

1/24/02

**THIS DISPOSITION
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Paper No. 12
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cafe Management, LLC¹

Serial No. 75/429,062

James R. Eley of Kegler, Brown, Hill & Ritter, LPA for Cafe Management, LLC.

Yong Oh (Richard) Kim, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Simms, Cissel and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On February 5, 1998, Cafe Management, LLC (an Ohio limited liability company) filed an application to register on the Principal Register the service mark CLEVELAND SPORTS HALL OF FAME CAFE² for "restaurants." The application is

¹ Applicant's name is set forth as both "Cafe Management, LLC" and as "Cafe Management, LLC" in different parts of the original application. Inasmuch as the papers filed throughout the prosecution of the application refer to applicant as Cafe Management, LLC, the Board will utilize that spelling of applicant's name.

² The mark shown on the drawing page of applicant's application is CLEVELAND SPORTS HALL OF FAME CAFE. Throughout most of the papers filed after the application, applicant erroneously refers to its mark as "CLEVELAND SPORTS HALL OF FAME CAFÉ."

based on applicant's assertion of a bona fide intention to use the mark in commerce. Applicant disclaimed the word "cafe." Although not offered as a formal amendment to the application as a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, applicant contends that the words "hall of fame cafe" have acquired secondary meaning and are uniquely associated with applicant.

The Examining Attorney initially refused registration on the ground that the mark is merely descriptive of the identified services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), specifically contending that the words "cafe" and "hall of fame" are merely descriptive; that when CLEVELAND SPORTS is added thereto "the combined term signifies a memorial to sports teams and figures with a connection to Cleveland"; and that "from the plain meaning of the words, applicant's mark merely describes a restaurant with a theme and emphasis on Cleveland sports teams and figures." (First Office action, p. 2.)

Subsequently, in his second office action, the Examining Attorney continued the merely descriptive refusal, and alternatively refused registration on the ground that the

mark is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2).³

The Examining Attorney made both refusals final, and applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs.⁴ Applicant did not request an oral hearing.

We consider first the refusal to register the mark CLEVELAND SPORTS HALL OF FAME CAFE as primarily geographically descriptive under Section 2(e)(2). In order for registration of a mark to be properly refused on the ground that it is primarily geographically descriptive of the applicant's goods or services, it is necessary to show

³ Applicant contends that the Board should "overrule" the Examiner's final refusal on geographical descriptiveness because the Examining Attorney did not raise this issue until the second Office action, and did not comply with TMEP §1105.03(a) which indicates that the Examining Attorney "should point out why the refusal or requirement was not made earlier...." First, this section of the TMEP also specifically states that even if it was possible to raise an issue on the first Office action, the Examining Attorney "may take appropriate action in a subsequent" Office action. Second, the Manual (TMEP) only suggests that the Examining Attorney "should" set forth a reason. Third, and in any event, the Board is not bound by the TMEP.

⁴ In applicant's brief on appeal at page 8, applicant referred to a "Response to Final Office Action" and two items presumably attached thereto--(i) photocopies of 11 registrations and applications of marks including the words "hall" and "fame" and "café"; and (ii) a search of YellowPages.com showing three listings for cafes with "hall of fame" incorporated into their name--all three listings allegedly being for applicant's restaurants. There is no "Response to Final Office Action" in this record. We note that even if said "Response" with attachments were properly of record herein it would not be persuasive of a different result.

that the mark sought to be registered is the name of a place generally known to the public, and that the public would make a goods/place or services/place association, that is, believe that the goods or services for which the mark is sought to be registered originate in that place. See *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); and *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988). See also, *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). Moreover, if a geographical term in a mark is neither remote nor obscure, and geographical significance of the term is the primary connotation of the term, and where the goods or services come from the place named in the mark, a public association of the goods or services with the place may ordinarily be presumed. See *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); and *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

The addition of descriptive words and/or generic words to a geographical term does not avoid the refusal of primary geographical descriptiveness. See *In re U.S. Cargo Inc.*, 49 USPQ2d 1702 (TTAB 1998); *In re Cambridge Digital*

Systems, 1 USPQ2d 1659 (TTAB 1986); and In re BankAmerica Corp., 231 USPQ 873 (TTAB 1986).

