This Opinion is Not a Precedent of the TTAB

Hearing: February 26, 2016 Mailed: March 3, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lawrence Foods, Inc.

Serial No. 86256664

Alain Villeneuve of Vedder Price P.C.,
for Lawrence Foods, Inc.

Ty Murray, Trademark Examining Attorney, Law Office 113
Odette Bonnet, Managing Attorney.[1]

Before Richey, Deputy Chief Administrative Trademark Judge, and Bergsman and Pologeorgis, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Lawrence Foods, Inc. ("Applicant") seeks registration on the Principal Register of the mark CHOCOLATE GLAÇAGE (in standard characters) for "icing and glazes

[1] Michael Baird, Managing Attorney of Law Office 121, appeared at the oral hearing on behalf of the USPTO.

for cakes, pies, donuts, and bakery goods," in International Class 30.[2] "The English translation of 'GLAÇAGE' in the mark is either 'icing,' 'glazing" or 'frosting.'"[3]

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that the mark CHOCOLATE GLAÇAGE "is immediately understood to refer to chocolate glacage-type icings and glazes."[4]

I. Preliminary Issues

A. The only issue before the Board is whether the mark CHOCOLATE GLAÇAGE is merely descriptive.

The Board pointed out in its October 16, 2015 order that the prosecution of this application is "hardly a model of clarity."[5] In that order, the Board noted that the only issue is whether Applicant's mark is merely descriptive.

> Applicant is seeking, by way of its amendment filed October 9, 2014, to register its mark on the Principal Register. The operative refusal on appeal, as evidenced by the Examining Attorney's final refusal dated June 4, 2015 and his brief filed August 24, 2015, is mere descriptiveness under Section 2(e)(1).[6]

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[2] Application Serial No. 86256664 was filed on April 18, 2014, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. On August 15, 2014, Applicant filed an Amendment to Allege Use which was accepted.

[3] October 9, 2014 Response to an Office Action. A subsequent Examiner's Amendment, the November 5, 2014 Office Action, reflected Applicant's agreement to disclaim the exclusive right to use the word "Glaçage." At the oral hearing, Mr. Baird, on behalf of the USPTO, agreed to withdrawal of the disclaimer.

[4] 22 TTABVUE 8.

[5] 19 TTABVUE 1.

[6] 19 TTABVUE 2.

To resolve any confusion, the Board authorized the filing of new briefs "directed to only the issue of mere descriptiveness under Section 2(e)(1) of the Act."[7] Accordingly, we will not consider Applicant's arguments regarding whether the mark CHOCOLATE GLAÇAGE is generic.

B. Applicant may not amend its application to the Supplemental Register.

Initially, Applicant sought to register its mark on the Principal Register. Upon receipt of the mere descriptiveness refusal, Applicant amended its application to the Supplemental Register.[8] The Trademark Examining Attorney then refused to register Applicant's mark on the ground that it is generic for "icing and glazes for cakes, pies, donuts, and bakery goods."[9] Upon receipt of this Office Action, Applicant amended its application back to the Principal Register.[10]

At no time during the prosecution of this application did Applicant argue in the alternative that, if its mark is found to be merely descriptive, it would seek registration on the Supplemental Register. Nevertheless, in its Supplemental Brief, Applicant authorized the Board to amend the application to the Supplemental Register if it finds that the mark CHOCOLATE GLAÇAGE is merely descriptive but not generic.[11]

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[7] 19 TTABVUE 2.

[8] August 27, 2014 Response to an Office Action.

[9] September 16, 2014 Office Action.

[10] October 9, 2014 Response to an Office Action.

[11] 20 TTABVUE 7.

In an application filed under Section 1 of the Trademark Act, the applicant may seek registration on the Principal Register and, in the alternative, on the Supplemental Register. If the issues are framed in the alternative (*i.e.*, whether the matter sought to be registered is merely descriptive or, in the alternative, whether it is capable of registration on the Supplemental Register), the applicant may continue to argue that its mark is not merely descriptive on appeal. If the mark is found to be merely descriptive, the Board will address whether the mark is entitled to registration on the Supplemental Register.

