer's hearsay objections in turn.

i. Paragraph Nos. 15-25²⁸

The objected-to paragraphs are as follows:

15. When people talk to me about my toy figures, they also pronounce the word "MENTCHEES" with a long "e" sound followed by an "s" sound, and not like any of the words "mentch", "mensch", "mensches", or "menschen".

16. MENTCHEES is not a word in Yiddish spelled using Hebrew/Yiddish letters.

17. I have never created a word in Yiddish using Hebrew/Yiddish letters that when pronounced, sounds like MENTCHEES.

18. I do not translate the word "MENTCHEES" into Yiddish (using Hebrew/Yiddish letters) when used in connection with my products.

²⁸ 26 TTABVUE 16-17.

19. No one I know translates the word “MENTCHEES” into Yiddish (using Hebrew/Yiddish letters) when used in connection with my products.

20. The word “MENTCHEES” is not an intentional misspelling of the Yiddish word “mensch”, or “mentch” or any other singular form of the Yiddish word when transliterated into English letters.

21. The word “MENTCHEES” is not an intentional misspelling of the Yiddish word “menschen” or “mentches” any other plural form of the Yiddish word when transliterated into English letters.

22. The presence of the ending or suffix “EES” in the word MENTCHEES is important to distinguish it from transliterated words of “mensch” and the like since it provides the mark with not only a different spelling, but also a different pronunciation.

23. I did not or do not use the word “MENTCHEES” as a plural word, or even consider the word MENTCHEES to be a plural word, even though it ends with the letter “s” which in English usually but not always indicates a plural form, but rather consider each toy figure sold under the mark taken individually to be a MENTCHEES.

24. I coined the word MENTCHEES for toy figures that would provide a visual aid to enable children of observant Jewish families, and especially Yiddish-speaking families, to relate to their families by forming the toy figures to be similar in appearance to people they are familiar with in their home environment.

25. Prior to my beginning to use the word MENTCHEES as a trademark, I was not aware of anyone that was then using MENTCHEES or any other similar words that have at their beginning the word “mentch” or a variant thereof and end in “EES” or “IES” or other similar sounding ending for toy figures configured as I created them with Jewish characteristics.

The only statements that constitute hearsay are Paragraph Nos. 15 and 19. *See* Fed. R. Evid. 801(c)(1) and (2). We sustain Opposer's hearsay objection as to those paragraphs.

Paragraph Nos. 24 and 25 are not inadmissible hearsay because Horowitz's statements are based on her personal knowledge and observations and speak to her intent in creating Applicant's applied-for mark. Opposer's objections are overruled.

The remaining paragraphs constitute opinion statements regarding Yiddish and the translation of Applicant's proposed mark. For this reason, Opposer's hearsay objections are overruled. However, given that we have determined that Horowitz's testimony is not admissible as an expert in Yiddish, we accord her statements minimal probative weight.

ii. Paragraph Nos. 107-120²⁹

Horowitz's testimony in Paragraph Nos. 107-110, 112-113, and 117-120 pertains to statements purportedly made by Opposer's witness Joseph Itzkowitz concerning Itzkowitz's use of the terms "menchies" or "kinder menchies." Because Itzkowitz's statements were "not ma[d]e while testifying at the current trial," Fed. R. Evid. 801(c)(1), and "offer[ed] in evidence to prove the truth of the matter asserted" therein, Fed. R. Evid. 801(c)(2), we sustain Opposer's hearsay objection.

As to Horowitz's testimony in Paragraph Nos. 111, 114-116, Opposer's hearsay objection is overruled because her testimony does not pertain to out-of-court statements made by Itzkowitz; rather, her testimony is based on her own personal

²⁹ 26 TTABVUE 26-28.

knowledge and observations of Itzkowitz's use of the terms "menchies" or "kinder menchies."

iii. Paragraph Nos. 122-128³⁰

The objected-to paragraphs constitute speculative statements regarding the Jewish observant and Yiddish-speaking communities' perception of quality of Applicant's and Opposer's toy figures. The paragraphs also include statements that consumers purportedly have confused the source of Applicant's and Opposer's toy figures. Each of the statements constitute hearsay; none of the exceptions apply. *See* Fed. R. Evid. 801, 802 and 803(21) and (22). Opposer's objections are sustained.

iv. Paragraph Nos. 129-140 and 142-149³¹

Horowitz's testimony in Paragraph Nos. 129-140 and 142-149 pertains to "rumors" about Opposer and its CEO Yaacov Schwartz as well as Horowitz's purported business dealings with Opposer and its CEO and their interactions. Opposer's hearsay objections are sustained. *See* Fed. R. Evid. 801(c)(1) and (2).

F. Opposer's Objections to Applicant's Notice of Reliance

1. Third-Party Registrations

Applicant submitted under notice of reliance copies of third-party registrations consisting of marks comprised of the term MENSCH or its phonetic equivalent.³²

³⁰ 26 TTABVUE 28-29.

³¹ 26 TTABVUE 29-31.

³² 26 TTABVUE 35-51.

Opposer moves to strike the registrations on grounds they are irrelevant, prejudicial and inconclusive as to Opposer's substantive claims under Fed. R. Evid. 401 and 403.

Opposer's objection is overruled. There is no question that third-party registrations properly made of record under notice of reliance are admissible. *See* TBMP § 704.03(b)(1)(B) and authorities cited therein. While we agree with Opposer that third-party registrations are not per se conclusive on the issues of whether an applied-for mark is generic or merely descriptive, that does not provide a basis for striking the registrations from the record. Opposer's concerns go to the probative weight of the third-party registrations in determining whether Applicant's mark is generic or merely descriptive and not to their admissibility. The Board will examine the relevance of each registration below. *See, e.g., In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977) (disregarding third-party registrations including the term "SCHOLASTIC" on grounds that they did not involve the services set forth in the application before the Board).

2. Applicant's "Website Printouts"

Opposer moves to strike Exhibits DX-014 through DX-036 submitted under Applicant's Notice of Reliance³³ on the ground that the exhibits are not printouts from Applicant's website as Applicant represents on its Notice of Reliance Cover Sheet.³⁴ Opposer asserts that "none of the exhibits are actually representations of the Applicant's website," or "true and correct' printouts," but instead are "fabricated

³³ 26 TTABVUE 222-274.

³⁴ Applicant's Notice of Reliance Cover Sheet, ¶¶ 14-36; 26 TTABVUE 6-9.

exhibits” that “do not accurately reflect what the websites looked like at the time identified in each exhibit.”³⁵

Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2) states:

Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.

We have carefully reviewed each exhibit and agree with Opposer that none of the exhibits appear to be authentic printouts from Applicant’s website. Applicant admits as much in its brief, explaining that it effectively excerpted images and “removed” all “[n]on-relevant material at the website and on the webpages at which these images are present”³⁶ As a result, none of the objected-to exhibits are admissible under Trademark Rule 2.122(e)(2) and Opposer’s objection is sustained.

3. Newspaper Article

Opposer moves to strike an article entitled “His Hasidic Toy Story” by Kristen Clark from the Forward Newspaper dated March 27, 2014 on the ground that it constitutes as inadmissible hearsay under Fed. R. Evid. 801 and 802.³⁷

The objection is sustained to the extent that the statements made in the article constitute hearsay and cannot be used to prove the truth of the matter asserted therein. However, we decline to strike the article because it is admissible as a printed

³⁵ Opposer’s Brief; 40 TTABVUE 48.

