

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
December 10, 2009
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Southern Snow Manufacturing, Inc.

v.

Snowizard Holdings, Inc.

Cancellation No. 92044522
against Registration No. 2901592

Mark E. Andrews of Andrews Arts & Sciences Law, LLC for
Southern Snow Manufacturing, Inc.

Kenneth L. Tolar for Snowizard Holdings, Inc.

Before Bucher, Holtzman and Mermelstein, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

“A snowball, when it is prepared correctly, is a perfect blend of not only syrup and ice but art and science as well. Rich syrups, the color of any one of infinite possibilities of home-concocted flavors, flood the snowy surface and then, through capillary action, spread downward bringing color and taste to the icy fluff.”

-- “*Turning Ice Into Gold*,” by Errol Laborde,
NEW ORLEANS MAGAZINE, July 1980, at 66.

Southern Snow Manufacturing, Inc. has filed a petition to cancel a registration owned by Snowizard Holdings, Inc. for the mark **ORCHID CREAM VANILLA** (*in standard character format*) for goods identified as “flavoring concentrate for

non-nutritional purposes, namely, flavoring concentrate for shaved ice confections” in International Class 30.¹

As grounds for cancellation petitioner asserts that “Orchid Cream Vanilla” is a generic term for respondent’s goods and incapable of distinguishing such goods under 15 U.S.C. § 1052, and in the alternative, that this term is merely descriptive of respondent’s goods under 15 U.S.C. § 1052(e)(1) with no showing of acquired distinctiveness.

Respondent, in its answer, denies the essential allegations in the petition for cancellation.

The Parties’ Submissions

The record includes the pleadings; the file of the involved registration; and, as petitioner’s case-in-chief: its first Notice of Reliance of December 3, 2008, containing, *inter alia*, respondent’s answers to petitioner’s first set of requests for admissions, respondent’s answers to petitioner’s first set of interrogatories, respondent’s answers to petitioner’s second set of requests for admissions, respondent’s answers to petitioner’s second set of interrogatories, the discovery deposition testimony of respondent’s principal officer,

¹ Registration No. 2901592 issued on November 9, 2004. No claim is made to the exclusive right to use the term “Cream Vanilla” apart from the mark as shown.

Ronald R. Sciortino, taken on February 15, 2006, and other documents; and petitioner's second Notice of Reliance of March 11, 2009, containing several of respondent's publications. Respondent's case-in-chief includes the trial testimony deposition of Mr. Sciortino, taken January 21, 2009; and documents submitted via Notice of Reliance, including petitioner's responses to respondent's requests for production of documents and responses to respondent's requests for admissions, and other documents.

The Parties

Respondent, Snowizard Holdings, Inc. (hereinafter, "Snowizard" or respondent), produces flavored concentrates for distribution to snowball suppliers or vendors, and to wholesalers who resell the concentrates to these snowball suppliers or vendors. The snowball vendor mixes respondent's concentrate with sugar, water and possibly various other ingredients to produce a "ready-to-use" (RTU) syrup that is poured over shaved ice to produce a particular flavor of snowball. Accordingly, the concentrated product that respondent produces is not usable "as is" without further manipulation by the snowball vendor to produce the RTU syrup. Respondent does not produce or sell RTU syrups and sells no products

whatsoever to the ultimate snowball consumers, who would never be exposed directly to respondent's liquid goods in International Class 30.

Petitioner, Southern Snow Manufacturing, Inc. (hereinafter "Southern Snow" or petitioner), like respondent, is in the business of producing flavored concentrates for distribution to the same general classes of purchasers. The record reflects at least half a dozen prominent producers of flavored concentrates for snowball vendors and their distributors (e.g., National Fruit Flavor, Parasol Flavors LLC, Eisenmann Products Co., SnoWizard and Southern Snow). While respondent claims to distribute its flavored concentrates worldwide, the largest single market for both parties is greater New Orleans.

Standing

We turn first to the issue of standing. Standing is a threshold requirement that must be established by a plaintiff in every case. The purpose of the standing requirement is to prevent mere intermeddlers from initiating proceedings. Thus, to meet this requirement, a plaintiff need only show that it has a real interest in the outcome of the proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

We find that petitioner's standing has been established by submission of a copy of a "cease and desist" letter that counsel for respondent sent to petitioner on March 23, 2005. (Petitioner's exhibit P-7)

Further, respondent's answer and evidence submitted with its Notice of Reliance shows that petitioner offered and sold a flavor concentrate called "Orchid Cream Vanilla" (which was renamed simply "Orchid" after receipt of the "cease and desist" letter). Throughout this litigation, it has been most clear that these parties are competitors in the field of supplying flavor concentrates for snowballs. Thus, petitioner is no interloper, and has demonstrated an interest sufficient to maintain this proceeding.

