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Mailed: September 29, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Food Company, Inc.

Serial No. 76101362

Mark D. Schneider of Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski for American Food Company, Inc.

Linda M. King, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Quinn, Walters and Drost, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

American Food Company, Inc. has filed an application to
register the mark THE BEEF JERKY OUTLET for "retail store
services featuring meat products," in International Class
35.¹

The trademark examining attorney initially refused
registration on the Principal Register under Section 2(e)(1)
of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground

¹ Serial No. 76101362, filed August 1, 2000, based on use of the mark in
commerce, alleging first use and use in commerce as of November 2, 1992.

that applicant's mark is merely descriptive when used in connection with its services. Applicant responded by asserting a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f), with a declaration asserting various facts pertinent to its claim. The claim was rejected by the examining attorney as insufficient. Following issuance of a final refusal, applicant filed its notice of appeal and amended the application to seek registration on the Supplemental Register.² The Board remanded the application to the examining attorney, who refused registration on the Supplemental Register under Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that the alleged mark is generic when used in connection with the identified services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

The examining attorney contends that THE BEEF JERKY OUTLET is generic for the identified services, relying principally on applicant's brochure submitted as a specimen

² A claim of acquired distinctiveness under Section 2(f) of the Trademark Act is a concession that the mark is merely descriptive. However, applicant's claim was not made in the alternative, and, following applicant's amendment to the Supplemental Register, it became moot. Therefore, the issue of whether the mark is merely descriptive is not before the Board in this appeal.

of use. In addition to listing "beef jerky" in its product price list, the brochure includes the following statements:

A true factory outlet with real wholesale prices. Reinhold & Timko quality beef snacks, produced in the U.S.A.

The best tasting beef jerky on the market. High protein nutritional value, low-sugar and low-fat.

Beef Jerky has been a staple in the American diet for more than 100 years. Beef snacks are the fastest growing segment of the Snack Food Industry as consumers realize its Low-Fat (beef jerky is only 3% fat), low sugar, high protein nutritional value.

The examining attorney also seeks to rely on definitions of "beef jerky" and "outlet" obtained from the Internet web site www.Dictionary.com and submitted with the examining attorney's brief. In this regard, the Board has stated the following in *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999):

[T]he definitions have been retrieved from on-line dictionaries which, according to the Examining Attorney, are not available in a printed format. Under this circumstance, the Board is reluctant to take judicial notice of such matter after an ex parte appeal has been filed. The Board simply is unsure whether this material is readily available and, more significantly, the Board wonders about the reliability of it, noting applicant's legitimate concern that the dictionary's source is unknown. The evidence furnished by the Examining Attorney should have been made of record prior to the filing of the appeal, in which case applicant would have had the opportunity to check the reliability of the evidence and/or timely offer rebuttal evidence. In that situation, the Board more readily could have assessed the reliability and probative value of the evidence. In future cases, when Examining Attorneys intend to rely on Internet evidence that

otherwise would normally be subject to judicial notice (such as dictionary definitions), such evidence must be submitted prior to appeal.

The Examining Attorney has not indicated whether the Internet-excerpted definitions are available in print form. However, we have taken judicial notice of the submitted definition of "outlet" as, *inter alia*, "a commercial market for goods or services"³ because the excerpt clearly indicates its source is a dictionary the is widely available in print form.⁴ We also take judicial notice of the following terms defined in *Merriam Webster's Collegiate Dictionary* (11th ed. 2003):

Jerk: vt. to preserve (meat) in long sun-dried slices.

Jerky: jerked meat.

Citing *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), the examining attorney asserts that THE BEEF JERKY OUTLET is a compound term; that the individual words are generic terms for, respectively, dried beef strips and a commercial market; and that the individual words retain their generic significance when joined to form the compound term herein. She also relies on the proposition that a term that is generic for a type of goods is also generic for the service of selling primarily those

³ *The American Heritage Dictionary of the English Language* (4th ed. 2000); accessed on the Internet via *Dictionary.com*.

⁴ We decline to take notice of the additional definitions or of the other Internet material submitted with applicant's brief both because it is untimely and because it is inappropriate matter for judicial notice.

goods, citing, *inter alia*, *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for particular field or type of art and also for dealership services directed to that field). In this regard, she states the following:

Here, we have an outlet store that features beef jerky, specifically "the best tasting beef jerky on the market." Similar to the [name] RUSSIANART ... identifying the nature of the goods sold at the ... retail [establishment], the name BEEF JERKY identifies the nature of the goods featured at the applicant's outlet stores. The evidence shows that outlet stores are a defined genus of stores that sell goods ..., and that applicant's services constitute outlets featuring Reinhold & Timko beef jerky. Therefore, the proposed mark, THE BEEF JERKY OUTLET, is generic for the service of selling beef jerky.

