

THIS DISPOSITION IS  
NOT CITABLE AS  
PRECEDENT OF THE TTAB

Mailed:  
December 8, 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re Ice Creams and Coffee Beans, Inc.

---

Serial No. 76536293

---

Request for Reconsideration

---

Raymond F. Kramer, Esq. for Ice Creams and Coffee Beans,  
Inc.

Susan Leslie DuBois, Trademark Examining Attorney, Law  
Office 111 (Craig Taylor, Managing Attorney).

---

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

Opinion by Drost, Administrative Trademark Judge:

On September 29, 2005, the board affirmed the  
examining attorney's refusal to register the mark WHOLLY  
COW ICE CREAMS & COFFEE BEANS for restaurant services under  
Section 2(d) and on the ground that applicant must provide  
a disclaimer of the term "Ice Creams & Coffee Beans."  
Applicant has now filed a request for reconsideration.  
Applicant's principal argument is that: "What the TTAB has

done is to repudiate a U.S. trademark that has been registered on the Principal Register since October 14, 1997 (TM 2,105,232) and has had Section 8 and 15 affidavits filed and accepted and acknowledged, respectively on November 12, 2003, making the mark incontestable." Request for Reconsideration at 2. In effect, applicant is arguing that it should not be required to disclaim the term "Ice Creams & Coffee Beans" because it owns a Principal Registration for that term. While we addressed this point in the original decision, we now re-emphasize that the prior registration on which applicant relies "is subject to a Section 2(f) limitation." Final Office Action at 4. Because of the Section 2(f) limitation, applicant has admitted that its term in that registration is not inherently distinctive. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact").

In response to the examining attorney's requirement for a disclaimer, applicant had three choices. It could have shown that the term in the current application, despite the evidence of record, was not merely descriptive;

it could have submitted evidence of acquired distinctiveness to demonstrate that its term had acquired distinctiveness and is registrable under Section 2(f); or it could have disclaimed the term. As we explained in the original decision, the term "Ice Creams & Coffee Beans" was merely descriptive for restaurant services. Secondly, we pointed out that applicant could have requested that the present application be registered under the provision of Section 2(f) as to the term "Ice Creams & Coffee Beans." See, e.g., 37 CFR § 2.41(b) ("In appropriate cases, ownership of one or more prior registrations on the Principal Register ... of the same mark may be accepted as prima facie evidence of distinctiveness"). Applicant did not elect this option. Therefore, inasmuch as we found that the term "Ice Creams & Coffee Beans" was merely descriptive, and that there was no claim of acquired distinctiveness as in its referenced registration, the requirement for a disclaimer was appropriate. Simply put, an applicant with a registration on the Principal Register under the provision of Section 2(f) is not relieved of the requirement to show that a descriptive term in its present application has also acquired distinctiveness.

Applicant's other points were addressed in the original decision and do not warrant further discussion.

**Ser. No. 76536293**

We also are authorized to report that the Chief Administrative Trademark Judge has denied applicant's request to designate the original decision as precedential.

We have considered applicant's arguments but we find no basis to change our decision. Applicant's request for reconsideration is denied. The decision dated September 29, 2005 stands.