

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alec R. Fernandez

Serial No. 86176743

Frank Herrera of H New Media Law,
for Alec R. Fernandez.

Benji Paradewelai, Trademark Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

Before Kuhlke, Cataldo and Kuczma,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Alec R. Fernandez (“Applicant”) seeks registration on the Principal Register of
the mark:



for: Fast-food restaurant services in International Class 43.¹

The Trademark Examining Attorney refused registration of Applicant's mark on the ground that the wording "GOOD BUN" must be disclaimed because it is laudatorily descriptive, and thus is an unregistrable component of the mark under 15 U.S.C. §§ 1052 (e)(1), 1056(a). Although Applicant initially provided the required disclaimer, it was subsequently withdrawn in a Request for Reconsideration filed with the Notice of Appeal. After the Examining Attorney denied Applicant's second Request for Reconsideration, the appeal was resumed. We affirm the refusal to register.

The sole issue in this appeal is whether the term "GOOD BUN" is descriptive of Applicant's fast-food restaurant services requiring a disclaimer under Sections 2(e)(1) and 6 of the Trademark Act, 15 U.S.C. §§ 1052(e)(1) and 1056(a).

Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and, therefore, are subject to disclaimer if the mark is otherwise registrable. Thus, an examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a). Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007);

¹ Application Serial No. 86176743 was filed on January 27, 2014, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The mark consists of top and bottom hamburger bun with the word "goodbun" between each bun and a head of lettuce on bottom of bun. Color is not claimed as a feature of the mark.

In re National Presto Industries, Inc., 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

Thus, a term must be disclaimed apart from the mark as shown if it is deemed to be merely descriptive of the subject goods or services. A term is deemed to be merely descriptive within the meaning of 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); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

Applicant's mark consists of the term GOODBUN and a hamburger bun design for "fast-food restaurant services." Applicant describes his mark as "consist[ing] of top and bottom hamburger bun with the word 'goodbun' between each bun and a head of lettuce on bottom of bun."

The definition of "bun" is "A small roll, often sweetened or spiced and sometimes containing dried fruit."² The term "good" is defined as "Of high quality," "Having the qualities that are desirable."³ Laudatory terms attribute quality or excellence to goods and/or services and are considered merely descriptive. As such, laudatory terms, phrases and slogans are nondistinctive and unregistrable on the Principal Register without proof of distinctiveness. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK a

² See attachment to May 1, 2014 Office Action regarding definition of "bun" provided by Houghton Mifflin at <https://education.yahoo.com/reference/dictionary/entry/bun> (p. 9).

³ See attachment to May 1, 2014 Office Action regarding definition of "good" provided by Houghton Mifflin at <https://education.yahoo.com/reference/dictionary/entry/good> (p. 10).

laudatory, descriptive phrase that touts the superiority of applicant's bicycle racks); *In re The Place, Inc.*, 76 USPQ2d 1467 (TTAB 2006) (holding THE GREATEST BAR a laudatory, descriptive term for applicant's restaurant and bar since term "greatest" immediately informs prospective purchaser that applicant's establishment is superior in character or quality when compared to other restaurants and bars). In this case, the term GOOD BUN is laudatory as it describes a feature or characteristic of Applicant's services, namely, that the restaurant features bread rolls of high quality.

To further support the descriptiveness of GOOD BUN for Applicant's services, the Examining Attorney submits evidence showing that restaurants are known for serving "good buns."

A good burger needs a **good bun** and Eataly NYC's brioche bun is more than up for the task.

<https://www.facebook.com/EatalyNYC/photos/a.134561659921585.13914.128969973814087/796729637038114>⁴

... In the USA, the hamburger is a creation that embraces American's creativity and desire for flavors. Burgers are made from beef, lamb, chicken, and served on a **good bun**, and dressed with a large variety of condiments, vegetables, and other meats, like bacon.

We at Cheesy Charlie's, enjoy the unlimited possibilities of Burger creativity. We are always listing [*sic*] to our customers and creating new burgers.

<http://www.cheesycharlies.com/CharliesLocationMap.html>⁵

⁴ See attachment to February 26, 2015 Denial of Request for Reconsideration (p. 120).

