

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 3, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Emndee, Inc.**

Serial No. 75/058,039

Michael A. Grayson of Herzog, Fisher, Grayson & Wolfe for **Emndee, Inc.**

Susan J. Kastriner, Trademark Examining Attorney, Law Office 113
(Meryl L. Hershowitz, Managing Attorney).

Before **Hohein, Walters and Holtzman**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by **Frank H. Robinson & Company, Inc.** to register the term "THE GRILL" as a service mark for "restaurant services".¹

¹ Ser. No. 75/058,039, filed on February 14, 1996, which alleges dates of first use of January 1984. Although registration was originally sought on the Principal Register on the basis of a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), in view of a refusal under Section 2(e)(1) of such act, 15 U.S.C. §1052(e)(1) on the ground of genericness, applicant subsequently sought amendment of the application to seek registration on the Supplemental Register. Although the Examining Attorney has refused to allow such an amendment, it is pointed out that applicant is entitled to so amend its application in response to a refusal to register on the Principal Register, and that the appropriate response, if the Examining Attorney believes that registration on the Supplemental Register is not permissible, is to refuse registration on

Registration has been finally refused under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the basis that the term "THE GRILL" is generic and thus is not capable of distinguishing applicant's services.²

Applicant has appealed. Briefs have been filed,³ but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term must be capable of serving as an indicator of source in order for it to be registrable on the Supplemental Register. Whether a term has the capacity necessary for registration on the Supplemental Register is determined by considering the meaning thereof as applied to

such register. Accordingly, we have treated the application as having been amended to one seeking registration on the Supplemental Register.

² While the Examining Attorney has actually made final, as noted above, her "refusal to allow the applicant to amend the application to the Supplemental Register," we have construed such action as a final refusal to register the term "THE GRILL" on the Supplemental Register on the ground of genericness.

³ Although applicant devotes a substantial portion of its initial brief and part of its reply brief to the contention that the evidence which it has submitted establishes that the term "THE GRILL" has acquired distinctiveness and that such term is therefore registrable on the Principal Register, the only issue properly before the Board, in view of the election to amend the application to the Supplemental Register, is whether such term is capable of distinguishing applicant's services. Likewise, the Examining Attorney takes, in part, the same erroneous approach by arguing that, aside from the issue of "whether the applicant's mark is generic and therefore incapable of registration on the Supplemental Register," a second issue before the Board, "assuming *arguendo* that the mark were capable, is whether the applicant has demonstrated that the mark has acquired distinctiveness under Section 2(f) so as to be registrable on the Principal Register." Nevertheless, while it is pointed out that even if applicant were presently seeking registration on the Principal Register rather than the Supplemental Register, the issue of genericness would be the same, in view of the confusion on the part of applicant and the Examining Attorney we will also decide whether applicant, if it were seeking registration on the Principal Register and the term "THE GRILL" is not generic for restaurant services, has established that such term has acquired distinctiveness.

the goods or services, the context in which it is used on any specimens filed with the application, and the likely reaction thereto by the average customer upon encountering the term in the marketplace. See *In re Cosmetic Factory, Inc.*, 208 USPQ 443, 447 (TTAB 1980). "The test is not whether the mark is already distinctive of the applicant's goods [or services], but whether it is capable of becoming so." *In re Bush Brothers & Co.*, 884 F.2d 569, 12 USPQ2d 1058, 1059 (Fed. Cir. 1989), *citing* *In re Simmons Co.*, 278 F.2d 517, 126 USPQ 52, 53 (CCPA 1960). Furthermore, as noted in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), a generic term is incapable of registration on either the Principal Register or the Supplemental Register.

