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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Panera, Inc.

Serial No. 75/848,492

Paul F. Kilmer and Anthony R. Masiello of Holland & Knight LLP, and Mark I. Feldman and Christina L. Martini of Piper Rudnick for Panera, Inc.

Alicia P. Collins, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Hanak, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Panera, Inc. seeks to register the term YOU PICK TWO on the Principal Register as a service mark for "restaurant services" in International Class 42.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that this

¹ Application Serial No. 75/848,492, filed on November 15, 1999, is based upon applicant's allegation of use in commerce since at least as early as August 1991.

matter does not function as a service mark under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127.

Both applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

The Trademark Examining Attorney argues that this designation is merely an informational, merchandising slogan made up of ordinary words that blend into the surrounding text of applicant's advertisements and menus.

By contrast, applicant argues that as used on its substitute specimen of record (e.g., a cutout coupon incorporated into a glossy advertising flyer), the term "You Pick Two" is set off with quotation marks and is shown with the initial letter of each word capitalized.

Applicant contends that the record herein demonstrates that this term is not perceived as just a collection of "ordinary words," but rather is viewed as a valid source identifier. In support of this conclusion, applicant has made of record evidence that restaurant critics use this three-word slogan preceded by the otherwise grammatically incorrect word "the" (e.g., "the 'YOU PICK TWO' special"). Applicant argues that whether one looks to newspaper

stories or applicant's various uses, the term usually appears in context as good service mark usage - that is, as an adjective modifying a noun.

As did the Trademark Examining Attorney, we turn to the specimens and other examples of actual use made of record in order to ascertain the manner in which applicant uses the designation, the real-world milieu into which applicant has thrust this designation and the resulting commercial impact created by the asserted mark.

The substitute specimen of record shows applicant's applied-for designation used as follows:



Applicant notes that the term appears within quotation marks and with initial capital letters. Applicant points out that its menus (submitted with the request for

reconsideration) show this term in a totally separate and distinct manner from other surrounding text:

YOU PICK TWO	
Choose any two of the Following	\$4.95
Soup, Half Salad or Half Sandwich	
● Bowl of Soup and Sourdough Roll	
<i>In a sourdough bowl add \$1.15</i>	
● Half Salad ? Greek ? Healthy Choice ? Caesar	
● Half Sandwich on Your Choice of Bread	
? Turkey ? Premium Smoke Ham & Cheese ? Roast Beef ? Italian Salami	
? Albacore Tuna Salad ? Veggie ? Grilled Breast of Chicken ? Chicken Salad	
? Half a Combo Sandwich <i>add \$1.00</i>	

In spite of these uses where applicant contends the matter is set apart as a service mark, the Trademark Examining Attorney argues that the phrase sought to be registered by applicant is commonly used on menus and in restaurant reviews. According to the Trademark Examining Attorney, the frequent use of "You Pick Two" and/or "Pick Two" by restaurateurs has conditioned the public to view this matter as nothing more than an informational slogan indicating that applicant offers a number of *a la carte* food items from which the restaurant patron chooses two. In support of this contention, the Trademark Examining Attorney has made of record menus showing a variety of other eating establishments that use this designation on their menus. For example, the evidence shows that one of

applicant's competitors, Applebee's, had a nationwide campaign² of its own called "You Pick Two":

Welcome to *applebees.com*
the official Web site of
Applebee's International, Inc.

YOU PICK TWO

Some tastes just go great together, like a Steak and Shrimp platter.

YOU PICK TWO.

Cajun steak, barbeque chicken, or roasted garlic shrimp. Combine any two into one delicious meal.

Check it out!

² "I go out and talk to consumers in test markets, and we touch every demographic in the country," he [John Koch, Senior Vice President of R&D for Applebee's] says. <http://www.twofresh-twofold.com/writing/chain.links/applebee.htm>; "Applebee's Neighborhood Grill and Bar is the world's casual dining leader, with over 1,400 restaurants in forty-nine states and eight international countries ... " <http://www.applebees.com/>

In fact, this 1999 ad campaign (which clearly sets the designation "YOU PICK TWO" apart from the surrounding text better than does applicant) resulted in several stories (made of record by the Trademark Examining Attorney) focusing on the critical role played by John Koch, Senior Vice President of R&D for Applebee's:

