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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sno-Wizard Manufacturing, Inc.¹

Serial No. 76059333

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Finn, Blossman & Areaux for Sno-Wizard Manufacturing, Inc.²

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(Margaret Le, Managing Attorney).

Before Bucher, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Sno-Wizard Manufacturing, Inc. (applicant) applied to
register the term SNOBALL (typed) on the Principal Register
for goods ultimately identified as "ice shaving machines

¹ After this case was briefed, a paper was filed in the Office
assigning the mark to Snowizard Holdings, Inc. Real/Frame No.
2846/0936.

² On June 8, 2004, a new power of attorney was filed naming Seth
M. Nehrbass and other attorneys from Garvey, Smith, Nehrbass &
Doody, L.L.C. as the attorneys for applicant. A copy of this
opinion will be sent to both applicant's current and previous
counsel.

for sale to retail business selling shaved ice confections" in International Class 7. The application was eventually amended to claim a date of first use and a date of use in commerce of June 15, 1955, and to seek registration under the provision of Section 2(f). 15 U.S.C. § 1052(f).

The examining attorney³ sets out the issue in this case as follows: "Whether the applicant's mark SNOBALL is generic for snowball making machines under Trademark Act Section 1, 2 and 45 and whether the term fails to function as a mark as shown in the specimens of record under Trademark Act Section 1 and 45?" Examining Attorney's Brief at 3. The examining attorney also indicated in his brief that applicant's "acquired distinctiveness evidence must be rejected." Examining Attorney's Brief at 5.

The examining attorney argues that SNOBALL and SNOWBALL are legally identical terms and that third parties use the term "SNOWBALL MACHINE to identify a machine that make[s] a type of ice confection." Examining Attorney's Brief at 4. In response, applicant argues that the usage of record "reflects a careful and respected distinction between the terms 'snow ball' and 'snoball.'" The former

³ The current examining attorney was not the original examining attorney in this case.

term is used to refer to any ice-shaving machine; the latter term is not so used." Applicant's Brief at 16.

Genericness

The key issue in this case is whether the term SNOBALL is generic for applicant's ice shaving machines.⁴ The Court of Appeals for the Federal Circuit has held that: "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." H. Marvin Ginn Corp. v. Int'l Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Ginn goes on to explain that:

Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id.

We begin by analyzing the evidence of record on the question of whether "snoball" is used to refer to ice shaving machines. The evidence consists of excerpts

⁴ Inasmuch as applicant is seeking registration under Section 2(f), there is no question that its mark is merely descriptive. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact") (emphasis in original).

submitted by the examining attorney and applicant from the Internet, NEXIS, and phone book Yellow Pages. In an article from www.gumbopages.com, the author explains that:

The **sno-ball** is a New Orleans creation. The main reason for this is a machine called a "Hansen's Sno-Bliz." This is a machine that turns blocks of ice into **sno-balls**... The classic **sno-ball** machine (now manufactured by four or five companies in the area) works like a deli meat slicer. I have never seen anything like a **sno-ball** in any part of the country, although Lani Teshima-Miller's description of "shaved ice" in Hawaii is the closest thing I've heard. A **sno-ball** isn't an Italian ice, nor is it a crushed ice abomination.

Other evidence includes:

Snoballs are big business in New Orleans. So big that **snoball** machines are becoming a major export to foreign countries... The business has such stature that a **snoball** museum is being built on the Orleans-Jefferson parish line.

New Orleans CityBusiness, June 16, 1997.

Snoballs are extremely popular and "kind of like the espresso of Louisiana," Bridget Huckabay said. *Chattanooga Times and Free Press*, June 8, 2001.

In addition, the examining attorney made of record an entry from the *American Heritage Dictionary of the English Language* (3rd ed. 1992) that included a definition of "snow ball" as "*Chiefly Southern U.S.* A cup of crushed or shaved ice flavored with colored syrup."

