

ESTTA Tracking number: **ESTTA772131**

Filing date: **09/21/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86306250
Applicant	Business Building Solutions, LLC
Applied for Mark	THE BREAKFAST SHOPPE
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Submission	Appeal Brief
Attachments	Brief of Applicant 092116.pdf(3603759 bytes)
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Date	09/21/2016

**EX PARTE APPEAL FROM THE TRADEMARK EXAMINING ATTORNEY
TO THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Application of:

Business Building Solutions, LLC

Serial No. 86306250

Filed 6/11/2014

Mark: THE BREAKFAST SHOPPE

APPLICANT'S BRIEF ON APPEAL

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INTRODUCTION

Business Building Solutions, LLC (“Applicant”) appeals the Trademark Examining Attorney’s final refusal to register THE BREAKFAST SHOPPE (the “Mark”) on the basis that the Mark is generic for catering services and, alternatively, on the basis that the Mark is merely descriptive of catering services and that Applicant’s evidence of acquired distinctiveness was insufficient.

Applicant respectfully submits that THE BREAKFAST SHOPPE is not generic or even descriptive of catering services. Applicant requests that the Board reverse the Trademark Examining Attorney’s Section 2(e)(1) refusal and remand the Application to the Trademark Examining Attorney with instructions to allow the Application and pass the mark to publication.

DESCRIPTION OF RECORD

1. Applicant originally filed its application on June 11, 2014 with respect to both restaurant and catering services (“restaurant and café services” and “restaurant and catering services”).

2. The first Office Action generated by the Trademark Examining Attorney on September 22, 2014 asserted that the Mark was merely descriptive of Applicant’s services and recommended filing an Application for registration on the Supplemental Register and disclaiming the term “Shoppe”.

3. Applicant responded on November 14, 2014 by disclaiming the term “Shoppe” and by amending its application to one seeking registration under Section 2(f) and asserting that the Mark had become distinctive of the goods and services through the Applicant’s substantially exclusive and continuous use in commerce for at least the preceding five years.

4. Another Office Action issued on December 5, 2014, asserting that the claim of acquired distinctiveness based on five years’ use in commerce was insufficient due to the highly descriptive nature of the Mark.

5. Applicant responded on April 16, 2015 by submitting a Declaration signed by Jeffrey Edward Fitchett, Managing Member of the Applicant, setting forth that the Mark had been used exclusively and continuously by Applicant for Twenty-Seven years and setting forth the annual sales, marketing initiatives, awards and recognitions related to Applicant’s goods and services provided under the Mark. Applicant also submitted a sample advertisement and a webpage from Restaurant.com offering a coupon for The Breakfast Shoppe and indicating its five star reviews.

6. The next Office Action dated May 12, 2015 indicated that the application was refused because the Mark was generic and, in the alternative, that the Mark was merely descriptive and Applicant’s evidence of acquired distinctiveness was insufficient.

7. Applicant responded on October 26, 2015 by amending its goods and services description to “catering services” only, and by submitting numerous third party registrations in support of Applicant’s arguments in favor of registration.

8. The refusal was maintained by Office Action dated December 11, 2015 on the same bases as the prior Office Action. The Trademark Examining Attorney determined that the applicant’s restaurant services could not be separated from its catering services.

9. A Request for Reconsideration, along with the Notice of Appeal, was filed on June 10, 2016 in which Applicant submitted another Declaration by Mr. Fitchett, as well as additional third party registrations in support of Applicant’s registration.

10. The Request was denied on July 25, 2016 on the basis that the Request raised no new issues, nor did it resolve any outstanding issues, and because the analysis and arguments were not considered persuasive.

STATEMENT OF ISSUES

1. Whether the Mark, THE BREAKFAST SHOPPE is generic for catering services;
2. If the Mark is not generic, but alternatively descriptive of catering services, whether the evidence submitted by Applicant was sufficient to show acquired distinctiveness.

ARGUMENT

I. Genericness Issue

A. THE BREAKFAST SHOPPE is not generic for catering services.

In *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ 2d 1141 (Fed. Cir. 1997), the court held that the burden of establishing whether an applicant’s mark is generic for the services identified rests with the Examining Attorney. The Examining Attorney has a duty to make a “substantial showing...that the matter is in fact generic” and the substantial showing “must be based on clear evidence of generic use.” *Id.* at 1571, 4 USPQ2d at 1143. “A strong showing is required when the office seeks to establish that a term is generic, not descriptive, for the specific goods or services to which the applicant has attached it.” *In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 393, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Moreover, doubt on the issue of genericness must be resolved in favor of the applicant. *In re Waverly, Inc.*, 27 USPQ2d 1620 (TTAB 1993).

“A generic term cannot function as an indicator of the source of a product...because the relevant public understands the term primarily as the common name for the product,” *In re Steelbuilding.com*, 415 F.3d 1293, 1296, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005), *citing In re Dial-A-Mattress*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001).

In *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986), the court outlined a two part inquiry for determining whether a mark is generic:

1. What is the genus of goods or services at issue?
2. Is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

As to the first part of the test, according to *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005), the genus of the services at issue is determined by focusing on the recital of services in the application itself. See also, *Magic Wand Inc. v. RDB Inc.* 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991).

