

This Opinion is Not a
Precedent of the TTAB

Hearing: October 19, 2017

Mailed: April 4, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re HRHH IP, LLC
—

Serial Nos. 86525425 and 86525431
—

Jill M. Pietrini, of Sheppard Mullin Richter & Hampton LLP,
for HRHH IP, LLC.

Sani Khouri, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.

—
Before Kuhlke, Heasley, and Coggins,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

HRHH IP, LLC (“Applicant”) seeks registration on the Principal Register of the
mark THE JOINT (in standard characters) for:

Entertainment services, namely, live musical performances, shows, and
concerts; and nightclub services, in International Class 41;¹ and

¹ Application Serial No. 86525425 (for the Class 41 services) was filed on February 5, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as March 10, 1995.

Restaurant, bar and catering services, in International Class 43.²

The Trademark Examining Attorney originally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive of the respectively identified services. When Applicant requested, in the alternative, registration under Section 2(f), 15 U.S.C. § 1052(f), on the ground that the mark had acquired distinctiveness, the Examining Attorney refused registration on the additional ground that the proposed mark is generic and therefore incapable of distinguishing the identified services, or, alternatively, that the mark is merely descriptive and that Applicant had failed to show acquired distinctiveness under Section 2(f).

Applicant maintained that its mark was neither generic nor merely descriptive, and continued to pursue registration under Section 2(f) in the alternative. When the Examining Attorney made each refusal final, Applicant appealed and filed a request for reconsideration for each application. After the Examining Attorney denied the requests for reconsideration, the appeals were resumed, and an oral hearing was held October 19, 2017. We affirm the refusals to register.

I. Appeals Consolidated

These appeals involve common questions of law and fact and the records are substantially similar. The hearing was presided over by this panel and included a discussion of both applications. Accordingly, we consolidate and decide each appeal

² Application Serial No. 86525431 (for the Class 43 services) was also filed on February 5, 2015, under Section 1(a) of the Trademark Act, based upon Applicant's claim of first use anywhere and use in commerce since at least as early as March 10, 1995.

in this single decision.³ See *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TBMP § 1214 (June 2017).

II. Refusal on Ground of Genericness

We first address the Examining Attorney's refusal to register the proposed mark on the ground that it is generic for the identified services. A designation is generic if it refers to the class or category of goods or services on or in connection with which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) ("*Marvin Ginn*"). Generic terms are by definition incapable of indicating a particular source of the services, and cannot be registered as service marks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods [or services] as what they are." *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987) (quoting *CES Publ'g Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 188 USPQ 612, 615 (2d Cir. 1975)).

The test for determining whether a proposed mark is generic is its primary significance to the relevant public. *In re Am. Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991); *Marvin Ginn*, 228 USPQ at 530. Making this determination involves "a two-step inquiry: First, what is the genus of goods or

³ Unless otherwise specified, all TTABVUE and TSDR citations refer to the docket and electronic file database for Application Serial No. 86525425. All citations to the TSDR database are to the downloadable .pdf version of the documents.

services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (citing *Marvin Ginn*, 228 USPQ at 530).

The Examining Attorney has the burden of establishing by clear evidence that a mark is generic. *Merrill Lynch*, 4 USPQ2d at 1143; *Am. Fertility Soc’y*, 51 USPQ2d at 1835. The Examining Attorney must “analyze the term in relation to the services recited in the application, the context in which it is used[,] and the possible significance it would have to the recipient of the services.” *Marvin Ginn*, 228 USPQ at 530. Evidence of the public’s understanding of a term may be obtained from any competent source, including dictionaries, trade journals, newspapers, and other publications. *See Princeton Vanguard*, 114 USPQ2d at 1830 (citing *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)).

A. The genus of Applicant’s services

Because the identification of goods or services in an application defines the scope of rights that will be accorded the owner of any resulting registration under Section 7(b) of the Trademark Act, generally “a proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration.” *Magic Wand*, 19 USPQ2d at 1552 (citing *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). In these consolidated cases, the identifications of services are clear in meaning and are

appropriate expressions of the genus of services at issue.⁴ Accordingly, we proceed to consider whether the term THE JOINT is understood by the relevant public primarily to refer to live musical performances, shows, and concerts, and nightclub services (Application Serial No. 86525425, for the Class 41 services); and restaurant, bar and catering services (Application Serial No. 86525431, for the Class 43 services).

B. Public understanding of THE JOINT

The relevant public for a genericness determination is the purchasing or consuming public for the identified goods or services. *Magic Wand*, 19 USPQ2d at 1553. Because there are no restrictions or limitations to the channels of trade or classes of consumers in Applicant's identifications of services, the relevant consuming public consists of ordinary consumers who attend live musical performances, shows, and concerts; and who use nightclub, restaurant, bar, and catering services.