And Koch was responsible for the most successful campaign to date: "You Pick Two." This fourth-quarter promo menu featured a choice of two proteins - steak, chicken or shrimp - on one plate ...
<http://www.twofresh-twofold.com/writing/chain.links/applebee.htm>³

Other restaurant menus made of record also show the use of this exact phrase in much the same way it is shown on applicant's specimens of record. For example:

Morgan's Specials	
Three-Salad Sampler	
You choose! A sample of any three of our salads.	6.29
Soup and Salad	
Your choice of a cup of soup and any one of our small salads.	5.29
You Pick Two	
Pick and (sic) two . . . Half sandwich with either a cup of soup or a small salad.	6.29
Quiche and Salad or Soup	
Choose our quiche Lorraine or veggie quiche with your choice of a cup of soup or a small salad.	5.29

<http://www.shopbillings.com/restaurants/morgans_market.html>

³ Similar stories about Applebee's were drawn from <<http://home.oldmiss.edu/~benorris/Applebees.html>>, *Chain Leader* (January 2000), *Nation's Restaurant News* (October 1999), <<http://www.flavor-online.com/anderson.html>> and others.

Graul's Café – Lunch

Stop by Graul's Café next to Mays Chapel Wine and Spirits... for lunch – when we offer hearty soups, homemade wraps, and much more ...

CAFÉ LUNCH MENU

You

Pick Two!

Bowl of Soup, Half Sandwich, or Half Salad

\$5.99 Ea.

<<http://www.graulsmarket.com>>

Moreover, restaurant reviews and related news stories from the Lexis/Nexis database also show use of this term, of which the following is representative:

"It's hard to figure out. You pick your entrée off one page. Then **you pick two** vegetables and a potato off another."
("Daring to eat out with the kids," The Chattanooga Times, August 6, 1997)

Many more of the menus, restaurant reviews and news stories (from the Lexis/Nexis data base and from the Internet) used the "Pick Two" formulation where the "You" was implied, separated by other words from the term, "Pick Two," or where a third party was named as the actor (e.g., student, patron, diner, etc.):

Since you get to **pick two** side dishes with your meal...

<http://www.houstonpress.com/issues>

The menu features appetizers, main courses and desserts. Pick one of each for \$25. **Pick two** starters, a main plate and dessert for \$35.

www.weimax.com/restaural.html

Pick two of your favorite sides and desserts. Price: \$16.95 per guest.
www.cateringcarolina.com/HTML/grill.html

... There are twelve in all, ranging from hickory-smoked ribs and small steaks to fresh shrimp or salmon. For \$23.95, diners **pick two** items and get a choice of soup or salad, fresh bread, and a side dish of potato, pasta or rice. ("New Oconomowoc steakhouse is off to a delicious start," Milwaukee Journal Sentinel, November 28, 1997)

The combination - soup, salad or sandwich (**pick two** for \$5.95) - suited our appetites... "Artsy and hip 'twixt the cup and the lip," The Dallas Morning News, August 11, 2000).

Similarly, a number of menus made of record simply have short entries like "**Pick two** favorites" (Memphis Bar-B-Q Company), "**Pick two** menu combinations" (Boca Chica), "**Pick two** [pizza] toppings" (Down Under Pub), etc.

We begin our analysis by noting that not all slogans are created equally. As the predecessor to our principal reviewing court noted:

The determination of whether a given slogan is a registrable trademark is a matter which historically has not been free of difficulty (footnote omitted). Nor is it an easy task here. The mere fact that a combination of words or a slogan is adopted and used by a manufacturer with the intent Clairol has manifested here -- that it identify its goods and distinguish them from those of others -- does not necessarily mean that the slogan accomplishes that purpose in reality. See In re The Standard Oil Co., 275 F.2d 945, 125 USPQ 227 (CCPA 1960).

Roux Laboratories, Inc. v. Clairol Incorporated, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970).⁴

1. The ordinary meaning of the phrase

We do not question but that applicant expected that the term YOU PICK TWO would distinguish its services from similar services offered by others. On the other hand, having chosen informative words, and then having employed them in a context totally consistent with their ordinary meaning, applicant accepted the risk that this prosaic term may not function as a source indicator for its services.

