

THIS OPINION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

LMS

Mailed: August 2, 2005

Cancellation No. 92043525

Paramount Baking Co., Inc.

v.

American Bakery Products, Inc.

Before Holtzman, Rogers, and Drost,
Administrative Trademark Judges.

BY THE BOARD:

American Bakery Products, Inc. owns U.S. Reg. No. 2181559, issued on August 11, 1998, on the Principal Register for the mark LAWASH for "flat bread for consumption by the general public" in International Class 30.¹

On July 19, 2004, Paramount Baking Co., Inc., filed a petition to cancel the registration claiming that the mark is the phonetic equivalent of "lavash" and that both terms are generic for flat bread. Petitioner alleges that respondent's continued registration of LAWASH has interfered with its use of the term "lavash" to describe its flat bread products.

¹ Section 8 affidavit filed and accepted on April 14, 2004.

Cancellation No. 92043525

Respondent, in its answer, admitted "that 'lavash' is a terminology used for a type of Armenian flat bread" (Answer ¶ 2) and denied the remaining salient allegations.

This case now comes up on petitioner's motion for summary judgment, filed March 16, 2005, on the ground that the registered term is generic. Respondent disagrees and has challenged petitioner's standing. Both parties have submitted substantial evidence in support of their respective positions, which is discussed herein.

On a motion for summary judgment, the burden is on the moving party to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also, *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences which may be drawn from the underlying undisputed facts must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Cancellation No. 92043525

A petition to cancel a registration may be brought by "any person who believes that he is or will be damaged ... by the registration of a mark on the principal register..." 15 U.S.C. § 1064. In support of its standing, petitioner submitted copies of cease and desist letters received by its distributor and a retailer from respondent (exhibits 1 and 2 attached to motion). In addition, while respondent challenges petitioner's standing, Mr. Hamood, respondent's president, attested to the fact that he found petitioner's product in the marketplace under the term "lawash", confiscated the sign, and turned it over to his lawyer who contacted petitioner's distributor and sent a cease and desist letter. (Hamood declaration ¶¶'s 7-8). This is evidence of actual damage to petitioner, not simply the belief that petitioner will be damaged by the mark as required by the statute. Further, the statute permits a party to challenge a mark that has become generic because continued registration of the mark interferes with the free flow of the products known by that generic term. See generally *In re Le Sorbet, Inc.*, 228 USPQ 27, 30-31 (TTAB 1985). Accordingly, petitioner has standing to bring this action.

As grounds for the action, Section 1064(3) of Title 15, United States Code, permits a party to petition for cancellation of a registration for a trademark when the

Cancellation No. 92043525

"registered mark becomes the generic name for the goods or services...for which it is registered..."² A mark is generic when members of the relevant public primarily use or understand the registered term to refer to the category or class of goods in question. See *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

In support of its motion, petitioner, Paramount Baking Company, argues that because "lawash" so resembles "lavash," the generic term for flat bread, that its phonetic equivalent is equally generic. Petitioner further argues that a foreign term, which is generic in its own language, is also generic in the United States. In support of its arguments, petitioner submitted³ a dictionary definition of the term "lavash" from *Webster's Third International Dictionary*⁴ and numerous excerpts of search engine summaries

² Such a challenge may be brought at any time, and is not subject to the five-year limitation set out in 15 U.S.C. § 1064(1).

³ It is noted that two of the exhibits submitted with petitioner's motion for summary judgment were not properly supported by affidavits. Respondent challenged them in a motion to strike exhibits 8 and 9 (the Internet searches and the linguistic expert's report), filed April 8, 2005. In that petitioner would have been given an opportunity to correct the error had the motion to strike been decided, petitioner's rectification of the error by resubmitting the evidence, properly supported by affidavits through its reply to the motion, renders the motion to strike moot, and the exhibits are now properly of record.

⁴ "la.vash\`la,vash\n -es [Arm] : a large thin crisp unleavened wafer with a rough surface from air bubbles." *Webster's Third New International Dictionary* 1279 (1993).