Moreover, in the case of a term asserted to be incapable because it is generic, the burden is on the Patent and Trademark Office to show the genericness of the term by "clear evidence" thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). See also *In re American Fertility Society*, ___ F.3d ___, 51 USPQ2d 1832, 1835-36. As stated in *American Fertility Society*, *id.* at 1836, "[a]ptness is insufficient to prove genericness"; instead, "the correct legal test, as set forth in *Marvin Ginn*, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" Specifically,

in *Marvin Ginn*, supra at 530, our principal reviewing court held that:

Determining whether a mark is generic [and thus not capable of distinguishing an applicant's goods or services] ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

In applying such standard, the Board, in *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994), noted among other things that "evidence of the relevant public's understanding of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications," citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

With respect to the first prong of the genericness test, it is clear, and both applicant and the Examining Attorney appear to agree, that the category or class of services at issue is "restaurant services". Thus, the only real issue to be determined, as both applicant and the Examining Attorney correctly realize, is whether, under the second prong of the test for genericness, the term "THE GRILL" is understood by the relevant public primarily to refer to a category or class (i.e., a genus) of restaurant services.

Applicant, while conceding in its initial brief that "the word 'THE' in general is not necessarily considered to add trademark significant [sic]" to an otherwise generic term, argues that as shown by the various newspaper and magazine articles

which it has made of record concerning the restaurant services which it offers, "the mark 'THE GRILL' is sufficiently capable of distinguishing the Applicant's services because the phrase 'THE GRILL' is different from just simply ... [that of the] word 'Grill' [alone]." According to applicant, its "entire mark is 'THE GRILL' and the Examining Attorney has unfairly dissected the mark" by arguing that the word "'GRILL' itself is generic and [that the word] 'THE' lends nothing to the mark".

We agree with the Examining Attorney, however, that ordinary consumers, who constitute the relevant public, would regard the term "THE GRILL" as primarily signifying a particular kind of restaurant, namely, a grillroom or grill. The Examining Attorney's position is amply supported in the record by, inter alia, applicant's specimens of use; dictionary definitions of the words "grill" and "grillroom"; excerpts of articles from the "NEXIS" database, referring to "grill," "grill-type" and "grill-style" restaurants as well as to restaurants which have the word "grill" as part of their names; and third-party registrations of marks for restaurant services in which the term "GRILL" has been disclaimed in connection with restaurant services.

Specifically, as the Examining Attorney points out, applicant's specimens, which consist of menus, show that its restaurant services feature various "CHAR-BROILED MEATS" and "CHAR-BROILED FISH," which are types of grilled cuisine. In addition, the following dictionaries define the nouns "grill" and/or "grillroom" in pertinent part as set forth below:

(a) Random House Webster's College Dictionary (1992) at 588, which lists "grill" as meaning "4. GRILLROOM" and defines "grillroom" as connoting "a restaurant or dining room, as in a hotel, that specializes in serving grilled meat and fish";

(b) American Heritage Dictionary of the English Language (electronic version of 3rd. ed. 1992), which designates "grill" as signifying "3. An informal restaurant or a room in a restaurant where grilled foods are served; a grillroom";

(c) Webster's II New Riverside University Dictionary (1984) at 548-49, which sets forth "grill" as connoting "3. A grillroom" and lists "grillroom" as signifying "A place where grilled foods are served";

(d) Webster's New Collegiate Dictionary (1979) at 501, which sets forth "grill" as signifying "3 : a usu. informal restaurant or dining room esp. in a hotel" and lists "grillroom" as meaning "GRILL 3";

(e) Webster's New World Dictionary (2d coll. ed. 1972) at 615, which defines "grill" as meaning "4. *short for* GRILLROOM" and lists "grillroom" as signifying "a restaurant, club, or dining room that makes a specialty of grilled foods"; and

(f) The American College Dictionary (1970) at 533, which sets forth "grill" as connoting "3. grillroom" and defines "grillroom" as meaning "a room or restaurant where meats, etc. are grilled and served".

Thus, in light of the above, there is no doubt that applicant's services constitute the kind of a restaurant commonly known as a grill or grillroom. Articles in which applicant's restaurant services are reviewed, and which applicant has made of record, confirm that, as demonstrated by the examples (**emphasis**

added) reproduced below, such services and the like services of others are generically referred to as a "grill":

"In a city that thrives on pushing the envelope of **restaurant** style, restaurateur Bob Spivak had the audacity to open a traditional American **grill**. 'Every cosmopolitan city has a real old-time **grill**,' he says. 'We took the spirit of **grills** like Tadich's and Jack's in San Francisco, and Musso and Frank's in Hollywood, and tried to update it while still staying true to the tradition'." -- Gourmet, April 1993; and

"The Grill not only brought back an old-fashioned concept of service but also reintroduced the old-fashioned American **grill** to Los Angeles" and "The ... menu ... is exactly what an old-time **grill** menu should be." -- Gourmet, July 1991.