Thus, in this case, the genus is catering services as set forth in the application.

As to the second part of the test, the term “the breakfast shoppe” is not understood or used by the relevant public to refer to, or as a common name for, catering services.

Once the identification of goods and services was narrowed to catering services, the Trademark Examining Attorney only maintained the generic finding by failing to remove Applicant’s restaurant services from her analysis and by concluding, in her denial of the Request for Reconsideration, that breakfast foods are sometimes provided via catering services and concluding that the consuming public would understand “breakfast shoppe” to describe a type of catering that is provided in connection with a breakfast shop.

She goes on to say that “[b]ased on the evidence made of record it is *arguable* (emphasis added) that the purchasing or consuming public for applicant’s services will understand that BREAKFAST SHOPPE describes a type of catering that that [sic] is provided in connection with a breakfast shop. The evidence made of record from Google search engine and online dictionaries show that the wording “breakfast shop” in the applied-for mark means a type of restaurant that provides breakfast. Thus, the relevant public would understand this designation to refer primarily to breakfast for consumption on the premises and/or provides breakfast for consumption off premises, specifically catered food and drinks at a party, meeting and the like off the premises.” *Denial of Request for Consideration dated July 25, 2016*. This statement alone indicates that the Trademark Examining Attorney made an enormous leap in guessing as to what the relevant public would understand. Moreover, in her use of the word “arguable” in her statement above, it is clear that genericness was not found based on clear evidence of generic use of the term.

The Examining Attorney cited nothing that actually shows use of the term “the breakfast shop” to substitute for the word “catering.” Without such a showing, she cannot meet her burden of proving that THE BREAKFAST SHOPPE is another name for, and thus is generic for, catering services.

In further support of the contention that THE BREAKFAST SHOPPE is not generic for catering services, the court in *In re American Fertility Society*, 188 F.3d 1341, 1347, 51 USPQ2d

1832, 1836 (Fed. Cir. 1999) held that “the Board cannot simply cite definitions and generic uses of the constituent terms of a mark, or in this case, a phrase within the mark, in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark, or a phrase within the mark, generic.”

For example, in *K-T Zoe Furniture, supra* at 393, 29 USPQ3d at 1788, the court found that, while the terms “sofa” and “chair” may be generic, the phrase “the sofa & chair company” is not, for the common meaning of the phrase does not clearly include the specificity of the applicant’s services, which involved custom upholstery service.

In this case, Applicant’s catering services, as evidenced by the specimen of record, are not limited to breakfast foods, although, even if they were, the Mark would still not be generic per the above-cited case law. Simply pulling the dictionary definition of the word “breakfast” and finding breakfast items on Applicant’s catering menu is not an adequate inquiry.

The term “the breakfast shoppe” does not describe general catering services and certainly is not generic for them. “Descriptive terms describe a thing, while generic terms name the thing.” Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 12.03[1] (3d ed. 1992). Clearly, THE BREAKFAST SHOPPE is not a name for catering services, be it breakfast catering or otherwise.

B. The Examining Attorney erred in refusing to answer the question of registrability based on the identification of goods and services set for the in the application.

"The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed." *In re Cordua Restaurants*, 118 U.S.P.Q. 1632 (Fed. Cir. 2016) citing *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Trademark Examining Attorney concluded that, merely because Applicant’s restaurant and catering services are generated from the same place (The Breakfast Shoppe in Severna Park, Maryland), and because there is only one telephone number to call for either service, the services are “intertwined.”

This analysis was far too broad. Although the Trademark Examining Attorney cited two cases wherein non-claimed goods and services were reviewed and analyzed in determining that a mark was generic, those cases are easily distinguishable from the present one. In both *In re Reed Elseveir Props, Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) and *In re DNI Holdings Ltd., supra*, the applicants’ service was the provision of a website. In both cases, the mark sought to be registered was found generic for significant portions of items on the respective websites. The generic items, although not specifically included in the identification of goods and services, were so inextricably intertwined with the identified goods and services, that they could not be separated out of the analysis.

Where the goods and services are separate and distinct, it is not appropriate to define the genus of Applicant's applied for services by directly incorporating non-claimed services present on its website. "...[A] proper genericness inquiry focuses on the description of services set forth in [the application or] certificate of registration." *In re DNI Holdings, supra*; see also *Magic Wand Inc., v. RD Inc., supra*.

Applicant's restaurant and catering services can, and essentially do, exist independently. Unlike Applicant's restaurant services, its catering services are targeted to corporate customers and the catering menu is separate and distinct from its restaurant menu.

Applicant's customers entering the restaurant are very likely unaware that catering services are available, and its catering customers may never set foot in the restaurant. The restaurant could continue to function in the identical manner should the catering services be eliminated and the catering services could continue should the restaurant cease doing business.

With the two sides of applicant's business being separate and discreet, and clearly not inextricably intertwined, review should have been limited to the services identified in the application alone. While it may be appropriate to examine Applicant's website to fully understand its catering business, it was not appropriate to incorporate non-claimed services into the scope of the application where the services are not inextricably intertwined.

