

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SRO Management, LLC

Serial No. 76236221

David V. Radack for SRO Management, LLC.

Martha L. Fromm, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Hanak, Hohein and Bottorff, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

SRO Management, LLC (applicant) seeks to register on
the Principal Register in typed drawing form THE
CONTINENTAL for "restaurant and bar services." The
application was filed on April 5, 2001 with a claimed first
use date of September 1995.

Citing Section 2(e)(1) of the Trademark Act, the
Examining Attorney refused registration on the basis that
applicant's mark is generic as applied to applicant's
services. When the refusal to register was made final,
applicant appealed to this Board. Applicant and the

Examining Attorney filed briefs. Applicant did not request a hearing.

In considering whether applicant's mark is generic it is beyond dispute that "the burden of showing that a proposed trademark [or service mark] is generic remains with the Patent and Trademark Office." In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at 1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, "a strong showing is required when the Office seeks to establish that a [mark] is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir. 1994). Moreover, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

Having said the foregoing, the Examining Attorney has abundantly proved that the word "continental" (whether spelled with capital "C" or a lower case "c") is generic for a type of restaurant. To begin with, the Examining Attorney has made of record a dictionary definition of the word "continental" which is as follows: "often

capitalized: of, relating to, or being a cuisine derived from the classic dishes of Europe and especially France." Merriam-Webster Dictionary (2003). In addition, the Examining Attorney has made of record hundreds of articles where various restaurants across the country identify themselves as being a continental restaurant or featuring continental cuisine or continental dining. Moreover, the Examining Attorney has made of record numerous restaurant directories which list restaurants by their style of cuisine such as French, Italian, Mexican and Continental. In view of the foregoing, we have no doubt that the term "Continental" is a generic term for a type of restaurant. Indeed, applicant concedes this very point. At page 4 of its reply brief, applicant makes the following statement: "In this case, the term 'CONTINENTAL' is a type of restaurant, and while admittedly descriptive, it is not a descriptor for the entire genus, i.e. restaurant services." We certainly agree with the applicant that the term "Continental" names a type of restaurant. The fact that the term "Continental" does not name "the entire genus, i.e. restaurant services," is irrelevant. By applicant's reasoning, the terms "maple"; "redwood"; and "cypress" (to name just a few) would not be generic terms for specific

types of trees because they do not name the entire genus, which is "trees."

We acknowledge that applicant is not seeking to register CONTINENTAL, but rather is seeking to register THE CONTINENTAL. Technically, THE CONTINENTAL is a phrase, and under a literal reading of In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999), the Examining Attorney, in order to sustain a genericness refusal, would have had to have made of record articles which use the phrase "the continental" in a generic manner. The Examining Attorney could not do so.

However, we do not believe that the United States Court of Appeals for the Federal Circuit ever intended that American Fertility be read such that an applicant could take a clearly generic term and add to it a non-source identifying word such as "the" or "a" and thereby create a trademark or service mark. This is true even in the absence of proof by the Examining Attorney that others had used "the continental" or "a continental."

Quite some years ago a predecessor Court to our primary reviewing Court rejected applicant's reasoning when it held that the mark "the pill" was generic for oral contraceptives. In re G.D. Searle & Co., 360 F.2d 650, 149 USPQ 619, 624 (CCPA 1966). In so doing, the Court stated

"that the addition of quotation marks to an otherwise common descriptive name [generic term]" does not convert it into a trademark. Searle, 149 USPQ at 623. While the Court in Searle did not discuss the presence of the word "the" in applicant's mark, it is clear that if quotation marks could not save applicant's mark from being held generic, then the non-source identifying word "the" certainly could not.

In similar fashion, this Board held that with regard to computer outlet services, the presence of the word THE in the "mark" THE COMPUTER STORE (depicted in typed drawing form) did not prevent the mark from being generic. In re Computer Store, Inc., 211 USPQ 72 (TTAB 1981).

Of course, if a mark is depicted in an extremely stylized form (as opposed to typed drawing form) then it may be possible to obtain a registration for a mark consisting of the word THE followed by the generic term provided that the generic term has been disclaimed. In re Venturi, Inc., 197 USPQ 714, 715 (TTAB 1977) (The Board allowed registration of the words THE PIPE in a highly stylized form for smokers' pipes with the disclaimer of the generic term "pipe"). In the present case, there is not even a disclaimer of the generic term "continental."

Before leaving the issue of genericness, one last comment is in order. We would be remiss not to point out that in applicant's specimen of use the word THE is depicted in extremely small lettering, whereas the word CONTINENTAL is depicted in far, far larger lettering. As previously noted, applicant seeks to register THE CONTINENTAL in typed drawing form. This means that the mark is not limited to being "depicted in any special form" and hence we are mandated "to visualize what other form the mark might appear in." Phillips Petroleum Co. v. C.J. Webb Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). In particular, we must give special attention to the manner in which applicant has actually depicted its mark. See also INB National Bank v. Metrohost Inc., 222 USPQ2d 1585, 1588 (TTAB 1992). If applicant were to obtain a registration of THE CONTINENTAL in typed drawing form, it would be free to depict, as it so does, the mark with the word THE in barely legible form and the word CONTINENTAL in extremely large form. In essence, applicant would be obtaining rights in the clearly generic term "continental" for restaurant and bar services.

If it is ultimately determined that our finding that applicant's mark is generic is in error, we will next consider applicant's claim that its mark has acquired

distinctiveness pursuant to Section 2(f) of the Trademark Act. It is well settled that as a mark's descriptiveness increases, the applicant must present decidedly more evidence pursuant to Section 2(f) in order to establish that its mark has become distinctive of applicant's goods or services. Yamaha International v. Hoshino Gakki, 840 F.2d 572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

Applicant's evidence of acquired distinctiveness consists of the fact that it has used the mark for more than five years, and that its mark has received mention in two national publications as well as on a television show. Such evidence of acquired distinctiveness is woefully inadequate because applicant's mark, if not generic, is, at a minimum, extremely highly descriptive.

Decision: The refusal to register is affirmed.