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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Robert's American Gourmet

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Serial No. 75/600,461

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Myron Amer of Myron Amer, P.C. for Robert's American Gourmet.

Dawn J. Feldman, Trademark Examining Attorney, Law Office 111 (Kevin Peska, Acting Managing Attorney).

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Before Cissel, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 7, 1998, Robert's American Gourmet (a New York corporation) filed an application to register on the Principal Register the mark ST. JOHN'S WORT TORTILLA for "herbal and natural snacks" in International Class 30. Applicant claimed dates of first use and first use in commerce of March 15, 1995 and June 1, 1995, respectively.

In the first Office action, the Examining Attorney, inter alia, refused registration of the proposed mark as merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §2(e)(1), and stated that the proposed mark appears to be generic of the goods; including as evidence a dictionary definition of the word "tortilla" and printouts from a few websites showing uses of "St. John's Wort" as an herbal ingredient or nutritional supplement. In addition, the Examining Attorney explained that the mark shown on the drawing did not match the mark as used on the specimens and required either a new drawing or new specimens; and held that the identification of goods ("herbal and natural snacks") was indefinite. In response, applicant, inter alia, amended the application to seek registration on the Supplemental Register; submitted an amended drawing to show the mark as ST. JOHN'S WORT TORTILLA CHIPS; and submitted an amendment to the identification of goods to read "herbal and natural snacks, namely, tortilla chips, tortilla shells, containing St. John's Wort."

In the second Office action, the Examining Attorney accepted the amended drawing, the amendment to the identification of goods, and the amendment to the Supplemental Register; but refused registration on the basis that the proposed mark is the generic name for

applicant's goods; and including as evidence copies of several third-party registrations wherein the phrase "St. John's Wort" appeared in the identifications for goods enhanced with that herb. Applicant then submitted a second amended drawing showing the mark as ST. JOHNS WORT TORTILLA CHIPS (without the apostrophe -- as it appears on the specimens); proposed an amendment to the identification of goods deleting the phrase "containing St. John's Wort"; and argued the mark is not generic.

In the third Office action the Examining Attorney accepted the amended drawing; rejected the further amendment to the identification of goods; and continued the final refusal on the Supplemental Register, including as evidence printouts from a few websites showing uses of "St. Johns Wort" (without the apostrophe). In response, applicant proposed another amendment to the identification of goods, and again contended the mark is not generic.

In the next Office action, the Examining Attorney rejected the new proposed amended identification of goods; and in response thereto, applicant proposed that in the identification of goods the word "JOHN'S" be changed to "JOHNS"; and argued the mark is capable of distinguishing the goods.

The Examining Attorney accepted the amendment to the identification of goods and made final her refusal to register the mark on the Supplemental Register pursuant to Section 23 of the Trademark Act, 15 U.S.C. §1091. From this final refusal applicant has appealed.

Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

For clarity of the record, we reiterate that, the applied-for mark, as amended, is ST. JOHNS WORT TORTILLA CHIPS; and the identification of goods, as amended, reads "herbal and natural snacks, namely, tortilla chips, tortilla shells, containing St. Johns Wort."

One of applicant's specimens of record is reproduced below.

Applicant contends that the record does not indicate how "customers would respond to the specimen display [of the mark]" (brief, p. 3); that applicant uses the term as a trademark<sup>1</sup>; that "despite its descriptive nature, such a term [St. Johns Wort or St. John's Wort] is not one that the consuming public would normally expect to be associated with a snack food" (brief, p. 5); that the mark is not generic for these goods; that the use of "JOHNS" without the apostrophe is an incongruity compared to the overwhelming proper use of "JOHN'S" and it constitutes the modicum necessary to serve as a source-identifier and creates sufficient "ingenuity that is necessary for registration" (brief, p. 5).