We note the analysis and results of In re The Standard Oil Company, 275 F.2d 945, 125 USPQ 227 (CCPA 1960) [GUARANTEED STARTING for winterizing automobile engines].

In the present case it may be conceded that in using the words "guaranteed starting" in order to bring its services to the attention of the public the applicant intended and hoped, or perhaps expected, that they would distinguish them from similar services offered by others. However, having chosen words which, taken in their normal meaning, do no more than inform the public with reasonable accuracy what is being offered, it did not succeed.

⁴ While applicant cites favorably to this case (wherein the advertising slogan, "HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE," was registered), we note that Clairol's then well-known slogan was registrable only because the Court accepted applicant's rather extensive evidence of acquired distinctiveness. Applicant has not made such a showing herein.

The words are well understood, English words in common use. Taken together, they amount to no more than a sort of condensed announcement that the applicant will guarantee the work done in order to insure the starting of the customer's car. It must be assumed that the ordinary customer reading the advertisements displayed by an automobile service station would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the services advertised from similar services of other station operators. Whatever may have been the intention of the applicant in using them, their use has not accomplished what the applicant wished to do. Hence, they are not a service mark.

Upon closer examination of the precedent in this area, it is clear that some slogans will be found to be registrable while others will not.⁵ There is no question but that slogans *per se* should not be excluded from the category of registrable matter under the "word, name, symbol, or device or any combination thereof" portion of the service mark definition. See *In re Wisconsin Wire Works*, 291 F.2d 958, 130 USPQ 214 (CCPA 1961) [USE ME NEXT - I'M READY FOR SERVICE registrable for "Fourdrinier Wire

⁵ See *In re Illinois Bronze Powder & Paint Co.*, 188 USPQ 459, 462 (TTAB 1975)"

"... But, it must be recognized that not all words, devices, symbols and the like necessarily function as trademarks notwithstanding that they may have been adopted with the intent of doing so. The Act of 1946 is not an act to register marks, symbols, devices etc., but to register trademarks."

Cloth"]].⁶ However, the Trademark Examining Attorney's refusal to register herein is clearly premised on the statutory language "... to identify and distinguish the services of one person ..." If the involved slogan does not identify and distinguish applicant's services, then as a matter of statutory construction, it is simply not functioning herein as a service mark.

In the first step of our analysis, we are constrained to establish the ordinary meaning of this phrase from the vernacular, and evaluate it in the context of usage by applicant and other restaurateurs. Remembering high-school English, this slogan is actually in the imperative (or command) mood.⁷ Often times when one employs the force of an imperative, the same meaning will be communicated by dropping the initial word, "You," as the subject ["You"] is

⁶ Applicant cites with favor to the Wisconsin Wire Works opinion. However, in the face of a poorly-handled case by the Trademark Examining Attorney, the court in Wisconsin Wire Works merely held that the Lanham Act's Section 45 definition of a "trademark" (15 U.S.C. §1127) is broad enough to include slogans as a registrable type of mark. [Cf. In re Deister Concentrator Co., Inc., 289 F.2d 496, 129 USPQ 314 (CCPA 1961)]. In any event, the Wisconsin Wire Works opinion fails to discuss the issue of the distinctiveness of this particular matter as a source indicator.

⁷ **Mood** 1. *Gram.* a. a set of categories for which the verb is inflected in many languages, and that is typically used to indicate the syntactic relation of the clause in which the verb occurs to other clauses in the sentence, or the attitude of the speaker toward what he or she is saying, as certainty or uncertainty, wish or command, emphasis or hesitancy ... c. any of the categories of these sets: *the Latin indicative, imperative*

implied. Hence, the evidence in the record shows that it is quite common for eating establishments to include specials on their menus where the patron is faced with a directive - to "pick," "choose," or "select," one, two, three or more items from a designated area of the menu. The Trademark Examining Attorney has placed in the record examples where one is asked to select several pizza toppings, choose from among appetizers or light fare, or even where one is encouraged to pick a combination of dinner entrees from a list of possibilities.

2. Manner of use by applicant

Applicant points to usage on its advertising specimens and its menus where "You Pick Two" is set apart from other text by quotation marks and initial capital letters. On the other hand, the Trademark Examining Attorney points to use on those same substitute specimens by noting that the slogan has the same font as the surrounding words, and is logically part of a longer sentence (e.g., "'You Pick Two' with any signature sandwich").⁸ We agree with the Trademark

and subjunctive moods... The Random House Dictionary of the English Language, 1247 (2nd Ed. Unabridged 1987).