"An inquiry into the public's understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark." *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005)). Nonetheless, the Federal Circuit has noted that it may be appropriate "as a first step" to analyze the constituent terms

⁴ The Examining Attorney repeatedly stated that the identifications of services adequately define the genera at issue. *See* December 15, 2015 Office Action, TSDR 1; July 11, 2016 Office Action, TSDR 1; and Examining Attorney's brief, 10 TTABVUE 5-6. Applicant did not dispute these characterizations in any of its responses to Office actions or in its appeal or reply briefs.

in the applied-for mark. *Princeton Vanguard*, 114 USPQ2d at 1833. *See also 1800Mattress.com IP*, 92 USPQ2d at 1684 (explaining that the Board appropriately considered the separate meanings of “mattress” and “.com” when determining that the combination “mattress.com” was generic); *In re Hotels.com LP*, 573 F.3d 1300, 1304, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009) (affirming the Board’s finding that “the composite term HOTELS.COM communicates no more than the common meanings of the individual components”).

In undertaking our analysis, we keep in mind that while we look to the primary significance of the mark, we look to the applied-for mark in relation to the identified services, and we note that all possible generic names for a service must remain in the public domain. *See* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:9 (5th ed., Sept. 2017 update) (“There is usually no one, single and exclusive generic name for a product. Any product may have many generic designations. Any one of those is incapable of trademark significance.”).

Applicant and the Examining Attorney submitted the following definitions of the word JOINT:

- An establishment of a specified kind, especially one where people meet for eating, drinking or entertainment: ‘a burger joint;’⁵
- (originally slang) A restaurant, bar, nightclub or similar business;⁶

⁵ May 18, 2015 Office Action at TSDR 4 (from www.oxforddictionaries.com/us/definition/american_english/joint); and July 11, 2016 Final Office Action at TSDR 19 (same).

⁶ Exhibit C to November 23, 2015 Response to Office Action at TSDR 20 (from en.wiktionary.org/wiki/joint).

- *Slang* [a] cheap or disreputable gathering place: ‘The tavern is ... just a joint with Formica tables, a vinyl floor, lights over the mirrors’ (Scott Turow);⁷
- Slang. Establishment: place <We ate at a fancy joint.>;⁸
- bar or nightclub: a place of entertainment, e.g., a nightclub, especially one considered cheap or disreputable (slang);⁹
- prison: a prison or similar penal institution (slang);¹⁰
- *North American* Prison;¹¹
- A prison. Often used with *the*;¹² and
- (slang) (always with ‘the’) prison;¹³

and Applicant submitted the following definition of the term THE JOINT:

- “jail or prison.”¹⁴

⁷ Exhibit B to November 23, 2015 Response to Office Action at TSDR 15 (from www.ahdictionary.com/word/search.html?q=joint).

⁸ Webster’s II New Riverside University Dictionary © 1988, attached to an August 15, 1995 Office Action accompanying January 17, 2017 Request for Reconsideration at TSDR 465.

⁹ January 17, 2017 Request for Reconsideration at TSDR 479 (from encarta.msn.com/encnet/features/dictionary/DictionaryResults...).

¹⁰ *Id.*

¹¹ May 18, 2015 Office Action at TSDR 4 (from www.oxforddictionaries.com/us/definition/american_english/joint).

¹² Exhibit B to November 23, 2015 Response to Office Action at TSDR 15 (from www.ahdictionary.com/word/search.html?q=joint).

¹³ Exhibit C to November 23, 2015 Response to Office Action at TSDR 20 (from en.wiktionary.org/wiki/joint).

¹⁴ Exhibit D to November 23, 2015 Response to Office Action at TSDR 26 (from onlineslangdictionary.com/meaning-definition-of/the-joint).

In addition, the Board takes judicial notice of the following dictionary definitions of the word THE:¹⁵

- definite article – used as a function word to indicate that a following noun or noun equivalent is definite or has been previously specified by context or by circumstance;¹⁶
- def. art. Used before singular or plural nouns and noun phrases that denote particular, specified persons or things. Used before a singular noun indicating that the noun is generic;¹⁷
- definite article (used, especially before a noun, with a specifying or particularizing effect, as opposed to the indefinite or generalizing force of the indefinite article a or an) and (used to mark a noun as being used generically).¹⁸

The Examining Attorney attached to the July 11, 2016 Final Office Action excerpts of several articles taken from the Lexis-Nexis database using the word JOINT in context with entertainment and eating establishments. Many of the excerpts demonstrate use of the term THE JOINT:

“In what other line of work is 20 percent failure considered a success?” asked Ron Fournier of the National Journal. “If one out of every five

¹⁵ Neither Applicant nor the Examining Attorney submitted a definition of THE. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). The Board may notice dictionary definitions *sua sponte*. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹⁶ From www.merriam-webster.com/dictionary/the. Merriam-Webster © 2015. Accessed October 31, 2017.