II. Merely Descriptive Issue

Applicant made a Section 2(f) claim of acquired distinctiveness on November 14, 2014 at the recommendation of the Examining Attorney when restaurant services were included as an applicable service. At that time, the only finding by the Trademark Examining Attorney had been that the mark was merely descriptive. Believing that evidence of acquired distinctiveness would be sufficient for registration of the mark, and having no indication that a generic finding would later ensue, applicant made the concession that the mark was descriptive in order to make progress towards registration. Now, with the narrowing of the identification of goods and services to only applicant's catering service, the level of descriptiveness has diminished greatly. As the Trademark Examining Attorney pointed out, the more descriptive the term, the greater the threshold of evidence required to show acquired distinctively. It follows that, with a mark that is minimally descriptive, the level of evidence required is minimal.

The evidence of record sets forth that Applicant has acquired a sufficient level of acquired distinctiveness for its catering services to allow registration. Per the Declaration of Mr. Fitchett, the Mark has been in use exclusively and continuously for twenty-seven years and the business had achieved awards, publicity and notoriety sufficient to establish acquired distinctiveness.

Applicant is seeking registration only for catering, for which the term "The Breakfast Shoppe" is not descriptive. Already of record and summarized below are third party registrations that support a finding that that Applicant's Mark is registrable. As indicated in several of the examples below, far more descriptive terms have registered with only a simple assertion of five years exclusive and continuous use.

Trademark	Registration	Goods/Services	Trademark Act Section 2(e)/2(f) Status
The Medicine Shoppe	2994255	Retail drug prescription services	2(f) claimed after 2(e) raised; Applicant's declaration of more than 5 years of substantially exclusive and continuous use in commerce was sufficient (additional registrations existed)
The Faucet Shoppe	3401911	Retail store services in the field of plumbing parts, fixtures and accessories	2(f) claimed in application; Applicant's declaration of more than 5 years of substantially exclusive and continuous use in commerce was sufficient
The Bulk-Priced Food Shoppe	4591672	Supermarkets	2(f) claimed after 2(e) raised; Applicant's declaration of more than 5 years of substantially exclusive and continuous use in commerce was sufficient
Gym Shop USA	2908425	Retail store services, featuring exercise equipment and machines, namely, rowing machines, weight lifting machines and the like; mail order services featuring exercise equipment and machines, namely, rowing machines, weight lifting machines and the like.	2(f) claimed in application; Applicant's declaration of more than 5 years of substantially exclusive and continuous use in commerce was sufficient (additional registrations existed)
The Airplane Shop	2674186	Wholesale and retail mail order catalog services relating to aviation models and related items	2(f) claimed in application; Applicant's declaration of more than 5 years of substantially exclusive and continuous use in commerce was sufficient (additional registrations existed)
The Body Shop	2256604	Retail store services and mail order catalog services for cosmetics,	No 2(e) raised.

		toiletries, skin care preparations and hair care preparations; et al	
Corner Bakery Café	2597050	Restaurant, catering and bakery services.	2(f) claimed after 2(e) raised; Applicant's declaration of five years' use and other general declarations was sufficient (additional registrations existed)
The Vitamin Shoppe	2481906	Retail store services, mail order catalog services and online retail store services provided via global computer network featuring vitamins, nutritional supplements, books, herbal products, bath and shower products, skin treatment creams and related item (additional registrations existed)	History unavailable on on-line database; 2(f) indicated on Registration Certificate.
The Rose Shoppe	2441923	Retail floral services	History unavailable on on-line database; 2(f) indicated on Registration Certificate.

THE BREAKFAST SHOPPE is very comparable to the above-cited registrations and the fact that these marks registered supports registration of the Mark for both restaurant and catering services.

As is the case with a generic inquiry, doubt on the question as to whether a mark is merely descriptive or only suggestive is to be resolved in favor of the applicant. *In re Merrill Lynch, supra* at 1571, 4 USPQ2d at 1144.

Considering the narrowing of the goods and services description, the descriptive nature of the Mark has significantly diminished if not vanished. Accordingly, Applicant requests respectfully that the previously submitted evidence be accepted as more than adequate proof establishing a sufficient level of acquired distinctiveness to support registration of THE BREAKFAST SHOPPE for catering services on the Principal Register.

CONCLUSION

Based on the above, Applicant's Mark, THE BREAKFAST SHOPPE, is capable of distinguishing Applicant's catering services from those of others. The Trademark Examining Attorney's genericness finding, based on a refusal to look solely at the services identified in the application, was erroneous. Applicant respectfully requests that the generic finding be reversed.

Further, Applicant has submitted two Declarations of Mr. Fitchett, as well as additional evidence which is more than sufficient, especially in light of the cited third party registrations, in proving that THE BREAKFAST SHOPPE has acquired distinctiveness. Again, Applicant respectfully requests that this finding of inadequate evidence of acquired distinctiveness be reversed so that the Mark may proceed to publication.

Dated: September 21, 2016

Respectfully submitted,

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