

**THIS OPINION
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THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mars, Incorporated

Serial No. 78919907

Christina A Carvalho of Arent Fox for Mars, Incorporated.

Katherine S Chang, Trademark Examining Attorney, Law Office
115 (J Brett Golden, Acting Managing Attorney).

Before Walters, Cataldo and Bergsman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Mars, Incorporated has filed an application to register
on the Principal Register the standard character mark
MARROBITES for "pet food," in International Class 31.¹

The examining attorney has issued a final refusal to
register, under Section 2(e)(1) of the Trademark Act, 15

¹ Serial No. 78919907, filed June 29, 2006, based on an allegation of a bona fide intention to use the mark in commerce. The application includes a claim of ownership of two registrations on the Supplemental Register: nos. 2365399 and 2503227 for MARROBITES, in standard character and stylized form, respectively, both for pet food. However, we note that both registrations have been cancelled for failure to file a Section 8 affidavit.

U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

The examining attorney contends that MARROBITES is merely the combination to two descriptive words and the resulting compound work is not unique or incongruous; and that the "marro" portion of the mark is equivalent to the word "marrow" and would be so perceived by consumers. During examination, the examining attorney submitted definitions from *Merriam-Webster Online Dictionary* defining "marrow" as "the substance of the spinal cord; the choicest of food" and "bites" as "small amounts of food." We also take judicial notice of the definition in *The American Heritage Dictionary* (2nd college ed. 1985) of "marrow" as "the soft material that fills bone cavities, consisting, in varying proportions of fat cells and maturing blood cells together with supporting connective tissue and numerous blood vessels."

Additionally, the examining attorney submitted excerpts from several Internet websites (shown below) that refer to "marrow bites" as food or treats for dogs and she concludes that MARROBITES merely describes a significant aspect of

applicant's pet food, i.e., that it consists of small bite-sized pieces that include marrow.

- "Fill approximately one-third of the cavity with doggie treats such as biscuits, marrow bites, etc." (petfooddirect.com);
- "He has learned to crawl, sit & roll over and he really enjoys milk bone 'bone marrow bites'" and "My favorite tricks and treats are the good morning spin and bone marrow bites" (petchannel.com);
- "Try mixing turkey, chicken, or marrow bites with slightly moistened food nuggets" (regarding Kong toys);
- "... I might kick off dinner tonight with Soane's marrowbites" (entry on an Internet group discussion).

Applicant contends that its mark is, at most, suggestive because consumers viewing the mark on the goods must engage in a multi-step reasoning process; that its mark is unitary and the examining attorney has improperly dissected the mark in reaching her conclusion; and that "marro" is neither a recognized word nor a common or recognized shorthand for "marrow," noting that "marro" does not appear in any dictionary.

In support of its position, applicant submitted copies of third-party registrations of compound marks in which the second portion of the registered mark is BITES, as follows:

- CHOCOBITES for chocolate candy (no. 3269815);
- CINNABITES for cinnamon rolls (no. 2429125);
- CALCIBITES for calcium fortified pastries (no. 2505269);
- BAKLABITES for pastries (no. 2950154);
- CHED'R'BITES for cheese-based snack food (no. 1980526);

- APPLE PIE CINNI-BITES for bakery products (APPLE PIE disclaimed) (no. 2760086);
- MASH-BITES for processed potatoes (no. 3175113);
- NUTRI-BITES for food particles used for flavoring commercial baked goods (no. 3104646);
- BROCC-O-BITES for broccoli nutritional supplements (no. 2321699); and
- FLAV-R-BITES for food seasoning (no. 3045509).

Applicant also referenced its own registration no. 2077683 for the mark PEDIGREE MARROBONE for "food for dogs" and argues that this registration entitles it to a "presumption" in this case and that the registration is "prima facie evidence of the inherent distinctiveness of a nearly identical mark" (brief, p. 8); and referenced its recent registration no. 3406959 for the mark DENTABITES for pet food. Conversely, applicant argues that its other registrations on the Supplemental Register are not relevant in determining whether the mark herein is merely descriptive. Finally, applicant requests that any doubt be resolved in its favor.