³⁶ 41 TTABVUE 12.

³⁷ 26 TTABVUE 268-274.

publication and may be relevant to show descriptive or generic usage of a term. *See, e.g., In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles are not used to support the truth of the statements therein but to show descriptive usage of term).

III. The Parties

A. Opposer

Opposer is based in Brooklyn, New York and specializes in the design and sale of “educational books, toys, and games for Jewish children.”³⁸ Opposer has created “a line of toys under the brand KINDERVELT,”³⁹ including toy figurines.⁴⁰

Opposer “primarily operates in the wholesale market space and sells its products to other [online and brick-and-mortar] retailers,”⁴¹ including Judaica, Art Scroll, Eichlers, Toys 4 U, and Bubble Blastte.⁴² Opposer also owns and operates 18th Avenue Toys, Ltd. and Toys2Discover.⁴³ Toys2Discover sells Opposer’s products via retail brick-and-mortar stores in multiple locations in Brooklyn and via its direct-to-consumer website www.toys2discover.com.⁴⁴

B. Applicant

Applicant Mitzvah Kinder, Inc. is also based in Brooklyn, New York. Applicant’s

³⁸ Y. Schwartz Decl. ¶ 8; 21 TTABVUE 252.

³⁹ Y. Schwartz Decl. ¶ 15; 21 TTABVUE 252.

⁴⁰ Y. Schwartz Decl. ¶ 17; 21 TTABVUE 253.

⁴¹ Y. Schwartz Decl. ¶ 9; 21 TTABVUE 252.

⁴² Y. Schwartz Decl. ¶ 56; 21 TTABVUE 259.

⁴³ Y. Schwartz Decl. ¶¶ 10-13; 21 TTABVUE 252.

⁴⁴ Y. Schwartz Decl. ¶¶ 10-13; 21 TTABVUE 252.

President Toby Horowitz testified that in 2012, she “created toy figurines with traditional Jewish clothing and characteristics to appeal to observant Jewish parents and children seeking toy figures that comply with the Jewish code of law (Halacha).”⁴⁵ Horowitz testified that she came up with the trademark MENTCHEES for Applicant’s toy figurines in 2012⁴⁶ because she thought that adding “the ending ‘EES’ to the word ‘mentch’” resulted in “a cute and unique word” and “catchy term.”⁴⁷ She views the MENTCHEES toy figures she designs as “a visual aid to enable children of observant Jewish families, and especially Yiddish-speaking families, to relate to their families by forming the toy figures to be similar in appearance to people they are familiar with in their home environment.”⁴⁸

Applicant’s toy figurines are sold in many of the same online and brick-and-mortar retail stores as Opposer such as Toys4U, Judaica Place, and Eichlers.⁴⁹ Applicant also sells its products at Mekor Judaica, Malkys Toy Store, and Hamafitz as well as through its own direct-to-consumer website at www.mitzvahkinder.com.⁵⁰

⁴⁵ Horowitz Decl. ¶ 5; 26 TTABVUE 14-15.

⁴⁶ Horowitz Decl. ¶ 7; 26 TTABVUE 15.

⁴⁷ Horowitz Decl. ¶¶ 11-12; 26 TTABVUE 16.

⁴⁸ Horowitz Decl. ¶ 24; 26 TTABVUE 17.

⁴⁹ Applicant’s Response to Opposer’s First Set of Interrogatories No. 12; 20 TTABVUE 72-73. *See also* Horowitz Decl. ¶¶ 106-107; 26 TTABVUE 26 (“For several years, I have done business with Mr. Joseph Itzkowitz, owner of Toys 4 U, Inc. for which a Declaration was provided in testimony by Opposer. Mr. Itzkowitz has sold my products at his company’s stores.”).

⁵⁰ Applicant’s Response to Opposer’s First Set of Interrogatories No. 12; 20 TTABVUE 72-73.

IV. Entitlement to a Statutory Cause of Action

An opposer in any inter partes case before the Board must prove its entitlement to a statutory cause of action. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Section 13 of the Trademark Act, 15 U.S.C. § 1063(a), states:

Any person who believes that he would be damaged by the registration of a mark upon the principal register, ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered.

To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, Opposer must demonstrate (1) that its claims fall within the zone of interests protected by the statute (i.e., has a “real interest” in the outcome of the proceeding); and (2) damage proximately caused by the proposed registration (i.e., a reasonable basis for its belief in damage). *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa*, 111 USPQ2d 1162; *see also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999) (defining a “real interest” as a “direct and personal stake” in the outcome of the proceeding).

Entitlement to a statutory cause of action for a mere descriptiveness claim may be alleged and ultimately proven on the basis that the plaintiff is a competitor of the defendant and has an interest in using the term descriptively in its business. *See, e.g., Nobelle.Com, LLC v. Qwest Commc'ns Int'l, Inc.*, 66 USPQ2d 1300, 1304 (TTAB 2003) (standing to assert descriptiveness requires only that plaintiff has right to use term descriptively in its business); *Plyboo Am. Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.5 (TTAB 1999) (“standing to oppose [on the ground of mere descriptiveness] is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business”) (internal citation omitted). *Cf. Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (finding competitor has standing, now known as entitlement to a statutory cause of action, because it has an interest in the outcome beyond that of the general public). This same logic applies to genericness claims as well.

Opposer's owner and Chief Executive Officer Yaacov Schwartz testified that Applicant “is a direct competitor” because “[b]oth companies specialize in Jewish educational games, toys, and books.”⁵¹ He testified that Opposer sells “Jewish themed toys” (i.e. small figurines) which it calls “mentchies,”⁵² sold online and at various

⁵¹ Y. Schwartz Decl. ¶ 80; 21 TTABVUE 264.

⁵² Y. Schwartz Decl. ¶ 55; 21 TTABVUE 259.

brick-and-mortar toy stores under the brand name KinderVelt.⁵³ He further testified as to the reasons why Opposer refers to its toy figurine product line under this term:⁵⁴ Yaacov Schwartz further explained that Opposer needs to use the term “mentchies” to describe its toy figurines, and that if Applicant obtained a trademark registration for the phonetic equivalent MENTCHEES it would impede Opposer’s ability to describe its toy figurines and cause financial harm:⁵⁵

Based this on testimony, we find that Opposer has an interest falling within the zone of interests protected by Section 13 of the Trademark Act and a reasonable belief in damage proximately caused by the proposed registration of Applicant’s mark MENTCHEES for “Toy figures; Modeled plastic toy figurines; Molded toy figures.” Opposer has proven its statutory entitlement to bring this action by a preponderance of the evidence.

V. Genericness Claim

“A generic name—the name of a class of products or services—is ineligible for federal trademark registration.” *USPTO v. Booking.com B.V.*, 591 U.S. 549, 140 S. Ct. 2298, 2020 USPQ2d 10729, at *2 (2020). “Because generic terms ‘are by definition incapable of indicating a particular source of the goods or services,’ they cannot be registered as trademarks.” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *In re Dial-A-Mattress*

⁵³ Y. Schwartz Decl. ¶ 55; 21 TTABVUE 259.

⁵⁴ Y. Schwartz Decl. ¶ 61; 21 TTABVUE 260.

⁵⁵ Y. Schwartz Decl. ¶¶ 85-87; 21 TTABVUE 265.

Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001)); *see also In re Cordua Rests.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016). “Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold.” *In re Dial-A-Mattress*, 57 USPQ2d at 1810 (citations omitted). *See also Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1366 (Fed. Cir. 2018). Generic terms can neither be registered on the Principal Register under Trademark Act Section 2(f) nor on the Supplemental Register under Trademark Act Section 23.

“The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *Princeton Vanguard*, 114 USPQ2d at 1830 (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). This determination “involves a two-step inquiry: First, what is the genus 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; *see also Princeton Vanguard*, 114 USPQ2d at 1829 (“there is only one legal standard for genericness: the two-part test set forth in *Marvin Ginn*”).

A. What Is the Genus?

Because the identification of goods in an application defines the scope of rights that will be accorded the owner of any resulting registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), generally “a proper genericness inquiry focuses

on the description of [goods] set forth in the [application or] certificate of registration.”
In re Cordua Rests., 118 USPQ2d at 1636 (internal citation omitted).

“[A] term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *In re Cordua Rests.*, 118 USPQ2d at 1638 (holding CHURRASCOS, a word that is generic for a type of grilled meat, to be generic for restaurant services because it referred to a key aspect of those services). Any term that the relevant public uses or understands to refer to the genus of goods or services, or a key aspect or central focus or subcategory of the genus, is generic. *Royal Crown*, 127 USPQ2d at 1046-47 (directing the Board to consider whether the relevant public understands the term ZERO to refer to a key aspect of at least a sub-group or type of the claimed genus of beverages, which encompassed zero-calorie beverages as a sub-group); *In re Empire Tech, Dev. LLC*, 123 USPQ2d 1544 (TTAB 2017) (COFFEE FLOUR held generic for a type of flour made from coffee cherry skins, pulp, and pectin); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389, 1391 (TTAB 1991) (finding PERMA PRESS generic for soil and stain removers for permanent press fabrics because “the term ‘perma press’ may be considered a term identifying a category of goods at issue—perma press products (including perma press soil and stain removers)”). As explained by the U.S. Court of Appeals for the Federal Circuit in *Royal Crown*:

[The Federal Circuit] also explained that “a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public

does not understand the term to refer to the broad genus as a whole.”

In *In re Cordua*, we found that the term “churrasco” was generic, even for use in connection with a broad class of restaurant services, because the key public would understand the term to be referring to a specialty dish—a sub-aspect of restaurant services. We made clear that “[t]here is no logical reason to treat differently a term that is generic of a category or class of products where some but not all of the goods identified in an application fall within that category.” **We pointed out, for instance, that the term “pizzeria” would be generic for restaurant services, even though the public does not understand the term to refer to the broad class of restaurants as a whole; the public need only understand that the term refers to “a particular subgroup or type of restaurant rather than to all restaurants.”**

Royal Crown, 127 USPQ2d at 1046 (quoting in part *In re Cordua Rests.*, 118 USPQ2d at 1637) (internal citations omitted) (emphasis added).

The record shows that Applicant’s toy figures and figurines are dressed in traditional Jewish attire and/or coiffed with traditional Jewish hairstyles.⁵⁶ As Applicant’s President Horowitz explained:⁵⁷

the toy figurines ... included an adult male with a beard and sidelocks (peyot), the typical hairstyle of Chassidim (devout Jews), and a fur hat (streimel) on its head that Chassidim wear on Shabbat, an adult female with modest attire (no emphasis on her bust) and having head tied with a kerchief not to expose her “hair” as per our religious code in which adult women’s hair is covered, a little boy with

⁵⁶ For example, “The grandfather and grandmother characters sold in the 2 piece Mentchees Set | Zeidy and Bubby are fictitious characters dressed in traditional Jewish fashion for a grandfather and grandmother and are not based on or intended to represent any living male and female adults.” Horowitz Decl. ¶ 78; 26 TTABVUE 22.

⁵⁷ Horowitz Decl. ¶ 6; 26 TTABVUE 15. This is the description of Applicant’s “first batch” of toy figurines sold under the trademark Mitzvah Kinder. *Id.* Applicant then changed the trademark to MENTCHEES “in or around 2012.” Horowitz Decl. ¶ 7; 26 TTABVUE 15.

tzitzis (fringes on his shirt as is worn by observant Jewish males), peyot, a kipah (head covering as is worn by observant Jewish males) and a tzedaka box in his hand, a little girl referred to as “Malky” dressed with long sleeves and her dress covering her knees (as is traditionally worn by observant Jewish female children), and a baby referred to as “Chaim” holding a torah.

Below are excerpts of the substitute specimen submitted during prosecution displaying Applicant’s proposed mark MENTCHEES:⁵⁸



⁵⁸ Substitute Specimen submitted on May 10, 2021 at TSDR 2 and 4 (.pdf format).



We therefore find that the genus is defined by the identification, “Toy figures; Modeled plastic toy figurines; Molded toy figures,” which, as unrestricted, is sufficiently broad to encompass the subgenus or narrower category of toy figures, modeled plastic toy figurines, and molded toy figures dressed in traditional Jewish

attire and/or coiffed with traditional Jewish hairstyles. *See, e.g., Royal Crown*, 127 USPQ2d at 1043 (“the Board found that the proper genus of the goods is ‘the broad category of soft drinks (and sports and energy drinks), which encompasses the narrower category of soft drinks (and sports and energy drinks) containing minimal or no calories.’”); *Alcatraz Media*, 107 USPQ2d at 1761 (for mark ANNAPOLIS TOURS, finding services identified as “conducting guided tours of historic districts and other areas of cities” adequately defined genus and were sufficiently broad to include tours of the city of Annapolis).

B. Who Is the Relevant Public?

Next we determine the relevant public. In the context of a genericness inquiry, the relevant public is “the actual or potential purchasers of the [goods].” *Loglan Inst. Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (internal citation omitted). Here, because there are no restrictions on or limitations to the channels of trade or classes of consumers in the application on appeal, the relevant public comprises ordinary consumers who purchase “Toy figures; Modeled plastic toy figurines; Molded toy figures” including those members of the public seeking toy figurines dressed in traditional Jewish attire and/or coiffed with traditional Jewish hairstyles. *See In re Mecca Grade Growers*, 125 USPQ2d 1950,1957 (TTAB 2018) (Board took into account that the identification contained no restrictions as to trade channels or end users in determining the relevant public).⁵⁹

⁵⁹ Opposer urges the Board to limit the relevant public to “observant Jewish individuals seeking to incorporate traditional Jewish themes into children’s play” arguing that “[t]here is no dispute by either side that the relevant purchasing public is niche, given the religious

C. Does the Relevant Public Understand MENTCHEES to Primarily Refer to the Genus or Subgenus?

We now turn to the question of whether the designation MENTCHEES is understood by the relevant purchasing public as primarily referring to toy figures, modeled plastic toy figurines, molded toy figures dressed in traditional Jewish attire and/or coiffed with traditional Jewish hairstyles. Whether a particular term is generic is a question of fact. *In re Cordua Rests.*, 118 USPQ2d at 1634.

“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.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)); *see also In re Cordua Rests.*, 118 USPQ2d at 1634; *Princeton Vanguard*, 114 USPQ2d at 1830. “Evidence informing [a genericness] inquiry can [also] include ... usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning.” *Booking.com*, 2020 USPQ2d 10729, at *7 n.6.