However, an applicant may not amend to the Supplemental Register after the Trademark Trial and Appeal Board has affirmed a refusal of registration on the Principal Register. *See* 37 CFR § 2.142(g) ("An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated."). After having elected one of the remedies available for contesting the basis for the refusal, namely, appeal rather than amendment to the Supplemental Register, and having pursued the remedy to a conclusion, Applicant may not return to its previous position and pursue another remedy for the same refusal anew. *See In re Phillips-Van Heusen Corp.,* 63 USPQ2d 1047, 1047 n.2 (TTAB 2002) (request in applicant's brief that if the refusals are maintained the application be amended to the Supplemental Register denied because application which has been decided on

appeal will not be reopened); *In re Taverniti, SARL*, 225 USPQ 1263, 1264 n.3 (TTAB 1985) (it has been the practice of the Commissioner [now Director] to refuse to reopen, after final decision, for amendment to the Supplemental Register); *In re Dodd International, Inc.*, 222 USPQ 268, 270 (TTAB 1983) (Board denied request to reopen application, after final decision, for amendment to Supplemental Register, quoting 37 CFR § 2.142(g)).

"Applicant's right to seek registration on the Supplemental Register is not prejudiced [by this decision] since it is not precluded from filing a new application for registration on the Supplemental Register." *Ex parte Simoniz Co.,* 161 USPQ 365, 366 (Comm'r Pats. 1969). The quoted proposition holds true in this case.

II. Applicable Law

A term is merely descriptive of goods or services within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark or a component of a mark is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered

merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the products or activities listed in the description of goods or services. Rather, the question is whether someone who knows what the products or services 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, 1316-1317 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a non-descriptive commercial impression. If each component retains its merely descriptive significance in relation

to the goods or services, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920)). *See also In re Tower Tech, Inc.*, 64 USPQ2d at 1318 (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has an incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for "bakery products"); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs"). Thus, we must consider the issue of descriptiveness by looking at the mark in its entirety.

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). *See also, In re Shutts*, 217

USPQ at 364-65; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). In this regard, "incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark." *In re Shutts,* 217 USPQ at 365. *See also In re Tennis in the Round, Inc.*, 199 USPQ at 498 (the association of applicant's mark TENNIS IN THE ROUND with the phrase "theater-in-the-round" creates an incongruity because applicant's services do not involve a tennis court in the middle of an auditorium).

"Chocolate" is defined as "a food that is made from cacao beans that is eaten as candy or used as a flavoring ingredient in other sweet foods."[12]

"Glaçage" is the French word for icing or glazing.[13] It is pronounced "glah sahzh."[14]

The Trademark Examining Attorney submitted the excerpts from the websites listed below in his December 29, 2014 Office Action showing the phrase "Chocolate Glacage" or "Chocolate Glaçage" used to describe pastry icings.[15]

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[12] Merriam-Webster online dictionary (merriam-webster.com) attached to the July 16, 2014 Office Action.

[13] Reverso website (dictionary.reverso.net) derived from the **COLLINS ENGLISH FRENCH DICTIONARY** (2005).

[14] The mark (,) under the letter "c" in "glacage" is a cedilla and it is pronounced as the letter "s." *Dictionary.com* derived from **THE RANDOM HOUSE DICTIONARY** (2016) ("a mark (,) placed under a consonant letter, as under c in French, in Portuguese, and formerly in Spanish, to indicate that it is pronounced (s)." The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

[15] Purchasers are not apt to place much significance on the cedilla. *Cf. In re G. D. Searle & Co.*, 360 F.2d 650, 149 USPQ 619, 623 (CCPA 1963) (holding common descriptive term "the pill" generic despite addition of quotation marks because "the evidence of record simply does not support appellant's position that the addition of quotation marks to an otherwise

1. *Noodle.com* website presenting access to a video entitled "Overview of How To Make Chocolate Glacage Glaze Frosting For Dessert." The video was also posted on the *RadiantChocolate.com* website.[16] The text accompanying the video is set forth below:

> A remarkable tutorial on making Chocolate Glacage glaze frosting.
>
> This How to Make Chocolate Glacage Frosting video tutorial really gave me a hand in perfecting my Glacage glaze frosting. I really enjoyed watching this presentation.
>
> It's really refreshing to know how to make this one. This is perfect for almost every type of cake. Just be careful though. This delectably sweet recipe can actually be your diet's worst nightmare.

2. Eileen's Cookery website (*Eileenscookery.com*) (September 12, 2012) features an article entitled "Steamed Chocolate Cake With Chocolate Glacage."

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common descriptive name converts it into a trademark."); *In re Litehouse Inc.,* 82 USPQ2d 1471, 1474 (TTAB 2007) ("the presence of the exclamation points in applicant's mark does not suffice to negate the mere descriptiveness of the mark."); *In re Vanilla Gorilla L.P.*, 80 USPQ2d 1637, 1639 (TTAB 2006) (noting that "the addition of punctuation marks to a descriptive term would not ordinarily change the term into a non-descriptive one."); *In re Samuel Moore & Co.*, 195 USPQ 237, 240 (TTAB 1977) ("the addition of punctuation marks to a descriptive term would not ordinarily change the term into a non-descriptive one.").

