

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: January 8, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Elkay Plastics Co., Inc.*

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Serial No. 88573025

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Gary M. Anderson of Fulwider Patton LLP,  
for Elkay Plastics Co., Inc.

Sahar Nasserghodsi, Trademark Examining Attorney, Law Office 115,  
Daniel Brody, Managing Attorney.

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Before Wellington, Goodman and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Elkay Plastics Co., Inc., applied to register the standard character mark COMPOSTA on the Principal Register for the goods, as amended:<sup>1</sup>

Pouches and rigid containers all made from kraft paper and kraft board for packaging use in the food service industry; Plastic pouches and films all made from bio-resin for use in the food service industry for

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<sup>1</sup> Application Serial No. 88573025 was filed on August 9, 2019 based on Applicant's allegation of an intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant subsequently filed an Amendment to Allege Use under Section 1051(c) of the Trademark Act, 15 U.S.C. § 1051(c), along with specimens of use, alleging March 5, 2020 as the date of first use of the mark anywhere and in commerce, which was accepted. A third class of goods in Class 22 was deleted at that time.

packaging; Rigid containers consisting primarily of kraft paper, kraft board and also including bio-resin, for packaging use in the food service industry; all aforementioned goods being compostable, in International Class 16; and

Plastic rigid containers made from bio-resin for use in the food service industry; Rigid containers consisting primarily of a bio-resin plastic substitute and also including kraft paper and kraft board, for packaging use in the food service industry; all aforementioned goods being compostable, in International Class 20.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of the identified goods. When the refusal was made final, Applicant requested reconsideration, which was denied. Applicant subsequently filed an appeal to this Board. The appeal is fully briefed.

We affirm the refusal.

### **I. Applicable Law**

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive ... of them,” unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). A mark is “merely descriptive” within the meaning of Section 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of the goods ... for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). “A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough

if it describes one significant attribute, function or property of the goods.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

Whether a mark is merely descriptive is “evaluated ‘in relation to the particular goods for which registration is sought, the context in which it 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 or intended use,’” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *Bayer*, 82 USPQ2d at 1831), and “not in the abstract or on the basis of guesswork.” *Fat Boys*, 118 USPQ2d at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). We ask “whether someone who knows what the goods and services are will understand the mark to convey information about them.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods are to reach a conclusion about their nature from the mark. *See, e.g., Fat Boys*, 118 USPQ2d at 1515.

“Evidence of the public’s understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers[,] and other publications.” *Real Foods*, 128 USPQ2d at 1374 (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127

USPQ2d 1041, 1046 (Fed. Cir. 2018)). “These sources may include [w]ebsites, publications and use ‘in labels, packages, or in advertising material directed to the goods.’” *N.C. Lottery*, 123 USPQ2d at 1710 (quoting *Abcor Dev.*, 200 USPQ at 218).

## II. Examining Attorney’s Evidence and Arguments

The Examining Attorney relies on the doctrine of foreign equivalents to support her argument that COMPOSTA is merely descriptive of the identified goods. Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English word marks. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). In descriptiveness cases:

It is a well[-]established principle of trademark law in this country that the foreign equivalent of a merely descriptive English word is no more registrable than the English word itself despite the fact that the foreign term may not be commonly known to the general public. That is, normally no distinction can be made between English terms and their foreign equivalents with respect to registrability. Foreign language words, not adopted into the English language, which are descriptive of a product, are so considered in registration proceedings despite the fact that the words may be meaningless to the public generally.

*In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1102 (TTAB 2018) (quoting *In re Highlights for Children, Inc.*, 18 USPQ2d 1268, 1270 (TTAB 2016)) (internal citations and quotations omitted).