⁵ See attachment to February 26, 2015 Denial of Request for Reconsideration (p. 122).

Seattle Kitchen host Thierry Rautureau said his French tastes have him calling for a **good bun**.

“To me, a burger should be something with good bread, **good bun**,” said Tautureau. “I like to have something a bit chewy that has been toasted or grilled and have a nice char.”

*<http://mynorthwest.com/869/668576/Seattle-Kitchen-recommends-Best-burgers>*⁶

Best Burger: Trencherman (address and info)

When you’re dealing with juicy, house-ground, farm-raised chuck covered in a liberal layer of Tillamook Cheddar and house-made pickles, and the star of the show is the bun, you know you’re dealing with a damn-**good bun** (which is also made in-house).

*<http://www.thrillist.com/eat/chicago/best-chicago-burgers-by-neighborhood-logansquare-lincoln-park-river-north-restaurants>*⁷

Overall, the Huey Burger had some good flavor. It’s a decent size preformed patty, pressed and delivered daily from Charlie’s Meat Market. I do believe there are somethings Huey’s can do to make their burgers better. One would be to get rid of the sesame bun if its going to toast up like that. A **good bun** can make the burger. A bad one, can kill it. My other suggestion would be to use more seasoning and make sure those patties are juicy and bursting with flavor. A lot of flavor resides in that juice. It’s a shame none was there.

*<http://www.bestmemphisburger.com/2011/12/05/hueys-midtown/>*⁸

But what I really like here are the burgers. The buns [*sic*] seems to be a whole grain bun with oats on the top. Very **good bun** always fresh.

*<http://www.yelp.com/biz/good-stuff-burgers-los-angeles>*⁹

⁶ See attachment to February 26, 2015 Denial of Request for Reconsideration (p. 124).

⁷ See attachment to February 26, 2015 Denial of Request for Reconsideration (pp. 134-135).

⁸ See attachment to February 26, 2015 Denial of Request for Reconsideration (p. 138).

⁹ See attachment to February 26, 2015 Denial of Request for Reconsideration (p. 96).

A **good bun** helps a lot, although I eat most of my burgers without a bun. When I do have a bun it needs to be substantial enough to hold the burger together without being intrusive on the taste of the burger itself. I want to primarily taste the burger, not the bun. Pinegrove Market gets the balance just right.

<http://bestburgerreview.com/tag/jacksonville/>¹⁰

Each juicy patty is made in-house from Painted Hills ground beef (grain-fed and handwooded [sic] in Oregon), and while the origin of the buns is secret, they function exactly like a **good bun** should: as a delicately sweet and spongy edible napkin.

<http://www.thestranger.com/seattle/capitol-hill-burgermadness/Content?oid=1310385010>.¹¹

Additionally, the Examining Attorney submitted copies of numerous third-party registrations for marks containing the term “good” and for marks containing the word “bun,” all for restaurant services.¹² Inasmuch as the wording “good” and “bun” in the registered marks are either disclaimed, registered on the Supplemental Register or under Section 2(f) based on a showing of distinctiveness, they provide further evidence of the descriptiveness of “good” and “bun” for restaurant services. *See Institute National des Appellations D’Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987).

¹⁰ See attachment to February 26, 2015 Denial of Request for Reconsideration (p. 109).

¹¹ See attachment to February 26, 2015 Denial of Request for Reconsideration (p. 117).

¹² See attachments to February 26, 2015 Denial of Request for Reconsideration (pp. 13-66). While one of the registrations has been cancelled and a few others are owned by the same parties, there are numerous remaining supporting registrations.

Without evidentiary support, Applicant argues that the GOODBUN portion of its mark is unitary and is not traditionally dissected in order to require a disclaimer.¹³ However, when an entire unitary phrase or slogan is generic, descriptive or merely informational, it remains unregistrable.

A mark or portion of a mark is considered “unitary” when it creates a commercial impression separate and apart from any unregistrable component. The test for unitariness inquires whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable. *See In re EBS Data Processing*, 212 USPQ 964, 966 (TTAB 1981); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). The inquiry focuses on “how the average purchaser would encounter the mark under normal marketing of such goods and also ... what the reaction of the average purchaser would be to this display of the mark.” *Dena Corp. v. Belvedere International, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (quoting *In re Magic Muffler Service, Inc.*, 184 USPQ 125, 126 (TTAB 1974)). The Court of Appeals for the Federal Circuit has set forth the elements of a unitary mark:

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements.

