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Sent: 1/24/2013 6:33:00 PM

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FISH FRY - 10030.028 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77816809

MARK: EST. 1982 LOUISIANA FISH FRY



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Louisiana Fish Fry Products, Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO.:

10030.028

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

Applicant, Louisiana Fish Fry Products, Ltd. (hereinafter "Applicant"), has appealed the Final Refusal to register the applied-for mark EST. 1982 LOUISIANA FISH FRY PRODUCTS BRING THE TASTE OF LOUISIANA HOME! and design. Registration is refused on the Principal Register pursuant to Trademark Act Section 6(a), 15 U.S. C. §1056(a), on the ground that a disclaimer of the wording "FISH FRY PRODUCTS" is required because this term is generic in connection with applicant's goods. In the alternative, the wording "FISH FRY PRODUCTS" is highly descriptive of a key feature or use of Applicant's goods, and Applicant has failed to provide sufficient evidence under Trademark Act Section 2(f), 15 U.S.C. §1052(f), to demonstrate that the term "FISH FRY PRODUCTS" has acquired distinctiveness such that a disclaimer would not be required. It is respectfully requested that this refusal be affirmed.

II. STATEMENT OF FACTS

On August 31, 2009, Applicant filed a use-based application for registration of the composite mark EST. 1982 LOUISIANA FISH FRY PRODUCTS BRING THE TASTE OF LOUISIANA HOME! and design for “Marinade; Sauce mixes, namely, barbecue shrimp sauce mix; Remoulade dressing; Cocktail sauce, Seafood sauce; Tartar sauce; Gumbo filé; and Cayenne pepper” in International Class 30.

On December 14, 2009, the undersigned examining attorney (“Examining Attorney”) required Applicant to enter a disclaimer of the wording “EST. 1982,” “LOUISIANA FISH FRY PRODUCTS” and “the map of Louisiana” pursuant to Trademark Act Section 6(a), 15 U.S.C. §1056(a), on the grounds that the wording “EST. 1982” was purely informational and non-source identifying, and the map of Louisiana and the wording “LOUISIANA FISH FRY PRODUCTS” were geographically descriptive of the origin of applicant’s goods.¹

On February 2, 2010, Applicant responded to the disclaimer requirement by submitting separate §2(f) claims and supporting evidence for (1) “EST. 1982,” “LOUISIANA” and the “map of Louisiana” and (2) “FISH FRY PRODUCTS.”

During the course of the subsequent prosecution of this application, a disclaimer of “EST. 1982” was entered, Applicant’s partial §2(f) claim as to “LOUISIANA” and “the map of LOUISIANA” was accepted, and the requirement for a disclaimer of “FISH FRY PRODUCTS” was made final in an Office action dated June 9, 2011, on the

¹ The Examining Attorney also required an amendment to the description of the mark, an amendment to the identification of goods, and entry of a claim of ownership of prior U.S. Registrations Nos. 2794015, 2827057, 2827571 and others. These requirements were later satisfied by Applicant’s Response of February 2, 2010.

grounds that the wording “FISH FRY PRODUCTS” is generic or, alternatively, that Applicant had failed to show that this wording had acquired distinctiveness.

On December 2, 2011, Applicant submitted a request for reconsideration of the final Office action, and on December 8, 2011, Applicant instituted the present appeal with the Trademark Trial and Appeal Board (“Board”).

On January 11, 2012, after further consideration of the application, the Examining Attorney issued a new non-final Office action (1) withdrawing the finality of the June 9, 2011 Office action, (2) maintaining the requirement for a disclaimer of “FISH FRY PRODUCTS,” (3) withdrawing Applicant’s partial claim of acquired distinctiveness as to “LOUISIANA” and the “map of Louisiana,” (4) requiring a disclaimer of “LOUISIANA FISH FRY PRODUCTS” and the “map of Louisiana,” as primarily geographically descriptive of the origin of Applicant’s goods, and (5) rejecting Applicant’s §2(f) evidence as to the wording “LOUISIANA FISH FRY PRODUCTS.”

On July 11, 2012, Applicant provided additional arguments against the requirement for a disclaimer of “LOUISIANA FISH FRY PRODUCTS,” the “map of Louisiana,” and “FISH FRY PRODUCTS,” and provided additional arguments in support of its partial claims of acquired distinctiveness with respect to “LOUISIANA FISH FRY PRODUCTS” and “FISH FRY PRODUCTS.”

