

THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B

Mailed: January 24, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re J. R. Simplot Company

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Serial No. 78765736

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Barbara A. Friedman of Edell, Shapiro & Finnan, LLC for J.  
R. Simplot Company.

Linda M. Estrada, Trademark Examining Attorney, Law Office  
104 (Chris Doninger, Managing Attorney).

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Before Holtzman, Zervas and Kuhlke, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

J. R. Simplot Company, applicant, has filed an  
application to register the mark PANCAKE PODS (in standard  
character form) on the Principal Register for goods  
ultimately identified as "pre-packaged batter-based  
breakfast pastries and sweet snack foods in the nature of  
jelly and/or custard-filled pancakes, and excluding made-

to-order pizza dough-based entrees" in International Class 30.<sup>1</sup>

The examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods. After the examining attorney made the descriptiveness refusal final, applicant concurrently filed an appeal and a request for reconsideration. Upon the examining attorney's denial of the request for reconsideration, the Board resumed the appeal. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." 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 MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant

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<sup>1</sup> Application Serial No. 78765736, filed on December 2, 2005, under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b),

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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 Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). 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 ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. 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, 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 Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Finally, while a combination of descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning, In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968), the mere

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alleging a bona fide intention to use the mark in commerce.

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combination of descriptive words does not necessarily create a nondescriptive word or phrase. In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. In re Oppedahl & Larson LLP, supra.

It is the examining attorney's position that "the term 'pancake' immediately conveys information to consumers about the nature of the goods as pancakes [and] the term 'pod' conveys information to consumers about a characteristic and feature of the goods relative to their shape." Br. p. 7. The examining attorney primarily supports her position by relying on the following dictionary definition of "pod":

Pod: 4. Something resembling a pod, as in compactness.

The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000).

The record also includes the following dictionary definitions of "pod" and "compact":

Pod: 1. A somewhat elongated, two valved seed vessel, as that of the pea or bean.

Dictionary.com; and

Compact: joined or packed together; closely or firmly united; dense; solid.

Dictionary.com.

The examining attorney also submitted printouts from applicant's webpage retrieved from the Internet which show that its goods consist of "two pancakes joined or packed together." Br. p. 7. The goods are specifically described on the website as "3 [inch] pancakes heat sealed together with real fruit or crème filling." [www.simplotfoods.com](http://www.simplotfoods.com). Excerpts from the webpage are reproduced below.



Applicant argues that "the absence of relevant pertinent evidence establishing a direct meaning of 'pods' with regard to these goods, coupled with conclusions that are ambiguous and unsupported demonstrates that no prima facie case has been established, and the application should have been approved for publication." Br. p. 9. Further, applicant argues that:

[a]lthough the examining attorney opined that "pod" describes the form or shape of applicant's goods and that the goods resemble a pod, to the contrary, the evidence of record submitted by applicant demonstrates that "pod" does not convey any direct information about applicant's pancake snacks, thereby clearly rebutting the examining attorney's finding. The physical attribute of a pod, as defined in the evidence of record, is "a somewhat elongated, two-valved seed vessel, as

that of the pea or bean". As the record reflects, a "seed vessel" is defined as "the ripened and variously modified walls of a plant ovary." In the field of botany, which is the context of the ... definition, "valve" is "a segment of a wall of a seed pod or other fruit that splits apart to reveal its contents". The physical shape and appearance of a pod is thus very specific, and it neither should be extended to, or would it be understood as, that of a pancake.

Br. pp. 9-10.

Applicant continues stating that:

[t]he evidence of record establishes that compactness does not refer to size, shape, dimension, or exterior appearance, but rather it refers to a spatial quality of being crowded together, arranged within a small area, or having the consistency of a compact solid ... The connotation clearly is one of maximizing efficiency and usable space in compact areas. There is no evidence that the same connotation of compactness or density extends to snack foods that have a filling.

Br. p. 11.

In addition, applicant argues that:

[a]pplicant's search on the Google search engine disclosed thousands of references to "pod" appearing with "pastry" or "baking" or "cooking" or "food." Although impractical to access and review each and every reference, among the first fifty, the only descriptive use of "pod" was in connection with raw food ingredients in the form of actual pods (two-valved seed vessels) such as vanilla bean pods, carob bean pods, cardamom pods, and cocoa beans, to name a few ... Clearly, this evidence demonstrates that "pod" is not used in ordinary parlance to describe products in the field of pastry, baking, cooking, or food, other than with respect to two-valved seed vessels.

Br. p. 13.