¹³ Applicant’s Appeal Brf. pp. 1-2 (12 TTABVUE 2-3). Counsel for Applicant notes that Applicant was not represented by counsel when he entered the disclaimer for GOOD BUN on May 13, 2014. This is of no consequence. The USPTO provides an online warning that applicants must comply with all substantive and procedural requirements of the Trademark Act whether or not they are represented by counsel. *See Hurley International LLC v. Volta*, 82 USPQ2d 1339, 1342 (TTAB 2007).

In other words, a unitary mark must create a single and distinct commercial impression.

Dena Corp., 21 USPQ2d at 1052.

If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise, is required. A phrase such as Applicant's mark qualifies as unitary in the trademark sense only if the whole is something more than the sum of its parts. *Dena Corp.*, 21 USPQ2d at 1052 (finding EUROPEAN FORMULA and design for cosmetic products not unitary because the "elements are not so merged together that they cannot be regarded as separate" and the proximity of the words to the design feature "does not endow the whole with a single, integrated, and distinct commercial impression").

When prospective purchasers see Applicant's mark, they would readily understand it to be comprised of the two separate words, "good" and "bun" and the design of a bun and a head of lettuce. Each of the component terms retains its descriptive significance in relation to Applicant's restaurant services, and the combination GOODBUN results in a composite that is itself descriptive. *See In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation, and real estate listing services); *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) ("THEATL is simply a compressed version of the descriptive term THE ATL without a space between the two words. Without the space, THEATL is equivalent in sound, meaning and impression to THE ATL and is equally descriptive of applicant's goods"); *In re Planalytics Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of

providing on-line risk management services in the field of pricing and purchasing decisions for natural gas; the absence of the space does not create a different meaning or perception of the term).

While Applicant initially contends, without evidentiary support, that the wording GOODBUN could also be construed as a surname, Applicant now asserts that GOODBUN is neither merely descriptive nor is it primarily a surname.¹⁴ In any event, to the extent GOODBUN may possess any surname significance, the issue is not before us. With regard to the issue on appeal, descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). Determining the descriptiveness of a mark is done in relation to an applicant's goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831).

As applied to Applicant's services, consumers would view the mark as describing a feature of the restaurant services, *i.e.*, serving buns that taste good. Additionally, the mark, containing a design of a hamburger bun, reinforces the commercial impression of a feature of a restaurant serving, *inter alia*, hamburger buns. Indeed, the description of the mark in the application provided by Applicant, reads "The

¹⁴ See Applicant's Appeal Brief pp. 3-4 (12 TTABVUE 4-5).

mark consists of top and bottom hamburger bun with the word ‘goodbun’ between each bun and a head of lettuce on bottom of bun.”

Lastly, Applicant contends that because there are no other GOODBUN marks in the USPTO records for restaurant services his mark is not laudatory or descriptive.¹⁵ The fact that an applicant may be the first and only user of a merely descriptive or generic designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Thomas Nelson Inc.*, 97 USPQ2d 1712, 1717 (TTAB 2011); *In re Hunter Fan Co.*, 78 USPQ2d 1474, 1476 (TTAB 2006); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983). In light of the foregoing, it is clear that the wording GOODBUN in Applicant’s GOODBUN and Design mark is descriptive of his restaurant services.

Decision: The requirement for a disclaimer of GOOD BUN and the refusal of registration based on Applicant’s failure to submit such disclaimer, are affirmed. However, in the event that Applicant submits the required disclaimer¹⁶ within thirty (30) days from the date of this decision, the refusal to register will be set aside, the disclaimer will be entered, and the application will proceed to publication.

¹⁵ See Applicant’s Appeal Brief p. 4 (12 TTABVUE 5).

¹⁶ The proper format for the disclaimer is: “No claim is made to the exclusive right to use GOOD BUN apart from the mark as shown.”