The rule, however, is not absolute and should be viewed merely as a guideline. *Id.* The doctrine of foreign equivalents should be applied only when: (1) the relevant English translation is direct and literal and there is no contradictory evidence

establishing another relevant meaning, *In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012), and (2) “it is likely that the ordinary American purchaser would ‘stop and translate [the word] into its English equivalent.’” *Palm Bay*, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). “The rule is not to be applied mechanically.” *In re Isabella Fiore, LLC*, 75 USPQ2d 1564, 1569 (TTAB 2005). The “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

The Examining Attorney submitted English translations from five online Italian-English translation dictionaries to show that the word “composta” translates from Italian to English as “compost,” “mixture,” or “compound.”<sup>2</sup> She also provided a definition of the word “compost” as meaning a “mixture, compound,” or “to convert (a material, such as plant debris) to compost,” as well as a definition of the word “compostable” as meaning “capable of being used as compost.”<sup>3</sup>

The Examining Attorney asserts that “Applicant’s mark is in Italian, which is a common, modern language in the United States,”<sup>4</sup> referencing an article from Babel Magazine, which states that “about 709,000 people in the country speak Italian at

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<sup>2</sup> November 14, 2019 Office Action, TSDR 12 (wordreference.com); March 6, 2020 Final Office Action, TSDR 7-8 (dictionary.cambridge.org and it.bag.la); June 5, 2020 Request for Reconsideration Denied, TSDR 4-5 (context.reverso.net and translate.systran.net).

<sup>3</sup> November 14, 2019 Office Action, TSDR 13-14 (merriam-webster.com and thefreedictionary.com).

<sup>4</sup> 10 TTABVUE 5 (Examining Attorney’s Brief).

home, according to the U.S. Census Bureau” and that “Italian is the fifth most-studied foreign language in the United States. ... New York and New Jersey are the states with the largest number of native Italian speakers, with around 294,000 and 116,000 speakers, respectively.”<sup>5</sup> Based on the foregoing, the Examining Attorney contends that the ordinary American purchaser, which includes those proficient in Italian, would likely stop and translate the mark.<sup>6</sup>

Turning to her argument that the mark, as would be translated by the ordinary American purchaser, is merely descriptive of Applicant’s goods, the Examining Attorney notes that “Applicant’s identification of goods indicates that the goods are compostable. Thus, the term COMPOST/COMPOSTA, as applied to applicant’s goods, immediately describes that the goods may be used as compost.”<sup>7</sup>

In further support of her contentions, the Examining Attorney provided third-party Internet webpage evidence that she states “shows similar goods, specifically that bags, films, boxes and/or containers are sold touting that they are compostable and are suitable for the purpose of composting,” and “shows use of the terms ‘COMPOST’ or ‘COMPOSTABLE’ in a descriptive manner in conjunction with those goods,”<sup>8</sup> including evidence from:

- BioBag, which provides bags and films for restaurants, grocery stores, kitchens and institutions for the collection of organic waste for the purpose of composting: “We are a small, privately owned company dedicated to only producing certified compostable bags

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<sup>5</sup> March 6, 2020 Final Office Action, TSDR 9-10.

<sup>6</sup> *Id.* at 5-6.

<sup>7</sup> *Id.* at 6.

<sup>8</sup> *Id.*

and films.”;<sup>9</sup>

- Eco Products, which provides compostable liners and bags made with renewable resources: “These compostable plastic bags are made with renewable resources, BPI certified compostable and compliant.”;<sup>10</sup>



- Bed Bath & Beyond, which sells bags described as “100% compostable for disposing of your waste. These 4-liter bags take the mess out of cleaning your compost unit” and “to dispose of food scraps in preparation for gathering compost.”;<sup>11</sup>
- WebestaurantStore, which sells environmentally friendly “compostable paper take-out containers” for the packaging of food;<sup>12</sup> and
- LetsGoGreen.biz, which sells eco-friendly 100% compostable and biodegradable food containers: “[We’ve got a great selection of 100% compostable and biodegradable food and deli disposable takeout containers to meet your needs.”<sup>13</sup>

### III. Applicant’s Evidence and Arguments

Applicant provided additional Italian-English translations for COMPOSTA

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<sup>9</sup> November 14, 2019 Office Action, TSDR 15-16.

<sup>10</sup> *Id.* at 17.

<sup>11</sup> *Id.* at 18.

<sup>12</sup> *Id.* at 19.