A slight misspelling or the phonetic equivalent of a generic designation does not obviate the generic nature of the term. *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX held generic for mineral licks for feeding livestock); *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990), *aff’d*, 20 USPQ2d 1319 (Fed. Cir.

and ethnic connotation in the dolls themselves” Opposer’s Brief; 40 TTABVUE 17. We see no reason to limit the purchasing public in this manner given that non-observant Jewish individuals may also seek Applicant’s goods for a variety of reasons (for example, as a gift).

1991) (ICE PAK for reusable ice substitute for use in food and beverage coolers held generic).

There are no English or Yiddish dictionary definitions in the record for the proposed mark MENTCHEES or its phonetic equivalent. Nonetheless, the fact that a term is not found in a dictionary is not controlling on the question of genericness if the record shows that the term has a well understood and recognized meaning. *See In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *1, *8 (TTAB 2019) (citing *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1603 (TTAB 2014); *cf. In re Dairimetics, Ltd.*, 169 USPQ 572, 573 (TTAB 1971) (holding ALGAE WAFERS merely descriptive of fish food although the term was not found in the dictionary); *In re Orleans Wines, Ltd.*, 196 USPQ 516, 516-17 (TTAB 1977) (holding BREADSPRED merely descriptive of jellies and jams although the term was not found in the dictionary). Indeed, evidence of current usage may carry more weight than dictionary evidence. *See In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 (TTAB 2017) (finding modern-day usage of “well-living” more significant than dictionary definition). Such is the case here.

The record includes third-party website excerpts from retailers such as Walmart, Eichlers, Judaica Plaza, Toys4You, Judaica Place and Binyan Blocks showing use of the term “mentchees,” or the phonetic equivalent thereof, as a designation for the subcategory of toy figures, modeled plastic toy figurines, molded toy figures dressed in traditional Jewish attire and/or coiffed with traditional Jewish hairstyles. *See In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007)

(finding third-party websites competent sources for determining what the relevant public understands mark to mean). Below we summarize the most persuasive website evidence in the record from third parties:

- A screen capture from the online retailer Judaica Plaza showing the search results for the category “**Mentchees**” retrieving over 40 products of toy figurines manufactured by Applicant and Opposer. Some examples below include Kinder Velt Shabbos Family Pack, Kinder Velt Extended Family Pack, Mitvah Kinder Purim Set, and Mitvah Kinder Cousins.⁶⁰

⁶⁰ https://judaicaplaza.com/collections/toys-mentchees/categories_mentchees accessed on September 16, 2020; 20 TTABVUE 43-46.

"PLEASE NOTE" All orders received after Thursday Sep 17, 3:00 PM will be processed after Rosh Hashana- Local Delivery- Greater Lakewood Area- Use code "WEBFREE" - Free Shipping on all orders over \$35. Same Day Delivery Orders Must be in by 1:30 pm and Friday by 11:30 am. All shipping orders received after 4:00 pm will be processed the next day.

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Filters

Mentchees

Categories

- Children
- Mentchees
- Mitzvah Kinder Collectibles
- Occasion
- Toys & Games
- Upsherin








Toys - Mentchees

41 products

Filter (1) Display: 48 per page Sort bySort by: Best selling View

Mentchees












41 results

 <p>Take Along Dollhouse - Hatzalah \$22.99</p> <p>Add to cart Quick view</p>	 <p>Kinder Velt: Shabbos Family Pack (30+ Pack) \$45.99</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Mega Bucket 60+ \$159.99</p> <p>Add to cart Quick view</p>	 <p>Kinder Velt: Extended Family Pack (10 Pack) \$29.99</p> <p>Add to cart Quick view</p>
 <p>Mitzvah Kinder - Purim Set</p>	 <p>Mitzvah Kinder - Cousins</p>	 <p>Mitzvah Kinder - Pop Up Toy</p>	

https://judaicaplaza.com/collections/toys-mentchees/categories_mentchees

9/16/2020 Toys - Merchises - Judaica Plaza

see along with more - actual set

<p>\$17.00</p> <p>Add to cart</p> <p>Quick view</p> 	<p>\$17.00</p> <p>Add to cart</p> <p>Quick view</p> 	<p>\$22.00</p> <p>Add to cart</p> <p>Quick view</p> 	<p>\$17.00</p> <p>Add to cart</p> <p>Quick view</p>
<p>Mitzvah Kinder - Girls Hefkes Yadayim Set - Glow in the dark</p> <p>\$14.00</p> <p>Add to cart</p> <p>Quick view</p>	<p>Mitzvah Kinder - Boys Hefkes Yadayim Set - Glow in the dark</p> <p>\$14.00</p> <p>Add to cart</p> <p>Quick view</p>	<p>Mitzvah Kinder - Girls Hefkes Yadayim Set - Green</p> <p>\$14.00</p> <p>Add to cart</p> <p>Quick view</p>	
			
<p>Mitzvah Kinder - Girls Hefkes Yadayim Set - Pink</p> <p>\$14.00</p> <p>Add to cart</p> <p>Quick view</p>	<p>Mitzvah Kinder - Bedtime Merchises</p> <p>\$21.00</p> <p>Add to cart</p> <p>Quick view</p>	<p>Mitzvah Kinder - Girls Bedroom</p> <p>\$34.00</p> <p>Add to cart</p> <p>Quick view</p>	<p>Mitzvah Kinder - Guest Room</p> <p>\$36.00</p> <p>Add to cart</p> <p>Quick view</p>
			
<p>Mitzvah Kinder - Dancing Matzah</p> <p>\$27.00</p>	<p>Mitzvah Kinder - Dancing Matzah</p> <p>\$27.00</p>	<p>Mitzvah Kinder - Seder Torah Set</p> <p>\$6.00</p>	<p>Mitzvah Kinder - Cheshbon Set</p> <p>\$104.00</p>

<https://judaicaplaza.com/collections/toys-merchises/categories/merchises>

9/16/2020

Toys - Mitzvoches - Judaica Plaza










 <p>Mitzvah Kinder - Twin Girls - Mindy & Hindy \$6.00</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Tobby Set \$17.99</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Mommy Set \$17.99</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Seferim Room \$26.99</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Shul Set \$60.00</p> <p>Add to cart Quick view</p>
 <p>Mitzvah Kinder - Toys & Shiloh \$8.00</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Mitzah Toy Set - Libiah \$21.00</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Mitzah Toy Set - Chassidish \$21.99</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Playgo Bucket #2 \$60.00</p> <p>Add to cart Quick view</p>	
 <p>Mitzvah Kinder - Playgo Bucket #1 \$60.00</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Fater Fischel & Mr. Kaplovsky \$6.00</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Shabbos Twins - Yossi & Tinky \$6.00</p> <p>Add to cart Quick view</p>	 <p>Mitzvah Kinder - Zaidy & Bobby \$6.00</p> <p>Add to cart Quick view</p>	