On August 8, 2012, the Examining Attorney issued a Subsequent Final Action, accepting Applicant’s partial claims of acquired distinctiveness with respect to the wording “LOUISIANA FISH FRY PRODUCTS” and the pictorial representation of the map of Louisiana, maintaining the requirement for a disclaimer of “FISH FRY PRODUCTS” as generic, or, alternatively, as highly descriptive of a feature or use of

Applicant's goods and that Applicant had failed to provide sufficient evidence to demonstrate that the designation "FISH FRY PRODUCTS" had acquired distinctiveness such that a disclaimer would not be required. The application was subsequently returned to the Board.

III. ARGUMENT

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements, or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e)(1), the Office can refuse registration of a mark if the mark is merely descriptive or generic of the goods and/or services listed in an application. 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(c) *et seq.* Thus, the Office may require an applicant to disclaim an unregistrable portion of a mark because, when used in connection with the goods and/or services, it is merely descriptive or generic. *See Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Brown-Forman Corp.*, 81 USPQ2d 1284 (TTAB 2006); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983); TMEP §§1213, 1213.03.

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

In this case, Applicant has been required to enter a disclaimer of the term "FISH FRY PRODUCTS" apart from the mark as shown because this term, when used in connection with the goods in the application, is generic and therefore unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Alternatively, the wording "FISH FRY PRODUCTS" is highly descriptive, and Applicant has failed to provide

sufficient evidence of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f), such that a disclaimer would not be required.

A. The term “FISH FRY PRODUCTS” is generic for a key feature or use of Applicant’s goods.

The term “FISH FRY PRODUCTS” in the applied-for mark is generic in connection with the goods at issue; therefore, the Examining Attorney may require Applicant to disclaim this term pursuant to Trademark Act Section 6(a).

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods. TMEP §1209.01(c); *see In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods, and cannot be registered as trademarks; doing so “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c). A two-part test is used to determine whether a designation is generic:

- (1) What is the class or genus of goods at issue?; and
- (2) Does the relevant public understand the designation primarily to refer to that class or genus of goods?

In re 1800Mattress.com IP LLC, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *H. Marvin Ginn Corp., v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i).

1. The class or genus of goods at issue

The genus is often derived from the identification of goods and/or services in the application as the identification accurately reflects an applicant's actual use of the applied-for mark. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437-38 (TTAB 2005) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)). In this case, applicant's goods are identified as "Marinade; Sauce mixes, namely, barbecue shrimp sauce mix; Remoulade dressing; Cocktail sauce, Seafood sauce; Tartar sauce; Gumbo filé; and Cayenne pepper."

Applicant contends, however, that the class or genus of goods is sauces, marinades and spices. Applicant's Appeal Br., at 4-6. The Examining Attorney notes that the term "FISH FRY PRODUCTS" is generic even under Applicant's interpretation of the class or genus of goods. Generally, an applied-for mark may be found generic where the identification is broadly worded and encompasses the narrower category of goods named in the mark. *See, e.g., In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1082 (TTAB 2010) (holding NANDRIVE generic for "electronic integrated circuits" because NAND drives were types of solid state flash drives, a subcategory of applicant's broadly worded "electronic integrated circuits"); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2024-25 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for electric candles, a subcategory of applicant's broadly worded "lighting fixtures"); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1790 (TTAB 2002) (holding BONDS.NET generic for information and electronic commerce services regarding financial products because bonds were a subcategory of applicant's broadly worded "financial products").

Under Applicant's interpretation, the genus "sauces, marinades and spices" is broadly-worded and encompasses the narrower category of sauces, marinades and spices

– which includes the goods listed in Applicant’s identification, namely, “Marinade; Sauce mixes, namely, barbecue shrimp sauce mix; Remoulade dressing; Cocktail sauce, Seafood sauce; Tartar sauce; Gumbo filé; and Cayenne pepper” – for use on or with fish fries/fried fish. Therefore, the genus of goods at issue includes the sub-group of sauces, marinades and spices for use on or with fish fries/fried fish.

2. The relevant public’s understanding of the term “FISH FRY PRODUCTS”

No restrictions have been placed on the consumers to whom Applicant’s sauces, marinades and spices are offered. Therefore, it is presumed that the relevant purchasing public is the general public. This group of consumers would understand “FISH FRY PRODUCTS” primarily to refer to Applicant’s specific types of sauces, marinades and spices, namely, sauces, marinades and spices for use on or with fish fries/fried fish.

