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

TTAB

In re Application of: Paradise Inn Hawaii, LLC	)
Application Serial No.: 78696954	)
Application Filing Date: August 20, 2005	)
Mark: SUSHI BURGER	)

NOTICE OF APPEAL, REQUEST FOR SUSPENSION AND REMAND OF THE APPLICATION TO THE EXAMINING ATTORNEY FOR RECONSIDERATION

Applicant, by and through its undersigned attorney, pursuant to Trademark Rule 2.141, hereby appeals to the Trademark Trial and Appeal Board from the Examining Attorney's Final Office Action dated June 29, 2006, refusing registration of the subject service mark.

Pursuant to Trademark Rule 2.142(d), applicant respectfully requests that action on this appeal be suspended, and that the applicant's application be remanded to the Examining Attorney for reconsideration of her FINAL refusal. This Notice of Appeal, Request for Suspension and Remand of the Application to the Examining Attorney is being filed contemporaneously with the applicant's Request for Reconsideration to the Examining Attorney, and within the allowable six (6) months to respond to the Examining Attorney's Final Office Action dated June 29, 2006. Accordingly, these documents are therefore timely.

In the event that the Examining Attorney maintains her FINAL refusal of the application, applicant respectfully requests the Trademark Trial and Appeal Board to proceed with this appeal.

Check no. 7772 made payable to the Commissioner for Trademarks, in the amount of $200, being the *ex-parte* appeals fee for an appeal in two classes, is enclosed herewith. Authorization is hereby

[redacted]

01-04-2007

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

given to charge Applicant's representative's USPTO Deposit Account no. 501198 in the event the amount submitted is insufficient for any reason.

Dated: Honolulu, Hawaii, December 27, 2006.

Respectfully submitted,

By: _____

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CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a).

I hereby certify that the foregoing Notice of Appeal, Request for Suspension and Remand of the Application to the Examining Attorney for Reconsideration, and the fee described therein, is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on December 27, 2006:

_____

Seth M. Reiss

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK EXAMINING OPERATION

In Re Application of: Paradise Inn Hawaii, LLC Serial No.: 78/696954 Filed: August 20, 2005 Mark: SUSHI BURGER	Trademark Law Office: 102 Trademark Attorney: Robin S. Chosid-Brown

TO: Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

REQUEST FOR RECONSIDERATION

Dear Commissioner:

In response to an e-mail communication from the Trademark Examining Attorney dated June 29, 2006, and designated "Final Office Action," Applicant respectfully requests that the Examiner reconsider her position based upon the argument and authority earlier submitted which is repeated, with some modification below:

Remarks

APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE OF THE CLAIMED GOODS AND SERVICES; RATHER, WHEN PROPERLY VIEWED IN ITS ENTIRETY IT IS AN ARBITRARY MARK. THERE IS NO SUCH THING AS A SUSHI BURGER AND EACH INDIVIDUAL'S CONCEPTION OF WHAT SUCH A THING MIGHT BE OR LOOK LIKE WILL NECESSARILY DIFFER.

Applicant's mark SUSHI BERGER must be tested for its validity and distinctiveness by considering it as a whole, rather than dissecting it into its component parts. "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P.D. Beckwith, Inc. vs. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). 2 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:27 (4th ed. 2003).

> When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM held merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet); *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of "facsimile terminals employing electrophoretic displays"); *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be

> merely descriptive of bread containing oats and hazelnuts); *In re Serv-A-Portion Inc.*, 1 USPQ2d 1915 (TTAB 1986) (SQUEEZE N SERV held to be merely descriptive of ketchup and thus subject to disclaimer); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE held to be merely descriptive of banking and trust services); *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (STEELGLAS BELTED RADIAL held merely descriptive of vehicle tires containing steel and glass belts); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of coasters suitable for direct mailing).
>
> However, a mark comprising a combination of merely descriptive components **is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods.** *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

TMEP § 1209.03(d)(emphasis supplied).