Is the term merely descriptive?

We turn then to the critical question of whether the mark **ORCHID CREAM VANILLA** for "flavoring concentrate for shaved ice confections" is merely descriptive.

Respondent argues that the applied-for term is not descriptive inasmuch as the flavored concentrate at issue contains no orchid, no cream and only an artificial vanilla flavoring. Respondent takes the position that petitioner has produced no evidence as to the public perception of this

three-word phrase as being merely descriptive. Critical to respondent's logic is the separation in the channels of trade between its products and the ultimate snowball consumer, and the fact that the term "syrup" in the snowball business vernacular represents a middle stage in the business/processing chain, and that "syrup" has a completely different connotation than does the word "concentrate."

(Sciortino depo. at 13)

By contrast, petitioner argues that respondent has, over the years, published instructions for its customers on how to concoct their own "Orchid Cream Vanilla" snowball syrup. Whether a snowball vendor uses respondent's goods as directed, petitioner's goods (formerly named "Orchid Cream Vanilla" and now named "Orchid"), or resorts to a "home-brew" method of using flavorings and red and blue food colorings, the intermediate step results in a RTU syrup critical for making something that both vendors and knowledgeable consumers will refer to as an "Orchid Cream Vanilla" snowball.

A term is merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). On

the other hand, a term is suggestive if, in the context of those goods, a purchaser must use imagination, thought, or some type of multi-stage reasoning to understand the term's significance. See *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999).

The question of whether a designation is merely descriptive must be determined not in the abstract or on the basis of guesswork, but in relation to the goods for which registration is sought. See *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002); and *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). Thus, in making this determination, we consider the significance or meaning of the term, if any, as applied to the goods, and we look to the evidence of record.

As noted by an earlier panel of this board, "the wording 'cream vanilla' has been shown to be merely descriptive as a [term] for a flavoring concentrate containing cream (evaporated milk) and having a creamy, vanilla flavor." (Denial of Motion for Summary Judgment, May 13, 2008, at 7). According to the registration certificate, respondent has disclaimed exclusive right to use this two-word term apart from the mark as shown.

Nonetheless, to ensure a complete understanding of the goods and the applied-for mark, we look at these words individually. In the snowball business, the word "Cream"

refers to "creamy" flavors where historically the snowball vendor might mix into the RTU syrup evaporated milk or an ice-milk mix. Neither party debates the fact that the word "Cream" is merely descriptive of (1) certain flavors of finished snowballs, (2) some RTU syrups irrespective of exactly how they may have been concocted, as well as of (3) creamy flavoring concentrates, as sold by both parties.

As to the term "Vanilla," there is no question but that a key ingredient of the involved goods is a form of natural or artificial vanilla flavoring.

va·nil·la n.

1. Any of various tropical American vines of the genus *Vanilla* in the orchid family, especially *V. planifolia*, cultivated for its long narrow seedpods from which a flavoring agent is obtained.
2. The seedpod of this plant. Also called *vanilla bean*.
3. A flavoring extract prepared from the cured seedpods of this plant or produced synthetically.

adj.

1. Flavored with vanilla: *vanilla pudding*.
2. Lacking adornments or special features; basic or ordinary: "*We went through a period of vanilla cars*" (*Charles Jordan*).

[Obsolete Spanish *vainilla*, diminutive of *vaina*, *sheath* (from the shape of its seedpods), from Latin *vāgīna*.]

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In the context of these goods, the word "vanilla" would be descriptive whether the flavoring is derived from 100% pure and natural vanilla extract or contains only artificial vanilla flavor derived from chemical imitations thereof.

² THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fourth Edition, 2002

In fact, the record contains contradictory information about whether respondent uses "pure vanilla extract" in its concentrates, and whether repeated claims that its concentrate contains pure vanilla were an inadvertent oversight or a conscious attempt to mislead its customers.



For example, see petitioner's motion to test the sufficiency of respondent's responses to petitioner's admission requests of May 26, 2006.

