

On My Mind Blog

The Pitfall of Applying to Register a Mark that is Merely Descriptive of Some of Your Listed Goods or Services

03.01.2022 By [Meichelle R. MacGregor](#)

If your mark is found to describe *any* of the goods or services identified in your application for registration, and they are in the same class as other goods or services identified in your application, the registration may be refused for that *entire class*.

Lukumades AGD Limited, owner of a pastry shop named LUKUMAΔΕΣ in Athens, Greece, planned to expand to the United States. It filed an intent to use application for a Principal Register registration of the stylized mark LUKUMAΔΕΣ for goods in Class 29 (including yogurt drinks, milk beverages, butter, prepared fruits, jellies, and white pudding), goods in Class 30 (including doughnuts and pastry as well as syrups, honey, candy, coffee, tea, cocoa products, fruit sauces, and ice cream), and services in Class 43 (for preparing and providing food and drink).

LUKUMÁΔΕΣ

The Applicant conceded that Greek dough balls or doughnuts (fried dough balls, soaked in honey syrup and topped with cinnamon or walnuts) are commonly known as “loukoumádes.”



The Examining Attorney refused registration on the ground that this mark was the misspelled phonetic equivalent of the Greek word for some of the identified goods and services, and therefore was merely descriptive of those goods and related services.

The Applicant appealed to the Trademark Trial and Appeal Board (TTAB), arguing that the spelling of its mark, and its stylization, made its mark suggestive rather than merely descriptive, that the inclusion of Greek letters Δ (Delta) and Σ (Sigma) surrounding the Roman letter E at the end of the mark made the mark as a whole a mystery, and that its mark certainly would not immediately bring to mind ice cream, tea, juices, yogurt drinks, milkshakes, or other beverages.

The TTAB held that it was likely that the vast majority of Greek American consumers, and other consumers familiar with the Greek letters, would understand the mark to be the word “Lukumádes,” especially in the context that it referenced Greek dough balls, the Applicant’s signature product.

Therefore, the TTAB found that this mark was merely descriptive of at least *some* of the goods in Class 30 (such as doughnuts), and *some* of the services in Class 43 (such as preparing food). It affirmed the refusal of registration for *all* the goods and services in those classes even though this mark had not been found merely descriptive as to some of the goods in Class 30 (such as syrups, honey, candy, coffee, tea, cocoa products, fruit sauces, and ice cream) or some of the services in Class 43 (such as preparing and serving drink).

However, the TTAB found that the Examining Attorney had failed to establish that the mark was merely descriptive as to *any* of the goods in Class 39 (such as milk drinks, prepared fruits, and frozen desserts), and reversed the refusal of registration as to that class.

[In re Lukumades AGD Limited](#), Application No.88844592 (T.T.A.B. January 25, 2022).

Author’s Note: A merely descriptive mark can be registered on the Supplemental Register, and it can be registered on the Principal Register after it has acquired “secondary meaning” as an indication of the source of the goods or services.

To help you select a more protectable mark, see our earlier blog post titled “[Choosing a New Trademark](#).”

For further information, please contact [Meichelle R. MacGregor](#) or your CLL attorney.

[Meichelle R. MacGregor](#)



Partner

[Email](#) | 212.790.9259

Meichelle practices in the IP and litigation fields and counsels clients on a wide range of intellectual property including trademarks, trade dress, licensing, copyrights, domain names and e-commerce. She also handles commercial and corporate disputes.