

**THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB**

Mailed: February 13, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re J&B Inc.

Application No. 78555821

Robert C. Griffin, Crowley, Haughey, Hanson, Toole & Dietrich, PLLP, for applicant.

Kyle C. Peete, Trademark Examining Attorney, Angela Wilson, Managing Attorney, Law Office 112.

Before Drost, Cataldo, and Mermelstein, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

J&B, Inc. has filed an application to register on the Principal Register the mark CITY BREW (in standard characters) for the following goods and services:

Goods and Services	International Class
Ground and whole bean coffee; coffee, tea, herbal tea, cocoa and espresso beverages, and beverages made with a base of coffee, tea, herbal tea, cocoa and espresso; baked goods, namely biscotti, bread, brownies, cakes, cookies, muffins, pastries, scones, bagels and granola bars; chocolate; candy	30
Coffee kiosk services	35
Coffee house services	43

The examining attorney issued a final refusal to register, based on two grounds: (1) that applicant's mark so resembles the mark CITY BREWS for "restaurant and bar

services"¹ that it would, when used on or in connection with the identified goods and services, be likely to cause confusion, pursuant to Trademark Act § 2(d); 15 U.S.C. § 1052(d); and (2) that applicant failed to comply with the examining attorney's requirement for a disclaimer of the term "brew," apart from the mark as shown, pursuant to Trademark Act § 6, 15 U.S.C. § 1056. The examining attorney contends that "brew" is descriptive of applicant's goods and services.

Applicant timely appealed the refusal to register and both applicant and the examining attorney filed main briefs. March 28, 2007, after briefing, the Board issued an order noting that the cited registration was more than six years old, and that it did not appear that the registrant had filed an affidavit of continued use as required by Trademark Act § 8; 15 U.S.C. § 1058, and that the grace period for doing so had passed. The Board suspended this appeal pending action by the post-registration examiner, and on October 29, 2007, after the registration was cancelled, the Board issued an order resuming proceedings.

Accordingly, the examining attorney's refusal to register because of a likelihood of confusion with the now-cancelled registration is moot, and will be given no further consideration. We therefore focus the remainder of this

¹ Registration No. 2419465, issued January 9, 2001, based on use

decision on the examining attorney's final requirement for a disclaimer of "brew."

Record on Appeal

With his first office action, the examining attorney submitted a dictionary definition reproduced in significant part below:

brew

transitive and intransitive verb

1. make beer: to make beer or similar alcoholic drinks by a process of seeping, boiling, and fermenting grain with hops, sugar, and other ingredients

2. make tea or coffee: to prepare tea or coffee for drinking by infusing it to develop its flavor

noun

1. beer: beer or a type of beer such as lager or ale

2. brewed beverage: a drink such as coffee or tea made by infusion, or a serving of such a drink (*informal*)

<http://encarta.msn.com> (visited August 31, 2005).

Applicant submitted no evidence bearing on the disclaimer requirement.

Applicable Law

"The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Trademark Act § 6(a). A term which is descriptive within the meaning of Trademark Act § 2(e)(1); 15 U.S.C.

in commerce. Cancelled, October 13, 2007 (Trademark Act § 8).

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§ 1052(e)(1) is unregistrable, and must therefore be disclaimed if so required by the examining attorney.

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass'n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Discussion

As noted, the examining attorney submitted a dictionary definition of the term "brew," indicating the significance of the term respect to coffee. In its brief, applicant repeated verbatim its response to the first office action with respect to the disclaimer requirement:

The plural term "BREWS," when viewed by a typical consumer, immediately will be perceived as referring to beer. Nevertheless, the U.S. Patent and Trademark Office did not find the use of this term so descriptive as to require Interstate Hotels to disclaim the term "BREWS" in its mark CITY BREWS.^[2]

If there was no need to disclaim the term "BREWS" in Interstate Hotels' mark CITY BREWS, there is even less need to disclaim the term "BREW" in the Applicant's mark CITY BREW. Unlike the plural "BREWS," the singular "BREW" is subject to a number of different interpretations. It might refer to beer, beer-making supplies, coffee, tea, other soft drinks, medicinal preparations, or even computer software. As the result of this ambiguity, the term "BREW" is suggestive rather than descriptive when it appears in the mark CITY BREW. See *Public Service Co. of New Mexico v. Nexus Energy Software, Inc.*, 36 F. Supp. 2d 436, 438-39 (D. Mass. 1999) (Finding that the mark ENERGY PLACE for the Internet website providing information about energy was suggestive rather than descriptive, since it was susceptible to several different interpretations). Therefore the Applicant should not be required to disclaim the term "BREW."

Applicant's Brief at 16. As noted, applicant submitted no evidence on the disclaimer issue, instead (1) relying on the cited registration (and its lack of a disclaimer); and (2) arguing that the definition proffered by the examining attorney was "ambiguous."

As to applicant's first point, although the cancelled '465 Registration remains part of the record, each case must be decided on its merits and, thus, the cancelled registration is not probative of whether a disclaimer is

² Applicant is apparently referring here to the registration which was cited as a bar to registration under Trademark Act § 2(d). As noted above, that registration was for the mark CITY BREWS for "restaurant and bar services." The registration did not include a disclaimer.

appropriate in this case. Further, the Board is not bound by the actions of an examining attorney. See, e.g., *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits... the PTO's allowance of ... prior registrations do not bind the Board or this court." (citation omitted)); *In re Wilson*, 57 USPQ2d 1863, 1871 (TTAB 2001).

We are likewise unconvinced by applicant's second argument - that "brew" is ambiguous because it could refer to more than one thing. As a glance at most any dictionary will confirm, many words in the English language have more than one sense or meaning. But the test of descriptiveness under the Trademark Act is not whether one could determine some characteristic of the goods or services from viewing a term in the abstract; rather, the question is whether, in the context of the identified goods or services, the term conveys information about those goods or services. The mere fact that a term has a different meaning in a different context is not relevant.

Applicant's goods include "coffee, tea, herbal tea, ... espresso beverages, and beverages made with a base of coffee, tea, herbal tea, ... and espresso" and its goods consist of "coffee kiosk services" and "coffee house services." Obviously, such goods include coffee, tea and coffee- and tea-related services. Thus, although "brew"

might refer to beer³ in another context, it is clear that when seen in the context of applicant's services, it does not.

The evidence of record plainly defines "brew" in this context as referring either to coffee or tea or to the preparation of such beverages.⁴ We have no doubt that potential purchasers of applicant's goods and services would immediately recognize the term as describing a feature of applicant's goods and services, namely the sale of brewed coffee and tea beverages and the associated services of providing these beverages through a "coffee kiosk" or a "coffee house." A disclaimer of the term "brew" is therefore appropriate.

Decision: The refusal to register the mark CITY BREW based on applicant's refusal to disclaim the exclusive right to use "brew" apart from the mark as a whole is affirmed. However, if applicant submits the required disclaimer of "brew" to the Board within thirty days of the mailing date of this decision, this decision will be set aside.⁵ See Trademark Rule 2.142(g).

³ Applicant's statement that "brew" could also refer to computer software is not supported by any record evidence.

⁴ Although the first sense is listed as "informal," there is no indication that purchasers of applicant's goods and services would not immediately understand "brew" in this context to refer to the identified beverages or the services of providing them, or that the relevant consumers would expect more formal language in this context.

⁵ The standard printing format for the required disclaimer text in this application is as follows: "No claim is made to the

exclusive right to use 'brew' apart from the mark as shown." TMEP § 1213.08(a)(i) (5th ed. 2007).