Applicant submitted excerpts from twenty years of Yellow Pages from the New Orleans area. Those Yellow Pages

show that since at least 1990 products such as applicant's are listed under the category entitled "Snow Ball Machines." The term "snow ball" is a term commonly used by applicant's competitors in these Yellow Pages ads. For example, the April 1994 New Orleans Yellow Pages contained the following entries from companies other than applicant:

Fluffy-Ice Snowball Machines Flavors & Supplies

Eisenmann Products

- Snowball & Block Ice Machines

The Original Southern Snow Machine

- Snow Ball Machines

The May 1998 Yellow Pages contains an ad from a competitor that refers to itself as the "Home of the 'New Orleans Style Snowball Machine & Flavors.'"

Applicant's ad in the May 1996 Yellow Pages describes an individual apparently connected with applicant as the "Inventor of the Snowball Machine." Applicant also submitted that it was aware of a competitor using the term SNO BALL in the 1987 edition of the Yellow Pages. After applicant complained to the phone book, the ad was changed to refer to "snow ball." Sciortino affidavit, April 25, 2002 at 2. Applicant admits that the term "snow ball" is a "term used to refer to any ice-shaving machine." Applicant's Brief at 16. Indeed, applicant admits that members of the public recognize that "'Snow Ball Machines,'

not SNOBALL machines, is the generic term for the goods at issue." Applicant's Brief at 17. Therefore, based on this evidence, it is clear that "snow ball" is a generic term that refers to an ice-shaving machine.

We next look at whether applicant's term is understood by the relevant public to refer to that genus. Ginn, 228 USPQ at 530. "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications." In re Merrill Lynch, Fenner and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." Ginn, 228 USPQ at 530. Applicant defines the relevant public as "manufacturers, distributors, and purchasers of ice-shaving machines." Applicant's Brief at 17. Obviously, these purchasers of ice-shaving machines would use the Yellow Pages to purchase these machines.⁵ The 1998 Yellow Pages identify the

⁵ Applicant's president indicated that "the ice-shaving machine manufacturers that advertise in the Greater New Orleans Yellow Pages represent at least 70% of the total sales, by volume, of ice-shaving machines in the United States." Sciortino affidavit dated April 24, 2000 at 2.

category of the goods as "Snow Ball Machines" and "Snow Ball Machines Equipment & Supplies." Prospective purchasers would see advertisements that refer to the goods with language such as "snowball & block ice machines," "snow ball machines," and "New Orleans Style snowball machine and flavors." This evidence leads to the conclusion that customers would understand that the genus of the goods is snow ball or snowball machines.

At this point, we address the question of whether applicant's exact mark SNOBALL is generic. As noted earlier, applicant admits that the term "Snow Ball Machines" is "the generic term for the genus of goods at issue." Applicant's Brief at 17. It is also clear from the Yellow Page advertisements that the term "snowball machines" is likewise generic. Applicant in its ad (New Orleans Yellow Pages April 1994) refers to George J. Ortolano as "The Inventor of The Snowball Machine." On the same page, Eisenmann Products lists "Snowball & Block Ice Machines" and a separate entry appears for "Fluffy-Ice Snowball Machines Flavors & Supplies." Therefore, the only question is whether the term SNOBALL is not generic while the terms SNOWBALL and SNOW BALL are generic.

A slight misspelling does not convert a generic term into a non-generic term. See Nupla Corp. v. IXL

Manufacturing Co., 114 F.3d 191, 42 USPQ2d 1711, 1716 (Fed. Cir. 1997) ("Based on overwhelming documentary evidence of record showing widespread and long-time prior use of the CUSHION-GRIP mark in the hand tool industry, we agree with the district court's conclusion that there is no genuine issue of material fact that Nupla's mark [CUSH-N-GRIP], which is merely a misspelling of CUSHION-GRIP, is also generic as a matter of law, and the registrations are therefore invalid"); In re A La Vielle Russie Inc., 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for particular field or type of art and also for dealership services directed to that field); In re Yardney Electric Corp., 145 USPQ 404, 405 (TTAB 1965) ("`NICEL' is merely a misspelling and phonetic equivalent of `nickel' and means the same thing. As such the subject matter identifies applicant's product as to kind and not source. It is therefore not registrable within the purview of the statute) (citation omitted). The terms SNOBALL and SNOWBALL would be pronounced identically and have the same meaning. Omitting the letter "w" in the middle of the term does not change the term from a generic term to a non-generic one.