In this case, the wording “FISH FRY PRODUCTS” is in the nature of a compound mark in that it is comprised of two or more distinct words. TMEP §1209.01(c)(i). For a mark that is a compound term, the evidence of record must show that each of the constituent words is generic, and that each word retains its generic meaning when combined such that the composite formed is generic and does not create a different, non-generic meaning. *See In re Gould Paper Corp.*, 834 F.2d 1017, 1018-19, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987); *In re Wm. B Coleman Co.*, 93 USPQ2d 2019, 2021 (TTAB 2010); TMEP §1209.01(c)(i).

The term “FISH FRY” in the applied-for mark refers to “[a] cookout or other meal at which fried fish is its main course” or “[a] piece of fried fish,” that is, the name of the food or meal with which Applicant’s goods are used. *See, e.g.:*

- Merriam-Webster Online Dictionary (2010) (defining “fish fry” as “a picnic or supper featuring fried fish” or “fried fish”) (from the 03/19/2010 Office action)²

While Applicant argues that the term “FISH FRY” is not the generic name for sauces, marinades and spices, this argument is unpersuasive. Applicant’s Appeal Br., at 6. A word or term that is the name of a key feature or use of the goods can be generic for those goods and thus incapable of distinguishing source. *See In re Northland Aluminum Prods. Inc.*, 777 F.2d 1556, 1559-60, 227 USPQ 961, 963-64 (Fed. Cir. 1985) (holding BUNDT generic for cake mix); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for automatic sprinklers for fire protection used primarily in attics); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (holding CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (holding PASTEURIZED generic for face cream); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (holding SUDSY generic for ammonia); *In re Eddie Z's Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (holding BLINDSANDDRAPERY.COM generic for online retail store services featuring blinds, draperies and other wall coverings); *In re Candy Bouquet Int’l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (holding CANDY BOUQUET generic for “retail, mail, and computer order services in the field of gift packages of candy”); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (holding ART DECO generic for flatware); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (holding HENNA ‘N’ PLACENTA generic of ingredients for hair conditioner); *A.J. Canfield Co. v. Honickman*, 808 F.2d

² 03/19/2010 Office action, p. 4.

291, 1 USPQ2d 1364 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas); *see* TMEP §§1209.01(c) *et seq.* In this case, “FISH FRY” is generic for a key feature or use of the goods, namely, that they are to be used on or with fish fries or fried fish.

Applicant also contends that “several of the goods at issue would ordinarily not be used on fried fish and that the other goods and services at issue could be used on a wide variety of other food products in addition to fried fish.” Applicant’s Appeal Br., at 7. This argument is also unavailing. Indeed, if a mark is generic for one of the goods listed in the class, it is generic for the entire class. *See, e.g., In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 525, 205 USPQ 505, 507 (C.C.P.A. 1980) (“Registration will be denied if a mark is merely descriptive of *any* of the goods or services for which registration is sought.”) (emphasis added). Consequently, the term “FISH FRY” is generic in connection with Applicant’s sauces, marinades and spices because it is the name of a key feature or use of the goods, namely, that they are to be used on or with fish fries/fried fish.

The word “PRODUCTS” is also generic, or at least non-source-identifying, because it refers to any goods or services produced by a company. *See, e.g.:*

- Encarta World English Dictionary [North American Edition] (2009) (defining “product” as “the goods or services produced by a company”) (from the 03/19/2010 Office action)³

Indeed, the Board has previously found the term “PRODUCTS” to be without source-identifying significance. *See, e.g., In re Northside Imports, Inc.*, 2012 TTAB LEXIS 232, *11 (TTAB 2012) (non-precedential) (stating that “PRODUCTS” “is a general term for any items, and consumers would not ascribe to this word any source-identifying

³ 03/19/2010 Office action, pp. 6-7.

significance”); *In re Williams Products, Inc.*, 2007 TTAB LEXIS 499, *8 (TTAB 2007) (non-precedential).

Here, Applicant has conceded that each of the subject goods is a product. *See* Exhibit C to Response of April 28, 2011, pp. 1-4. Moreover, Applicant repeatedly uses the words “product” and “products” generically to refer to its goods. *See* Response of July 11, 2012, p. 6. Accordingly, the term “PRODUCTS” is generic (or non-source identifying) in connection with Applicant’s goods because it is the generic name of any good sold by a company, including Applicant’s sauces, marinades and spices.