<https://judaicaplaza.com/collections/toys-mitzvoches/categories/mitzvoches>

3/5

9/16/2020

Toys - Mentchees - Judaica Plaza

 <p>Mitzvah Kinder - Twins - Yosi & Yanky \$8.00</p> <p>Add to cart</p> <p>Quick view</p>	 <p>Mitzvah Kinder - Community Helpers \$20.00</p> <p>Add to cart</p> <p>Quick view</p>	 <p>Mitzvah Kinder - Livish Set \$17.00</p> <p>Add to cart</p> <p>Quick view</p>	 <p>Kinder Welt: Rafuah Sheleimah Pack (8 Pack) \$26.00</p> <p>Add to cart</p> <p>Quick view</p>
 <p>Kinder Welt: Yerushalmi Pack (8 Pack) \$17.00</p> <p>Add to cart</p> <p>Quick view</p>	 <p>Kinder Welt: Haduken Heroes Pack (12 Pack) \$15.00</p> <p>Add to cart</p> <p>Quick view</p>	 <p>Kinder Welt: Boy With Torah And Girl With Duff (2 Pack) \$6.00</p> <p>Add to cart</p> <p>Quick view</p>	
 <p>Kinder Welt: Zaidy And Buby (3 Pack) \$8.00</p> <p>Add to cart</p> <p>Quick view</p>	 <p>Kinder Welt: Chosson And Kalilah (2 Pack) \$6.00</p> <p>Add to cart</p> <p>Quick view</p>		

<https://judaicaplaza.com/collections/toys-mentchees/categories/mentchees>


4







- A screenshot of the categories list from the online retailer Eichlers showing “**Menchies**” as a standalone category of products and retrieving toy figurines manufactured by Applicant and Opposer or distributed by Opposer. The search results under the “Menchies” category include Mitvah Kinder Cousins, Chasuna Dancing Mentcheleh Boys, Take Along Girls School Set, Back to School Mitzva Kinder Twins, Mitvah Kinder Shelaimah Refuah Collection and Kinder Velt Doll House.⁶¹









⁶¹ <https://www.shopeichlers.com/kids/8> accessed March 3, 2023; Opposer’s Notice of Reliance; 20 TTABVUE 307-308.

Menchies View All









					
Mitzvah Kinder Mitzvah Kinder Cousins \$22.99	Chazak Dist. Chasuna Dancing Mentchelech - Boys \$25.99	Chazak Take Along Girls School Set \$19.99	Chazak Dist. Back to School Mitzva Kinder Twins \$7.99	Chazak Dist. Mitzva Kinder Refuah Shelaimah Collection \$18.99	Chazak Dist. Kinder Velt Doll House \$49.99







Toys View All

					
L'Chaim Mein Leam Shpil - My Learning Toy \$19.99	Pack of 4 Batteries \$1.99	Bow and Arrow Set From \$4.99	L'Chaim Learn and Recording Telephone \$15.99	Rite Lite Pesach 10 Plague Masks \$10.99	Rite Lite Pesach Bag of Frogs \$4.99

Talking Toys View All

					
Pack of 4 Batteries \$1.99	L'Chaim Learning Fun Telephone \$15.99	Mitzvah Family Shpiel Mit Mir Ipad Toy \$29.99	Kinder Shelet Leren Mein Bichele Yiddish With Buttons \$23.99	Kinder Ys Kilt A Gut Shabbos Book - Yiddish \$29.99	L'Chaim Mein Erste Lern Bich - My First Learning Book \$29.99

Stickers View All

					
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- Eichlers website offering for sale a toy figurine called “Shpielman’s Set: Shabboas with Bubby.” Eichlers website describes the set as a “fun way to encourage the love of Torah and Mitzvos, this set features familiar Chassidishe **mentchies** that your child will love to play with.”⁶²

The screenshot shows the Eichlers website interface. At the top, a banner reads "Welcome to our new website! New products, features & updates added daily. Email us: feedback@shopeichlers.com". The navigation bar includes the Eichlers logo, a search bar, and links for "Account" and "Assistance". Below the navigation bar, the breadcrumb trail shows "Children's Games & Toys > Toys > Shpielman's Set: ...". The main product image is a purple box for "The Shpielman's Bubby" set, featuring a figurine of a woman in a striped dress and a red hat, along with two challos and a washing cup. The price is listed as \$4.99. A list of contents includes "Bubby", "Two Challos", and "Washing Cup". Shipping information indicates "Shipping to 98101" with delivery dates of "Get it Sat, December 24" (with free shipping over \$59) and "Get it Thu, December 22" (with express shipping at checkout). A green "Out of stock" button is visible. A red arrow points to the "Overview" section, which contains the text: "A fun way to encourage the love of Torah and Mitzvos, this set features familiar Chassidishe mentchies that your child will love to play with."

⁶² <https://www.shopeichlers.com/products/shpielmans-set-shabbos-with-bubby/43721> accessed December 20, 2022; 20 TTABVUE 109.

- A screenshot from the retailer Toys4You offering for sale Mitvah Kinder's Purim set of toy figurines. The Toys4You website describes the set as "Play Purim all year round, with these adorable **mentchees!** It's a great addition to your Mitvah Kinder Collection."⁶³

⁶³<https://toys4u.com/categories/lego-figures/mitzvah-kinder-purim-set.html> accessed September 17, 2020; 20 TTABVue 57.

9/17/2020

Mitzvah Kinder Purim set - Toys 4 U

FREE Shipping on all orders over \$69.99*



Toys4U



HOME / CATEGORIES / LEGO & FIGURES / MITZVAH KINDER PURIM SET



Mitzvah Kinder

Mitzvah Kinder Purim set

[Write a Review](#)

SKU: Mk126 - Mitzvah Kinder Purim Set

UPC: 807676308160

\$19.99

Out of stock

ADD TO WISH LIST

Out Of Stock



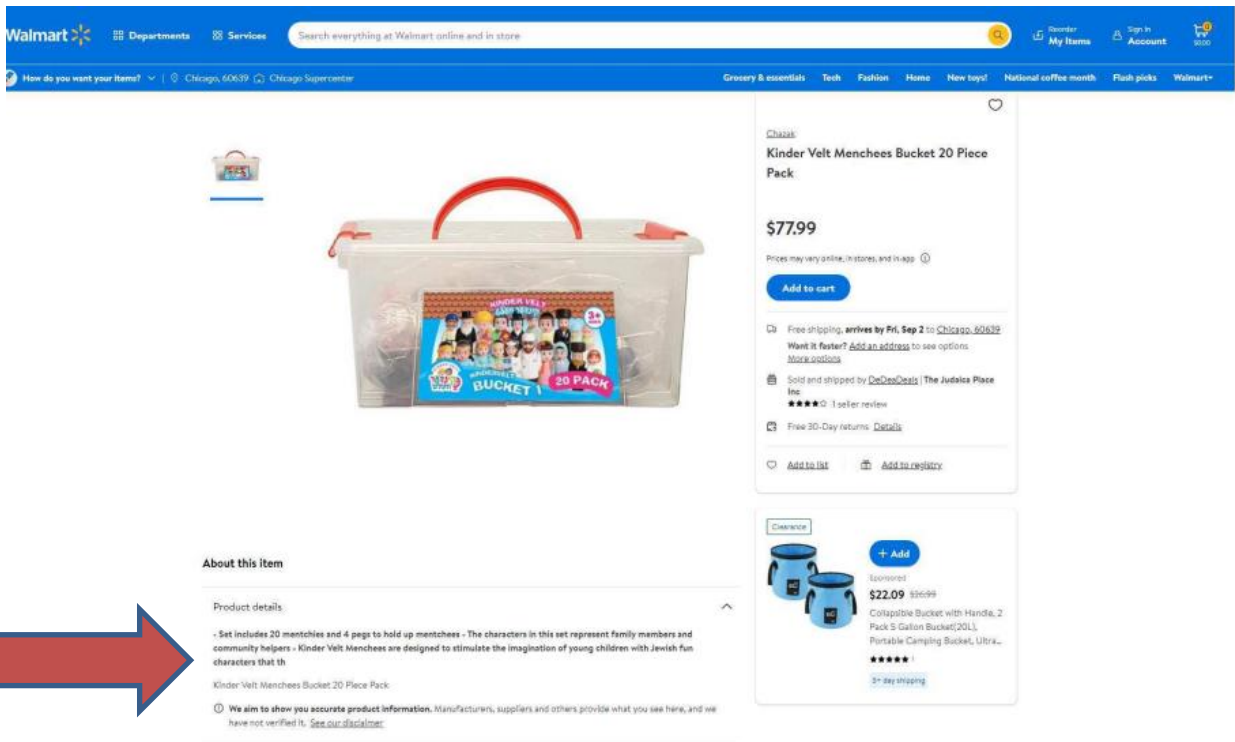
DESCRIPTION

Play Purim all year round, with these adorable mentchees! It's a great addition to your Mitzvah Kinder Collection

Watch those faces glow! Kids will enjoy hours of endless jewish imagination and fun.

