This Opinion is Not a Precedent of the TTAB

Mailed: July 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Tasty Fish Co., LLC

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Serial No. 85740939

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Matthew H. Swyers,
for Tasty Fish Co., LLC.

Anthony M. Rinker, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Wellington, Lykos and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Tasty Fish Co., LLC ("Applicant") seeks registration on the Principal Register of the mark TASTY FISH CO. (in standard characters) for "seafood" in International Class 29.[1]

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the

[1] Application Serial No. 85740939 was filed on September 28, 2012, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

ground that Applicant's mark is merely descriptive.[2] After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.,* 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Chamber of Commerce of the U.S.,* 102 USPQ2d at 1219 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). The burden is on the United States Patent and Trademark Office to make a prima facie showing that the mark in question is merely descriptive. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1090

[2] "Applicant voluntarily disclaimed the terms FISH CO. apart from the mark as a whole conceding the descriptive and generic nature of these terms as they relate to the Applicant's mark." Appeal Brief, p. 5.

(Fed. Cir. 2005) (citing *In re Abcor Development, supra*); *see also In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987). The Office has met its burden.

The basis for the refusal is the laudatory nature of the mark, to wit,

> [m]arks that are merely laudatory and descriptive of the alleged merit of a product [or service] are . . . regarded as being descriptive" because "[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services]." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, [103 USPQ2d at 1759] (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); see *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK merely laudatory and descriptive of applicant's bicycle racks being of superior quality); *In re The Boston Beer Co.*, [ ]53 USPQ2d at 1058-59 (holding THE BEST BEER IN AMERICA merely laudatory and descriptive of applicant's beer and ale being of superior quality); TMEP §1209.03(k). In fact, "puffing, if anything, is more likely to render a mark merely descriptive, not less so." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, [ ] 103 USPQ2d at 1759.

Examining Attorney's Brief, unnumbered pp. 4-5 6 TTABVUE at 5-6. As evidence that the phrase TASTY FISH CO. is merely laudatory and descriptive of Applicant's seafood, the Examining Attorney submitted definitions of "TASTY" and "FISH" from Collins Dictionaries (www.collinsdictionary.com), which are:

- Tasty:

  1. having a pleasant flavor;

  2. (British, informal) attractive: used chiefly by men when talking about women;

  3 (British, informal) skillful or impressive – she was a bit tasty with a cutlass; and

4. (New Zealand) (of cheddar cheese) having a strong flavor.

- Fish:

1. any large group of cold-blooded aquatic vertebrates having jaws, gills, and usually fins and a skin covered in scales: includes sharks and rays (class Chondrichthyes; cartilaginous fishes) and the teleosts, lung fish, etc. (class: bony fishes);

2. any of various similar but jawless vertebrates, such as hagfish and lamprey

3. any of aquatic invertebrates, such as cuttlefish, jellyfish, and crayfish; and

4. the flesh of fish used for food…

Office Action dated February 4, 2013.[3]

He also submitted copies of five third-party registrations from the Trademark Electronic Search System (TESS) for marks consisting of the word "TASTEE" (which is a misspelling and phonetic equivalent of "TASTY") in combination with generic or descriptive terms for food products. Three of the registrations are on the

[3] The definitions from Collins Dictionaries are British English. The words have the same meanings in American English. We take judicial notice of a number of dictionaries that define these terms in American English, i.e. *Merriam-Webster.com,* Merriam-Webster ("tasty"-"having a good flavor …" and "fish"- "the flesh of fish used as food"); Dictionary.com. *Dictionary.com Unabridged*. Random House, Inc. ("tasty"- "good-tasting" and "fish" – "the flesh of fishes used as food"; and The American Heritage® Dictionary of the English Language, Fourth Edition copyright ©2000 by Houghton Mifflin Company. Updated in 2009 ("tasty" – "having a pleasing flavor" and "fish" – "the flesh of such animals [fish] used as food.")

The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Supplemental Register. The other two are on the Principal Register, one with a disclaimer of TASTEE or a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *Id*.

When used in connection with seafood, or food in general, the word "tasty" means "having a pleasant flavor." As such, the Examining Attorney argues that the word "tasty" as used in the mark is self-laudatory. Case law supports this position. *See In re Geo. A. Hormel & Company*, 227 USPQ 813 (TTAB 1985) ("Tasty" describes a characteristic of sausage).

Applicant argued that to be merely descriptive the mark must be "only descriptive." Appeal Brief, p.7, 4 TTABVUE at 9. Applicant's argument is not well-taken. As discussed *supra,* "[w]hether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use; that a term may have other meanings in different contexts is not controlling." *In re Chamber of Commerce of the U.S.,* 102 USPQ2d at 1219.