Both “FISH FRY” and “PRODUCTS” in the designation “FISH FRY PRODUCTS” are generic in connection with Applicant’s goods. The designation, as a whole, maintains its generic nature when the words are combined, as the combination of the individual terms lends no additional meaning to “FISH FRY PRODUCTS,” which are any goods, including sauces, marinades and spices, that are used on or with fish fries/fried fish. This conclusion is supported by the evidence of record, which shows that sauces, marinades and spices are commonly used on or with fish fries/fried fish. *See, e.g.:*

- *From the 03/19/2010 Office Action:*
 - Chow, <http://www.chow.com/recipes/10611> (“**Remoulade** is a mayonnaise loaded with flavor. ... Though it is **normally served with fried fish dishes** such as our Cornmeal Fried Catfish, we also like it with boiled shellfish or mixed into a potato salad”)⁴
 - eHow, http://www.ehow.com/how_4447429_dipping-sauce-fish-seafood.html (“This homemade **cocktail sauce goes well with** baked, broiled or **fried fish** or seafood”)⁵

⁴ 03/19/2010 Office action, pp. 24-32.

⁵ *Id.* at pp. 45-47.

- Cooks.com, <http://www.cooks.com/rec/view/0.1845.154190-238199.00.html> (recipe for **Fried Catfish with Cajun Seafood Sauce**)⁶
 - Catfish History-Catfish Recipes, <http://whatscookingamerica.net/Seafood/FriedCatfish.htm> (recipe for **“Deep Fried Catfish”** – “In a pie place [sic], lay fillets and pour milk over the top. In another pie plate, combine cornmeal, salt, pepper, and **cayenne pepper**”)⁷
 - Game and Fish Recipes, <http://www.gameandfishrecipes.com/catfish-fried-recipe.php> (“**Traditional Fried Catfish Recipe**” – “In a bowl combine cornmeal, flour, salt, black pepper and **cayenne pepper**”)⁸
- *From the 10/22/2010 Office Action:*
- Provincetown Seafood Gets Portuguese Touch, THE BOSTON GLOBE, June 4, 2004, at E6 (“This Portuguese version, a specialty at Provincetown’s Clem & Ursie’s, takes the basic idea of **fried fish** and vinegar and transforms it with a garlicky vinegar-based **marinade**”)⁹
 - Short Order by John Broening Desserts light as air, yet sinfully French, THE DENVER POST, May 5, 2010, at D-03 (“I would sit down to a prix-fixe lunch, often a plate of small, very fresh **deep-fried fish** filled with sharp little bones and **served with remoulade** and a garnish of fried parsley...”)¹⁰
 - Solid entertainment; Little Bucharest Bistro pubs a new twist on Old World fare, CHICAGO SUN TIMES, Apr. 23, 2010, at NC16 (“The frites with the fish were quite good, too, but the **roasted red pepper remoulade** and the honey jalapeno slaw were even better, elevating this rather simple **fish fry** to a [sic] another level of deliciousness”)¹¹
 - Fish fry a staple of chef’s formative years, CHICAGO SUN TIMES, Sept. 9, 2009, at S3 (“Lockwood chef Phillip Foss jazzes up his version of a Wisconsin **fish fry** with eggplant relish and **remoulade**”)¹²

⁶ *Id.* at pp. 62-64.

⁷ 03/19/2010 Office action, pp. 83-85.

⁸ *Id.* at pp. 91-92.

⁹ 10/22/2010 Office action, p.7.

¹⁰ *Id.* at p. 8.

¹¹ *Id.* at p. 9.

¹² *Id.* at pp. 10-11.