<sup>13</sup> *Id.* at 20.

including “composed”<sup>14</sup> and “compote,” and argues that the “primary translation” of COMPOSTA is one of those translations, and that “the Examining Attorney’s proposed translation is at best the third possible translation of ‘Composta.’”<sup>15</sup> According to Applicant, the existence of these additional English translations shows that there is “contrary evidence of record regarding the meaning of COMPOSTA” and “precludes the application of the doctrine of foreign equivalents.”<sup>16</sup> In support, Applicant points to TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(b)(vi), which states that “if the evidence shows that the relevant English translation is literal and direct, and no contradictory evidence of shades of meaning or other relevant meanings exists, the doctrine generally should be applied by the examining attorney.” (Emphasis added by Applicant).<sup>17</sup> Here, Applicant asserts, “there is not clear, uncontradicted evidence in the record as to the proper English translation of record.”<sup>18</sup>

Regarding mere descriptiveness, Applicant argues that because “COMPOSTA translates as ‘composed,’ or ‘compote’ the Examining Attorney’s citation to various websites ... are not relevant.”<sup>19</sup> Applicant argues that it is inconsistent for the USPTO to allow two prior registrations for the marks COMPOSTABOX (for “coated, leak

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<sup>14</sup> February 18, 2020 Response to Office Action, TSDR 8 (Google Translate excerpt) and March 11, 2020 Request for Reconsideration, TSDR 13 (translate.yandex.com).

<sup>15</sup> 8 TTABVUE 8 (Applicant’s Brief).

<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* at 9.

proof, biodegradable and compostable cardboard boxes for storage, shipment and in-box composting of compostable material”) and COMPOST-A-PAK (for compostable paper-pulp based to-go containers for food), “both of which actually contain the word compost, without disclaimers thereby admitting that trademarks are not merely descriptive, yet refuse Applicant’s registration for a word that does not mean compost.”<sup>20</sup> Finally, Applicant argues that “COMPOSTA may be suggestive but it is not merely descriptive” because “the primary translation ... is either ‘composed’ or ‘compote.’ Applicant submits it would take imagination on the part of the consumer to associate ‘COMPOSTA’ with ‘compost’.”

#### **IV. Discussion**

Applicant misconstrues the guidelines provided by TMEP § 1207.01(b)(vi) which, contrary to Applicant’s assertion, do not preclude application of the doctrine of foreign equivalents whenever a term has multiple meanings. “The doctrine is applicable in this case because the record shows that the **relevant** English translation is literal and direct, the word comes from a common, modern language, and there is no contradictory evidence of another **relevant** meaning.” *Sadoru Grp.*, 105 USPQ2d at 1485. Many words have multiple meanings. Hence, the applicable definition of a word depends on the context of its use.

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<sup>20</sup> *Id.* Registration Nos. 4851549 (COMPOSTABOX) and 4633237 (COMPOST-A-PAK) were previously cited and made of record by the Examining Attorney for refusals to register based on likelihood of confusion, which were subsequently withdrawn. *See* November 14, 2019 Office Action (initial Section 2(d) refusals) and 10 TTABVUE 3 (Examining Attorney’s statement that withdrew such refusals following Applicant’s May 11, 2020 Request for Reconsideration).

The Examining Attorney, as noted above, provided English translations for “composta” (compost, mixture, or compound) and definitions for “compost” (a mixture, compound, or to convert a material to compost). We compare the overlapping definitions of “composta” with the relevant meanings of the other translations—“mixture” and “compound”—of which we take judicial notice:

- Mixture – “the act, the process, or an instance of mixing”; “the state of being mixed”; “the relative proportions of constitutes”; and “the product of mixing: COMBINATION: such as ... a combination of several different kinds”;<sup>21</sup>
- Compound – “to put together (parts) so as to form a whole: COMBINE”; “to form by combining parts.”<sup>22</sup>

Here, the relevant English meanings of COMPOSTA—compost, mixture, and compound—are not contradictory of one another, but rather, are highly related. “That several related meanings are also listed in the dictionary does not doom the refusal for lack of precision.” *In re Geo. A. Hormel & Co.*, 227 USPQ 813, 814 (TTAB 1985)

(affirming refusal to register *Saporito*, Italian equivalent of English word “tasty,” as merely descriptive and laudatory of applicant’s dry sausage notwithstanding other definitions such as “lively,” “witty” and “expensive); *see also S. Malhotra*, 128 USPQ2d 1100, 1105 (affirming refusal to register ΓΑΜΟΣ, Greek equivalent of English words “marriage, “matrimony,” and “wedding,” as merely descriptive of

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<sup>21</sup> <https://www.merriam-webster.com/dictionary/mixture> (accessed January 7, 2021). The Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries that exist in printed form or have regular fixed editions. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

