

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Leonard's Bakery, Ltd.

Serial No. 77556405

Seth M. Reiss of Seth M. Reiss, AAL, ALLLC for Leonard's Bakery, Ltd.

Brian P. Callaghan, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Bucher, Kuhlke and Walsh, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Leonard's Bakery, Ltd. (applicant), on August 26, 2008, filed an application to register on the Supplemental Register PAO DOCE WRAPS in standard characters for goods identified as "bakery products" in International Class 30.

The examining attorney refused registration under Section 23 of the Trademark Act, 15 U.S.C. § 1091, on the ground that applicant's proposed mark is generic and, as such, unregistrable. Applicant appealed the refusal to

register its proposed mark PAO DOCE WRAPS on the Supplemental Register and the appeal is now fully briefed.

As a preliminary matter, the examining attorney's objection to the materials attached to applicant's brief is overruled. Applicant merely attached excerpts from the Trademark Office's own manual of acceptable identifications. While we do not go so far as to characterize it as "authority," as applicant states it is "merely one of several tools that the Office provides its examiners to advance the Office's work and consistency." Reply Br. p. 3. In that regard, it is perhaps more akin to a standard reference work of which we may take judicial notice. *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980).

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See *In re Hotels.com*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

The critical issue is to determine whether the record shows that members of the relevant public primarily use or

understand the term sought to be registered to refer to the category or class of goods or services in question.

H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Making 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?" Ginn, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See Merrill Lynch, *supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

Finally, the evidentiary burden is different depending on the type of mark an applicant seeks to register. Where marks are compound terms, the examining attorney may establish that the term is generic by producing evidence that each of the constituent words is generic, and that the separate words retain their generic significance when joined to form a compound that has "a meaning identical to

the meaning common usage would ascribe to those words as a compound." In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens). See also TMEP §1209.01(c)(i) (6th ed. rev. 2010). Where marks are more in the nature of a phrase, the United States Patent and Trademark Office ("USPTO") must provide evidence of the meaning of the composite mark as a whole. In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine because where the mark is a phrase evidence that each separate term is generic is not sufficient). See also In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (1-888-M-A-T-R-E-S-S not generic for telephone shop-at-home retail services in the field of mattresses because it "bears closer conceptual resemblance to a phrase than a compound word" and there is no evidence of record that the mark as a whole is generic); and In re Active Ankle Systems Inc., 83 USPQ2d 1532 (TTAB 2007) (DORSAL NIGHT SPLINT found generic for orthopedic splints for the foot and ankle based

on record that included third-party use of the entire phrase).

The examining attorney contends that:

The term "PAO DOCE" represents a commonly known type of Portuguese sweet bread [and t]he term "WRAPS" is commonly used as a generic designation for "food wraps"...that are commonly used to hold various ingredients together for baking or eating the food...[thus,] the relevant public would understand the designation PAO DOCE WRAPS primarily to refer [to] a generic type of bakery product, as opposed to a source identifier. As evidenced by applicant's specimens of record, applicant's proposed goods are wraps comprised of Portuguese sweet bread, commonly known as pao doce, along with fillings such as Portuguese sausage and macaroons...[and further] the joining of the individual terms into one compound word lends no additional meaning to the term.

Br. pp. 7-11.

In support of his position, the examining attorney relies on, inter alia, excerpts from third-party websites in which the terms "pao doce" and "wraps" are used generically as the name of various bakery products. See, e.g., www.grouprecipes.com ("Pao Doce Portuguese Sweet Bread Recipe"); www.gohawaii.about.com ("Portuguese sweet bread (pao doce), sometimes labeled Hawaiian sweet bread, is a staple and good for making French toast in the morning."); www.recipezaar.com ("This recipe comes from a bakery in Honolulu that made the best Pao Doce. Pao Doce is a holiday bread made by people in Portugal or of

Portuguese decent"); www.cookingbyyourself.com ("Pao Doce (Portuguese Sweet Bread)...Ingredients...");
www.govisithawaii.com ("The restaurant is well known for its malasadas and pao-doce which are pastries that Portugese immigrants introduced to Hawaii...Pao-doce were rolls with savory fillings like ham, bacon, and cheese.");
Recipetips.com Glossary of Cooking Terms ("Food Wraps include items such as tortillas or tortilla-like baked products, dough enclosures, leaves from plants, paper, foil and several other types of wraps..."); and
www.homebistrocooking.com ("New Orleans Sausage Wraps - CONTEST Skewer the sausages on the sticks. Next, wrap the dough around each sausage diagonally. Sprinkle lightly with spices. Place the wraps on baking sheet.")