- Good food, drink, music are on the playlist, THE BOSTON GLOBE, Mar. 5, 2008, at E4 (“The Highland **fish fry** is a piece of moist, perfectly fried catfish **served with** hush puppies and **remoulade**”)¹³
- Voices of the Gulf Biloxi quieted by spill anxiety BILOXI: Fun remains, but crowds few, THE HOUSTON CHRONICLE, Jul. 14, 2010, at 1 (“I ordered the Seafood Platter – **fried fish**, shrimp, oysters and stuffed crab. The waiter asked, “Would you like that with **tartar sauce, cocktail sauce** or BP oil?”)¹⁴
- Legion fish fries are cook’s trademark, ORLANDO SENTINEL, Apr. 12, 2009, at J7 (“A couple of days before the **fish fry**, he prepares his own recipes for coleslaw, **tartar and cocktail sauces**, hush puppies and breading for the fish”)¹⁵
- Bottles make for a saucy affair, THE DETROIT NEWS, Nov. 8, 2007, at 4E (“All of our panelists like to **use cocktail sauce with** shellfish and **fried fish**”)¹⁶
- Fish fries offer a place for gab and grub/Parishioners bond in Lenten tradition, ST. LOUIS POST-DISPATCH, Apr. 2, 2004, at A1 (“But she doesn’t want her **fried fish** to taste greasy. And she likes homemade **cocktail sauce** and anything else that the fish fry volunteer armies don’t pour from cans”)¹⁷
- Dining/Restaurant Review; Offshoot falls short of mark for Cincinnati classic, THE COLUMBUS DISPATCH, Mar. 4, 2010, at O7 (“Several pieces of battered, deep-fried cod (Ted’s **fish fry**, \$17.50) are enhanced by an excellent **tartar sauce** with horseradish overtones”)¹⁸
- Dear Heloise, THE WASHINGTON POST, Dec. 9, 2009, at Style (“We always include slaw and **tartar sauce** at our family **fish fries**”)¹⁹
- *From the 08/08/2012 Subsequent Final Office Action:*
 - New Friday flavors; Where to cast your line for a different bit of fish, MILWAUKEE JOURNAL SENTINEL, Mar. 3, 2000, at 16E (“So generally speaking, our search for **fish fries** with a twist found that

¹³ *Id.* at p. 12.

¹⁴ *Id.* at p. 16.

¹⁵ 10/22/2010 Office action, p. 17.

¹⁶ *Id.* at p. 18.

¹⁷ *Id.* at p. 19.

¹⁸ *Id.* at p. 22.

¹⁹ *Id.* at p. 24.

your fried fish is safe, Milwaukee – though it sometimes gets updated and redefined **with spices and marinades**”)²⁰

- City hosts 65th fish fry at new location, ORANGE COUNTY REGISTER, Jun. 1, 2012, at B (“Del Mar scout volunteer helpers dish out the **tartar sauce for the fish fry dinners** at a previous Fish Fry and Carnival”)²¹
- Find It Recipe, <http://www.finditrecipe.com/cooking-video-tutorials/homemade-fried-catfish-fishfry-recipe/> (**Homemade Fried Catfish-Fish Fry Recipe** – made with **marinade**)²²
- All Over Albany, <http://alloveralbany.com/archive/2011/08/23/fish-fry-at-genes> (“As a primer to those unfamiliar with the form, there are three **fish fry sauces: tartar, cocktail** and chili”)²³
- I Have the Recipe for That, <http://ihavetherecipeforthat.com/2011/07/09/homemade-cocktail-sauce-for-your-fish-fry/> (recipe for “**Homemade Cocktail Sauce for Your Fish Fry**”)²⁴
- Ray’s Butcher Shoppe, <http://www.raysbutchershoppe.com/fishfrys.html> (“**Friday Fish Fry Carryout**” – “All Buckets and Dinners **include tartar or seafood sauce**, coleslaw, rolls, French fries or steak fries, and your choice of one of our homemade soups of the day”)²⁵

Moreover, applicant concedes that at least some, if not most, of the identified goods are used on or with fried fish. *See* Response of September 27, 2010, at p.2 (“At most then, the examiner’s evidence supports a *prima facie* showing that Fish Fry Products is descriptive of some of the goods in the application”); Response of April 28, 2011, at p. 4 (“most of the goods included in the present application, such as cayenne pepper and cocktail sauce, are goods that can and are used with fried fish”); Exhibit C to

²⁰ 08/08/2012 Office action, p. 2.

²¹ *Id.* at p. 8.

²² *Id.* at pp. 53-55.

²³ *Id.* at pp. 58-62.

²⁴ 08/08/2012 Office action, pp. 77-78.

²⁵ *Id.* at pp. 86-87.

Response of April 28, 2011, pp. 29-31 (acknowledging that remoulade dressing, cocktail sauce, seafood sauce, tartar sauce and cayenne pepper are used on or with fried fish).

Accordingly, based on the evidence of record, the relevant purchasing public, when viewing the term “FISH FRY PRODUCTS” in connection with Applicant’s goods, would understand this term primarily to refer to sauces, marinades and spices for use on or with fish fries/fried fish and, thus, that “FISH FRY PRODUCTS” is a generic term in connection with these goods.