For our purposes, any distinction between 100% pure vanilla and artificial vanilla flavoring is immaterial because the evidence of record establishes that the term "vanilla" is descriptive of both pure vanilla and artificial vanilla flavorings. There is no dispute but that the

concentrates and the resulting syrups contain a flavoring agent that makes the ultimate snowball have a vanilla taste. Hence, we conclude that the term "vanilla" is merely descriptive of these goods irrespective of the precise way in which flavorists and manufacturers may formulate their concentrates.

The record also suggests another way in which the word "vanilla" could be found descriptive of these goods. While many vendors of "orchid cream vanilla" snowballs use evaporated milk to supply the creamy flavor, another option that may be preferable - both from the standpoint of lower cost and better taste - is to use a *vanilla* ice milk mix to achieve "cream vanilla."

Hence, irrespective of where in the process, or exactly how, the vanilla flavoring is introduced, the term "vanilla" is highly descriptive of an essential flavoring component of respondent's concentrate, the syrup and the ultimate snowballs derived therefrom.

Accordingly, the dispute herein seems to turn on the answer to the question of whether, when the term "orchid" precedes the words "cream vanilla," this three-word composite immediately conveys information about a feature of the labeled goods.

The record contains various dictionary definitions of the word "orchid":

or·chid n.

1.
 - a. A member of the orchid family.
 - b. The flower of any of these plants, especially one cultivated for ornament.
2. A pale to light purple, from grayish to purplish pink to strong reddish purple.

[From New Latin *Orchideae*, *family name*, from Latin *orchis*, *a kind of orchid*, from Greek *orkhis*, *testicle, orchid (from the shape of its tubers)*.]

or'chid *adj.*

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Main Entry: **or·chid**

Pronunciation: \ˈôr-kəd\

Function: *noun*

Etymology: irregular from New Latin *Orchis*

Date: 1845

1 : any of a large family (Orchidaceae, the orchid family) of perennial epiphytic or terrestrial monocotyledonous plants that usually have showy 3-petaled flowers with the middle petal enlarged into a lip and differing from the others in shape and color

2 : a light purple

— **or·chid·like** \-,lĭk\
adjective

[\[ORCHID ILLUSTRATION\]](#)

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These entries both list first an ornamental flower, presumably having a showy appearance. The second definition points to the color purple.

³ *THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE*, Fourth Edition, 2002.

⁴ "orchid." *MERRIAM-WEBSTER ONLINE DICTIONARY*, 2006
<http://www.merriam-webster.com/dictionary/orchid>

With regard to this second definition, we note that in the naming of flavor concentrates for snowballs, the primary competitors in this field consistently use descriptive indicators for both color and flavor in the general flavoring nomenclature (e.g., black cherry, blue raspberry, clear grape, green apple, pink lemonade, etc.). Given this pattern, it would be entirely consistent with industry practice that "orchid cream vanilla" would be a creamy flavor of vanilla that is colored purple. Moreover, there is every indication from this record that the same name (e.g., black cherry, or "orchid cream vanilla") is used for the concentrates by manufacturers and vendors, as well as downstream for the resulting syrups, and finally on the ultimate consumer product, the snowball. Indeed, respondent does not seem to deny that at the street level, where the snowball vendors are dealing with the ultimate snowball customer, "orchid cream vanilla" is descriptive of the much-sought-after object of this transaction.

In determining the significance or meaning of the applied-for mark within this industry, it is appropriate to examine the record to see how snowball consumers in the greater New Orleans area would have perceived the combined term "orchid cream vanilla" over the past seventy-five years, and more specifically, during the past dozen years.

As to possible historical understandings, respondent's own newsletter points toward the long and popular history of the "orchid cream vanilla" flavored snowball in the New Orleans area:

Orchid Cream Vanilla Color

Last year we released a new flavor named Orchid Cream Vanilla. This flavor was created and made popular by one of SnoWizard's first customers back in the early 1940's and has been popular in New Orleans since then. In [sic] has been traditional in New Orleans for the flavor to be made as a "cream" flavor.

In our development of the flavor, we wanted to recreate the rich, creamy and complex taste of vanilla, along with the subtle flowery overtones of the vanilla orchid. We also wanted to give this wonderful new favor a unique and different color that would demand attention. The main coloring components are FD&C [Food Drug & Cosmetic color] Red #3 and FD&C Blue#1. The result was a bright, neon-like mauve color. The color is so eye-catching that customers have told us that their customers order it for the color alone...