⁸ See the remarkably similar construction of a slogan-within-a-sentence of *In re Morganroth*, 208 USPQ 284 (TTAB 1980) [NATUR-ALL-IZE YOUR HAIR COLORING not registrable as a service mark for hair salon services when used as part of ad copy saying "Natur-all-ize your hair coloring with another new service"].

Examining Attorney that this is a familiar expression employing common words in a most ordinary fashion. The prospective patron is faced with promotional information presented in a concise manner as part of a larger message. See In re European-American Bank & Trust Company, 201 USPQ 788 (TTAB 1979) [banking slogan THINK ABOUT IT not registrable]⁹; In re Wakefern Food Corp., 222 USPQ 76 (TTAB 1984) [WHY PAY MORE! does not function as a service mark]¹⁰; In re Melville Corporation, 228 USPQ 970 (TTAB 1986) [BRAND NAMES FOR LESS unregistrable for retail clothing store services]¹¹; In re Mautz Paint & Varnish Company, 157 USPQ

⁹ "... the phrase 'THINK ABOUT IT' is a familiar expression, and we believe that the ordinary customer or prospective customer reading applicant's advertisement would take the phrase at its ordinary meaning rather than attributing thereto the special meaning of a service mark ..."

201 USPQ at 790.

¹⁰ "We fully agree with the Examining Attorney that this relatively common merchandising slogan does not act or function as a mark which identifies and distinguishes applicant's services from those of others. This commercial phrase, in our opinion, would not be perceived by the public as a service mark identifying the source of applicant's services. Rather, this familiar phrase would be perceived as an expression suggesting that applicant's stores offer lower food prices than others ..."

222 USPQ at 78.

¹¹ "In an environment where consumers are accustomed to the use by merchants of similar informational phrases, we believe that consumers are not likely to view applicant's slogan as a service mark but rather as a merchandising slogan using common ordinary words merely to convey information about applicant's services."

228 USPQ at 971

637 (TTAB 1968) ["PAINTING ... ask the EXPERT the man in the ORANGE JACKET!" found to be unregistrable for paints and similar coverings]¹²; and In re Gilbert Eiseman, P.C., 220 USPQ 89 (TTAB 1983) [Designation IN ONE DAY not registrable as a service mark for plastic surgery services]¹³.

¹² "In the particular mark, the words forming part of the matter sought to be registered tells the prospective purchaser or the purchaser, in a concise manner, that if he has any problems or questions concerning his do-it-yourself project of painting, he can ask an expert, identified by the orange jacket being worn, to help him. We must assume that the ordinary customer reading applicant's advertising literature, which comprises the leaflets and brochure, would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the paints advertised by applicant from similar products of others. What is sought to be registered is, hence, not a trademark."

157 USPQ at 638.

¹³ "It will be noted that 'IN ONE DAY' appears as part of a larger message 'In one day * * * the good looks you've always wanted can now be yours through the creative art of plastic surgery.' While IN ONE DAY appears on the first line of the total five-line message, it reads as an integral and natural part of the larger thought, is presented in the same type size and style as the other matter ... and is not used elsewhere in the specimens as a source identifier or distinguishing designation for applicant's plastic surgery services. (The latter seem to be identified in a service mark mode by the stylized monogram designation 'PSC' appearing on the advertisements)."

"Evaluating the designation on the basis of the submitted specimens of use, as the Board must, we think it clear that applicant has failed to demonstrate that 'IN ONE DAY' is employed as a service mark. It is established that when a designation or slogan imparts an impression of conveying advertising or promotional information rather than of distinguishing or identifying the source of goods or services, it cannot be the basis for registration."

220 USPQ at 90.

Furthermore, when one considers the use of this matter on applicant's menus, the header entitled "You Pick Two" is used in a similar fashion to headings like "Sandwiches," "Salads," "Soups," and "Beverages." With this layout, applicant has certainly not conditioned the prospective diner who is reading the menu to look for source indicators in these prominent spaces reserved for section headings.