[VIEW ALL](#)

- A screenshot from Walmart listing for sale on its website Kinder Velt Menchie's with the description that the toy figurine set “includes 20 **mentchie's** and 4 pegs to hold up **mentchie's**. The characters in the set represent family members and community helpers.”⁶⁴



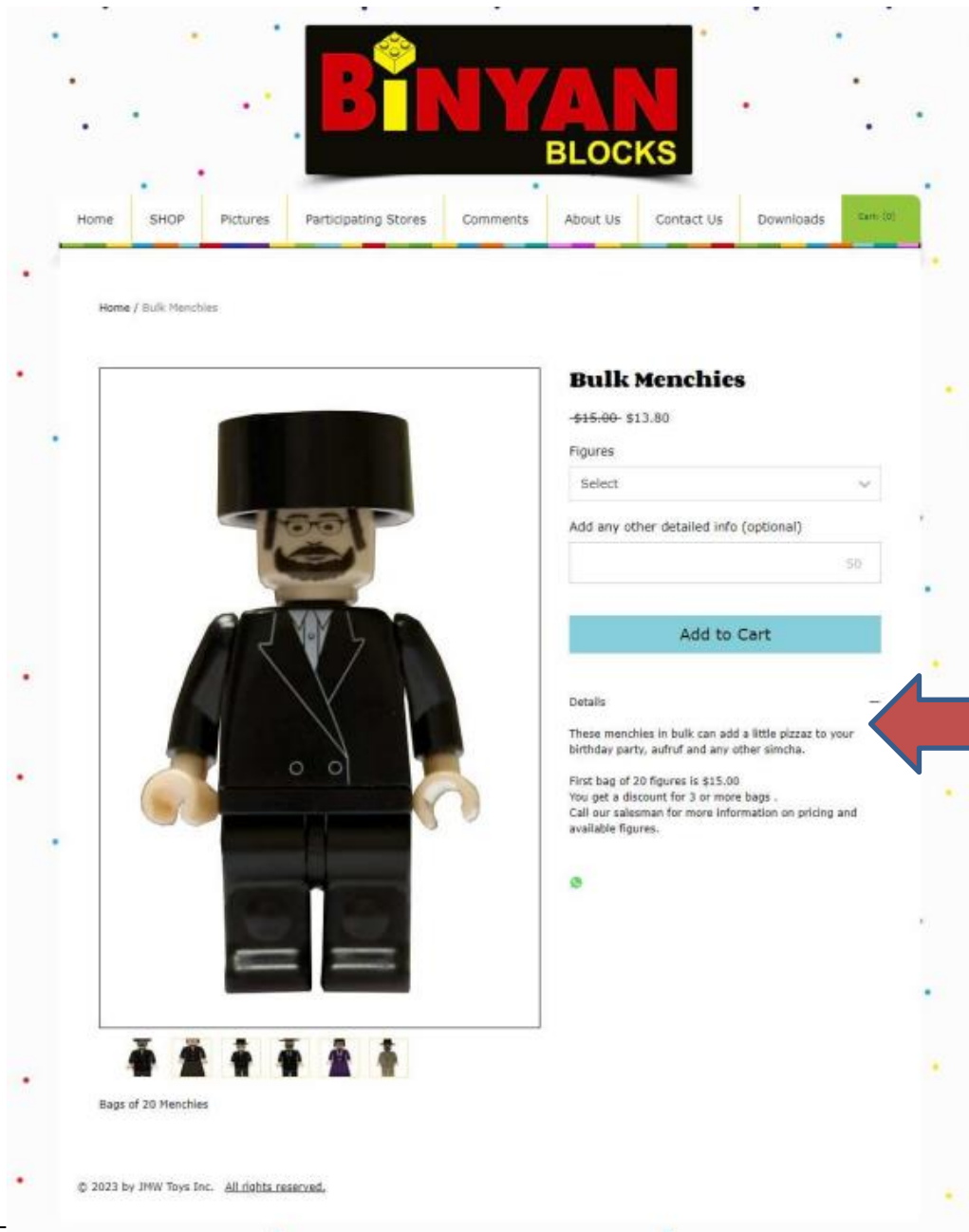
⁶⁴ <https://www.walmart.com/ip/Kinder-Velt-Menchie's-Bucket-20-PiecePack/176991770> accessed August 24, 2022; 20 TTABVue 102.

- Judaica Place offers for sale on its website the “Binyan Blocks Dreidel Set - Assorted Mentchie Figures” with the description that the “**Mentchie** Figure can either be a girl or boy.”⁶⁵

The screenshot displays the website interface for Judaica Place. At the top, there is a red banner with a 15% off promotion and contact information. Below this is a navigation bar with a search box and various category links. The main content area features a promotional banner for free gifts and a product listing for the 'Binyan Blocks Dreidel Set - Assorted Mentchie Figures'. The product listing includes a thumbnail image, a price of \$7.95 (reduced from \$9.99), a star rating, and an 'ADD TO CART' button. A large red arrow points to the product description, which states: 'Mentchi Figure can be either a girl or a boy. Order will include one. Figure can not be guaranteed. Assembled Dreidle Dimensions 1 1/4" x 2 1/2" H Ages 6+'. The page also includes social media sharing options and a 'Write a Review' section.

⁶⁵ <https://www.judaicaplace.com/binyan-blocks-dreidel-set-assortedmentchiefigures/> accessed December 20, 2022; 20 TTABVue 113.

- Binyan Blocks offers for sale “Bulk Menchies” toy figurines. The website touts that “these **menchies** in bulk can add a little pizzazz to your birthday party, aufruf and any other simcha.”⁶⁶



⁶⁶ <https://www.binyanblocks.com/product-page/bulk-menchies-1> accessed August 23, 2023; 21 TTABVue 77.

Opposer is a competitor of Applicant, and competitor use also is probative on the issue of genericness. *See Booking.com*, 2020 USPQ2d 10729, at *9 (evidence of genericness “can include ... usage by ... competitors”); *Cont’l Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999) (use of term e-ticket by media and competitors indicates term is generic for electronic tickets); *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 176 (TTAB 1986) (evidence that competitors have used a particular word as the name of their goods is persuasive evidence of genericness). Below are examples of Opposer’s product packaging for its Kinder Velt line of toys using “menchees” to indicate the type of toy figurines. Examples include the Kinder Velt “Extended Family Pack” as containing “10 **MENCHEES**”; the Kinder Velt Bucket as containing “20 **MENCHEES**”; and the Kinder Velt Mazel Tov Pack as containing “4 **MENCHEES**.”⁶⁷

⁶⁷ <https://www.shopcreativekids.com/search/mentchies/%20https://www.eichlers.com/kinder-7-v%20elt-yerushalmi-6-piece-pack-kv113.html> accessed December 20, 2022; 20 TTABVUE 76-86.