3. Evidence of third party or competitor use (or lack thereof) is not controlling on the question of registrability.

Applicant contends that the term “FISH FRY PRODUCTS” is not generic because the Examining Attorney “has presented no evidence that the relevant purchasing public understands the phrase “FISH FRY PRODUCTS” as a whole as the common or class name for sauces, marinades, and spices, as required by *American Fertility*, 188 F.3d at 1347.” Applicant’s Appeal Br., at 6-7. This argument is without merit.

Turning to the relevant evidentiary burden for determining genericness, in *American Fertility*, the Federal Circuit stated that if the PTO can prove “(1) the public understands the individual terms to be generic for a genus of goods and services; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms.” 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999).

Here, the evidence of record demonstrates that “FISH FRY PRODUCTS” is the generic name for sauces, marinades and spices for use on or with fish fries/fried fish and

would be understood by the relevant public primarily to refer to these goods.

Accordingly, Applicant's argument that the Examining Attorney has presented no evidence showing third-party use of "FISH FRY PRODUCTS" as a whole is irrelevant.

Moreover, even if true, evidence of third party use (or lack thereof) is not controlling on the issue of registrability. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines Ltd.*, 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b). The examining attorney must show that the relevant public would understand the term "FISH FRY PRODUCTS," as a whole, to have generic significance; it is not necessary that the relevant public already uses the applied-for mark generically. *Cf. In re Mattress.com IP LLC*, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009) (citation omitted) (discussing genericness of MATTRESS.COM in connection with online retail store services in the field of mattresses, beds and bedding):

The test is not only whether the relevant public would itself use the term to describe the genus, but also whether the relevant public would understand the term to be generic. ... Thus, it is irrelevant whether the relevant public refers to online mattress retailers as "mattress.com." Instead, as the Board properly determined, the correct inquiry is whether the relevant public would understand, when hearing the term "mattress.com," that it refers to online mattress stores.

Thus, the test turns upon the primary significance that the term would have to the relevant public. *See* TMEP §1209.01(c)(i). Here, the evidence shows that "FISH FRY PRODUCTS," as a whole, would be primarily understood by the relevant public to be the class or genus name of Applicant's sauces, marinades and spices for use on or with fish fries/fried fish.

4. Applicant's third-party registrations have little, if any, probative value.

Applicant submitted several third-party registrations in support of its contention that "FISH FRY PRODUCTS" is not the name of the goods and is, therefore, not generic.

Third party registrations, however, are not conclusive on the question of genericness. An applied-for mark that is generic does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a). None of these third-party registrations have any bearing on whether the term “FISH FRY PRODUCTS” is generic in connection with sauces, marinades and spices for use with fish fries/fried fish. Indeed, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int’l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

In any event, a word or term does not need to be the generic name of the goods to be generic. As previously discussed, the Board has long held that terms may be generic even if they serve to identify a key feature or characteristic of the goods. *See, e.g., In re Cent. Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (holding ATTIC generic for sprinklers installed primarily in attics).

Finally, while Applicant asserts that “[w]hatever ‘Fish Fry’ may be for batter mix, that does not make it generic for sauces, marinades and spices,” Applicant’s Appeal Br. at 8-9, Applicant never identifies what distinct commercial impression is created by combining these, at best, highly descriptive terms. Indeed, Applicant has provided no evidence of a non-generic meaning created by the term “FISH FRY PRODUCTS.”

For all of the foregoing reasons, the term “FISH FRY PRODUCTS” is the name of a class or genus of sauces, marinades and spices for use on or with fish fries/fried fish, and the relevant public would primarily understand it as such. Accordingly, because generic terms are unregistrable under Trademark Act Section 2(e)(1), the Examining Attorney may require Applicant to disclaim the term “FISH FRY PRODUCTS” pursuant to Trademark Act Section 6(a).

B. Alternatively, the term “FISH FRY PRODUCTS” is highly descriptive and Applicant has not shown that this term has acquired distinctiveness.

The term “FISH FRY PRODUCTS” is the generic name for sauces, marinades and spices for use on or with fish fries/fried fish. However, if it is determined that the term “FISH FRY PRODUCTS” is not generic, then such term is so highly descriptive of a key feature or use of Applicant’s goods (i.e., sauces, marinades and spices for use on or with fish fries/fried fish) that Applicant’s evidence is insufficient to demonstrate that the term “FISH FRY PRODUCTS” has acquired distinctiveness. *See, e.g., In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727; *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657 (TTAB 1986).