The examining attorney analyzed the evidence under the Gould standard. The examining attorney argues that the two terms PAO DOCE and WRAPS separately are generic and they "retain their generic significance when joined to form a compound that has 'a meaning identical to the meaning common usage would ascribe to these words as a compound.'" Br. p. 11, quoting, Gould, 5 USPQ2d at 1111-1112.

In traversing the refusal, applicant does not dispute that "pao doce" is the name of a type of bakery product, that "wrap" is the name of a "tortillas or tortilla-like

products, dough enclosures...”, or that its goods are comprised of pao doce with a filling.

Applicant argues that the “phrase” PAO DOCE WRAPS “does not ‘embrace an entire class of products.’ Moreover, there is no evidence that the relevant buying public understands the principal meaning of the phrase PAO DOCE WRAPS as a generic name for bakery products.” Br. p. 10.

Applicant argues that the examining attorney has not offered evidence “establishing that the phrase PAO DOCE WRAPS considered as a whole is generic for bakery goods.” Reply Br. p. 3. Applicant’s position is that its proposed mark is a phrase not a compound term and, therefore, the Gould standard is inapplicable. Quoting from the Trademark Manual of Examining Procedure applicant argues:

As clearly explained by the Office’s Trademark Manual of Examining Procedures, “the Court of Appeals for the Federal Circuit has expressly limited the holding in Gould to ‘compound terms formed by the union of words’ where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends ‘no additional meaning to the term.’ In re Dial-A-Matress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (citing In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)). Where the mark is a phrase, the examining attorney cannot simply cite definitions and generic uses of the individual components of the mark, but must provide evidence of the meaning of the composite mark as a whole.” TMEP §1209.01(c)(i) (emphasis omitted)

Reply Br. pp. 6-7.

Applying the American Fertility standard, applicant argues that the record does not support a genericness finding because the "Examiner Attorney has provided no evidence of how the public regards the composite mark as a whole." Reply Br. p. 7.

In support of its position that its proposed mark is not generic for bakery products, applicant submitted the results of a search for the term PAO DOCE WRAPS on the Internet showing no instance "in which the public had used the words PAO DOCE WRAPS contiguously." Br. p. 12.

Applicant also relies on the examples of its own use of the proposed mark using the TM designation, asserting that it uses the "phrase" in a trademark manner. In addition, applicant points to an example from the examining attorney's evidence wherein a food reviewer is commenting on applicant's restaurant and does not use the designation PAO DOCE WRAPS but rather comments that "Pao-doce were rolls with savory fillings like ham, bacon, and cheese."

Applicant concludes that based "upon the applicable legal test and the lack of any evidence that the relevant purchasing public perceives the principal meaning of the phrase PAO DOCE WRAPS as a generic name for bakery

products, this Board is compelled to reverse the determination of the Examining Attorney..."¹ Br. p. 19

There is no dispute between the examining attorney and applicant, and we agree, that the genus at issue in this case is adequately defined by applicant's identification of goods, namely, "bakery products." *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration.") As shown below, applicant's specimen of use further clarifies that the goods in this genus include pao doce filled with various items:

¹ Applicant's reliance on other cases from various district and appellate courts (e.g. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 662, 3 USPQ2d 1442 (8th Cir. 1987) *Apple Raisin Crisp* for a breakfast cereal) are not persuasive of a different result inasmuch as we must make our determination based on the factual record before us. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).