Finally, applicant argues that:

[i]f a filled pastry were considered to resemble a pod, then it would be expected that there would be evidence that such types of pastries or snacks were referred to, either by competitors in the food service industry, by the media, or by consumers, as "pods." To the contrary, there is a notable absence of such evidence in the record, and Applicant was unable to locate any such references in various searches performed on the internet search engines.

Reply Br. p. 4.

Applicant concludes that PANCAKE PODS "is the archetypical 'good' trademark, i.e., one that may shed some light upon the nature of the applicant's snacks, but that does so with an element of incongruity, requiring a multi-stage reasoning process and imagination on the part of the observer in order to be understood." Reply Br. p. 5.

After careful review of the evidence and consideration of applicant's arguments, we conclude that the record in this case supports a finding of mere descriptiveness of the phrase PANCAKE PODS. Applicant does not dispute that the word PANCAKE is descriptive of its goods. Reply Br. p. 2. Just as PANCAKE describes the nature of the goods, PODS also describes what the nature of this product is, in that it consists of two filled halves joined together. We find the dictionary definition for PODS as "something resembling

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a pod, as in compactness" combined with applicant's webpage sufficient to determine that the word "PODS" when used in connection with applicant's "3 [inch] pancakes heat sealed together with real fruit or crème filling" merely describes the nature of the goods, i.e., resembling a pod. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005) (dictionary definition and press release about the applicant's goods constituted substantial evidence to support finding that STEREO TAXIS is merely descriptive). Applicant's attempt to limit the meaning of "pod" to only a specific elongated shape described by a seed pod is not warranted by the definition "something [i.e., anything] resembling [not identical to] a pod, as in compactness." Moreover, the definition "resembling a pod" is not limited by applicant's narrow application of the term "compactness" and, in any event, applicant's product could certainly be described as compact, i.e., "joined or packed together; closely or firmly united," as depicted on its webpage fitting into the pocket of a backpack.

We further note, that while the record does not present examples of "pod" used to describe bakery items, it appears to be used to describe prepackaged espresso, coffee and tea. See Google search result summary attached to Applicant's Response (10/17/06) ("The following Home Cafe

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coffee machines and coffee pods are currently the best";  
"Coffee Pods: Buy thousands of gourmet foods from over 100  
countries..."; "Espresso Pods - Cooking.com"; "Find your  
Starbucks Espresso Pods here at Cooking.com"; "Get the  
Simplehuman Pod Brewer for ... at Cooking.com  
www.singleservecoffee.com"; "TeaOne English Breakfast Tea  
Pods"; "Espresso pods are not compatible with single-serve  
pod coffee makers, such as ..."; "Anyone Have A Pod  
Coffeemaker?"; "Each pod measures 2in. in diameter, By  
using a coffee or espresso maker specifically designed for  
use with pods, the pod"; "More espresso pods. Easy to use  
with no mess to clean up."; "The Gourmet Kitchen has  
everything a gourmet chef could want. Save on cooking  
products including ... Melitta coffee makers, coffee  
pods..."; and "Kraft Foods is offering a free bag of  
Maxwell House coffee pods to be used with the new style  
single serving coffee makers.").<sup>2</sup> Thus, in the food and  
beverage industry, at least as to espresso, coffee and tea,  
pod appears to describe the manner in which the goods are  
provided. In any event, it is well established that the  
fact that applicant may be the first and only user of a

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<sup>2</sup> The probative value of search engine summary results depends upon the facts of a particular case. See *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). In this case, we find that the summaries provide sufficient context for the term to be of some probative value.

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term that is merely descriptive does not justify registration if the only significance conveyed by the term is merely descriptive. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983). Clearly, these terms separately have a descriptive significance in relation to applicant's goods. The question remains whether combined they present a unique or incongruous combination.

We find that when combined the terms PANCAKE and PODS do not lose their descriptive significance and, in fact, make clear that applicant's goods consist of pancakes resembling a pod. Thus, we are persuaded by the evidence of record that the words PANCAKE and PODS are merely descriptive of applicant's identified goods and that when combined do not present a unique or incongruous meaning. In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002).

Looking at the average or ordinary prospective customers of applicant's goods, as we must, In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987), the average consumer of applicant's goods would certainly know and be familiar with the terms pancake and pods. Nor would it take any speculation or mental leap to understand that PANCAKE PODS describes pod-like, filled pancakes.

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Viewing PANCAKE PODS as a whole, we find the evidence of record sets forth a prima facie case that such phrase is merely descriptive and applicant has not rebutted this showing. Thus, we are persuaded that when applied to applicant's goods, PANCAKE PODS immediately describes, without need for conjecture or speculation, a significant feature or function of applicant's goods. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective consumers of applicant's goods to perceive readily the merely descriptive significance of PANCAKE PODS as it pertains to applicant's goods.

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