The record includes The American Heritage Dictionary of the English Language (3rd edition 1992) definition of "Cleveland" as "1. A city of northeast Ohio on Lake Erie." In addition, on page 5 of applicant's reply brief, applicant "concedes that the CLEVELAND portion of the mark in question is not given much weight as it is geographically descriptive." There is simply no doubt that the geographical significance of the term "CLEVELAND" is its primary significance, and it is neither remote nor obscure in the context of consumer awareness.

The addition of the generic term "cafe" and the highly descriptive terms "sports hall of fame" to the geographic term do not negate the geographic nature of applicant's mark. The Examining Attorney also submitted The American Heritage Dictionary of the English Language (Third edition 1992) definitions of the following words:

"café" (noun) is defined as "A coffeehouse, restaurant, or bar";
and

"hall of fame" (noun) is defined as "1. A group of persons judged outstanding, as in sport or profession. 2. A building housing memorial items honoring illustrious persons."

In addition, the Board takes judicial notice (see TBMP §712.01) of the definition of "sports" (adjective) from The American Heritage Dictionary of the English Language (Fourth edition 2000) in which it is defined as "1. Of, relating to, or appropriate for sports...."

The record establishes a prima facie case that the words "sports hall of fame cafe" are descriptive and do not detract from the primary geographical significance of the mark as a whole. See *In re Gold's Gym Enterprises Inc.*, 3 USPQ2d 1716 (TTAB 1987) (BODYBUILDING HALL OF FAME held merely descriptive of the service of maintaining and conducting an exhibition displaying outstanding participants and events in the field of bodybuilding). Consumers (the general public) would readily perceive that applicant's restaurant is located in Cleveland. Further, consumers would think that the restaurant features sports teams and hall of fame figures.

Applicant has focused heavily on its claim of secondary meaning (acquired distinctiveness) as to at least a portion of a previously registered mark, BUCKEYE HALL OF FAME CAFÉ.⁵

⁵ Registration No. 2,211,718, issued on December 15, 1998 to The Ohio State University for "restaurants." The term "café" is disclaimed. The claimed date of first use is September 1997.

It is permissible under Section 2(f) of the Trademark Act to claim acquired distinctiveness of a mark or a portion of a mark which is the subject of an intent-to-use application. The burden of establishing the claim of acquired distinctiveness lies with the applicant. See *In re Rogers*, 53 USPQ2d 1741, 1743-1744 (TTAB 1999). See also, TMEP §1212.09. However, in this case, applicant's argument that "the base portion of this mark ['hall of fame cafe'] has acquired a secondary meaning, and thus is not primarily geographically descriptive" (Applicant's December 7, 1999 response, p. 4) is not persuasive.

The Examining Attorney was not persuaded by applicant's claim of secondary meaning, explaining in his brief (p. 5) as follows: "reliance on such registration [Registration No. 2,211,718] is improper since the prior registration is not owned by the applicant nor is the prior mark the same as the one in the present application."

Applicant contends that as the exclusive licensee⁶ of The Ohio State University (record owner of Registration No. 2,211,718), applicant is the "constructive owner" of the registered mark BUCKEYE HALL OF FAME CAFÉ. Applicant supports this argument by citation to the case of *Ste.*

⁶ Applicant submitted a copy of the Trademark License Agreement into this record on December 7, 1999.

Pierre Smirnoff, Fls., Inc. v. Hirsch et al, dba L. Hirsch & Sons, 109 F. Supp. 10, 96 USPQ 168 (SDCA 1952) wherein the District Court said that "...the grant of an exclusive and irrevocable right to use a mark in a designated territory is an assignment and not a mere license."