At the outset, the Examining Attorney notes that the issue is not whether the designation “LOUISIANA FISH FRY PRODUCTS,” as a whole, has acquired distinctiveness. That has already been determined. Instead, the issue is whether Applicant has shown that “FISH FRY PRODUCTS” is a “separable element” that creates a “distinct commercial impression apart from the other elements of the mark” as required under Trademark Act Section 2(f), 15 U.S.C. §1052(f).

The burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001,

1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01. The greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. *Yamaha Int'l Corp.*, 840 F.2d at 1008; *In re Merrill Lynch*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

The sufficiency of the evidence offered to prove secondary meaning must be evaluated in light of the nature of the designation. Highly descriptive terms are less likely to be perceived as trademarks, and therefore more substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness.

In this case, in support of its claim of acquired distinctiveness under Section 2(f) in part, Applicant relies on (1) a claim of acquired distinctiveness as to the wording “FISH FRY PRODUCTS” based on five years’ use, (2) a declaration of its president, William Pizzolato, in support of Applicant’s claim of acquired distinctiveness based on five years’ use, as to the wording “FISH FRY PRODUCTS,” (3) a claim of acquired distinctiveness under Section 2(f) in part, based on two prior registrations, U.S. Registration Nos. 2801892 and 2827058, and (4) evidence that the wording “LOUISIANA FISH FRY PRODUCTS” has acquired distinctiveness (including a claim of acquired distinctiveness based on five years’ use, ownership of six prior registrations,²⁶ and a separate declaration of William Pizzolato attesting to Applicant’s long use of this wording, gross sales, advertising expenditures, estimated market share, and two advertising samples).

For the reasons set forth below, this evidence is insufficient to establish acquired distinctiveness as to the designation “FISH FRY PRODUCTS” because Applicant has

²⁶ U.S. Registration Nos. 2794015, 2786198, 2801892, 2827057, 2827058 and 2827571.

not shown that it has used “FISH FRY PRODUCTS” as a separate mark, or that the designation “FISH FRY PRODUCTS” presents a separate and distinct commercial impression apart from the other elements of the mark.

As a preliminary matter, the evidence showing that the wording “LOUISIANA FISH FRY PRODUCTS” has acquired distinctiveness is insufficient as it provides no factual basis to support a determination of acquired distinctiveness as to the term “FISH FRY PRODUCTS” by itself. While Applicant contends that the December 1, 2011 declaration of William Pizzolato alone “should suffice as a basis to allow amendment to §2(f) rather than requiring a disclaimer,” Applicant’s Appeal Br., at 10, this argument is unpersuasive.

As explained in the January 11, 2012 Office action, the present case is similar to the NATIONAL CAR RENTAL case referenced in TMEP §1212.02(f)(ii)(B) where NATIONAL CAR RENTAL is combined with an inherently distinctive design element. That is, if applicant can show acquired distinctiveness in the wording “NATIONAL CAR RENTAL,” then, according to the TMEP, “the proper §2(f) statement is §2(f) in part as to the wording NATIONAL CAR RENTAL with a separate disclaimer of CAR RENTAL.” *Id.* Similarly, in this case, the proper §2(f) statement is §2(f) in part as to the wording “LOUISIANA FISH FRY PRODUCTS” with a separate disclaimer of “FISH FRY PRODUCTS.” The fact that the wording “LOUISIANA FISH FRY PRODUCTS” as a whole may have acquired distinctiveness does not mean that this distinctiveness automatically transfers to the constituent elements of the mark.

Further, as none of Applicant’s prior registrations are solely for the wording “FISH FRY PRODUCTS,” these registrations also cannot form the basis for Applicant’s

claim of acquired distinctiveness as to the term “FISH FRY PRODUCTS” alone. *See* TMEP §1212.04(b) (“[w]hen an applicant is claiming §2(f) in part as to only a portion of its mark, then the prior registered mark must be the legal equivalent of the portion for which applicant is claiming acquired distinctiveness”). Indeed, the record is devoid of any evidence demonstrating that Applicant has used and promoted the term “FISH FRY PRODUCTS,” by itself, as an indicator of source for its goods, or that consumers perceive the term “FISH FRY PRODUCTS” as pointing solely to Applicant.

