

This Opinion is Not a
Precedent of the TTAB

Mailed: February 20, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Soremartec SA
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Serial No. 79204456
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E. Anthony Figg, Leo M. Loughlin and Davide F. Schiavetti of Rothwell, Figg, Ernst & Manbeck P.C., for Soremartec SA.

Tracy Whittaker-Brown, Trademark Examining Attorney, Law Office 111,
Christopher Doninger, Managing Attorney.

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Before Cataldo, Wolfson and Pologeorgis,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Soremartec SA (“Applicant”) seeks registration on the Principal Register of the mark depicted below for “Pastry and confectionery; biscuits, cookies; filled wafers” in International Class 30.¹

¹ Application Serial No. 79204456 was filed on January 19, 2017, under Section 66(a) of the Trademark Act, 15 U.S.C. 1141(f), based on Applicant’s request for extension of protection of International Registration No. 1337510, filed January 19, 2017 on the basis of priority derived from Benelux Reg. No. 0998960, dated July 19, 2016. The application includes the following description of the mark: “The mark consists of the stacked stylized wording ‘NUTELLA PETITS.’ The letter ‘N’ in ‘NUTELLA’ is black, and the remaining letters in the



Registration has been refused pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on Applicant's failure to comply with the requirement to disclaim the term PETITS on the ground that it is merely descriptive of Applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

When the refusal was made final, Applicant appealed and filed a Request for Reconsideration. On June 12, 2018, the Examining Attorney denied the request and maintained the refusal. The appeal was subsequently resumed and fully briefed. We affirm the refusal of registration in the absence of a disclaimer.

I. Applicable Law

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). A disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark in a trademark application or registration. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013). "The effect of a disclaimer is to disavow any exclusive right to the use of a specified word, phrase, or design outside of its use within a composite mark." *Id.* (citing *In*

term are red. The term 'PETITS' is brown." The colors black, red and brown are claimed as a feature of the mark.

re Franklin Press, Inc., 597 F.2d 270, 201 USPQ 662, 665 (CCPA 1979)). Failure to comply with a disclaimer requirement is grounds for refusal of registration. *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. A term is deemed to be merely descriptive of goods or services if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)); *see also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

II. Whether PETITS is Merely Descriptive of the Goods

Applicant's goods are "pastry and confectionery; biscuits, cookies; filled wafers." The Examining Attorney argues that the term PETITS is descriptive of the goods "in that it refers to their size because the goods are small."² In support, the Examining Attorney submitted English-language dictionary definitions for "petit," defined as

² 13 TTABVUE 6. Citations to the record are to TTABVUE, the docket history system for the Trademark Trial and Appeal Board, by entry number and page.

“small or of less importance; petty”³ and the related term “petite,” defined as “small in size or scope; tiny.”⁴ The Examining Attorney also provided printouts from an Internet search and articles retrieved from the Nexis database showing descriptive uses of the term PETITS⁵ in connection with pastry and bakery goods. For example:

- Chocolateandzucchini.com/recipes lists a recipe for “Petits Beurres (French Butter Cookies)”;⁶
- Bonappetit.com provides a recipe for making “Petits Pains au Chocolat”;⁷
- Vosgeschocolate.com offers “Petits Chocolats” (bite-sized bonbons);⁸
- Martin Booe, “Fancy That!; Petits Fours Enjoy a Renaissance With Los Angeles Pastry Chefs,” LOS ANGELES TIMES, November 10, 2002.⁹

Applicant does not dispute that in the food industry, the term “petits” denotes small items, or that “petits four” has become a term of art meaning a bite-sized, decorated cake.¹⁰ Rather, Applicant agrees that “petit” is a recognized word meaning

³ At <https://www.collinsdictionary.com/dictionary/english/petit>, attached to July 25, 2017 Priority Action, at TSDR 3. The Trademark Status and Document Retrieval (TSDR) citations refer to the electronic file database for the involved application at <http://tsdr.uspto.gov>.

⁴ American Heritage dictionary, at <https://www.ahdictionary.com/word/search.html?q=petite>, attached to July 25, 2017 Priority Action at TSDR 8. Applicant also provided a definition of “petit” from Dictionary.com, attached to its September 29, 2107 Response at TSDR 5.

⁵ Evidence of record also supports a finding that “petit” and “petite” (in singular or plural form) are French terms meaning “small,” but because the term “petits” is recognized as an English word, we need not apply the doctrine of foreign equivalents.

⁶ October 2, 2017 Office Action at TSDR 11-22.

⁷ June 12, 2018 Denial of Request for Reconsideration at TSDR 51-53.

⁸ At <https://www.vosgeschocolate.com>, attached to June 12, 2018 Denial of Request for Reconsideration at TSDR 96-98.

⁹ June 12, 2018 Denial of Request for Reconsideration at TSDR 1.