See *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005), quoting, *Application of Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 48 (CCPA 1975) (“Our predecessor court...has stated that registration should be refused if the mark is descriptive of any of the goods for which registration is sought”); *In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff’d*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (unpublished) (registration is properly refused if the subject matter for registration is generic of any one of the goods for which registration is sought).

Turning to the second inquiry, the public’s understanding of the term, the relevant public consists of

the ordinary consumer interested in purchasing bakery products, including applicant's pao doce wraps.

As noted above, the evidentiary burden of establishing that a term is generic rests with the USPTO and the showing must be based on clear evidence. *Merrill Lynch*, 4 USPQ2d at 1143. Based on this record, we find that there is clear evidence to support a finding that the relevant public, when they consider PAO DOCE WRAPS in conjunction with the class of involved goods, would readily understand the term to identify a type of bakery product, namely, pao doce wraps.

There is no dispute that the term "pao doce" is the name of a type of sweet bread. The dispute centers on the effect of the addition of the word "wraps" to the term "pao doce" and which standard to be applied in analyzing the evidence.

The record shows that "pao doce" is a unitary generic term for a type of bakery product. The record also establishes that the term "wraps" is a generic term for goods within the genus bakery products. Therefore, PAO DOCE WRAPS is the combination of two generic terms joined to create a compound. In *re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037, 1041-42 (TTAB 2005) (compound term comprised of the generic term "blinds and drapery" coupled

with non-source identifying term “.com,” is generic and the burden of genericness was met by providing evidence of the genericness of “blinds and drapery” and “.com” separately). Thus, Gould-type evidence showing the generic nature of the two terms is sufficient to establish that the separate terms retain their generic significance when joined to form a compound that has “a meaning identical to the meaning common usage would ascribe to those words as a compound.” Gould, 5 USPQ2d at 1111-12. The space between the generic terms “pao doce” and “wraps” does not disqualify this type of proposed mark from the Gould analysis. If anything, the terms appearing as they should in normal usage make it even more common. There is no logical basis upon which to conclude that Gould would have yielded a different result if the mark had been SCREEN WIPE rather than SCREENWIPE. In re Wm. B. Coleman Co., 93 USPQ2d 2019, 2025 (TTAB 2010). Finally, as noted by the examining attorney, use of the designation TM “cannot transform an otherwise unregistrable designation into a mark.” Br. p. 15, citing, In re Remington Products Inc., 3 USPQ2d 1714 (TTAB 1987).

Applicant also relies on 15 U.S.C. § 1064(c) which provides that “[a] registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique

product or service" and *In re Montrachet S.A.*, 11 USPQ2d 1393 (Fed. Cir. 1989). Applicant argues that it "is entitled to use its PAO DOCE WRAPS mark to distinguish its unique line of bakery products from bakery products manufactured and sold by others." Br. p. 19.

While the fact that a designation is used in connection with a unique product cannot be the basis for finding a term to be generic, that is not the basis here for finding PAO DOCE WRAPS to be generic. The finding here is based on the composition of the proposed mark itself. The fact that applicant may be the first and only purveyor of these goods does not obviate a finding that a combination of generic terms is merely the name of a particular category of goods rather than a source identifier, and, as such, should be freely available for use by competitors. See *Northland Aluminum Products, Inc.*, 777 F.2d 987, 228 USPQ2d 528 (Fed. Cir. 1986); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1631 (TTAB 1998); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). Applicant's use of the term would be understood by relevant purchasers as naming a category of bakery products, namely, pao doce wraps.

Montrachet is distinguishable on its facts. That case involved a situation where the term *Montrachet* "originated

as a designation" of source and the issue before the Court was "whether MONTRACHET ha[d] lost its original trademark significance." *Montrachet*, 11 USPQ2d at 1394. The Court distinguished those circumstances from those present in cases such as *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978) where the newly-formed compound GASBADGE was held to be descriptive.

In view of the above, the examining attorney has met his burden to establish that PAO DOCE WRAPS is generic and incapable of registration for "bakery products."

Decision: The refusal to register is affirmed.