That ordinary consumers would indeed understand that the term "THE GRILL" primarily names a specific kind or category of restaurant services is further shown by the excerpts, a representative sample of which (**emphasis added**) is set forth below, of articles from the "NEXIS" database wherein references are made to various restaurants which incorporate the word "grill" as part of their trade names:

"Jesse Padon looks forward to his new venture in Pelican, Alaska, upgrading Rose's Bar and **Grill**. The **restaurant** and lounge is legendary among Alaska fishermen." -- News Tribune, July 24, 1996;

"It will also include a meal in the Paddock **Grill restaurant**." -- Sporting Life, July 18, 1996;

"There are 70 Macaroni **Grill restaurants** around the country" -- Commercial Appeal (Memphis), July 17, 1996;

"'I was struck by it,' Mr. Bocho said recently during lunch at the China **Grill**, the

restaurant that occupies the ground floor of ... CBS's headquarters in Manhattan." -- N.Y. Times, July 14, 1996;

"He owns the Buffalo **Grill restaurant**" -- Orange County Register, May 30, 1996; and

"Expect the unexpected at Atomic **Grill**, the **restaurant** that opened at the site of the legendary Leo's last October." -- Providence Journal-Bulletin, July 28, 1995;

Other excerpts of articles from the "NEXIS" database further demonstrate that, to the purchasing public, the word "grill" generically designates a particular category or kind of restaurant services. Representative examples thereof are set forth below (**emphasis added**):

"The author ... sought the 25 best **grill restaurants** around the world for tips and recipes for the book" -- Commercial Appeal (Memphis), July 19, 1998;

"The Edge, a bar and **grill-type restaurant**." -- Pantagraph (Bloomington), July 10, 1998;

"Gone Tomatoes is an excellent Italian bar and **grill**. The **restaurant** provided the following directions for making the creamy tomato basil dressing." -- Boston Herald, June 28, 1998;

"The area's most eclectic restaurant, an Argentine pizza and **grill restaurant** called La Milonga, has apparently closed" -- Atlanta Journal & Constitution, June 19, 1998;

"Orleans now boasts a real wood-fired **grill restaurant** called Sunset Grill that emphasizes takeout barbecue." -- Boston Globe, June 18, 1998;

"The renovation ... will include a new veranda for outside dining at the Carlyle on the Green **restaurant**, a **grill-style**

restaurant" -- N.Y. Times, June 7, 1998;
and

"The '**grill**' in the **restaurant's** [Tako Grill] name refers to the robatayaki offerings - small and usually inexpensive servings of grilled vegetables and seafood."
-- Washingtonian, June 1998.

Finally, as noted previously, the record contains numerous third-party registrations of marks, such as "DAILY GRILL" and design,⁴ "SUB-URBAN GRILL," "MACARONI GRILL," "MICKEY'S GRILL," and "LALANI'S RESTAURANT AND GRILL," in which the term "GRILL" has been disclaimed in connection with restaurant services. This evidence is additional proof that the term "grill" is generic for restaurant services.

In view of the above, we concur with the Examining Attorney that the addition of the word "THE" to the generic term "GRILL" merely creates a unitary term which has the same meaning, and hence is generic for restaurant services, as the term "GRILL" alone. As the Examining Attorney correctly points out in her brief, it is settled that "[n]o 'unique' effect is created by the utilization of the article 'THE' in association with a . . . generic term" and that, in such a combination, "the word 'THE' cannot serve as an indication of origin, even if the applicant's [goods or] services are the only [goods or] services which use the wording." See, e.g., Conde Nast Publications Inc. v. Redbook Publishing Co., 217 USPQ 356, 357 (TTAB 1983) ["THE MAGAZINE FOR YOUNG WOMEN" held generic for magazines directed to young women];

⁴ Such registration, we note, is indicated in a letter accompanying the application to be owned by "Grill Concepts, Inc., a company with common ownership with the Applicant".