¹⁷ From www.ahdictionary.com/word/search.html?q=the. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, FIFTH EDITION. Houghton Mifflin Harcourt Publishing Company © 2017. Accessed October 31, 2017.

¹⁸ From <http://www.dictionary.com/browse/the?s=t>. RANDOM HOUSE UNABRIDGED DICTIONARY. Dictionary.com, LLC © 2017. Accessed October 31, 2017.

meals served by a restaurant is inedible, **the joint** goes out of business.”¹⁹

Crazy for ChoLon, the LoDo pan-Asian restaurant? **The joint’s** triumph rests, in part, on the shoulders of its chef, Lon Symensma. Now he and his partners plan to open Gather, a cafe where the emphasis will be on more breakfast sandwiches, lunchtime soups, happy-hour small plates and coffee rather than Singapore-style lobster and roasted venison chops.²⁰

Delta’s, situated in a former firehouse, is not your ordinary soul food restaurant. **The joint** jumps on Thursdays, Fridays and Saturdays, when DJs and jazz and R&B groups turn Delta’s into a happening spot.²¹

The restaurant’s website announces: “(Our snarky bartenders asked us to tell you we don’t take reservations, and due to the presence of video poker machines only those 21 and over are allowed in the restaurant.)” **The joint** is open “11 to closing” and guest reviews rave about the gumbo, the crab claws and the fried chicken.²²

Linda recruits everyone for her murder mystery theater production inside the restaurant, including Mort for some of the special effects (he’s mum on whether the blood and viscera he brings over is real). Later, Gene slides across a blood-puddled restaurant floor, and a robber busts into the restaurant to case **the joint** but ends up tangoing with Linda - who, ever a sucker for the limelight and spontaneous singing, duets with him before he dances his way out of the store with a bag of cash.²³

The joint: Pita Restaurant & Market, 73 Main St., Brockport; (585) 391-3156. Dine in or take out.

The meal: Shawarma combo

The check: \$14.03

The story: First, you’re thinking, “Fourteen bucks ain’t cheap.” In this case, it is. I ate barely half of my shawarma combo, so it made

¹⁹ PITTSBURGH POST-GAZETTE, December 1, 2013; TSDR 5.

²⁰ THE DENVER POST, October 31, 2012; TSDR 6.

²¹ THE STAR-LEDGER (Newark, New Jersey), August 1, 2012; TSDR 6-7.

²² MOUNTAIN DEMOCRAT (Placerville, California), May 27, 2016; TSDR 8.

²³ THE DAILY EMERALD: University of Oregon, May 22, 2016; TSDR 9.

for a large lunch the next day, too. This is two meals, easy - or a meal ...²⁴

William Eggleston, the near-mythic southern gentleman and father of color photography, who is placed in the pantheon of the greats alongside Walker Evans and Robert Frank, greeted me with a courtly little bow at his favorite hangout in New York City, El Quijote restaurant, **the joint** adjoining the Chelsea Hotel.²⁵

If anyone knows how to make vegan desserts not terrible, it should be a vegan restaurant. **The joint** has a half[-]dozen cupcake flavors in rotation every day.²⁶

History San Jose is gearing up for another fundraising celebration of Manny's Cellar on Sept. 18 in the historic downtown Fallon House, which was once home to the restaurant and bar. **The joint** was a haunt for the city's movers and shakers from 1962 until 1990, when owner Manny Pereira closed because of the Fallon House restoration. "Manny's is a special place for so many, and this event provides the opportunity to relive history by reminiscing, swapping stories, and enjoying music and a great meal," said History San Jose CEO Alida Bray. ²⁷

I came back home and wrote one of my first Drive-Thru Gourmet reviews about Lombardi's Coal Oven Pizza in the Houston Chronicle. I went into the history of the restaurant, described **the joint** and raved about the pizza.²⁸

The others demonstrate use of the word JOINT. The following excerpts are representative:

Aina Burger from Ate-Oh-Ate

What are the chances of finding a great burger at an unfussy Hawaiian **joint**? When said restaurant happens to spring from the mind of Laurelhurst Market co-owner Ben Dyer, pretty high.²⁹

²⁴ ROCHESTER DEMOCRAT AND CHRON. (New York), April 14, 2016; TSDR 10.