Furthermore, in addition to the genericness of the term "snow ball" and "snowball," there is evidence that the same term for which applicant seeks registration, "SNOBALL"

with and without a space, is used generically. See New Orleans CityBusiness ("Snoballs are big business in New Orleans. So big that snoball machines are becoming a major export"); Chattanooga Times and Free Press ("Snoballs are extremely popular"); www.gumbopages.com ("About Sno-Balls"). This evidence supports the correctness of the examining attorney's conclusion that the term SNOBALL is generic for "ice shaving machines for sale to retail business selling shaved ice confections."

Applicant argues that "the constituent SNO does not have the meaning of 'snow,' to wit: frozen precipitation that falls in soft white flakes; similarly, the constituent BALL does not mean a spherical object. Applicant's SNOBALL mark is not used on a ball of snow; rather, it is used on an ice-shaving machine." Applicant's Brief at 5-6 (citations to record omitted). However, the refusal in this case is not based on an argument that the individual words are generic and that they form a generic compound. See, e.g., In re Gould Paper Co., 834 F.2d 1017, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987) ("We hold, however, that the PTO has satisfied its evidentiary burden if, as it did in this case, it produces evidence including dictionary definitions that the separate words joined to form a compound have a meaning identical to the meaning common

usage would ascribe to those words as a compound").

Instead, the refusal here is based on the evidence that the term "Snoball" itself is generic. Obviously, if the evidence shows that the term "football" is generic for an athletic competition, the examining attorney does not have to show that the individual terms "foot" and "ball" are individually generic for the game.

Applicant also argues that several references use the term "snoball" and its equivalents "to refer to the snow ball product (purchased at the retail level by consumers of shaved-ice confections), not the ice-shaving machine used in creating the product (purchased by retail businesses selling shaved-ice confections)". Applicant's Brief at 10-11 (emphasis in original). While several references refer to the products, much of the evidence including applicant's own usage in its ads, its competitor's ads, the heading in the Yellow Pages, and some of the articles specifically use the term "snow ball" and its equivalents to refer to the machines themselves. *See, e.g., New Orleans CityBusiness*, June 16, 1997 ("[S]noball machines are becoming a major export to foreign countries").

Applicant maintains that "the use of a mark on goods or services other than the goods or services for which registration is sought has no probative value as to whether

such term is generic for the field of interest."

Applicant's Brief at 9 (emphasis omitted). Applicant then goes on to explain that "evidence of usage of the term 'chair' on baseball caps or cigarettes has no probative value as to whether the term 'chair' is generic for a piece of furniture." Id. While applicant's example is correct, it would not be true that evidence of the genericness of the term "chair" for furniture would not be relevant in considering whether the term "chair" is generic for a store that sells chairs or a machine that makes chairs. See In re Northland Aluminum Products, 777 F.2d 1556, 227 USPQ 219 (TTAB 961) (BUNDT generic for a "ring cake mix" despite evidence that showed generic use of the term only for a type of cake, and not for a cake mix); A La Vielle Russie, 60 USPQ2d at 1900 (RUSSIANART "is generic for applicant's services of selling such art"); In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for "architectural design of buildings, especially houses, for others," and "retail outlets featuring kits for constructing buildings, especially houses"). Even if the evidence only showed that the products produced by applicant's machines are called snowballs or snow balls, it is at least some evidence that the machines themselves would be known as snowball or snow ball machines. Of

course, there is more direct evidence in this case. For example, applicant itself in its ads uses the term "snowball machine" in a generic fashion and it admits in its brief that the term "Snow Ball Machines" is "the generic term for the genus of goods at issue." Applicant's Brief at 17.