...

...[M]ake your Orchid Cream Vanilla into a cream flavor [by adding Vanilla Ice Milk Mix or Evaporated Milk to the flavor], which you will then need to refrigerate⁵

Respondent's heading above calls it a "color," and goes on to discuss the developer's desire for "a unique and different" color. Then the text refers repeatedly to "orchid cream vanilla" as a "flavor." The expression "flowery overtones" seems to reflect back to respondent's use of the term "flowery aromatics" at the time of the introduction of the flavoring concentrate in May 1998:

10, 11, 12, 13 ...

plus, more new flavors . . .

In our April newsletter we announced the release of 9 new flavoring extracts. Actually, we had 10 new flavoring extracts ready but forgot to include one in the newsletter, so here in number 10, plus 11, 12

⁵ THE SNOWIZARD EXPRESS, respondent's periodical of July 2000.

Black Cherry begins our newest release -- and the one we failed to include. This is a true Black Cherry flavor with a full rich, fruity taste. It's also darker in color than our other cherry flavors *but not black in color*.

Spumoni is number two on our list. Spumoni is made up of those same delicious flavors that go into the Italian ice cream. It has a wonderful and unique fruity taste and is medium to dark-green in color.

Orchid Cream Vanilla is our next addition and once again shows our expertise in the manufacture of pure vanilla extracts. It has an intense vanilla flavor with flowery aromatics. The color is opaque lavender. In order to obtain the full richness and color intensity of this flavor, we recommend that you serve it as a cream flavor, *premixed* with the milk or cream

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A month later, respondent highlights again "the unusual and beautiful eye-catching color" of the brilliantly-colored Orchid Cream Vanilla syrup.

FLASH!!! – New Flavors Update.

Orchid Cream Vanilla and Dill Pickle were two of our new flavors introduced last month. Many customers have commented about the unusual and beautiful eye-catching color of the Orchid Cream Vanilla. As a cream flavor, it's even more beautiful. So unusual that some customers have reported that their customers are ordering it just because of the color. We suggest that you display this one where your customers can easily see the brilliant color to generate additional sales...

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In a more recent newspaper interview with respondent's principal, the author uses the words "glowing lavender":

Flavor experts share the science behind our icy summer sensations

...One of [Ronald R. Sciortino's] first customers, who opened Williams' Plum Street Snoballs in the 1940's invented orchid cream vanilla, Sciortino says. More recently, he gave it a more flowery character and a fluorescent shade that can only be described as glowing lavender.

Some people buy it for the color alone," Sciortino said. He grinned as he shook the bottle."

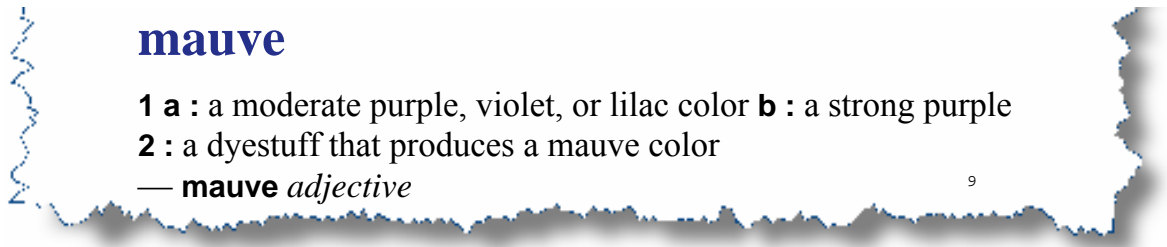
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⁶ THE SNOWIZARD EXPRESS, respondent's periodical of May 1998.

⁷ THE SNOWIZARD EXPRESS, respondent's periodical of June 1998.

⁸ "Snow biz," New Orleans Times-Picayune, July 8, 2004.

In fact, Mr. Sciortino has variously described the color of Orchid Cream Vanilla as being lavender, purple or mauve.