The above third-party and competitor evidence belies Applicant's contention that its proposed mark MENTCHEES "should be treated like a neologism in Yiddish, i.e., as a word that does not mean anything."⁶⁸ Rather than supporting Applicant's argument, the evidence shows that "mentchee" or its phonetic equivalent is now part

⁶⁸ Applicant's Brief; 41 TTABVUE 35. To use Applicant's own words, we characterize Applicant's argument as "Chutzpah!"

of the U.S. English vernacular to denote a subtype of “toy figure; modeled plastic toy figurines; molded toy figure.” The fact that some of the usage is in the singular as opposed to the plural form of the word that Applicant seeks to register is of no significance.

We are also unpersuaded by Applicant’s submission under notice of reliance of copies of third-party registrations consisting of standard character marks comprised of the term MENSCH or its phonetic equivalent registered on the Principal Register.⁶⁹ The third-party registrations are as follows:⁷⁰

Registration No. 4476105 for the mark MENSCH ON A BENCH for “Decorative toy mobiles and plush toys for children made of felt; Plush toys; Stuffed and plush toys” in International Class 28;

Registration No. 6034686 for the mark SNOWMENSCH for “Plush dolls” in International Class 28;

Registration No. 6702783 for the mark THE MENCH KIDS (KIDS disclaimed) for “Dolls; Dolls for playing; Plush toys; Fabric dolls; Novelty plush toys for parties; Plush dolls; Smart plush toys; Stuffed dolls; Stuffed and plush toys” in International Class 28;

Registration No. 6152529 for the mark MENCH SUPER STAY (SUPER STAY disclaimed) for “Collar stays” in International Class 26;

Registration No. 3519334 for the mark MENCHIE’S for “Ice cream shop services in the nature of a restaurant” in International Class 43; and

⁶⁹ Applicant’s Notice of Reliance; 26 TTABVUE 35-51.

⁷⁰ We have not considered Registration No. 2600810 for the composite mark BREADBAG-ETTES which has been cancelled. *Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) (cancelled registration has no probative value).

Registration No. 3255801 for the mark MENCHES BROS.
for “Restaurant services featuring hamburgers and ice
cream” in International Class 43;

The term “mench” or its phonetic equivalent “mensch” in the first three registrations for dolls and plush toys is not the same as Applicant’s proposed mark MENTCHEES. *See In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *22 (TTAB 2021) (a mark that is merely descriptive or generic does not become registrable simply because other seemingly similar marks appear on the register) (citing *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519. The remaining registrations lack probative value because they are for entirely different goods and services.

Viewing the above evidence as a whole, we find that Opposer has satisfied its burden of demonstrating that the relevant public primarily views the proposed mark MENTCHEES as a generic designation for “Toy figures; Modeled plastic toy figurines; Molded toy figures” which includes the subgenus of such items dressed in traditional Jewish attire and/or coiffed with traditional Jewish hairstyles.⁷¹

Accordingly, the opposition is sustained as to Opposer’s genericness claim.

⁷¹ Despite the fact that neither party submitted expert testimony from a linguistics or etymology expert, both parties focused on whether the mark MENTCHEES is a diminutive version of the Yiddish word “mensch” or the phonetic equivalent thereof. To be clear, we have not relied on any of Opposer’s, or for that matter, Applicant’s testimony, to find that Applicant’s mark is generic. *See Alcatraz Media*, 107 USPQ2d at 1755 (Board weighed the probative value of each party’s testimony against any potential bias, hostility or animus given that the parties were competitors).

VI. Trademark Act Section 2(e)(1) Mere Descriptiveness Claim

For sake of completeness, we consider Opposer's alternative claim that Applicant's mark is merely descriptive of "Toy figures; Modeled plastic toy figurines; Molded toy figures" and lacks acquired distinctiveness under Trademark Act Section 2(f).

In the absence of acquired distinctiveness under Section 2(f), Section 2(e)(1) of the Trademark Act, precludes registration of a mark on the Principal Register which, when used in connection with the applicant's goods, is merely descriptive of them. A mark is "merely descriptive" within the meaning of Section 2(e)(1) if it immediately conveys knowledge of a quality, feature, function, characteristic or subject matter of the applicant's goods. *In re Chamber of Com. of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). By contrast, a mark is suggestive if it "requires imagination, thought, and perception to arrive at the qualities or characteristics of the [goods or services]." *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987).

The determination of whether a mark is merely descriptive must be made in relation to the goods, not in the abstract. *In re Chamber of Com.*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the marketplace. *In re Chamber of Com.*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. In other words, the question is not whether someone presented

only with the mark could guess the goods listed in the identification. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress*, 57 USPQ2d at 1812). It is not necessary that a term describe all of the purposes, functions, characteristics, or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute, or property. *In re Chamber of Com.*, 102 USPQ2d at 1219 (citing *In re Dial-A-Mattress*, 57 USPQ2d at 1812).

Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys,” *In re Bayer*, 82 USPQ2d at 1831, as well as “labels, packages, or in advertising material directed to the goods.” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). It may also be obtained from websites and publications. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

Based on the evidence of record discussed above to establish that Applicant’s proposed mark is generic, we find that Applicant’s mark immediately conveys to

prospective consumers a characteristic of Applicant's "Toy figures; Modeled plastic toy figurines; Molded toy figures," namely that the items are dressed in traditional Jewish clothing and attire and/or coiffed with traditional Jewish hairstyles. Thus, when the proposed mark is viewed in the context of Applicant's broadly identified goods, the term MENTCHEES immediately informs prospective customers as to the type of "Toy figures; Modeled plastic toy figurines; Molded toy figures." In other words, no imagination or thought is required by prospective consumers to discern the nature of Applicant's goods. Applicant's proposed mark immediately conveys, without conjecture or speculation, an attribute of Applicant's goods.

Accordingly, we find that Opposer has shown by a preponderance of evidence that Applicant's proposed standard character mark MENTCHEES is merely descriptive of the identified goods. As a result, Applicant's mark is ineligible for registration on the Principal Register without a showing of acquired distinctiveness under Section 2(f).

VII. Acquired Distinctiveness Under Trademark Act Section 2(f)

Lastly, we address the issues of (1) whether Opposer has proven that Applicant's mark is so highly descriptive of the goods that Applicant is subject to a higher burden of proof to demonstrate acquired distinctiveness; and (2) if so, whether Opposer has shown that Applicant has failed to meet that burden.