We are also not persuaded by applicant's point that there is evidence of non-generic usage and that some articles use the term ice-shaving machines. There is nothing unusual about a product or a service having more than one generic name or about a generic term having some evidence of de facto trademark recognition. Roselux Chemical Co. v. Parsons Ammonia Co., 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962) ("Consider, however, that the product commonly known as tooth paste is also commonly known as dentifrice and dental cream. A gravestone is also commonly known as a headstone, a tombstone and a monument"); In re Recorded Books Inc., 42 USPQ2d 1272, 1282 (TTAB 1997) ("Nonetheless, if the evidence as a whole establishes -- as it does to our satisfaction -- that the term is primarily perceived as a generic term, the recognition of the term as a trademark by a subset of applicant's customers must be deemed no more than a de facto secondary meaning that, in

legal effect, can neither confer nor maintain trademark rights in the designation sought to be registered”).

Acquired Distinctiveness

If applicant’s term is generic, which we have found in this case, then no amount of evidence of acquired distinctiveness can establish that the mark is registrable. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985). However, for the sake of completeness, we now address applicant’s claim that its mark has acquired distinctiveness. On this issue, applicant has the burden of proving that its mark has acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”). “[L]ogically that standard becomes more difficult as the mark’s descriptiveness increases.” Yamaha Int’l, 6 USPQ2d at 1008.

Applicant’s evidence of acquired distinctiveness consists primarily of a claim that two competitors changed their Yellow Pages ads to read “snow ball” instead of “snoball.” Applicant’s Brief at 20-21. The fact that two competitors chose to change the spelling of the generic name for the goods to include the traditional letter “w”

after applicant protested is hardly significant. Indeed, it would have been surprising if these entities litigated over the right to use "snoball" when applicant had no objection to their use of the virtually identical term "snowball."

When the only difference between the generic term and applicant's alleged trademark is a letter that does not change the pronunciation, any evidence of acquired distinctive would have to be very persuasive. If a salesman or a speaker at an industry convention referred to "snowball machines," it would not be clear whether he was referring to applicant's "Snoball Machines" or Southern Snow Machine's "snow ball machines" or Eisenmann Products Co.'s "New Orleans Style Snow Ball Machines." See 2002 New Orleans Yellow Pages. We also add that even applicant's allegation of long use of the term does not convert a generic term into a non-generic term. In re Helena Rubinstein, Inc., 410 F.2d 438, 161 USPQ 606, 609 (CCPA 1969). Inasmuch as applicant's mark is phonetically identical to the admittedly generic term, applicant's evidence falls far short of demonstrating that its mark has acquired distinctiveness, even if the mark would ultimately be determined to not be generic for applicant's goods.

Does Not Function as a Mark

The examining attorney has also refused registration on the ground that the term does not function as a mark.

The examining attorney argues (p. 6) that:

The method of presentation, a moniker identifying a product subservient to a classic trademark form, cannot be said to create a trademark impression since the specimen itself is identifying the product by a trademark ('SNOWIZARD'), and the rest of the wording, because of its placement and format, identifying and classifying the product itself ('SNOBALL MACHINE').

We do not view this refusal as a separate refusal.

Applicant's specimens show the term used roughly as

follows:

SnoWizard

SNOBALL MACHINE

There is no reason why applicant could not use more than one trademark in association with its goods. Applicant's use does not per se indicate that the term does not function as a mark. The examining attorney's failure to function as a mark refusal appears to be subsumed into the genericness refusal to the extent that if the term SNOBALL is generic, it obviously would not function as a mark. If, on the other hand, the term is not generic, its use on the specimens would not prevent it from being registered.

Therefore, we do not separately affirm a refusal to

Ser. No. 76059333

register on a ground that the term does not function as a mark.

CONCLUSION

Applicant's term SNOBALL is generic for the goods recited in the application and, in the event that the term is not generic, applicant has not demonstrated that its mark has acquired distinctiveness.

Decision: The refusal to register is affirmed.