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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
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Hearing: May 22, 2001

Paper No. 25
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Wackenhut Corporation

Serial No. 75/025,151

James F. McKeown of Evenson, McKeown, Edwards & Lenahan
for The Wackenhut Corporation.

Sue Carruthers, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Walters, Holtzman and Rogers, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

The Wackenhut Corporation has filed a trademark
application to register the mark CORRECTIONAL FOODSERVICE
MANAGEMENT for "foodserves for penal institutions."¹

¹ Serial No. 75/025,151, in International Class 42, filed November 28,
1995, based on an allegation of a bona fide intention to use the mark in
commerce. On December 2, 1996, applicant submitted an amendment to
allege use and specimens, alleging January 1996 as its date of first use
and use in commerce.

The Trademark Examining Attorney originally refused registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services. In response, applicant amended its application to assert acquired distinctiveness, under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f), based on less than one year of use of its mark in connection with the identified services. The Examining Attorney rejected the Section 2(f) claim on the ground that applicant had not established acquired distinctiveness of its mark; and she ultimately issued a final refusal to register under Section 2(e)(1) of the Trademark Act.

Applicant appealed and, subsequently, requested a remand for consideration of an amendment to the Supplemental Register.² On remand from the Board, the Examining Attorney withdrew the Section 2(e)(1) refusal and refused registration on the Supplemental Register, under Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that the subject matter of the application is

² Although applicant's submissions raised the question of whether applicant, in its appeal, maintains its Section 2(f) argument in the alternative, applicant's counsel clarified, at the Board hearing of this case, that registrability on the Supplemental Register is the sole issue before the Board in this appeal.

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generic in connection with the identified services. This refusal was made final.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We affirm the refusal to register.

With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods or services? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Examining Attorney contends that "correctional foodservice" and "foodservice management" are both generic terms; and that the compound term "correctional foodservice management" is equally generic. The Examining Attorney explains that "[a]dding the word 'correctional' to 'foodservice management' merely further defines the nature of the services[;] [i]t does nothing to give the phrase a nongeneric meaning." She concludes that "*correctional foodservice management* is recognized as a category of services in the corrections field." In support of her position, the Examining Attorney submitted excerpts of articles retrieved from the LEXIS/NEXIS database, excerpts from magazines and Internet web sites, and dictionary definitions.

Applicant contends, essentially, that the Examining Attorney's evidence is insufficient to establish that CORRECTIONAL FOODSERVICE MANAGEMENT is generic; and that the decision of the Court in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), is applicable in this case and precludes a finding that the entire phrase is generic based on evidence that the individual terms may be generic.

We begin our analysis by reviewing the evidence submitted by the Examining Attorney. The following are

examples of excerpts of articles retrieved from the
LEXIS/NEXIS database:

... past president of the American Correctional
Food Service Association.

...
Saving Money is one of the most critical aspects
of running a correctional foodservice operation.

...
To help battle the budgetary dragon,
correctional foodservice operators are turning
to alternatives to provide quality,
nutritionally balanced meals with as low a food
cost as possible.
[*The Voice of Foodservice Distribution*,
September 1996.]

Correctional foodservice is the fastest-growing
segment in the entire foodservice business.
[*Restaurants and Institutions*, August 1, 1996.]

"We're very happy about the review," said Bob
Jarousse, assistant director for correctional
food management for the city. [*Nation's*
Restaurant News, March 18, 1996.]

"Later, a few of the prison foodservice managers
we had been able to build long-standing
relationships with got the idea of forming
correctional foodservice management divisions
within other companies," Witzel adds. "This
business has just taken off and DPI Taylor
Brothers now has strong alliances with most of
the key players in correctional foodservice
management. ..." [*FoodService Distributor*, June,
1995.]

The Examining Attorney submitted excerpts from the
June 1996 issue of the magazine *Corrections Today*, which
includes an advertisement by Aramark Corrections
Services, shown below, and a page from its "Product
Index," which lists as a heading the term "Food Service

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Management" among other headings such as "Employment,"
"Fire Protection Equipment," and "Furniture."

The Examining Attorney submitted an excerpt from the Internet Web site of Aramark Correctional Services (www.aramarkcorrectional.com, July 15, 1998), which includes the following statements:

Since 1976, we've provided comprehensive, cost-effective food services programs to correctional facilities of all types and sizes.

ARAMARK Correctional Services is part of the ARAMARK Corporation, an internationally recognized leader in contract management services with annual revenues of \$6 billion and more than 150,000 employees worldwide.

The Examining Attorney submitted copies of two third-party registrations, one for the mark CORRECTIONAL FOODSERVICE on the Supplemental Register³; and one for the stylized mark SERVICE AMERICA THE FOOD SERVICE MANAGEMENT PEOPLE on the Principal Register with a disclaimer of THE

³ Registration No. 1,774,776, issued June 1, 1993, for magazines. [Cancelled for failure to file a Section 8 affidavit.]