The facts in the Ste. Pierre Smirnoff case are readily distinguishable from the matter before this Board. The 1952 District Court case (a trademark infringement and unfair competition lawsuit) involved defendants arguing that the plaintiff was without a protective right in the mark SMIRNOFF for vodka because it was a mere licensee while the original "Smirnoff" concern still operated abroad. The Court stated at 96 USPQ at 170 that "the evidence shows that plaintiff is the owner by virtue of a purchase for a lump sum of the entire exclusive and irrevocable right in the business, good-will of the business, and the name "Smirnoff" within the United States." In the case now before this Board, there is no foreign entity which sold rights in the United States, including the business, the goodwill, and the trademark itself. (If a foreign entity did sell rights in a mark to a U.S. company, then that assignee could seek registration of the mark in the United States.)

Quite the opposite, here we have evidence that the owner of the registration granted applicant only a license. Specifically, according to the June 17, 1997 "Trademark License Agreement" between applicant et al and The Ohio State University, applicant was granted an exclusive license to use, inter alia, the mark "Buckeye Hall of Fame Café"; but the contract is clear that the "The Trademarks" (defined on pages 1 and 2 of the contract⁷) are owned by OSU. Moreover, with regard to "Use of The Trademarks," paragraph 10 reads, in relevant part, as follows:

10. ...Use of the Trademarks, including the term Buckeye Hall of Fame Café (or any similar terms) by CAFÉ [applicant] pursuant to this Agreement shall inure solely to the benefit of OSU, and CAFÉ shall obtain no rights in The Trademarks because of CAFÉ'S use thereof in accordance with this Agreement.

...CAFÉ agrees to assign any and all trademark or service mark applications (Federal or state) that it may have already filed for any of The Trademarks referred to herein.

...In the event that Café desires to register any additional trademarks or service marks which include The Trademarks, it shall so advise OSU. OSU agrees to cooperate with CAFÉ in registering

⁷ Paragraph 1. A. reads as follows: "The trademarks shall mean the marks identified above, along with any additional trademarks, trade dress or service marks that refer to, relate to or in any way suggest an affiliation or connection with or endorsement by OSU, including the term 'Buckeye Hall of Fame Café'."

such marks as CAFÉ chooses, in OSU's name and at CAFÉ'S sole expense.

Thus, the contract is clear that applicant did not acquire ownership rights in the trademark BUCKEYE HALL OF FAME CAFÉ, and the use of the mark inures to OSU's benefit, not applicant's.⁸ Applicant simply operates the restaurant by that name in Columbus, Ohio pursuant to this license from OSU.⁹

Moreover, the Ste. Pierre Smirnoff case relied on by applicant has been distinguished by at least one appellate court, DEP Corporation v. Interstate Cigar Company, Inc. et al., 622 F.2d 621, 206 USPQ 673, footnote 2 (2nd Cir. 1980). The Second Circuit noted that the license agreement

⁸ In its reply brief (p. 5) applicant acknowledges that "while Applicant receives no rights in that mark [BUCKEYE HALL OF FAME CAFÉ], the mark itself acquires secondary meaning from its use. In turn, legally equivalent marks such as the one in question also achieve secondary meaning and acquire distinctiveness from Applicant's use." This argument by applicant is doubly flawed. First, according to the contract between OSU and applicant, the use of the mark BUCKEYE HALL OF FAME CAFÉ inures to OSU's benefit, not applicant's. Second, we cannot agree that the marks BUCKEYE HALL OF FAME CAFÉ and CLEVELAND SPORTS HALL OF FAME CAFE are legal equivalents. These two marks create different commercial impressions and differ materially from one another. See Van Dyne-Crotty Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); and Ilco Corp. v. Ideal Security Hardware Corp., 527 F.2d 1221, 188 USPQ 485 (CCPA 1976).

