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United States: Federal Circuit: TTAB Incorrectly Evaluated Alleged Genericness Of Pretzel Crisps Mark

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Princeton Vanguard, LLC v. Frito-Lay North America, Inc., 786 F.3d 960 (Fed. Cir. 2015)

The Federal Circuit recently vacated the Trademark Trial and Appeal Board's (the "TTAB" or the "Board") February 2014 opinion in the long-running PRETZEL CRISPS proceeding, finding that the Board both used the wrong legal standard in finding PRETZEL CRISPS generic for "pretzel crackers," and failed to adequately consider the evidence of record.

As discussed in our June 2014 Information Letter, Princeton Vanguard, LLC ("Princeton Vanguard") applied to register the PRETZEL CRISPS mark on the Principal Register in 2009. Frito-Lay North America, Inc. ("Frito Lay") opposed the 2009 application based on genericness, and also petitioned to cancel Princeton Vanguard's 2005 registration on the Supplemental Register for the same mark. Following trial, the TTAB found that the PRETZEL CRISPS mark was a compound term communicating no more than the common meaning of the individual elements of the term, rather than a unified phrase with a meaning beyond the sum of its parts, and therefore that genericness should be evaluated under the standard established in *In re Gould Paper Corp.*, 834 F.2d 1017 (Fed. Cir. 1987) by focusing on the individual words rather than examining the disputed mark as a whole. See generally *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 U.S.P.Q.2d 1949 (T.T.A.B. 2014). Limiting its analysis to the constituent words of the mark, the Board found that the term "pretzel" in PRETZEL CRISPS referred to a type of pretzel and that "crisps" was another name for a "cracker." See *id.* Based on this determination, the Board held that PRETZEL CRISPS was generic, and ruled in favor of Frito Lay.

On appeal, the Federal Circuit held that the Board erred by failing to consider the PRETZEL CRISPS mark in its entirety. Reviewing the Board's reasoning, the Federal Circuit first found that the Board failed to properly apply the genericness test set forth in *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987 (Fed. Cir. 1986), which requires the Board to "identify the genus of goods or services at issue, and then assess whether the public understands the mark, as a whole, to refer to that genus." *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 966 (Fed. Cir. 2015) (emphasis in original). The Circuit held that *Gould* did not alter *Marvin Ginn's* requirement of considering each mark in its entirety, but "merely provides additional assistance in assessing the genericness of compound terms where it can be shown that the public understands the individual terms to be generic, and the joining of those terms into one compound word provides no additional meaning." *Id.* at 968. As the panel determined, however, "[r]egardless of whether the mark is a compound term or a phrase, the applicable test is the same and the Board must consider the record evidence of the public's understanding of the mark as a whole." *Id.* at 968. In the end, "even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark." *Id.* at 967 (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005).

The Federal Circuit also held that the Board insufficiently considered the evidence of record. In particular, the panel found that

the Board had "short-cut its consideration of the factual record before it" by focusing on evidence introduced by Frito Lay that PRETZEL CRISPS was generic to the exclusion of "significant evidence in the form of declarations, survey evidence, and evidence of use of PRETZEL CRISPS in the snack food industry and by the media." *Id.* at 970. The Court further found that the Board improperly evaluated the survey evidence introduced by both parties, and essentially ignored the genericness survey offered by Princeton Vanguard despite offering no rationale for doing so. *Id.* at 971.

Given these errors, the Circuit remanded the case to the Board, ordering the Board to both reevaluate the alleged genericness of PRETZEL CRISPS in light of the requirement to consider the mark as a whole and to give appropriate consideration to all of the evidence of record, including the proffered survey evidence. The remand remains pending before the Board.

This decision clarifies the standard to be used in evaluating genericness, substantially eliminating the unified phrase/compound term dichotomy previously relied upon by the Board. Ultimately, it may make genericness more difficult to prove, since any such argument will require a detailed evaluation of the mark as a whole, as well as proof that the combination of two or more terms in a multiword mark does not add any meaning to the individual components.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

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