Moreover, we note in particular that several places on applicant's menus, the phrase "You Pick Two" is followed immediately by the phrase "[You] Choose any two ... " as part of the regular text of applicant's menu. This usage simply serves to reinforce the ordinary meaning of the phrase "You Pick Two." See European-American Bank & Trust Company, 201 USPQ at 790.

In the context of precedential decisions dealing with the registrability of slogans that are cited with favor by applicant, it is instructive in each case to review the exact statutory basis for the Office's refusal. Unlike the present case, in several cases cited by applicant where the Trademark Examining Attorney was eventually reversed, the slogans were refused by the Office as being merely descriptive under Section 2(e)(1) of the Act - a refusal never made herein. Yet it is hornbook trademark law that if such a slogan (or any other composite) combines several

merely descriptive components, it will be found to be registrable if the combination of terms creates a unitary mark having a unique or incongruous meaning as applied to the goods (e.g., In re Geo. A. Hormel & Company, 218 USPQ 286 (TTAB 1983) [FAST'N EASY registrable for pre-cooked meats]), or if the designation is simply found not to be merely descriptive (e.g., In re Colgate-Palmolive Company, 406 F.2d 1385, 160 USPQ 733 (CCPA 1969) [CHEW 'N CLEAN not merely descriptive for dentifrice]; In re Reynolds Metals Company, 480 F.2d 902, 178 USPQ 296 (CCPA 1973) [BROWN-IN-BAG is suggestive of transparent plastic film cooking bags]; and In re Kopy Kat, Inc., 498 F.2d 1379, 182 USPQ 372 (CCPA 1974) [WE PRINT-IT IN A MIN-IT registrable for consulting services offered in connection with printing]¹⁴.

3. Use in the media by restaurant critics referring to applicant's menu

Applicant has submitted fourteen examples where writers from across the country have allegedly treated the

¹⁴ The majority in Kopy Kat found that based on the record, this phrase was not descriptive. However, the majority identified this designation as a "rhyming couplet," which conclusion alone may be sufficient to overcome a descriptiveness refusal. Finally, in the context of the instant case and the question of whether a slogan is sufficiently creative, or just common and ordinary, even the dissenting judge in Kopy Kat (who found this matter to be merely descriptive) also volunteered that he found this particular slogan to be "catchy."

phrase "You Pick Two" as a unitary phrase. Applicant argues as follows:

Each of the words "you pick two" would be readily recognized by all speakers of standard American English. They ... might be recognized as a complete sentence. However, in the context of applicant's services, people use these words in ways that grammatically contradict the usual meanings of the words. This can be seen in numerous unsolicited comments in the press...

(Applicant's request for reconsideration, p. 3 and Exhibit A attached thereto).

We acknowledge that in each of these articles, the writer has set apart the words "You Pick Two" with quotation marks and/or initial capital letters. However, as seen above, we cannot overlook applicant's uses on its menus and promotional materials of record. Upon closer examination, we find that the quoted journalists are merely picking up this matter as an informational phrase set apart by applicant. In fact, we agree with applicant that "in the context of applicant's services, these writers show some uncertainty as to how to categorize this three-word phrase." (Applicant's request for reconsideration, p. 5). Given the uniform popularity of this combination special in applicant's eating establishments, the writers may be seen as simply directing future patrons to that part of a rather

extensive menu - a section that applicant has entitled "You Pick Two."

In evaluating applicant's usage on its menus, we note that clarifying language immediately following this phrase serves to reinforce the ordinary meaning of the phrase "You Pick Two":

YOU PICK TWO

Choose any two of the Following \$4.95
Soup, Half Salad or Half Sandwich

This is clearly borne out in the restaurant reviews submitted by applicant - all of which are incredibly similar in the paragraph dealing with this spot on the menu. Not surprisingly, when identifying this area of the menu, all the review paragraphs are structured remarkably like the menu. That is, following the usage of the term in the heading (You Pick Two) is the menu price for that restaurant (now \$5.15 to \$5.99) and a further explanation of the diner's choices (soup, half-salad or half-sandwich):

... the "**you pick two**" special. For **\$5.15** you may **choose any two** of a bowl of **soup**, a **half sandwich** or a **half salad**. (Knoxville)

... the "**You Pick Two**" special (**\$5.69**) option. Diners **choose two items**: a bowl of **soup**, any **half sandwich** or any **half salad**. (Rocky Mountain)