[16] Applicant objects to the video because it "is attached to a website named 'howtocookthat.net' where a woman named Ann Reardon helps talk about the glaze. She is a food scientist from Australia and her website is also from Australia." 20 TTABVUE 16-17. This website is accessible to American consumers as is shown by its being referenced by the *Noodles.com* website. Also, the video is accessible through the *RadiantChocolate.com* website which provides access to instructional videos and recipes for making different foods. Applicant's objection is overruled.

Steamed Chocolate Cake With Chocolate Glacage

The author wrote that "[t]he night before applying the chocolate glacage, my chocolate cake looked so dark. Thanks to Chef Jerry's suggestion to use Bensdrop cocoa powder."

3. Pinterest website (*pinterest.com*) has a "Glaçage" webpage featuring photographs of various desserts with icing.[17]

4. *Hereghty.com* website advertising handcrafted pastries, including the following cakes:

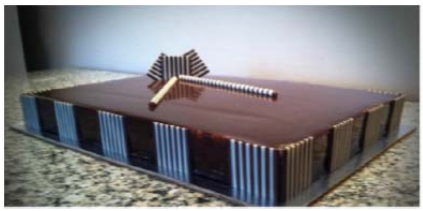
> **Paris Cake**
>
> Layers of dark chocolate mousse and chocolate sponge with a hint of rum, finished with dark chocolate glacage.

* * *

[17] Applicant objects to our consideration of the *Pinterest.com* website because it is "a big index where each word, each concept is given a page with links displayed dynamically. On the Pinterest page, each link refers to a different website. To say that Pinterest shows evidence of use of any word by itself is improper." 20 TTABVUE 21. Like any other Internet website, the *Pinterest.com* website entry for "Glaçage" is probative for what it shows on its face (*e.g.*, photographs of various desserts with icings under the label "Glaçage"). This website is just one piece of evidence. Each piece of evidence is considered in light of the rest of the evidence, rather than individually. *Cf. West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1666 (Fed. Cir. 1994). Applicant's objection is overruled.

> **Majorca**
>
> Layers of moist chocolate cake and passion fruit mousse topped with dark chocolate glacage.
>
> **London**
>
> Chocolate cake with raspberry buttercream filling, finished with chocolate glacage, toasted slivered almonds, and fresh fruit.

5. The Sweet Life website (tvelasquez.wordpress.com) featuring a blog entry entitled "Christmas Entremet '12."

> Pictured is a [sic] entremet I made for the familia for Christmas. The entremets consists of a "brownie like" base, with roasted slivered almonds, Irish cream chocolate mousse, and covered in a chocolate glacage (choc. shiny glaze), with chocolate decorations. …
>
> 

The webpage identifies tags as "baking, brownie base, chocolate decorations, chocolate glacage, etc."

6. *Wintercinculinaryschool.blogspot.com* (June 8, 2011) blog entry for "Chocolate Glacage."

> **Chocolate Glacage**
>
> This is a glaze that is a little bit thicker in consistency then [sic] ganache that you enrobe with, but not quite as thick as fondant. It should be of spreading consistency and should give a nice flat gloss to a dessert.

7. My Wife Makes website (*mywifemakes.com*) (October 26, 2014) featuring a recipe for pumpkin spice praline mousse cake.[18]

> Firstly, we have a lovely and light spice syrup soaked chiffon sponge base, and on top of it sits some poached pumpkin, a pumpkin cremeux, another layer of chiffon sponge. All of this sinful goodness is then encased in the best damn tasting milk chocolate praline mousse and is finally adorned with a silky glossy layer of chocolate glacage.

8. Let's Rock Like da Vinci blog (*rockdavinci.blogspot*) (November 10, 2012) featuring the recipe for "2012 Halloween – Oreo Bat Cave Cake with Chocolate Glacage."

> **Chocolate Glacage**:
>
> 6 oz Dark unsweetened dark chocolate pistols – chopped
>
> 6 oz heavy cream
>
> 3 Tbsp soft butter

* * *

[18] Applicant objects to this website because it is sponsored by an Australian couple. "The fact that some people in Melbourne use CHOCOLATE GLACAGE on one recipe is once again inconsequential to the current analysis." 20 TTABVUE 19. This website is accessible to American consumers surfing the Internet for recipes. The fact that the website is sponsored by an Australian couple does not in and of itself disqualify the website from consideration since it is accessible by American consumers. Applicant's objection is overruled.