¹⁰ See, e.g., Harry & David’s “Birthday Petits Fours” at <https://www.harryanddavid.com>, attached to June 12, 2018 Denial of Request for Reconsideration at TSDR 68-71; Landolakes.com’s recipes for “Petits Fours” and “Wedding Fruitcake Petits Fours,” *Id.* at 4-9 and 54-57.

“small,” and notes that “[p]etits is the plural of petit.”¹¹ Applicant contends, however, that “[w]hile it is true that the word ‘PETITS’ means ‘small’ in French, in this case it simply does not convey any immediate idea of the ingredients, quality, characteristics, function, feature, purpose or use of the goods sold under the ‘NUTELLA PETITS’ mark. This is because the pastry, confectionery, biscuits, cookies or wafers to be sold under the mark at issue are not miniature size, or even small products, but rather regular size products.”¹² Further, Applicant contends “there is no comparable regular size version” of the products sold under its NUTELLA PETITS mark.¹³

Whether the term “petits” is merely descriptive is determined, not in the abstract, but in relation to Applicant’s goods, the context in which the mark is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). Here, the application is based solely on an International Registration and no evidence has been put in the record to show the nature of the goods on which Applicant uses or intends to use its mark. Thus, there is no evidentiary support for Applicant’s statement that the goods are “regular size.” The record is devoid of any information as to what “regular size” means or the extent to which the relevant industry recognizes a standard for regular size versus

¹¹ September 29, 2017 Response to Office Action at TSDR 2. Applicant provided the following definition of “petit” from Dictionary.com: “small; petty; minor.” Attached to its September 29, 2107 Response at TSDR 5.

¹² Applicant’s Reply Brief, p. 1; 14 TTABVUE 4.

¹³ *Id.* at p. 2; 14 TTABVUE 5.

small or large size for such goods. On the other hand, given that the term “petits” has a defined meaning in the food industry to indicate smaller-sized foods, as well as a general meaning in the English language as meaning “small,” consumers will expect, upon encountering Applicant’s mark NUTELLA PETITS, that the term “petits” signifies that the goods are small in comparison to some larger version of themselves, or that they are packaged in small batches or portions.¹⁴ The term “petits” immediately conveys this meaning without any need for additional thought or imagination. Accordingly, it is merely descriptive of a feature of the goods.

Applicant argues that the Office has registered marks containing the term “petits” or variations thereof without disclaimers.¹⁵ In response to the Examining Attorney’s proffered third-party registrations of marks where the term PETITS (or variations thereof) were disclaimed,¹⁶ Applicant submitted 19 third-party registrations where PETITS was not disclaimed.¹⁷

¹⁴ See, e.g., the online article “Hostess Releases Grown-Up, Bite-Sized Snack Cakes,” noting that Hostess is “launching a line of new, small-batch-inspired treats...these Bakery Petites don’t come wrapped in pairs, but in large, resealable bags...” At <https://www.foodandwine.com>, attached to June 12, 2018 Denial of Request for Reconsideration at TSDR 28.

¹⁵ Applicant’s Appeal Brief, p. 4, 11 TTABVUE 8.

¹⁶ October 2, 2017 Office Action at TSDR 33-97.

¹⁷ April 30, 2018 Response to Office Action at TSDR pp. 2-23. We note that the proffered printouts of third-party registrations fail to show current status or title of the registrations. To properly make a third-party registration of record, a copy of the registration (such as from the electronic records of the Office) showing the current status and title of the registration must be submitted. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998) (citing *Smith and Mehaffey*, 31 USPQ2d 1531, 1532 at n.3 (TTAB 1994)); see also TBMP § 1208.02 (June 2018). For sake of completeness we have considered them; nonetheless, their probative value is limited, as discussed more fully below.

As we have often noted, each case must be decided on its own set of facts. *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Most of the marks in the registrations submitted by Applicant appear to be unitary phrases and, as such, a disclaimer of the individual word would not be required, and, in one case, the registration is on the Supplemental Register,¹⁸ which supports the Examining Attorney's position. Thus, the fact that the Office has not required a disclaimer of PETITS in the registrations submitted by Applicant does not persuade us that a disclaimer is not required in the case before us. *See generally*, TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §1213 (Oct. 2018).

III. Summary

Based on the record before us, we find that the relevant public, when it considers PETITS in connection with “pastry and confectionery; biscuits, cookies; filled wafers,” will immediately understand the term to describe something “small” about the goods, such as that they are small in size, served in small portions, or packaged in small quantities.

Decision: The refusal to register based on the requirement to disclaim the term PETITS is affirmed. However, if Applicant submits the required disclaimer of PETITS to the Board within thirty days, this decision will be set aside, the disclaimer

¹⁸ Reg. No. 3979717 for the mark PETIT BITE for “biscuits; cookies and crackers,” attached to April 30, 2018 Response at TSDR 21.

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will be entered, and the application will proceed to registration in due course.¹⁹ See Trademark Rule 2.142(g), 37 C.F.R. §2.142.

¹⁹ The standardized printing format for the required disclaimer text is as follows: “No exclusive right to use PETITS is claimed apart from the mark as shown.”