The test for determining whether a mark is merely descriptive is whether it 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 Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *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 that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). 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).

It is clear from the dictionary definitions of "marrow" and "bites" that both of these words are recognizable words that, individually, are merely descriptive of significant features of some pet food, i.e., "marrow" as an ingredient of pet food and "bites" as a reference to the size of morsels of pet food. While the Internet evidence showing use of the term "marrow" is not extensive, it supports the conclusion that "marrow" is a desirable ingredient in food or treats for dogs.²

²Applicant contends that the examining attorney's Internet excerpts are inapposite, stating that they use the recognizable and separate words "marrow" and "bites" in the same sentence. However, the evidence shows use of the phrase "marrow bites" and, as discussed, *infra*, we find this probative of the understanding of the compound word "marro[w]bites."

In this case, the mark MARROBITES consists of the components "marro" and "bites." Notwithstanding applicant's arguments to the contrary, we find that, considered in connection with pet food, "marro" is very likely to be perceived as the equivalent of "marrow." Not only is "marro" visually identical to "marrow" except for the final "w," but the final "w" in "marrow" is silent and, thus, "marro" is phonetically identical to "marrow." To make this finding, we do not need to conclude that "marro" is a recognized abbreviation for "marrow" or that "marro" appears in the dictionary. *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977) (It "is well settled that the fact that a term is not found in the dictionary is not controlling on the question of registrability, where as in the present case such term has a well understood and recognized meaning"). *See also In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001).

As such, we also find that applicant's mark is likely to be perceived as a compound word consisting of the two words "marro[w]" and "bites." We do not agree with applicant that the misspelling of "marrow" or the lack or a space or punctuation between these two terms renders them unrecognizable. The meaning or commercial impression of the term is not altered or otherwise affected by its compression from two words into one word. *See In re Gould Paper Corp.*,

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834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE legally equivalent to "screen wipe"); *In re Planalytics Inc.*, *supra* (GASBUYER legally equivalent to "gas buyer").

We agree with applicant that we must consider the mark in its entirety. While the components of a compound mark may be descriptive, it does not necessarily follow that the mark as a whole is merely descriptive. *In re Wisconsin Tissue Mills*, 173 USPQ 319 (TTAB 1972). However, we find that the terms "marro[w]" and "bites" when combined are no less descriptive than the terms are individually, considered in conjunction with applicant's goods, in other words, as a compound term their individual meanings remains the same and there is no incongruity in the combination. *See, e.g., In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (combination of SCREEN FAX PHONE held merely descriptive and without incongruity resulting from combination), and *In re Lowrance Electronics*, 14 USPQ2d 1251 (TTAB 1989) (generic terms COMPUTER and SONAR held just as generic and not incongruous when used in combination).

We are not convinced of the registrability of the mark herein by the third-party registrations submitted by applicant, by the references to other registrations owned by applicant, or by applicant's now-cancelled registrations for essentially the same mark. A determination of likelihood of confusion requires application of the law to the particular

facts involved in each case. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The facts and circumstances of the original registration of the mark herein on the Supplemental Register do not drive our decision in this case; nor does the registration on the Principal Register of the marks PEDIGREE MARROBONE and DENTABITES. With respect to the third-party registrations and applicant's DENTABITES registration, even without knowledge of the records in those cases, we note that one distinguishing difference between those marks and the mark herein is that each of those marks consists of a partial word, e.g., "choco," "cinna," "bakla," whereas the mark in this case consists of the word "bites" preceded by the phonetic equivalent of the entire word "marro[w]." With respect to applicant's PEDIGREE MARROBONE registration, we note that the mark may be distinguished by the additional word PEDIGREE. But regardless, we do not have the facts of that case before us and we are not bound by the decisions of the examining attorney in that case.

When we consider the record and the relevant factors pertaining to descriptiveness, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that, when applied to applicant's goods, the term MARROBITES immediately describes, without conjecture or speculation, a

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significant feature or function of applicant's goods, namely that its pet food consists of or contains small bite-sized pieces that include marrow or contain little pieces of marrow. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term MARROBITES as it pertains to applicant's goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.