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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 Scripps Networks, Inc.

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Serial No. 77418854

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Brian J. Downey and Samantha M. Quimby of Frost Brown Todd LLC for Scripps Networks, Inc.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

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Before Seeherman, Holtzman and Zervas, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Scripps Networks, Inc. has appealed from the final refusal of the trademark examining attorney to register CLUB DANCE, in standard character format, as a mark for restaurant and bar services. The application, Serial No. 77418854, was filed March 11, 2008, based on Section 1(b) of the Trademark Act (intent-to-use). Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's

mark is merely descriptive of its applied-for services. Specifically, it is the examining attorney's position that applicant's mark consists of descriptive terms that, when combined as CLUB DANCE, identify a feature, purpose or nature of applicant's services, namely, a club or venue where patrons can dance.

Before reaching the substantive issue before us, there is a procedural point that we must address. In its response to the first Office action, applicant referred to four third-party registrations, "included as Exhibit A." No registrations were submitted with applicant's response, and the examining attorney pointed this out in the next Office action, also advising applicant that the submission of only a list of registrations is not sufficient to make the registrations of record. Applicant did not submit copies of the registrations with the request for reconsideration it subsequently filed. However, as noted by applicant in its response, two of the registrations, Nos. 3284535 and 3292116, had previously been made of record by the examining attorney. Therefore, we have considered these registrations, but have not considered Registrations Nos. 3200789 and 3289302.

Section 2(e)(1) of the Trademark Act prohibits the registration of a mark that is merely descriptive of the

identified goods or services. However, a term that is suggestive is registrable. A term is deemed to be merely descriptive of goods or services if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

In support of the refusal the examining attorney has made of record third-party registrations for marks containing the word CLUB or the word DANCE in which that word was disclaimed, or the mark was registered on the Principal Register upon a showing of acquired distinctiveness. These registrations include CLUB SEVILLA for restaurant services, in which CLUB has been disclaimed; SAILFISH CLUB for restaurant and bar services, in which CLUB has been disclaimed; CLUB NO MINORS for restaurant and bar services, in which CLUB has been disclaimed and the mark as a whole registered pursuant to Section 2(f); and GOLD DIGGERS (stylized) with the single words DRINK DANCE DOWNTOWN appearing on separate circles for restaurant, bar and cocktail lounge services, in which DRINK and DANCE have

been disclaimed.[1] The examining attorney has also submitted dictionary definitions of the word "dance," and evidence of businesses that offer restaurant services and dancing.

Applicant has explained that it will provide traditional restaurant and bar services, and that "the restaurant and bar services are inspired by the theme of the television program CLUB DANCE for which applicant has other applications (former registration 1,882,585 and current ITU applications 78/436794 and 78/867945)." Response filed December 23, 2008. Applicant has argued that its customers will be familiar with applicant's television program and the mark will tie the restaurant in with the television program. Brief, p. 3. However, such an argument is not applicable to the present situation because applicant has not applied to register its mark pursuant to the provisions of Section 2(f) of the Act. See In re Nielsen Business Media Inc., 93 USPQ2d 1545, 1547 (TTAB 2010) (an intent-to-use applicant that has used the same mark on related goods or services may file a claim of acquired distinctiveness under Section 2(f) if the applicant can establish that, as a result of the

[1] We have listed only those registrations which do not include other services such as night club services or hotel services, since a disclaimer for CLUB or DANCE in connection with such registrations could reflect the descriptiveness of the term for non-restaurant services.

applicant's use of the mark on other goods or services, the mark has become distinctive of the goods or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and services in the intent-to-use application when use in commerce begins). Therefore, we cannot consider whether, because of any consumer perception of CLUB DANCE as a source-identifier for a television program, CLUB DANCE has acquired distinctiveness as a trademark for restaurant and bar services.[2]

As we have often said, there is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. See In re Recovery, Inc., 196 USPQ 830 (TTAB 1977). Here, we find CLUB DANCE to fall on the suggestiveness side of that line. First, we agree with applicant that restaurants do not usually offer a place to dance. Although nightclubs generally include bar services, and often offer food as well, they are not the

[2] We do not suggest that CLUB DANCE is distinctive or acts as a source-identifier for a television program, or that any distinctiveness that the mark may have for a television program would transfer to restaurant and bar services. Webpages that have been made of record indicate that applicant's television program was last broadcast in 1999.

same as restaurants. Therefore, the evidence that the examining attorney has submitted of establishments that provide dancing and food do not persuade us that "dance" describes a characteristic of restaurant and bar services, as opposed to nightclub services.[3] Moreover, the mark itself, CLUB DANCE, has an unusual syntax, since the familiar term is "dance club." These two points--the fact that restaurants do not usually feature dancing and the reversal of the order of the words in the mark from the normal term--are sufficient to create a mental pause or hiccup for those viewing the mark. As a result, we find that CLUB DANCE is suggestive for restaurant and bar services.

Finally, to the extent that there is any doubt on this issue, such doubt must be resolved in favor of applicant. In re Intelligent Medical Systems Inc., 5 USPQ2d 1674, 1676 (TTAB 1987) {"where reasonable men may differ, it is the

[3] For example, Latin Palace Restaurant and Private Club, listed in AOL cityguide for Baltimore, is described as a nightclub, as is Chapter 8 Steak House & Dance Lounge, www.opentable.com and Diva Lounge, http://divalounge.com (Lounge/Dance & Supper Club). With respect to the other webpages, the listing for "Bull Run Restaurant", www.socialweb.net states that Bull Run is a place for "wonderful concerts or entertainment events." The webpages regarding Food Dance Café, www. Greaterguide.com, on the other hand, indicate this business is a restaurant, but there is nothing to show that it has any dancing; rather, FOOD DANCE is literally the name of the restaurant, and "dance" has a suggestive meaning in connection with the food itself.

Board's practice to resolve the doubt in applicant's favor and publish the mark for opposition").

Decision: The refusal of registration is reversed.