Applicant also argued that the mark is suggestive rather than descriptive because "the 'mental link' between the mark TASTY FISH CO. and Applicant's goods as recited in the application is neither immediate nor instantaneous." Appeal Brief, p. 11, 4 TTABVUE at 12. This argument is not persuasive. A mark is considered suggestive, "if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the

term indicates ..." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). *See also, In re Shutts*, 217 USPQ 263, 364-65 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). In this case, the mark TASTY FISH CO. immediately conveys to consumers that the goods are tasty (pleasant flavored) fish.

In reaching our conclusion that Applicant's mark is merely descriptive, we have considered Applicant's argument that the "Board has adopted a three-part test to determine whether a mark is descriptive or suggestive: (1) the degree of imagination necessary to understand the product; (2) a competitor's need to use the same terms; and (3) competitors' current use of the same or similar terms." Appeal Brief, p. 12, 4 TTABVUE at 13. Applicant bases this argument on *No Nonsense Fashions Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). However, as discussed in *In re Carlson*:

> these "tests" were set out in an inter partes case in a discussion of whether use of a term by third parties on their packaging detracted from the plaintiff's trademark rights. Thus, to the extent that applicant is suggesting that the Office must prove all three points, Applicant is incorrect. Since this decision issued in 1985, there have been numerous decisions from the Court of Appeals for the Federal Circuit and the Board making clear that the test for descriptiveness is whether a term "immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831, citing *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987).

91 USPQ2d 1198, 1203 (TTAB 2009).

Applicant argues that a degree of imagination is required for a consumer to "get some direct description of the product …" Appeal Brief, p. 12, 4 TTABVUE at 13. In support of its position, Applicant contends that:

> Applicant uses the mark TASTY FISH CO. in connection with, in general, seafood. Applicant's goods are not simply limited to fish, but, as identified in the application, expand out into other seafood products. As such, does a mark that is relegated to fish alone, as a subset of seafood, create an instant association with "tasty" seafood as a whole? Does the term TASTYFISH CO. automatically [mean] seafood that tastes good? The answer is simply no. Because the mark is relegated to FISH even if fish is a subset of seafood TASTY FISH does not instantly conjure up good tasting seafood, in general. Some degree of imagination is required to associate the term TASTY FISH CO. with the Applicant's goods. And even if that imagination is utilized, we are still left wondering what type of goods TASTY FISH CO. provides.

Appeal Brief, pp. 12-13, 4 TTABVUE at 13-14. Applicant's argument is unpersuasive. "[I]t is a well settled legal principle that where a mark may be merely descriptive of one or more items of goods in an application but may be suggestive or even arbitrary as applied to other items, registration is properly refused if the subject matter for registration is descriptive of any of the goods for which registration is sought." *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988). Therefore, since Applicant's mark is merely descriptive of Applicant's fish, it is unnecessary for us to determine whether is it also merely descriptive of Applicant's other seafood.

Further, Applicant introduced a number of third-party registrations to show that the USPTO considers the words "TASTY" and "YUMMY" suggestive rather than descriptive. The Examining Attorney correctly noted that "Applicant's third-party

registrations are easily distinguished from applicant's mark in that none of the third-party marks combine a laudatory term, 'TASTY', as a modifier for a generic term for the food goods, as in applicant's mark." Examiner's Brief, unnumbered pp. 9–10, 6 TTABVUE pp. 10–11. Moreover, this issue was addressed by our primary reviewing court when determining the nature of the term "ULTIMATE" in registered trademarks. The Court stated:

> The record in this case contains many prior registrations of marks including the term ULTIMATE. These prior registrations do not conclusively rebut the Board's finding that ULTIMATE is descriptive in the context of this mark. As discussed above, the term ULTIMATE may tilt toward suggestiveness or descriptiveness depending on context and any other factor affecting public perception. The Board must decide each case on its own merits. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985). Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.

In re Nett Designs Inc., 57 USPQ2d at 1566. As with the *Nett Designs* case, the third-party registrations introduced do not rebut our findings that TASTY is descriptive in the context of this mark.

Finally, Applicant's contention that no competitor has used, or will ever have need to use, the term TASTY FISH CO. is not supported by any evidence. Moreover, it does not affect our decision in this matter as "[i]t is well established that even if an applicant is the only user of a merely descriptive term, this does not justify registration of that term. *In re Carlson*, 91 USPQ2d at 1203; *See also In re BetaBattInc.*, 89 USPQ2d 1152, 1156 (TTAB 2008); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985).

In view of the foregoing, we find that the mark TASTY FISH CO. is merely descriptive when used in connection with "seafood."

Decision: The refusal to register Applicant's mark TASTY FISH CO. is affirmed.