<sup>22</sup> <https://www.merriam-webster.com/dictionary/compound> (accessed January 7, 2020).

applicant's jewelry and watches despite alternate meanings, including "small deer," "buck," and "a sexual ritual that plays out a marriage between a god and a goddess"); *In re Tokutake Indus.*, 87 USPQ2d 1697 (TTAB 2008) (affirming refusal to register AYUMI and Japanese-character equivalent as merely descriptive of footwear despite evidence of multiple meanings of "ayumi," including "walking," "a step," and "one's pace"). Accordingly, we find that Applicant's proposed mark COMPOSTA has definite English translations as "compost," "mixture," or "compound."

In addition, we find that "it is likely that the ordinary American purchaser would 'stop and translate [COMPOSTA] into its English equivalent.'" *Palm Bay*, 73 USPQ2d at 1696. Historically, the doctrine of foreign equivalents has been applied to Italian in a number of cases with little or no discussion of how many Americans speak the language. "[I]t does not require authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States." *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986). Nor does Applicant dispute that Italian is a common modern language. To the extent there is any question, the Examining Attorney's Internet evidence, citing U.S. Census Bureau statistics from 2013 that more than 700,000 people speak Italian, and that Italian is the fifth most-studied foreign language in the United States, adds to that finding. *Accord In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1310 (TTAB 2006) ("There is no question that Russian speakers living in the United States, according to the record approximately 706,000 in number, would immediately know that BAIKALSKAYA means 'from Baikal.'").

Applicant's argument that the Examining Attorney's third-party Internet evidence is not relevant is tied to its corresponding misconception regarding applicability of the doctrine of foreign equivalents and therefore is unavailing. Instead, we find that the third-party evidence is relevant and probative to show that the term COMPOST, and its use in adjective form as COMPOSTABLE, is descriptive of goods with the feature and characteristic of being used for compost and/or is compostable.

Also unavailing is Applicant's argument regarding asserted inconsistency on the part of USPTO, or that the USPTO has acknowledged the "COMPOST" is not merely descriptive for similar goods by permitting the registrations of COMPOSTABOX and COMPOST-A-PAK on the Principal Register without a disclaimer. As the Examining Attorney correctly observes, citing TMEP § 1213.04, the marks in those registrations "are irrelevant because the term 'COMPOST' appears within the marks that are unitary; accordingly, no disclaimer would have been required in either mark."<sup>23</sup> As the Examining Attorney further notes, "the fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness," citing *In re Scholastic Testing Serv., Inc.* 196 USPQ 517, 519 (TTAB 1977).<sup>24</sup> "In a final analysis, we are not so much concerned with what has been registered, but rather what should or should not be registered." *Id.* Moreover, it is well settled that each case must be decided on its own facts and the Board is not

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<sup>23</sup> 10 TTABVUE 8 (Examining Attorney's Brief).

<sup>24</sup> *Id.*

bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Finally, Applicant argument that COMPOSTA is suggestive but not merely descriptive because “the primary translation ... is either ‘composed’ or ‘compote,’ is without merit. That “composta” is translated first as “compote” in one of the Examining Attorney’s dictionary definitions of record, and second as “compost,” as Applicant points out,<sup>25</sup> is inconsequential. “It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive.” *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *see also In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1034 (TTAB 2007); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). As explained, the relevant meaning of a term depends on the context in which the term is used. Here, as clearly stated in Applicant’s identification of goods, **all** of Applicant’s pouches, containers, and films are compostable; that is, they can all be made into compost. This is a feature and characteristic of Applicant’s goods that is immediately described by the word COMPOST, the relevant English translation of Applicant’s proposed mark COMPOSTA from Italian.

## **V. Conclusion**

Based on the record in its entirety, we find that consumers of Applicant’s compostable pouches, containers and films who are familiar with the Italian language would immediately understand COMPOSTA to convey information about a feature

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<sup>25</sup> 8 TTABVUE 7-8 (Applicant’s Brief).

or characteristic of those goods, namely, that they may be used as compost and/or are compostable. Because the proposed mark immediately conveys knowledge about Applicant's goods, it is merely descriptive under Trademark Act Section 2(e)(1).

***Decision:*** The refusal is affirmed.