Cancellation No. 92043525

retrieved from the Internet containing references to

"lavash"⁵ including:

`Lavash Mountain Bread. Popular through the Eastern Mediterranean, Iran and the Caucasus... at www.superluminal.com/cookbook/bread_lavash

"Lavash (Flatbread) - Lavash, a flatbread sprinkled with sesame seeds..." at <http://lesleycooks.tripond.com/breads/lavash.htm>

"RecipeSource: Lavash...lavash prepared in this fashion is also used for Aram sandwiches..." at www.recipesource.com/ethnic/africa/middle-east/turkish/lavash1.html

"Stuffed lavash. Lavash is a kind of unleavened flat bread eaten in the Caucasus..." at <http://ashycook.topcities.com/snacks/stuffedlavash.htm>

"...Round Lavash Soy Pita..." and "...Square Lavash. Whole Wheat..." at www.gardencityfoods.com

"If you can't find Lawash bread where you live, you can use flour tortillas..." at www.thatsmyhome.com/mainstreetdeli/feta.htm

"Lawash sandwiches. Herb Chicken Lawash Roasted chicken,... all rolled in lawash bread." at www.mcgeadys.com/menu

"spinach lawash, or flour tortillas..." at www.smartsource.com

"chicken Caesar lawash..." at www.unionstreetdetroit.com/menus

⁵ Petitioner's first submission for the term "lavash" in the AOL search, dated July 16, 2004, produced 446 matching sites containing the term "lavash". Petitioner's second submission, filed with its reply, was for the term "lawash" from the AOL search engine, dated July 16, 2004 and April 27, 2004. This search produced 17 matching sites containing the term "lawash", one of which was respondent's. Through the Google search engine the search for "lawash" produced 386 references. These Internet searches are supported by an affidavit from petitioner's president, Joseph Hanna, who conducted the searches.

Cancellation No. 92043525

In further support of its motion is petitioner's report from Dr. Kevork Bardakjian, a professor of Armenian Language and Literature in the Department of Near Eastern Studies at the University of Michigan, which states that "lawash" is the phonetic equivalent of "lavash", the "w" and "v" being pronounced the same in Armenian; that older dictionaries spell the word with the "w"; and Dr. Bardakjian, in his introduction, defines "lavash" as "a type of bread known to a number of traditions in the Middle East: Armenian, Kurdish, Persian, Turkish and perhaps others."⁶

Petitioner has also submitted a printout from respondent's website, www.lawash.com, showing mixed forms of use⁷ of LAWASH, e.g., "Home of Lawash Bread"; "NEW IDEAS TO WRAP IT UP WITH LAWASH BREAD" including "...layered in a Original White Lawash"; "Garden Spinach Lawash"; "Wheat Lawash"; or "Sun Dried Tomato Lawash" and describing it as an "Arabic Style Flat Bread" and that "[t]he lawash bread is available in several flavors, White, Whole Wheat, Sun Dried Tomato and Garden Spinach".

Finally, petitioner submitted excerpts from the discovery deposition of respondent's president, Mr. Allen

⁶ This statement is consistent with the articles respondent submitted through the declaration of Dolores Tenniswood, *infra*, discussing the history of flatbread.

⁷ The use appears both with and without initial capitalization, as reproduced herein.

Cancellation No. 92043525

Hamood, wherein Mr. Hamood testifies that when he and his partner purchased American Bakery in 1990, the prior name⁸ was "Lavwash" from which they dropped the "v" to make it easier to pronounce (p.7, 1.11-12).⁹

Contradicting these arguments and in response to petitioner's motion, respondent argues that the Armenian lavash cracker bread is a different product from respondent's; that respondent's customers, namely the distributors and thereby the restaurants and catering businesses to which its product is supplied, refer to respondent's bread as "the LAWASH brand flat bread" and they recognize it as coming from respondent;¹⁰ that while restaurants have started to specialize in pita or flat bread sandwiches and have used respondent's term "lawash" to identify the sandwiches, such use does not make it a common descriptive term (*citing In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393 (Fed. Cir. 1989)); and that the two terms are not phonetic equivalents, but are spelled and

⁸ There are conflicting answers as to whether this was the name of the business Mr. Hamood purchased from the bankruptcy court or the product that had been sold there. (See deposition at p.7, 11. 11-12; p.8, 11. 21-23; and p.9, 11. 8-13).

⁹ Mr. Hamood also states that he was born in the United States and speaks a little Arabic and only heard of "lavash" when he got into the bread business in 1990 (p.10, 11. 8-13).

¹⁰ Declaration of Allen A. Hamood, President of petitioner, stating he sells his flat breads to distributors (¶ 16), that those distributors know the term "LAWASH" refers to respondent (as shown on purchase order forms) and that the menus of the restaurants that his distributors supply use the term "LAWASH".

Cancellation No. 92043525

pronounced differently.¹¹ In support of its arguments, respondent has submitted the declaration of its president, Allen Hamood, with supporting exhibits, specifically stating that a product was sold at the local Sam's Club with a sign using the name LAWASH for flat bread (¶¶ 5 & 10); that receipts showing respondent's sale of its goods to distributors, identifying the bread as LAWASH and sample menus for ultimate consumers of sandwiches sold at retail showing sandwiches made on "lawash" bread

A representative sample of these uses include:

"all sandwiches are rolled in lawash bread" (Exh. 12, Deli Café Menu).