The Examining Attorney contends that "St. John's Wort" (spelled with or without an apostrophe) is an herb supplement or additive believed to assist with mood regulation; that applicant's goods are tortilla chips and tortilla shells which contain the herb St. John's Wort as

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<sup>1</sup> Applicant submitted for the first time with its brief on the case, an exhibit marked "trademark portfolio specimens" which consists of several specimen labels of other marks apparently owned by applicant, with a registration number typed below each label. The Examining Attorney objected to this evidence as untimely. The objection is well taken, and this evidence has not been considered on appeal. See Trademark Rule 2.142(d). Even if considered, however, the evidence is not persuasive of a different result as it is not pertinent to the issue of the registrability of the designation applicant seeks to register here.

an ingredient thereof; that the designation sought to be registered, ST. JOHNS WORT TORTILLA CHIPS, names what the goods are, specifically, tortilla chips enhanced with the St. John's Wort herb; and that consumers would so recognize the designation.

The test for determining whether a designation is generic, as applied to the goods set forth in the application, turns upon how the term or phrase is perceived by the relevant public; and this perception is the primary consideration in a determination of genericness. See *Loglan Institute Inc. v. Logical language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Applicant does not dispute that the words "tortilla chips" are generic for its identified goods. Rather, applicant focuses on the words "ST. JOHNS WORT," emphasizing the lack of an apostrophe in the word "Johns"

as somewhat unique; and asserting that the goods are not herbs, but snack foods.

The Examining Attorney's evidence in the form of printouts from various Internet websites establishes that "St. John's Wort" (and/or "St. Johns Wort") is the generic name of an herb which is touted as an anti-anxiety or anti-depressant product. Moreover, the Board takes judicial notice of the PDR (Physicians Desk Reference) for Herbal Medicines (2000) which states the following:

St. John's Wort  
Hypericum perforatum ...  
Effects...A mild antidepressant....<sup>2</sup>

Applicant's own specimens list "St. Johns Wort" as an ingredient, and the effects thereof are promoted on the front of the specimen label (e.g., "feelin good"). Thus, St. John's Wort is a key ingredient in applicant's goods. The designation ST. JOHNS WORT TORTILLA CHIPS tells consumers what the goods are -- tortilla chips containing St. John's Wort.

Applicant's mere argument that its use of "JOHNS" without the apostrophe creates an incongruity and would be a cognitive factor to the purchasing public is not

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<sup>2</sup> See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

convincing. We disagree that consumers will notice the lack of the apostrophe. Moreover, even assuming some consumers might notice this minor difference, the Examining Attorney has shown that "St. Johns Wort" (without the apostrophe) is often utilized in referring to this herb.

The Examining Attorney has met the burden necessary to establish a prima facie case that the designation "St. Johns Wort" is generic for an herb which is a critical ingredient of the identified goods, and "tortilla chips" is generic for these snacks. The designation as a whole is the generic name of a key ingredient coupled with the generic term for the food product (e.g., "orange juice"), and consumers would so view this designation.

Finally, "generic names are regarded by the law as free for all to use. They are in the public domain." 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §12:2 (4th ed. 2001). See also, *Estate of P.D. Beckwith, Inc. v. Comm. of Patents*, 252 U.S. 538, 543-544 (1920). Even if applicant is the first entity to use the designation "ST. JOHNS WORT TORTILLA CHIPS" in relation to herbal and natural snack foods containing St. John's Wort, such is not dispositive where, as here, the designation clearly is the generic name of such goods. We believe that competitors would have a competitive need to

use this designation. The fact that there may not be others currently using the designation ST. JOHNS WORT TORTILLA CHIPS for these goods, does not make it less a designation of what the goods are, rather than where the goods come from.

We find the designation ST. JOHNS WORT TORTILLA CHIPS to be generic and incapable of distinguishing applicant's "herbal and natural snacks, namely, tortilla chips, tortilla shells, containing St. Johns Wort" from those of others. See *In re Hask Toiletries, Inc.* (TTAB 1984) (HENNA 'N' PLACENTA held generic for hair conditioner), and cases cited therein; and 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §12:57 (4th ed. 2001). See also, *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990), aff'd unpub'd, but appearing at 20 USPQ2d 1319 (Fed. Cir. 1991).

**Decision:** The refusal to register on the Supplemental Register is affirmed.