... the "**You Pick Two**" combo deal that lets a guest **choose two of the following**: **half a**

sandwich, a cup of **soup** or a **half a salad**.
(Bloomington)

... the "**You Pick Two**" combo. For **\$5.35** diners can **select two of the following**: a bowl of **soup**, a **half sandwich** or a **half salad**. (Des Moines)

... the "**You Pick Two**" thing. It's two out of three, really. The three are **soup**, a **half-salad** and **half-sandwich**. (Pittsburgh)

... the "**You Pick Two**" combo, which allows you to **pick two of the following**: bowl or **soup**, **half sandwich**, or **half salad** for only **\$5.35**. (Carnegie Mellon)

... the **You Pick Two**: two items from among a bowl of **soup**, **half sandwich** or **half salad** (**\$5.25**). (Cincinnati)

... (The "**You Pick Two**" allows you to **order two of the following**: bowl of **soup**, **half a sandwich**, or **half a salad**.) (Bloomington)

... the popular "**You Pick Two**" (**\$5.99**) is a good way to sample two items on the menu. **Choose from any half sandwich, salad** or bowl of **soup**. (Tampa)

... a menu item called "**You Pick Two**". For **\$5.40** you **select two [of] three** opinions (sic) ... any bowl of **soup**, **half a sandwich** or **half a salad**. (Knoxville/NBC)

... a nice feature called "**You Pick Two**." For **\$5.45** you can **select two of the following**: bowl of **soup**, **half a sandwich** or **half a salad**. (Alexandria/Washington DC)

Apart from this recurrent paragraph, we have also surveyed these same writer's tendencies to set aside other items in these same reviews. Accordingly, we are most reluctant to have this case turn on writers' uses of

quotation marks and capital letters. For example, these various writers reviewing applicant's restaurants, have used identical quotation marks elsewhere in these same articles, to set aside: "good" (Knoxville), "yummy," "bowl," "regular" (Rocky Mountain), "provel," "the highest quality ingredients," "'French' bread" (Des Moines), and "Café" sandwiches (Bloomington). Similarly, writers reviewing applicant's restaurants have also employed initial capital letters for generic menu items: Veggie sandwich, Hazelnut House Blend coffee (Carnegie Mellon), Cranberry Walnut Bagels, Fire-Roasted Vegetable Bisque (Chattanooga), Rosemary & Onion Focaccia, Tomato Basil bread (Tampa), and Veggie Sandwich, the French Onion Soup in a Sourdough Bread Bowl, Pecan Rolls (Knoxville/NBC), etc.

4. Manner of use by third party competitors

It is clear from the routine uses of this term by third parties (e.g., other restaurateurs) that applicant's alleged mark is not a particularly unique or catchy slogan. Rather, it consists of common words used in an ordinary fashion.¹⁵ Although applicant cites favorably to In re First Union National Bank, 223 USPQ 278 (TTAB 1984) [TAKE A

¹⁵ See Melville Corporation, 228 USPQ at 971.

CLOSER LOOK found to be a valid service mark for banking services], we note that in that record, unlike the current record:

There is no evidence in the record to even suggest that the slogan "TAKE A CLOSER LOOK" is used by anyone else in the banking industry, either as a service mark or in the ordinary sense of the words.

223 USPQ at 280. By contrast, the evidence in the instant case suggests that restaurateurs around the nation likely assume, with good reason, that they could freely use this informational slogan to tout a special combination of food items on their respective menus, and indeed, such merchants do in fact employ this prosaic term with some regularity.

5. Decision as to commercial impact created by the asserted mark

We have seen that the real issue in slogan cases involving a typical promotional phrase is whether or not the slogan or designation would be perceived as a service mark when encountered by consumers on a regular basis. However, we fail to see the requisite degree of cleverness that might cause prospective consumers to see this as having source-indicating significance. As noted earlier, we are also not persuaded by various writers' uses of initial capital letters and quotation marks. Indeed, the frequency with which fourteen restaurant reviewers have

used quotation marks might well reflect the writers' own uncertainty over why applicant highlights this prosaic matter. In that event, one could actually visualize these written examples as analogous to those irritating "air quotes" some speakers use to demonstrate the same point.¹⁶

Finally, applicant argues that it has used this matter as a source indicator for a decade now:

Applicant has used its Mark in commerce for more than ten years. This extensive use constitutes *prima facie* evidence that the Mark has become distinctive, as used on its goods (sic). See 15 U.S.C. §1052(f).