Applicant’s prior registrations are also insufficient to establish acquired distinctiveness in the term “FISH FRY PRODUCTS” because in all six registrations, at least some, if not all, of the wording “FISH FRY PRODUCTS” has been disclaimed. Without additional evidence, ownership of one or more prior registrations in which the relevant word or term is disclaimed is insufficient to establish a claim of acquired distinctiveness under Trademark Act Section 2(f). *See* 15 U.S.C. §1052(f); *Kellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 n.5 (TTAB 2007); *In re Candy Bouquet Int’l Inc.*, 73 USPQ2d 1883, 1890 (TTAB 2004); *In re Helena Rubinstein, Inc.*, 131 USPQ 152, 153 (TTAB 1961); TMEP §1212.04(a).

Applicant’s allegation and evidence of five years’ use is insufficient to show acquired distinctiveness as to the wording “FISH FRY PRODUCTS” because, as shown by the evidence of record, this wording is at least highly descriptive of Applicant’s goods. *In re Kalmbach Publ’g Co.*, 14 USPQ2d 1490 (TTAB 1989); TMEP §1212.05(a).

In support of its claim of acquired distinctiveness, Applicant also relies on over \$100 million in nationwide sales since 2007, over \$2.4 million in nationwide advertising expenditures since 2009, and a presence in over 40% of the nation’s grocery stores. This

evidence is also insufficient to establish that the term “FISH FRY PRODUCTS” has acquired distinctiveness.

Here, Applicant’s sales and advertising figures were all directed to the promotion of the “LOUISIANA FISH FRY PRODUCTS” mark as a whole – not the term “FISH FRY PRODUCTS” alone. This is confirmed by the declaration of William Pizzolato of December 1, 2011 (attached to Applicant’s Response of December 2, 2011, pp. 20-23), in which Mr. Pizzolato attests that Applicant’s gross sales were all for food products bearing the mark “LOUISIANA FISH FRY PRODUCTS” (Pizzolato Declaration at ¶¶7-10) and Applicant’s advertising expenditures were all directed to the promotion of “LOUISIANA FISH FRY PRODUCTS” (or “LOUISIANA FISH FRY”) as a mark (Pizzolato Decl. at ¶11). Accordingly, Applicant’s sales and advertising figures are of little probative value in demonstrating acquired distinctiveness as to the designation “FISH FRY PRODUCTS” alone. Indeed, while Applicant’s long use of “LOUISIANA FISH FRY PRODUCTS” and its sales and advertising figures and market share estimates all suggest that Applicant has enjoyed significant business success, this evidence does not demonstrate that its customers have come to view the designation “FISH FRY PRODUCTS” as a source-identifying trademark. *See In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312 (TTAB 2011). The issue here is the achievement of distinctiveness, and the evidence of record falls short of establishing this. Notably, for example, the record is devoid of any direct evidence that the relevant classes of purchasers of Applicant’s goods view “FISH FRY PRODUCTS” as a distinctive source identifier therefor.

Thus, even if the designation “FISH FRY PRODUCTS” were found not to be generic, but merely descriptive, given the highly descriptive nature of this wording, Applicant would need to provide more evidence than that which it has submitted in order to find that the designation “FISH FRY PRODUCTS” has become distinctive of Applicant’s goods. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately \$85 million, and annual advertising expenditures in excess of \$10 million, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark). Because Applicant has failed to meet its burden of establishing that the highly descriptive term “FISH FRY PRODUCTS” has acquired distinctiveness, the Examining Attorney may require a disclaimer of this wording pursuant to Trademark Act Section 6(a), 15 U.S.C. §1056(a).

IV. CONCLUSION

The wording “FISH FRY PRODUCTS” is generic because it is the name of a class or genus of the goods listed in the application, namely, sauces, marinades and spices for use on or with fish fries/fried fish, and the relevant public would primarily understand it as such.

In the alternative, the term “FISH FRY PRODUCTS” is highly descriptive of a feature or use of Applicant’s goods, and Applicant has failed to provide sufficient evidence demonstrating that “FISH FRY PRODUCTS” is a “separable element” that creates a “distinct commercial impression apart from the other elements in the mark” under Trademark Act Section 2(f), 15 U.S.C. §1052(f), such that a disclaimer would not

be required. Because Applicant has failed to enter the required disclaimer, the entire mark is refused registration pursuant to Trademark Act Section 6(a), 15 U.S.C. §1056(a).

For all of the foregoing reasons, the Examining Attorney respectfully requests that the refusal of registration under Trademark Act Section 6(a), 15 U.S.C. §1056(a), be affirmed.

Respectfully submitted,

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