⁹ Applicant's evidence regarding the number of patrons at the BUCKEYE HALL OF FAME CAFÉ in Columbus, Ohio; the sales and advertising figures; and publicity about the Columbus, Ohio cafe are irrelevant because applicant does not own the rights thereto, and because BUCKEYE HALL OF FAME CAFÉ is a different mark from the mark applicant seeks to register.

involved before it did not constitute an assignment of any rights in the trademarks; and commented that in the Ste. Pierre Smirnoff case, the plaintiff therein was the owner of the entire exclusive and irrevocable right in the business, the good-will of the business, and the involved trademark.

Even if applicant in fact owned the registration for "Buckeye Hall of Fame Café," and had established that the words "Buckeye Hall of Fame Café" or "Hall of Fame Café" had acquired distinctiveness showing applicant as the recognized source of the involved services, that would not mean that the mark CLEVELAND SPORTS HALL OF FAME CAFE is not primarily geographically descriptive. These marks are not legal equivalents.

The term "sports" likewise fails to remove the mark from being primarily geographically descriptive. While this is an intent-to-use application, we must assume that the proposed restaurant in Cleveland will involve a sports theme. The record is clear that applicant markets the BUCKEYE HALL OF FAME CAFÉ (which it operates in Columbus, Ohio as the licensee of OSU) "extensively through tie-ins and promotions with The Ohio State University, area sports teams, local sports legends, ..." Also, applicant submitted a photocopy of a September 16, 1998 article from

"The Knoxville News-Sentinel" in which a person who was working to open a restaurant in Knoxville, Tennessee explained that he patterned his planned restaurant after the "sports-oriented concept" of applicant's restaurant in Columbus, Ohio.

The purchasing public, upon seeing the mark CLEVELAND SPORTS HALL OF FAME CAFE, will immediately think of a restaurant located in Cleveland, Ohio, and particularly featuring a sports theme and housing sports memorabilia relating to Cleveland, Ohio sports teams and illustrious individuals, or possibly relating to sports teams and hall of fame individuals in general. There is nothing particularly unique or incongruous regarding the juxtaposition of all these words. The reasonable shopper in this context is the general public. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:21 (4th ed. 2001).

We find that the primary significance of the mark CLEVELAND SPORTS HALL OF FAME CAFE remains geographical. See *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993); *In re U.S. Cargo Inc.*, supra; *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1992); *In re California Pizza Kitchen*, supra; and *In*

re Opryland USA Inc., 1 USPQ2d 1409 (TTAB 1986). See also, In re Texsun Tire and Battery Stores, Inc., 229 USPQ 227 (TTAB 1986).

The second prong of the test under section 2(e)(2) is whether there is a services/place relationship. Applicant does not dispute that, if it commences use of this mark for these services, the restaurant services would come from and be located in Cleveland, Ohio. Further, the Examining Attorney submitted several stories retrieved from the Nexis database, and an excerpt from one of those stories appears below:

...Jon M. Self, president of the Buckeye Hall of Fame Café in Columbus, is interested in bringing a local version of his restaurant/entertainment club to downtown Cleveland....Self said he'd like to build, but finding that much space with enough parking isn't easy. If successful, the local operation would be the Cleveland Sports Hall of Fame Cafe. "Cleveland Plain Dealer," May 3, 1998.

Thus, the record shows that applicant's services do or will come from the place named in the mark; and therefore a public association of the services with the place named in the mark is presumed. That is, because there is clearly an association of applicant's restaurant services with the place named in the mark (Cleveland), we presume a public

association of the services with the place from the fact that applicant's services would come from the geographical place named in the mark.

Because both parts of the enunciated test have been met, we find CLEVELAND SPORTS HALL OF FAME CAFE is primarily geographically descriptive of applicant's restaurant services within the meaning of the Trademark Act.

While the two grounds for refusal asserted by the Examining Attorney may not be mutually exclusive,¹⁰ nonetheless, because we have decided the case on the Section 2(e)(2) ground--primarily geographically descriptive, we do not reach the Examining Attorney's Section 2(e)(1) ground--merely descriptive.

Decision: The refusal to register under Section 2(e)(2) is affirmed.

¹⁰ See *In re Urbano*, 51 USPQ2d 1776, 1780 (TTAB 1999).