In re Computer Store, Inc., 211 USPQ 72, 74-75 (TTAB 1981) [THE COMPUTER STORE" found generic for computers and computer book outlet services); and S. S. Kresge Co. v. United Factory Outlet, Inc., 209 USPQ 924, 928 (D. Mass. 1980) ["THE MART" held generic for retail discount stores].

In particular, as the Board stated in an analogous case holding the term "THE PILL" to be generic for oral contraceptive pills (footnote omitted):

The use of the article "THE" in association with a name or word such as "PILL" is a common or usual method adopted to refer to an object or person previously identified or to refer to something or someone assertedly unique; and it is frequently employed to shorten or eliminate unnecessary use of repetitious or descriptive wording. And considering that applicant's "ENOVID" product was the only one of its kind then on the market for commercial sale, the use of the designation "THE PILL" in association therewith was essentially as a term of reference and not necessarily as an indication of origin. If we were to give any weight to applicant's arguments concerning the "unique" effect created by the utilization of the article "THE" in association with the mark "PILL" ..., it would seem to follow that an automobile manufacturer could register the designation "THE AUTOMOBILE" or an appliance manufacturer the phrase "THE REFRIGERATOR". Manifestly, the utilization of the article "the" ... cannot convert a simple notation comprising ordinary words of the English language used in their ordinary sense into a registrable trademark.

In re G. D. Searle & Co., 143 USPQ 220, 222-23, *aff'd*, 360 F.2d 650, 149 USPQ 619 (CCPA 1966). Likewise, and contrary to applicant's contention that the Examining Attorney has engaged in

improper dissection, the term "THE GRILL" in the context of restaurant services is simply a term of reference used to categorize the particular style of restaurant operated by applicant, namely, a grill or grillroom, rather than an indicator of a specific source. The evidence of record, in summary, clearly demonstrates that the term "THE GRILL" is generic in that, to ordinary consumers, the primary significance thereof is to designate a particular class, kind or category of restaurant services. As such the term is incapable of registration on the Supplemental Register.⁵

⁵ While, as pointed out earlier, a generic term is also not registrable on the Principal Register, we note that even if applicant were seeking registration on the Principal Register instead of the Supplemental Register and the term "THE GRILL" was not considered to be generic for restaurant services, applicant's claim of acquired distinctiveness for such a merely descriptive term would nevertheless be insufficient to permit registration on the Principal Register under Section 2(f). Applicant's evidence of acquired distinctiveness consists solely of a declaration from its vice president, attesting that "to the best of his knowledge and belief the mark ... has become distinctive of the services through the Applicant's substantially exclusive and continuous use in commerce in connection with restaurant services for at least the five years immediately before the [filing] date" of the application, and the submission of 13 excerpts from newspapers, magazines and a cookbook which mention applicant's restaurant by name. While several of the excerpts constitute articles which indicate that "The Grill" is notable as a "power" restaurant among certain celebrities in the Los Angeles area where applicant renders its restaurant services, we disagree with applicant's contention that such evidence establishes that its restaurant "has become so well known that everyone associates 'THE GRILL' with the applicant." Instead, we concur with the Examining Attorney that (footnote omitted):

[F]rom such material, it is impossible to glean much except that a small portion of the public, i.e., "the rich and famous" of Los Angeles, may frequent the applicant's restaurant and that it may enjoy a certain trendiness - none of which proves that the mark has acquired distinctiveness among this small circle or beyond.

Given the high degree of descriptiveness inherent in the use of the term "THE GRILL" in connection with restaurant services, we further agree with the Examining Attorney that, absent evidence such as the extent of applicant's annual sales, its level of advertising

Decision: The refusal under Section 23 is affirmed.

G. D. Hohein

C. E. Walters

T. E. Holtzman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

expenditures, representative samples of its promotional materials, and/or affidavits or declarations attesting to recognition of the term sought to be registered as a source indicator by customers, it simply cannot be said, on the basis of a period of use in excess of five years, that the term "THE GRILL" is perceived by the relevant public as identifying and distinguishing applicant's restaurant services from the grill or grillroom services offered by other restaurants. Absent a showing of acquired distinctiveness, such term is barred by Section 2(e)(1) of the statute from registration on the Principal Register.