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Mailed:
January 3, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spice Depot, Inc.

Serial No. 78475078

Clifford W. Vermette of Vermette & Co. for Spice Depot,
Inc.

Dominick Salemi, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Hohein, Grendel and Bergsman, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark NEW YORK STEAK (in standard character form) for
goods identified in the application as "herbs and spices."¹

¹ Serial No. 78475078, filed on August 27, 2004. The application is based on the intent-to-use provisions of Trademark Act Section 1(b), 15 U.S.C. §1051(b). We note that applicant, in the application, classified its "herbs and spices" in International Class 7, and that the Office has assigned the same classification to the goods. This appears to be incorrect, inasmuch as Class 7 covers machinery items. According the Office's manual covering identification and classification of goods, "spices" are

In its response to the first Office action, applicant submitted a voluntary disclaimer of STEAK apart from the mark as shown.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that it is merely descriptive of applicant's goods. See Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). The appeal is fully briefed.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely

classified in Class 30, as are "processed herbs." "Fresh herbs," "raw herbs," and "unprocessed herbs" are classified in Class 31. Thus, it would appear that applicant's identification of goods is indefinite as to "herbs." Because applicant paid the filing fee for only one class of goods, and because "spices" are classified in Class 30, we will assume that applicant's "herbs" are "processed herbs" in Class 30. We note in any event that whether applicant's "herbs" are Class 30 processed herbs or Class 31 unprocessed herbs, the distinction is not material to our decision herein.

descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

We take judicial notice² that The Random House Dictionary of the English Language (Unabridged) (2d ed. 1987) has the following entry for "New York steak" (at page 1296): "See shell steak." The dictionary's definition of "shell steak" (at page 1763) is as follows: "Cookery. A porterhouse steak with the fillet removed. Also called New York cut, New York steak."

We note that applicant, in its reply brief, repeatedly uses the term "New York steak" generically to name a particular cut of beef. For example, on page 6 of the reply brief, applicant makes the following statements: "As the Examiner has pointed out, NEW YORK STEAK is a term used to identify a particular cut of beef"; and "As a consequence, the present mark may be suggestive of the suitability of the spices for seasoning New York steak but not merely descriptive of the function of seasoning New York steak." At page 7 of the reply brief, applicant states: "A New York steak is not seasoned in any particular way"; "A seasoning appropriate for a New York steak would also be appropriate for a T-bone steak, a porterhouse, etc."; and "A porterhouse steak may be cooked

² The Board may take judicial notice of dictionary definitions. 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).

slightly differently from a New York steak depending on size, thickness, etc."

Based on this dictionary evidence and on applicant's own usage, we find that "New York steak" is a unitary designation which is the name of a particular type of steak or cut of beef.³

We also find that NEW YORK STEAK is merely descriptive of applicant's "herbs and spices" because it directly and immediately identifies a purpose or function of the goods, i.e., they are or may be used to season New York steaks.

The fact that herbs and spices may be used to season New York steaks, or stated differently, the fact that New York steaks may be seasoned with herbs and spices, is not in dispute. However, applicant argues that the mark NEW YORK STEAK is suggestive of the goods, rather than merely descriptive, because "[a] New York steak is not seasoned in

³ We are not persuaded by the Trademark Examining Attorney's argument that NEW YORK STEAK is a composite mark consisting of NEW YORK, which is argued to be merely descriptive of "the origin" of the goods, and STEAK, which is merely descriptive of the function or purpose of the goods. Instead, we find that NEW YORK STEAK is a unitary term denoting a type of steak. We note that the Trademark Examining Attorney's argument regarding "the origin" of the goods appears have resulted in or encouraged applicant's repeated proffering of the irrelevant argument that NEW YORK is not primarily geographically descriptive of the goods under Trademark Act Section 2(e)(2), due to an asserted meaning of NEW YORK (which is in addition to the geographical meaning) as connoting sophistication and quality, or due to the lack of a goods/place association between New York and herbs and spices.

any particular way," and/or because "[a] seasoning appropriate for a New York steak would also be appropriate for a T-bone steak, a porterhouse, etc." (Reply brief at 7.) We are wholly unpersuaded by these arguments. The fact that there may be no particular or single type of "herbs and spices" which are deemed to be appropriate for seasoning New York steaks, and the fact that any herbs and spices which might be used to season New York steaks could also be used to season different types of steak or cuts of beef, are immaterial.

Rather, the critical point is simply that "herbs and spices," the goods as identified in the application, clearly are or may be used to season New York steaks. Thus, NEW YORK STEAK is more than suggestive; it immediately and directly informs purchasers of a significant purpose or function of applicant's herbs and spices, i.e., that they can be used to season New York steaks. It is well settled that terms that identify the function or purpose of a product or service may be merely descriptive or generic under Section 2(e)(1). See, e.g., *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic for an anti-static cloth used for cleaning computer and television screens); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC found generic for

sprinklers installed primarily in attics); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS is generic for soil and stain removers for use on permanent press products); *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984) (WALLYBALL held descriptive of sports clothing and game equipment); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977) (BURGER held merely descriptive of cooking utensils); and *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jams and jellies). Similarly, because an obvious purpose or function of "herbs and spices" is that they are or may be used to season New York steaks, NEW YORK STEAK is merely descriptive of the goods. The fact that the same herbs and spices may be used to season other types of steaks, or the fact that New York steaks can be seasoned by more than one particular type of herbs and spices, does not detract from the simple fact that a function or purpose of "herbs and spices" is that they may be used to season New York steaks.

For these reasons, we find that NEW YORK STEAK is merely descriptive of applicant's "herbs and spices," and that it therefore is unregistrable on the Principal Register

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pursuant to Trademark Act Section 2(e)(1).

Decision: The refusal to register is affirmed.