"[T]he commercial impression of a composite mark may be arbitrary or suggestive even though its separate parts are descriptive. The composition may be more than the mere sum of its parts: 'The whole, in trademark law, is often greater than the sum of its parts. Common words in which no one may acquire a trademark because they are descriptive or generic may, when used in combination, because a valid trademark.'" 2 McCarthy, *supra* § 11:26, at 11-55 to -56 quoting *Association of Co-operative Members, Inc. vs. Farmland Industries, Inc.*, 684 F.2d 1134 (5th Cir. 1982), *cert. denied*, 460 U.S. 1038 (1983).

So, for example, SUGAR & SPICE as applied to bakery products were held to be non-descriptive, and registerable, notwithstanding that each term alone was descriptive of the goods for which the mark was being claimed. *In re Colonial Stores, Inc.*, 394 F.2d 549 (C.C.P.A. 1968). A similar result was found in the context of the mark MOUSE-SEED for

rodent exterminators and SEASON-ALL for aluminum storm windows. See discussion in 2 J. McCarthy, *supra* § 11:26 and cases cited therein.

The words SUSHI and BURGER, when juxtaposed, evoke an image of some nonsensical food item. Each individual will necessarily imagine something different, which may or may not include a bun, which may have meat and fish on the inside or on the outside or both on the inside or outside, and which may be combined with processed seaweed and rice in any variety of ways. Combining the words SUSHI & BURGER creates a far more arbitrary mark than combining the words SUGAR and SPICE, MOUSE and SEED or SEASON and ALL.

> When there is evidence that the composite mark itself has been used together to form a phrase that is descriptive of the goods or services, it is unnecessary to engage in an analysis of each individual component. *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998) (TARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce and render more efficient wide area network usage).

TMEP § 1209.03(d). The record lacks evidence that the words SUSHI and BURGER have been used together to describe a specific food item, or even a general category of food items, and there is no logical basis to accurately predict what such an item or items might look like were the words to be so used.

> The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

TMEP § 1209.01(b). Because the words SUSHI and BURGER, when combined, form an arbitrary mark, the significance of the mark will necessary differ to each average purchaser. If the significance of the mark is different to each purchaser, then mark cannot be said to be merely descriptive.

> The fact that a term is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show that the term has a well understood and recognized meaning. See *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jellies and jams).

TMEP § 1209.03(b). There are no dictionary definitions for the composite mark SUSHI BURGER and the Examining Attorney has not demonstrated that these terms, combined, evoke any "well understood or recognized meaning."

> Arbitrary and incongruous combinations of English terms with terms from a foreign language have been found registrable. See In re Johanna Farms Inc., 8 USPQ2d 1408 (TTAB 1988) (LA YOGURT for yogurt held registrable on Principal Register, with a disclaimer of "YOGURT"); In re Universal Package Corp., 222 USPQ 344 (TTAB 1984) (LE CASE held not merely descriptive of jewelry boxes and gift boxes and, therefore, registrable with a disclaimer of "CASE").

TMEP § 1209.03(h). Similarly, arbitrary and incongruous combinations of English terms with other English terms are inherently distinctive, and registerable.

The Examiner's offer of dictionary definitions for the individuals terms "Sushi" and "Burger" does not, in Applicant's view, discharge the Examiner's burden in this case because that burden in not in respect to the terms used individually, but with respect to the terms used together to form a unitary mark.

"Because the line between merely descriptive and only suggestive terms is 'so nebulous,' the Trademark Board takes the position that doubt is resolved in favor of the applicant. . . ." 2 J.

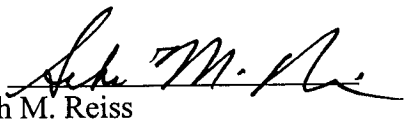
McCarthy, *supra* § 11:51. Here, where the combination of descriptive terms evokes a food item impossible to imagine, Applicant is entitled to having any doubt as to what this food item might be resolved in favor of finding its mark inherently distinctive and registerable on the Principal Register.

Conclusion

Applicant respectfully submits that for the reasons given above, the Examining Attorney should reconsider her FINAL refusal, and allow the applicant's mark to proceed to publication. If, however, the Examining Attorney maintains her refusal, the applicant respectfully requests that the application file be forwarded to the TTAB for further proceedings.

Dated: Honolulu, Hawaii, December 27, 2006.

Respectfully submitted,

By: 

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on December 27, 2006:

Seth M. Reiss