Applicant contends that the examining attorney has not met the burden of proving by "clear evidence" that its mark as a whole is generic; that there is no evidence of the public's perception of the mark as a whole; and that there is no evidence that "beef jerky" is a generic term for a type of goods and certainly no evidence that it is generic for retail services featuring those goods. Applicant argues that its brochure submitted as a specimen with its application is not evidence of how the relevant public would perceive its mark; and that applicant's declaration accompanying its claim of acquired distinctiveness⁵ attests

⁵ Charles P. Reinhold, applicant's vice president, attested to the following pertinent facts:

to applicant's "long use of the mark and significant sales in connection with the mark [which] strongly indicate[s] that the mark is at least capable of distinguishing itself as an indicator of source to the relevant public" (brief, p. 2).

We begin our analysis by noting the established rule that a mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*. The United States Patent and Trademark Office has the burden of establishing by clear

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- The mark has been in substantially continuous and exclusive use in commerce in connection with the identified services since November 2, 1992;
 - The mark has been extensively advertised and promoted in connection with the identified services through flyers, print and broadcast media;
 - Applicant has retail outlets in Michigan, Florida and Indiana; and
 - Applicant's annual sales from 1996 through the first six months of 2001 range from a low of \$170,557 to a high of \$708,295.

Serial No. 76101362

evidence that a mark is generic and, thus, unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).

Our first task under *Marvin Ginn* is to determine, based on the evidence of record, the genus of applicant's services. Applicant's brochure describes applicant's service as "a true factory outlet" for "beef snacks." Thus, the genus of services involved herein may be accurately identified as "retail store services featuring beef snacks."

We must next determine whether the designation THE BEEF JERKY OUTLET is understood by the relevant purchasing public primarily to refer to that genus of services. In this case, the relevant purchasers are likely to be ordinary retail consumers of beef snacks.

The factual record before us, limited to two definitions and applicant's brochure, pertains only to the constituent terms of the mark, BEEF JERKY and OUTLET.

The Federal Circuit, in *American Fertility*, stated that "[t]he board cannot simply cite definitions and generic uses of the constituent terms of a mark....in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark ... generic." 51 USPQ2d at 1836. The Federal Circuit went on to state that the prior case of *In re Gould Paper Corp.*, 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) "is limited, on its facts, language, and holding,

to compound words formed by the union of words" and that it was legally erroneous to apply language found in the *Gould* case "to phrases consisting of multiple terms, which are not 'joined' in any sense other than appearing as a phrase." *Id.* at 1837. The Federal Circuit further stated that "the correct legal test....is set forth in *Marvin Ginn* and is to be applied to a mark, or disputed phrase thereof, as a whole, for the whole may be greater than the sum of its parts." *Id.*

We find the examining attorney's reliance on *In re Gould, supra*, to be misplaced in this case. In light of the Federal Circuit's decision in *American Fertility*, we are constrained to find that the examining attorney has failed to show that the designation as a whole, THE BEEF JERKY OUTLET, has acquired no additional meaning to retail consumers of beef snacks than the terms "BEEF JERKY" and "OUTLET" have individually. That is to say, although the terms "BEEF JERKY" and "OUTLET" may be generic for, respectively, a type of beef snack and a commercial market, the record falls short of establishing that the phrase THE BEEF JERKY OUTLET, as a whole, is generic. This is not a case where the Office has clearly proven that the designation as a whole is no less generic than its constituents. While THE BEEF JERKY OUTLET is certainly an apt name for a retail establishment that sells strips of

Serial No. 76101362

dried beef, the evidence does not show that it is used as a generic name for such services. Aptness is insufficient to prove genericness.

We find, based on the evidence of record, that the Office has not met its burden of establishing by clear evidence that the designation THE BEEF JERKY OUTLET, as a whole, is generic for the identified goods. See *In re Merrill Lynch, supra*. Genericness is a fact-intensive determination, and the Board's conclusion must be governed by the record that is presented to it. Although we have concerns here about the genericness of applicant's designation, it is the record evidence bearing on purchasers' perceptions that controls the determination, not general legal rules or our own subjective opinions. Any doubts raised by the lack of evidence must be resolved in applicant's favor. *Id.* Further, on a different and more complete record, such as might be adduced by a competitor in an opposition proceeding, we might arrive at a different result on the issue of genericness.

Decision: The refusal of registration on the Supplemental Register, under Section 23 of the Trademark Act, is reversed.