Also, the Board looks at the evidence as a whole and this website is just one piece of evidence under consideration.

> Pour the chocolate glacage over the cake. Let it drizzle down the side of the cake naturally. …
>
> 

9. Evan's Kitchen Ramblings blog (*bossacafez.blogspot*) (December 28, 2012) featuring a chocolate banana yule log with chocolate glacage.[19]

10. LoveJoyBakers website (*lovejoybakers.com*) offering cakes with chocolate glacage as a frosting option.

In his November 5, 2014 Office Action, the Trademark Examining Attorney included an excerpt from the *Ziplist.com* website for a recipe for Chocolate Glacage originally from Epicurious.

The evidence in its entirety shows that CHOCOLATE GLAÇAGE immediately describes a specific flavor of a particular type of icing used on cakes and other bakery goods. This evidence establishes the mere descriptiveness of CHOCOLATE

[19] Applicant objects to this website because it is sponsored by "a Japanese [woman] who speaks Korean and English. She has a passion for French and Japanese pastries and desserts. … The fact that one blogger in Japan, with a nice mastery of English used the expression chocolate glacage in 2012 on one of her recipes is hardly evidence of generic use of the term in the United States. The use of the mark in Japan is inconsequential to the prosecution of a mark in the United States. For this reason, this site is irrelevant to this analysis and should be dismissed as evidence from this list." 20 TTABVUE 20. This website is accessible by American consumers surfing the Internet for recipes. It is one piece of evidence considered in light of the other evidence. Applicant's objection is overruled.

GLAÇAGE as applied to "icing and glazes for cakes, pies, donuts, and bakery goods."

Applicant vigorously argues that the doctrine of foreign equivalents does not apply in this case. The Trademark Examining Attorney agrees.

> Based upon the fact that the mark is immediately recognized and understood by the general public as generically describing the applicant's goods of icing and glazing, the examining attorney agrees the Doctrine is not applicable in this case.[20]

As shown in the record, chefs and food writers describe their icing as a CHOCOLATE GLAÇAGE; they do not translate the French word "glaçage." Thus, it is the phrase CHOCOLATE GLAÇAGE itself that is merely descriptive, without translation of any part of the phrase.

Applicant also argues that there is no dictionary evidence for the word "glaçage." However, the fact that a term is not found in a dictionary is not controlling on the question of registrability where, as in this case, the examining attorney has shown that the term has a well understood and recognized meaning. *See In re Planalytics Inc.,* 70 USPQ2d 1453, 1456 (TTAB 2004) ("the presence of a term in the dictionary is not a condition precedent for a finding that a term is merely descriptive."); *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977).

As to the asserted "uniqueness" of CHOCOLATE GLAÇAGE because it is not well known term,[21] the fact that no other competitor may be using CHOCOLATE GLAÇAGE does not make it an inherently distinctive when the only significance

[20] 20 TTABVUE 14.

[21] 20 TTABVUE 11,

projected by the term is merely descriptive. *See In re Thomas Nelson Inc.,* 97 USPQ2d 1712, 1717 (TTAB 2011) (NKJV is merely descriptive for bibles); *In re Hunter Fan Co.,* 78 USPQ2d 1474, 1476 (TTAB 2006) ("a word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is the first to use a descriptive term in connection with its goods, does not imbue the term with source-identifying significance"); *In re Alpha Analytics Investment Group LLC*, 62 USPQ2d 1852, 1856 (TTAB 2002) (ALPHA ANALYTICS DIGITAL FUTURE FUND is merely descriptive for "financial services, namely, investment advisory services and mutual fund investment services")

Finally, at the oral hearing, Applicant questioned the probative value of random websites referencing the term CHOCOLATE GLAÇAGE that would be seen by an indeterminate and presumably small number of readers. However, the websites demonstrate how the authors use the term CHOCOLATE GLAÇAGE and how that term will be perceived by the readers. The evidence is sufficient to create a *prima facie* case that CHOCOLATE GLAÇAGE is merely descriptive. *Cf.* Juice Generation*, Inc. v. GS Enters. LLC,* 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015) (while the specifics as to the extent and impact of the use of third party marks was not proven, that a considerable number of third parties use similar marks is "powerful on its face."). We are not persuaded that Applicant's specimen of use showing use of CHOCOLATE GLAÇAGE™ ICING rebuts the *prima facie* case made by the Examining Attorney.

Decision: The refusal to register Applicant's mark CHOCOLATE GLAÇAGE on the ground that it is merely descriptive is affirmed.