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FOOD SERVICE MANAGEMENT PEOPLE.⁴ These two registrations are not probative of the issue of genericness. Nor does the cancelled registration of CORRECTIONAL FOODSERVICE on the Supplemental Register in connection with magazines persuade us that applicant's mark for the identified services is capable of becoming a mark, because each case must be decided on its facts.

Applicant submitted excerpts from a document it identified as its "10-K report." Following are several quotes from that document:

Through its correctional business ... the Company also provides correctional and facility design, development and management services to governmental agencies.

...
In addition to its expansion into the Correctional Business ..., the Company has leveraged its management skills to expand into other support services. In 1992, the Company entered into the foodservices business for correctional institutions

... The Company bids for foodservices contracts and provides food services on a cost per meal basis. Complete foodservices management, commissary, laundry and janitorial programs are available to correctional clients.

Applicant's specimens of use include the following information about its services:

⁴ Registration No. 1,626,381, issued December 4, 1990, for providing food services through the use of vending machines and cafeteria services. [Sections 8 and 15 affidavits accepted and acknowledged, respectively. No record of renewal application.]

Correctional Foodservice Management provides professional foodservice management and ancillary services to Federal, state, county and private correctional facilities throughout the United States. Headquartered in Phoenix, Arizona, Correctional Foodservice Management provides an integrated quality assurance program that encompasses all aspects of the correctional foodservice operation.

...

The staff of Correctional Foodservice Management is comprised of widely respected professionals with established credentials in the operation and management of foodservices in a corrections environment.

We find that the Examining Attorney has established by clear and convincing evidence that CORRECTIONAL FOODSERVICE MANAGEMENT is generic in connection with "foodservices for penal institutions." As indicated by the evidence of record, in particular, applicant's own specimens, providing foodservices to penal, or correctional, institutions involves management of the many aspects of those services by the company providing the services. It also involves managing the entire foodservice operation for the correctional institution. Not only are there examples in the evidence, including applicant's specimens, of the generic use of the component terms CORRECTIONAL FOODSERVICE and FOODSERVICE MANAGEMENT, but there are also examples of use of the term FOODSERVICE MANAGEMENT in connection with correctional facilities. Additionally, there is at least

one example of generic use of the entire term CORRECTIONAL FOODSERVICE MANAGEMENT. Thus, we find that CORRECTIONAL FOODSERVICE MANAGEMENT defines the category of services involved. The nature and extent of the evidence of record further establishes that the relevant public is likely to understand CORRECTIONAL FOODSERVICE MANAGEMENT as the category of services involved.

This case is distinguished from *In re American Fertility Society, supra*, on its facts. In that case, the applicant sought to register the mark AMERICAN SOCIETY OF REPRODUCTIVE MEDICINE on the Supplemental Register. The Federal Circuit vacated the Board's decision that SOCIETY OF REPRODUCTIVE MEDICINE is generic and that a disclaimer is required, and remanded the case for application of the correct legal test.

The Court characterized the question in *American Fertility Society* as "whether the PTO may satisfy its burden of proving a phrase as a whole generic, based solely on the genericness of the phrase constituents" (*supra at 1835*). The Court stated that "the correct legal test, which was not applied by the Board, is set forth in *Marvin Ginn* and is to be applied to a mark, or a disputed phrase thereof, as a whole, for the whole may be greater than the sum of its parts"; and that "[t]he PTO

here failed to provide any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE, has acquired no additional meaning to the relevant public than the terms 'society' and 'reproductive medicine' have individually" (1837). The evidence of record included a dictionary definition of "society" and ninety-nine pages of references to "reproductive medicine" from the LEXIS/NEXIS database.

The nature of the evidence in the case before us is distinctly different than the evidence in *American Fertility Society*. We have at least one example of a generic use of the phrase CORRECTIONAL FOODSERVICE MANAGEMENT in its entirety. Further, this is not a case involving examples of generic use of only the three individual terms of the phrase, rather we have evidence of generic use of overlapping components of the phrase. We have many examples of FOODSERVICE MANAGEMENT, both generally and as applied specifically to correctional institutions. Similarly, we have many examples of CORRECTIONAL FOODSERVICE, some of which are used in relation to foodservice management. It is not a leap of logic, but, rather, a reasonable step to conclude that the entire phrase, CORRECTIONAL FOODSERVICE MANAGEMENT,

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is, and would be perceived by the relevant public as, the category of services involved herein.

In conclusion, we find that CORRECTIONAL FOODSERVICE MANAGEMENT simply names applicant's identified services and is, therefore, generic and incapable of registration on the Supplemental Register.

Decision: The refusal under Section 23 of the Act is affirmed.