

**THIS DECISION IS
NOT A PRECEDENT
OF THE T.T.A.B.**

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Firehouse Restaurant Group, Inc.

Serial Nos. 78714565 and 78714600

Richard S. Vermut and Stephen E. Kelly of Rogers Towers,
P.A. for Firehouse Restaurant Group, Inc.

Jason Paul Blair, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Quinn, Zervas and Bergsman, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

On September 16, 2005, Firehouse Restaurant Group,
Inc. ("applicant") filed two applications to register
FOUNDED BY FIREMEN (in standard character form) on the
Principal Register. The first application (Serial
No. 78714565) is for "restaurant franchising" in
International Class 35, and the second application (Serial
No. 78714600) is for "restaurant services" in International
Class 43. On September 25, 2007, the examining attorney

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approved applicant's amendments to allege use, filed on April 5, 2007.

The examining attorney has issued a final refusal in each application under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, if applied to applicant's services, would be merely descriptive of its services.

Applicant has appealed the final refusals. In an order dated June 27, 2007, the Board consolidated both applications for briefing of the appeal. We affirm the refusal in each application.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). See also *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). To be merely descriptive, a term need only describe a single significant quality or property of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Also, "[t]he perception of the relevant purchasing public sets the standard for determining descriptiveness. Thus, a mark is merely descriptive if the ultimate consumers

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immediately associate it with a quality or characteristic of the product or service. On the other hand, if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive." *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (citations and internal quotation marks omitted).

In support of his refusals, the examining attorney has submitted with his first Office action a webpage from applicant's www.firehousesubs.com website which states:

In 1994, Firehouse Subs was founded by brothers Robin and Chris Sorensen, members of the Jacksonville, Florida fire department. As the frequent cooks for their stationhouse, they quickly gained a reputation for fighting hunger with the same success (and passion!) that they fought fires. After countless compliments, the brothers decided to take their culinary talents to a larger audience.

They spoke with financial advisors, friends, and family members. Finally, they scraped together enough money to open their first restaurant. Word spread like - well, wildfire - and soon people were lined up out the door to try this little shop with the smoking good food.

According to the examining attorney, the mark "immediately conveys to consumers an attribute of applicant's services, namely that the services were founded by firemen." Brief at (unnumbered) p. 3.

Applicant maintains that "Applicant's Mark is not merely descriptive of Applicant's Services because it conveys information about Applicant's corporate origins only, and not about characteristics or qualities of" restaurant franchising or restaurant services. Brief at p. 6. While applicant acknowledges that the "general rule in trademark law is that a term describing the provider of goods or services may be deemed descriptive of the underlying goods or services," citing to cases such as *In re Major League Umpires*, 60 USPQ2d 1059 (TTAB 2001), *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984) and *In re The Phone Co.*, 218 USPQ 1027 (TTAB 1983), applicant argues that "the Board has limited application of the general rule to instances where the mark causes the consumers to understand some mental link between the provider and the underlying goods and services." Reply at p. 4. In sum, applicant states that that "the information conveyed about applicant's corporate origins is not the type of information that trademark law designates as descriptive of the underlying goods or services." Brief at pp. 7 - 8.

The problem with applicant's argument is that Section 2(e)(1) is not limited to a "type of information." Professor McCarthy has noted:

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A "descriptive" term is one that directly and immediately conveys some knowledge of the characteristics of a product or service.

A mark is "descriptive" if it is descriptive of ... the provider of the goods or services.

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:16 (4th ed. June 2006). Also, the Board recognized in *Major League Umpires*, 60 USPQ2d at 160, that "[i]t is well-established that a term which describes the provider of goods or services is also merely descriptive of those goods and services." There, the Board found the mark MAJOR LEAGUE UMPIRE for various clothing items and athletic goods to be merely descriptive in view of evidence showing that the officers and partners of the applicant were employed as major league baseball umpires, applicant advertised and its website stated that it is owned and operated by three National League umpires, and applicant listed the biographies of these men prominently on the website, including that they were major league umpires. The Board concluded that "there can be no question that MAJOR LEAGUE UMPIRE describes the provider of the identified goods." Similarly, in this case, FOUNDED BY FIREMEN describes the provider of applicant's services, i.e., that applicant was founded by firemen. Also, even if these cases require that "consumers understand some mental

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link between the provider and the underlying goods and services," as applicant maintains, the term "founded" in the mark immediately creates a mental link between applicant as the provider and the services; it directly connects applicant to the services.

The Board's holdings in *The Phone Co., E.I. Kane, Inc.* and *Major League Umpires* do not require reversal of the refusals. None of these cases require that the provider of the goods or services be identified or named - they all state that a mark is merely descriptive if it describes the provider of the underlying goods or services. Here, FOUNDED BY FIREMEN describes applicant which is the provider of the identified services.

Applicant has also argued that "granting exclusive rights in the mark will not inhibit competitors from describing their competing restaurant services," noting that "the Examining Attorney provides no evidence of how the Mark FOUNDED BY FIREMEN is commonly used by" restaurant franchise and restaurant service companies. Briefs at p. 8. Registration of applicant's mark would of course inhibit competitors from using the phrase "founded by firemen" in describing those restaurants and restaurant franchises which were actually founded by firemen. Also, the examining attorney need not show how "founded by

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firemen" is commonly used by restaurant services companies. A word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is the first to use a descriptive term in connection with its goods, does not imbue the term with source-identifying significance. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983) (the fact that the applicant may be the first to use a merely descriptive designation does not "justify registration if the term projects only merely descriptive significance.").

Thus, after carefully considering all of the arguments of applicant and the examining attorney, as well as the evidence of record, we find that applicant's mark immediately describes, without imagination, thought or perception, a characteristic of such services, namely, that such restaurants and franchises were established or set up by firemen. See definition of "founded" from the online version of *The American Heritage Dictionary of the English Language*, 4th ed. (2000) at dictionary.com, submitted with the final Office action, i.e., "to establish or set up, especially with provision for continuing existence." FOUNDED BY FIREMEN, when used in connection with "restaurant franchises" and "restaurant services," is hence

merely descriptive of a characteristic of applicant's services.

Decision: The refusal to register is affirmed in both applications.¹

¹ Applicant has requested in its amendments to allege use that its applications be amended to seek registration on the Supplemental Register in the event that the Board affirms the examining attorney's Section 2(e)(1) refusals. Applicant's request is denied; applicant has elected a course of action and has had an adjudication of its applications. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 n.2 (TTAB 2002).