(Applicant's brief, pp. 11 - 12).

Despite allegations of ten years of use of this term, in light of the ordinariness of this term as used by restaurateurs in promotional materials and on restaurant menus, applicant faces a most heavy burden in arguing that it has achieved distinctiveness for this designation.

Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). The mere fact that so many others providing restaurant services have also been using this term increases the hurdles faced by applicant in showing "substantially *exclusive* and

¹⁶ For example, a Fort Worth reviewer quizzically notes: " ... the trademarked "You Pick Two" - a choice of, you guessed it, two selections of a soup, a half sandwich or a half salad for \$6.45." (emphasis supplied) This appears to be an unsolicited but clear comment on the informational nature of this phrase.

continuous use thereof as a mark by the applicant in commerce ..." [emphasis supplied] 15 U.S.C. §1052(f). As to arguably good source indicating usage by restaurant critics, we dismiss as questionable applicant's alleged evidence of this expression's source indicating ability based on the fourteen references applicant has located. Finally, whether one looks to the explicit terms of Section 2(f) of the Lanham Act, or to a similar showing of acquired distinctiveness in a parallel fashion,¹⁷ we agree with the Trademark Examining Attorney that this issue was never fully engaged as applicant failed to raise this justification until reaching the concluding pages of its appeal brief.

Alternatively: Trademark usage?

In response to applicant's submission of Lexis/Nexis and Internet excerpts about applicant's restaurants and menu items, the Trademark Examining Attorney seemed to suggest as an alternative basis for rejection that these uses and the appearances on applicant's menu may function as a trademark but not as a service mark:

¹⁷ See, e.g., discussion of secondary source for ornamental matter used on collateral goods, In re Paramount Pictures Corporation, 213 USPQ 1111, 1114 (TTAB 1982) viz., footnote 8 and surrounding text.

... For the reasons outlined below, however, the Examining Attorney concludes that this evidence does not support service mark use.

On the four different menu excerpts submitted by the Applicant, the proposed mark "YOU PICK TWO" is used prominently to identify a specific menu item, in each instance costing a specific amount and consisting of a choice of soup, half salad, or half sandwich. In the news articles submitted by the Applicant, the wording "YOU PICK TWO" is referred to as: (1) an "option;" (2) a "thing," (3) a "special;" (4) a "combo;" (5) a "combo deal;" (6) a "lunch idea;" (7) a "favorite option;" and/or (8) a "menu item."

Based on this evidence, it is clear that in these instances the proposed mark is used to identify a menu item or option and is likely to be recognized by the public as such. However, it does not necessarily or logically follow that the wording also performs a service mark function to identify the Applicant's restaurant services from the restaurant services of others, without a specific showing of service mark use. A designation or phrase used in a menu to identify a particular food or beverage available does not necessarily also function as a mark for restaurant services. See In re El Torito Restaurant Inc., 9 USPQ2d 2002,2004 (TTAB 1988) (MACHO COMBOS found to identify a menu item only and not a service mark for restaurant services) (citing In re Brown & Portillo, Inc., 5 USPQ2d 1381, 1383 (TTAB 1987)).

(Trademark Examining Attorney's appeal brief, p. 6).

Although this alternative basis for refusal is based upon the same statutory sections of the Lanham Act, it was not until the Trademark Examining Attorney's appeal brief

that we encounter this particular discussion for the first time. Accordingly, in light of the prosecution history of this file, where the Trademark Examining Attorney has consistently held that this matter does not function as a source indicator of any kind (e.g., it is neither a service mark nor a trademark), we have not considered whether the Nexis stories may indicate valid trademark usage in connection with a menu item.¹⁸

Decision: The refusal to register is affirmed.

¹⁸ There are at least two significant distinctions between the instant case and the facts of the El Torito Restaurants case. First, in applicant's favor, the substitute specimens in the instant case are advertisements in the form of flyers (acceptable for service mark usage), whereas the Board in El Torito had only table tents and menu boards (generally not acceptable for service mark usage). On the other hand, the Board in El Torito discussed the designation MACHO COMBOS as "arbitrary" matter - hardly the case herein.