The record also shows that over the years, respondent has supplied for its customers at least three substantially similar recipes for mixing their own flavored syrups to create snowballs referred to as "Orchid Cream Vanilla":

<p>SPECIALITY RECIPES</p> <p>The following recipes are for 1 gallon quantities. Add the ingredients listed for each flavor to a gallon jug and fill with simple syrup [sugar-water mixture].</p> <p>...</p> <p>ORCHID CREAM VANILLA</p> <p>4 oz. SnoWizard Vanilla Extract/Concentrate 2 drops Blue Food Coloring 2 drops Red Food Coloring 24 oz. Evaporated or Vanilla Ice Milk Mix</p>

Interestingly, the record and testimony suggest that these various recipes were published both before and after respondent started offering its own Orchid Cream Vanilla concentrate in 1998. Perhaps not surprisingly, the unchanging component in each recipe was the equal parts of

⁹ "mauve." *MERRIAM-WEBSTER ONLINE DICTIONARY*, 2006
<http://www.merriam-webster.com/dictionary/mauve>

blue and red food coloring that produces a serviceable imitation of a purple- or mauve-colored syrup.

Actually, we cannot be sure from this record whether it was the color of the snowball, the flavor imparted by the syrup concoction, or the overall showiness of the finished product that the Williams' Plum Street Snowball creator had in mind in the early 1940's when this term was first coined. In any case, we must conclude that the ultimate consumers of snowballs in the greater New Orleans area have long known of the popular and tasty "Orchid Cream Vanilla" colored and flavored snowball:

"Unique flavors are not new to snowball stands. Many stands through the years have had their own specialty flavors ... Williams' Plum Street, has had a reputation for its special Vanilla Orchid Cream flavor..."¹⁰

The Snowball Stand, 4608 W. Esplanade Ave. Open noon - 11 p.m. daily. The ice is quality and they don't skimp on the syrup, which is imported from Williams' Plum Street stand in New Orleans. There are 43 flavors at this premiere suburban stand near Clearview, including the tasty orchid cream vanilla..."¹¹

"When we purchased PLUM STREET SNOWBALLS, my husband and I acquired the recipe for ORCHID CREAM VANILLA that was a popular flavor sold under that name for many years prior to my

¹⁰ "Turning Ice Into Gold," by Errol Laborde, *NEW ORLEANS Magazine*, July 1980, at 70.

¹¹ *New Orleans Times-Picayune*, Lagniappe Entertainment Guide, July 22, 1988.

purchase of PLUM STREET SNOWBALLS. We have sold ORCHID CREAM VANILLA under that name at PLUM STREET SNOWBALLS from our date of purchase 26 years ago to the present."¹²

"While delivering products for EISENMANN PRODUCTS, I delivered [snowball] products to Plum Street Snowballs from 1975 to the present. In part because of this, I know that PLUM STREET SNOWBALLS sold a flavor called ORCHID CREAM VANILLA for at least the last 30 years."¹³

Finally, as the capstone of its argument, petitioner points in its brief and at oral argument to plant biology and the etymology of words. Petitioner emphasizes throughout this prosecution that the vanilla plant is actually an orchid plant.¹⁴ Moreover, curiously, the word "Orchid" is derived from the Greek word for a male characteristic (*testicle*) while the word "Vanilla" is derived from the Latin word for a female characteristic (*vagina*). While we find this yin-and-yang argument entertaining, we find it unnecessary to claw into classic languages or the subconscious mind to decide the issue before us. Furthermore, in order to grant this petition on

¹² Affidavit of Donna Black, dated May 11, 2005.

¹³ Affidavit of Ted Eisenmann, dated May 11, 2005.

¹⁴ In fact, in the excerpt drawn from respondent's own promotional literature (footnote 5, *supra*), respondent says "[i]n our development of the flavor, we wanted to recreate the rich, creamy and complex taste of vanilla, along with the subtle flowery overtones of the **vanilla orchid**.

the basis of descriptiveness, it is not necessary that respondent's involved vanilla-flavored concentrate actually contains parts of an orchid plant. Rather, in the context of these goods, the flowery, purple color of the goods is sufficient for us to conclude that the leading word "orchid" alone immediately conveys information about respondent's goods. Additionally, we find that the three-word term, "Orchid Cream Vanilla," when viewed as a whole, immediately conveys information about the purple color and the overall cream and vanilla flavors of the goods.

We conclude that respondent's mark is primarily merely descriptive of its identified goods, and that petitioner and other competitors in the same trade must remain free to use this descriptive term without legal harassment.

Genericness

As to petitioner's argument that the term is generic, in light of our finding above, we find that we do not need to reach that issue.

Decision: In view of the above findings, the petition to cancel is granted on the ground that the mark is merely descriptive under Section 2(e)(1) of the Act and judgment is hereby entered against respondent. Registration No. 2901592 will be cancelled in due course.