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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re O.R.A. Corporation

Serial No. 76236276

Bert A. Collison of Duane Morris LLP for O.R.A Corporation.

Christopher Scott Adkins, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Hairston and Rogers, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

O.R.A. Corporation seeks to register TACO BITES as a trademark for "frozen, packaged or prepared Mexican food, namely rolled corn taquito tortillas with chicken, beef or cheese fillings."¹

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15

¹ Serial No. 76236276, filed July 18, 2001, based on an allegation of a bona fide intention to use the mark in commerce.

U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of the identified goods.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney contends that TACO BITES is merely descriptive of the identified goods because it immediately conveys information about their nature and size, namely, that they are bite size tacos. In support of the refusal, the Examining Attorney submitted excerpts from The American Heritage Dictionary of the English Language (Electronic version, Third edition, 1992) wherein "**taco**" is defined as "*a corn tortilla folded around a corn filling such as ground meat or cheese;*" and "**bite**" is defined as "*an amount of food taken into the mouth at one time, a mouthful; and a light meal or snack.*" In addition, he submitted over twenty third-party registrations of marks that contain the word BITES for food items. In each registration, BITES has been disclaimed or the registration issued under the provisions of Section 2(f) or on the Supplemental Register. In addition, the Examining Attorney submitted excerpts of articles taken from the NEXIS database which contain references to "taco(s)" or "bite size" in relation to food items. On the basis of this

evidence, the Examining Attorney concluded that TACO BITES is merely descriptive of applicant's identified goods.

Applicant, on the other hand, argues that TACO BITES merely suggests information about the identified goods; that it does not describe the goods in any direct or immediate manner; that applicant's goods may be consumed in more than one bite; and that the Examining Attorney has improperly dissected the mark instead of considering the mark as a whole.

Further, applicant points to four registrations for marks that contain the word BITES with no disclaimer thereof. The registrations are: Registration No. 1,278,190 for the mark SPUD BITES for frozen potatoes, with a disclaimer of SPUD; Registration No. 1,399,736 for the mark BAGEL BITES for frozen bagels with various toppings, with a disclaimer of BAGEL; Registration No. 2,064,331 for the mark DYNA BITES and design for frozen breaded vegetables and cheese combinations; and Registration No. 2,322,663 for the mark HOT BITES for prepared appetizers, with a Section 2(f) claim. Applicant argues that these registrations support registration of its mark.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic,

function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality or property thereof. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Recovery, 196 USPQ 830 (TTAB 1977).

Applicant does not dispute that the word TACO is merely descriptive of applicant's goods. Also, as previously indicated, the Examining Attorney submitted a number of third-party registrations of marks that contain the word BITES for food items, wherein the word has been disclaimed, or the registrations issued under the provisions of Section 2(f) or on the Supplemental Register. In this regard, we note the following registrations:
Registration No. 2,358,304 for the mark BORDER BITES for

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Mexican appetizers, with a disclaimer of "BITES";
Registration No. 2,554,663 for the mark FUDGE BROWNIE DOUGH
BITES and design for candy, cakes, and bakery goods all
containing brownie dough, with a disclaimer of "FUDGE
BROWNIE DOUGH BITES"; Registration No. 2,416,552 for the
mark NANCY'S BAGUETTE BITES for frozen appetizers
consisting primarily of cheese and vegetable topping on
baguette, with a disclaimer of "BAGUETTE BITES";
Registration No. 2,271,929 for the mark COOKIE DOUGH BITES
and design for candy, cakes, and bakery goods all
containing cookie dough, with a disclaimer of "COOKIE DOUGH
BITES"; Registration No. 2,502,026 for the mark STRUDEL
BITES, issued under Section 2(f), for puff pastry with
fruit and other flavor fillings; Registration No. 2,254,562
for the mark JALAPENO BITES, issued on the Supplemental
Register, for breaded and fried jalapeno pepper; and
Registration No. 1,792,235 for the mark BUFFALO BITES,
issued on the Supplemental Register, for chicken for
consumption on or off the premises. These third-party
registrations support the Examining Attorney's position
that the word BITES is descriptive in connection with food.

The word BITES would be perceived as the equivalent of "bite size," and in the absence of any limitations in applicant's identification of goods, we must assume that applicant's tacos are of varying sizes, including small or appetizer size such that they may be consumed in a single mouthful. Thus, we find that the word BITES is descriptive of applicant's goods.

When these descriptive words TACO and BITES are joined in the mark TACO BITES, we find that the mark as a whole is merely descriptive of applicant's goods, in that it immediately conveys to consumers that applicant's goods are bite size tacos.

We admit that inconsistent Office handling of applications to register marks that include the word BITES is troubling. We note, however, that the mark HOT BITES issued under the provisions of Section 2(f), which is an admission of the descriptiveness of this mark. As to the other three registrations relied on by applicant, we do not know the circumstances under which they issued. Moreover, we do note that these registrations issued long before the third-party registrations put into the record by the Examining Attorney. As the Examining Attorney has pointed out, it is entirely possible that a term, i.e., "bites," that may not earlier have been viewed as descriptive has

come into common use and is now recognized as descriptive. In any event, as the Court noted in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1546, 1566 (Fed. Cir. 2001), the Board must assess each mark on the record submitted with the particular application. In this case, the fact that there are a handful of registrations for marks containing the word BITES without a disclaimer thereof does not outweigh the evidence of descriptiveness as shown by the dictionary definition and the numerous third-party registrations submitted by the Examining Attorney. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) ["[E]ach application for a registration of a mark for particular goods must be separately evaluated"].

Decision: The refusal to register under Section 2(e)(1) is affirmed.