"Breads: whole wheat lawash" (Pronto Deli menu);

"Lawash Sandwich Pin Wheels Party Tray" (Market Square of Birmingham, MI);

"Vegetarian Wrap.. grilled vegetables, cheese, wrapped in lawash bread..." (Lake Michigan College Conference Events)

"Assorted Lawash Sandwiches..." (Schramm's Deli and Grill).

A declaration was also submitted by Dolores Tenniswood, a paralegal at respondent's attorney's law firm, who conducted the Internet searches, copies of which were attached exhibits.¹²

¹¹ Hamood Declaration at ¶ 11.

¹² These exhibits include articles stating that "lavash" is the national bread of Armenia; providing the history of flat bread and excerpts from cookbooks, as well as dictionary references showing the absence of entries for the term "lawash".

Cancellation No. 92043525

In the instant case, while respondent appears to consider the relevant public to encompass distributors or retail sellers of its bread, or food service establishments that use its bread, we note that the identification in respondent's registration specifically covers "flat bread for consumption *by the general public*." Moreover, even if the identification were not so restricted we would have to consider members of the relevant public to include ultimate consumers, be they retail purchasers of bread or retail purchasers of sandwiches promoted as having been made using "lavash" or "lawash" bread. *See In re Eddie Z's Blinds & Drapery Inc.*, 74 USPQ2d 1037, 1040 (TTAB 2005).

The evidence of record shows, and there can be no genuine dispute, that the relevant public would view the term "lavash" as generic for an Armenian bread. (See respondent's answer at para. 2). Petitioner's linguistic expert further establishes the absence of any genuine issue that in the Armenian language, the pronunciation of the term "lawash" and "lavash" is the same, insofar as respondent has presented no evidence with its response to the motion which would counter this evidence.¹³ Yet, even if we accept, for the sake of argument, that the term "lawash" is pronounced

¹³ While Mr. Hamood states in his declaration that the terms are spelled and pronounced differently and that the Arabic dialect does not recognize or pronounce "W's" (dec. at ¶ 11), he also states that he does not speak any foreign languages fluently, but speaks a little Arabic (deposition at p.6, ll. 1-6).

Cancellation No. 92043525

differently than "lavash," the record shows that "lawash" would also be perceived by the relevant public as a generic name for a particular type of flat bread.¹⁴

The article excerpts and web pages show that both "lavash" and "lawash" are used as the names or designations for a class of flat bread, similar to pita.

Respondent's arguments that its distributors know "lawash" refers to respondent's products, as do the consuming public who see the menus, are unpersuasive. As noted earlier, the relevant public is, by respondent's own identification, the "general public" not distributors or food service establishments. Moreover, the use of both terms, "lawash" and "lavash", on the menus and order forms of record is not presented in a form that would be viewed as proprietary, in that it is used as a noun to identify a type of bread, and modified by the flavor. Moreover, there is broad use by the public beyond the restaurants whose menus respondent has provided, as demonstrated by the Internet search results. While respondent argues that its distributors and the restaurants are using the term as a trademark, the evidence does not support such use. We also note that there is no use of the registration symbol or "tm"

¹⁴ While Ms. Tenniswood submitted copies of the American Heritage Dictionary and the Merriam Webster Dictionary as exhibits to her declaration to show the absence of a definition for "lawash", we hereby take judicial notice of those same publications for their definition of "lavash".

Cancellation No. 92043525

notation in connection with the names of respondent's bread products on the menus.

Further, respondent's documentation showing no entry for "lawash" in the dictionaries, as there is for "lavash", and the articles respondent submitted describing the history of flatbread and its consistent spelling with a "v" is equally unpersuasive. The fact that this particular spelling does not appear in a dictionary or that the term may also be spelled with a "v" instead of a "w" is not controlling. The evidence, as a whole, clearly demonstrates that "lawash" is an alternate spelling of "lavash" and that it is equally generic for the goods.

Petitioner, Paramount Bakery, Inc., had the burden to show that there is no genuine issue of material fact that the primary significance of the term "lawash" to the relevant public is for flat bread. Petitioner has carried its burden as the moving party and respondent has not rebutted petitioner's showing.

Accordingly, petitioner's motion for summary judgment is hereby granted, and respondent's Registration No. 2181559 will be cancelled in due course.

.oOo.