A. Is Applicant's Mark Highly Descriptive of the Identified Goods?

We must first determine "whether the proposed mark is highly descriptive rather than merely descriptive." *Royal Crown*, 127 USPQ2d at 1045; *see also, e.g., In re La.*

Fish Fry Prods., 116 USPQ2d at 1265 (“On appeal, Louisiana Fish Fry does not challenge the Board’s finding that the term FISH FRY PRODUCTS is highly descriptive [of marinade; sauce mixes, namely barbecue shrimp sauce mix; remoulade dressing; cocktail sauce, seafood sauce; tartar sauce; gumbo file; and cayenne pepper].”); *Alcatraz Media*, 107 USPQ2d at 1765 (“the evidence discussed above amply demonstrates that the mark [ANNAPOLIS TOURS for ‘conducting guided tours of historic districts and other areas of cities’], while not generic, is highly descriptive.”). When proposed marks are highly descriptive, evidence of substantially exclusive and continuous for five years, or even longer, is generally insufficient to show acquired distinctiveness. *See In re La. Fish Fry Prods.*, 116 USPQ2d at 1265 (“[p]articularly for a mark that is as highly descriptive like FISH FRY PRODUCTS, the Board was within its discretion not to accept Louisiana Fish Fry’s alleged five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness.”). Rather, for highly descriptive terms, an applicant faces an “elevated burden to establish acquired distinctiveness.” *Id.* Under “this sliding-scale approach,” the more highly descriptive the proposed mark, the greater the burden. *Royal Crown*, 127 USPQ2d at 1047; *see also In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (“[T]he greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.” (quoting *In re Bongrain Int’l (Am.) Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990))).

Above we found that Applicant's mark is generic for the identified goods. Consistent with this finding, we find that the evidence discussed above demonstrates that on a sliding scale of mere descriptiveness, Applicant's mark is highly descriptive of the identified goods. *See, e.g., In re Sausser Summers PC*, 2021 USPQ2d 618, at *12 (TTAB 2021) (finding *onlinetrademarkattorneys.com* highly descriptive of "legal services"); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *3 (TTAB 2020) (third-party uses of the terms "guaranteed rate," "guaranteed mortgage rate," and "guaranteed interest rate" established GUARANTEED RATE is highly descriptive of mortgage related services); *In re Virtual Indep. Paralegals*, 2019 USPQ2d 111512, at *11 (TTAB 2019) (combination of descriptive terms "virtual," "independent," and "paralegals" in claimed VIRTUAL INDEPENDENT PARALEGALS mark for paralegal services made mark "highly descriptive of those services").

B. Does Applicant's Proposed Mark have Acquired Distinctiveness?

Having found that the proposed mark MENTCHEES is highly descriptive of the identified goods, we now consider Opposer's assertion that the mark lacks acquired distinctiveness under Trademark Act Section 2(f). In an opposition, "the opposer has the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f)." *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1680 (TTAB 2007) (quoting *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988)). "If the opposer does present its prima facie case challenging the sufficiency of applicant's proof of acquired distinctiveness, the applicant may then find it necessary to present additional

evidence and argument to rebut or overcome the opposer's showing...." *Id.* Applicant has the "final burden ... of going forward with evidence to ... establish acquired distinctiveness by at least a preponderance of the evidence." *Id.* "[T]he standard of proof in an opposition under section 2(f) has always been a preponderance of evidence, although logically that standard becomes more difficult to meet as the mark's descriptiveness increases." *Id.*

A mark has acquired distinctiveness "if it has developed secondary meaning, which occurs when, 'in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.'" *WalMart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4, n.11 (1982)). See e.g., *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140-41 (CCPA 1960) ("Here we have a little bottle with no features particularly connecting it with the pepper sauce except the pepper sauce itself ..."); see also *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) ("An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness."). *Accord Booking.com*, 2020 USPQ2d 10729, at *3 (2020) ("descriptive terms must achieve significance 'in the minds of the public' as identifying the applicant's goods or services--a quality called 'acquired distinctiveness'") (citation omitted).

In considering whether a mark has acquired distinctiveness, the Board considers factors such as (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by consumer 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. *Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018); accord *In re SnowWizard, Inc.*, 129 USPQ2d 1001, 1004-05 (TTAB 2018). On this list, no single factor is determinative and “[a]ll six factors are to be weighed together in determining the existence of secondary meaning.” *In re Guaranteed Rate*, 2020 USPQ2d 10869, at *3 (quoting *Converse*, 128 USPQ2d at 1546)).

The Board considers not only the evidence submitted at trial but also any relevant evidence submitted during prosecution. *See, e.g., Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1211 (TTAB 2018) (Board reviewed “the entire record pertaining to acquired distinctiveness of the Penta-Star Pattern,” including “all evidence made of record during prosecution of the subject application and application ... which matured into the subject registration), *judgment rev’d and vacated by consent decree on other grounds*, No. 1:18-cv-00599 (W.D.N.Y. June 8, 2022). *See also* Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b)).

A mere descriptiveness refusal under Trademark Act Section 2(e)(1) was issued during prosecution, but only after a Letter of Protest was filed. The Examining Attorney withdrew the refusal after Applicant responded to the first Office Action

refusing registration under Trademark Act Section 2(e)(1), and approved the application for publication for registration on the Principal Register with no Section 2(f) claim. As a result, there is no evidence of acquired distinctiveness from the prosecution record.

Nor do we have any evidence of acquired distinctiveness in the trial record. This is because Applicant argues that Section 2(f) does not apply because its application was not filed under this basis. Applicant is mistaken. As a legal matter, merely descriptive marks can only be registered on the Principal Register upon a showing of acquired distinctiveness.

Applicant made no evidence of acquired distinctiveness of record under the *Converse* factors during its assigned trial period and did not submit a testimony declaration attesting to substantial and exclusive use of its mark.⁷² And even if it did, such testimony standing alone would be insufficient to prove acquired distinctiveness for Applicant's highly descriptive mark. *See Real Foods Pty. v. Frito-Lay N. Am.*, 906 F.3d 965, 128 USPQ2d 1370, 1378 (Fed. Cir. 2018) ("while evidence of substantially exclusive and continuous use may be sufficient to prove a prima facie case of acquired

⁷² Applicant's date of first use of its applied-for mark in commerce is unclear. For example, Horowitz's testimony regarding Applicant's length of use of its applied-for mark states that "[f]or the [application] filing, I indicated that Applicant has been using the mark in commerce for toy figures, modeled plastic toy figurines, and molded toy figures since at least as early as the date of filing of the application, May 15, 2020 (which was the date of filing with the expectation that this date of first use would be made earlier during the prosecution of the application when an exact date of first use was investigated and ascertained, which it was by a response to an Office Action filed May 10, 2021)." Horowitz Testimony Decl. ¶ 10; 26 TTABVUE 15-16. *But see* Applicant's Response to Opposer's First Set of Interrogatories No. 1 ("By the end of 2013, Applicant had started to sell figurines with the mark MENTCHEES"); 20 TTABVUE 69-70.

distinctiveness, this is not always the case. . . . ‘Particularly for a mark that is . . . highly descriptive like [Real Foods’ proposed marks], the [TTAB] was within its discretion not to accept [Real Foods’] alleged five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness.’”) (internal citations omitted). Instead, Applicant argues Opposer failed to meet its burden by failing to show that Applicant lacks substantially exclusive use of its mark. Applicant’s argument is unpersuasive.

The evidence discussed above showing third-party use of the term “mentchees” or its phonetic equivalent to refer to Applicant’s goods satisfies Opposer’s initial burden of showing that Applicant has not made substantially exclusive use of its mark. The burden therefore shifts to Applicant to come forward with evidence of acquired distinctiveness. Because Applicant submitted no evidence to support a finding of acquired distinctiveness, we are compelled to sustain Opposer’s alternate claim that Applicant’s mark is merely descriptive and lacks acquired distinctiveness.

Decision: We sustain Opposer’s genericness claim and the alternative claim that Applicant’s mark is merely descriptive of the identified goods and has not acquired distinctiveness.