²⁵ VANITY FAIR, December 2015; TSDR 13.

²⁶ CURRENT (San Antonio), November 11, 2015 - November 17, 2015; TSDR 13.

²⁷ SAN JOSE MERCURY NEWS (California), August 21, 2015; TSDR 15.

²⁸ THE HOUS. CHRON., June 28, 2015; TSDR 15.

²⁹ THE OREGONIAN, September 5, 2014; TSDR 4.

Domino's isn't the first restaurant **joint** to offer incentives for ordering online, either. Competitor Papa John's consistently promotes special offers for digital orders, such as a free giant cookie with any pizza purchase.³⁰

While he wishes he had done some things differently, he has no regrets: "The best thing we can do is remember and learn from them." Walter hopes to pursue a college degree in business and one day open his own music/restaurant **joint**.³¹

I'd pulled the rolling metal gates down over the storefront of Elaine's, the legendary restaurant on the Upper East Side, and just as I was about to put the padlocks on, I realized that I wasn't sure if my boss, Elaine Kaufman, had left or not. She had. But in that moment, at 4 a.m. on the sidewalk, it occurred to me that Elaine might have been perfectly happy spending the night locked in her restaurant. Her relationship with her **joint**, as she called it, was co-dependent. She didn't want to be anywhere else, and the place couldn't exist without her.³²

It is well known that the location of Bar-Eat-O was formerly Vital Spot sports bar, which was most notably a late night and weekend hangout **joint**.³³

During prosecution of the applications, Applicant argued that "the critical difference between [dictionary] definitions [of JOINT] and Applicant's mark THE JOINT is the addition of the word THE before JOINT. The term THE JOINT is American slang for 'prison' or 'jail.'"³⁴ Applicant claimed that "[t]he addition of the word THE before JOINT transforms the meaning of Applicant's mark into a recognized phrase in the American vernacular" such that the "composite mark THE JOINT, as opposed to just JOINT, transforms the public's potential perception of the

³⁰ THE SAN DIEGO UNION-TRIB., July 17, 2014; TSDR 4.

³¹ THE PHILA. INQUIRER, May 21, 2013; TSDR 6.

³² THE N.Y. TIMES, May 26, 2011; TSDR 7.

³³ THE LAMRON: *SUNY at Geneseo*, February 7, 2016; TSDR 11.

³⁴ June 15, 2016 Response to Office Action, TSDR 4.

mark”³⁵

We are not convinced of this transformation. Two of the dictionary definitions of “joint” meaning “prison” are listed without any indication that “joint” must be preceded by the word “the.”³⁶ Another definition of “joint” meaning “prison” is listed with an indication that “joint” is merely “often used with *the*.”³⁷ Just one definition of “joint” meaning “prison” indicates that it is “always used with ‘the,’”³⁸ and there is but one corroborating definition of “the joint” provided by Applicant indicating that “joint, the” means “jail or prison.”³⁹ Applicant’s transformation argument is even less convincing when the term THE JOINT is considered in relation to the identified services (which do not include prison or jail services).

Applicant also argues that the Lexis-Nexis excerpts that refer to THE JOINT “are always preceded or succeeded by the name of the [establishment], in order for the reader to understand what ‘the joint’ is referring to.”⁴⁰ This argument reinforces the

³⁵ January 17, 2017 Request for Reconsideration, TSDR 6 and 7.

³⁶ See definitions from encarta.msn.com (January 17, 2017 Request for Reconsideration at TSDR 479) and oxforddictionaries.com (May 18, 2015 Office Action at TSDR 4).

³⁷ See definition from ahdictionary.com (Exhibit B to November 23, 2015 Response to Office Action at TSDR 15).

³⁸ See definition from en.wiktionary.org (Exhibit C to November 23, 2015 Response to Office Action at TSDR 20).

³⁹ See definition from onlineslangdictionary.com (Exhibit D to November 23, 2015 Response to Office Action at TSDR 26). Although this resource includes “American, English, and Urban Slang,” the Examining Attorney did not challenge the resource; moreover, inasmuch as the entry and definition appear to have been “[s]ubmitted by Walter Rader (Editor) from Sacramento, CA USA,” we presume the definition is American slang.

⁴⁰ Brief, p. 8 (7 TTABVUE 13).

dictionary definitions of the word “the” as a definite article used to indicate that the word following it (here, “joint”) has been previously specified by context.

We are concerned with the primary public perception, not just any possible perception, of the term THE JOINT to ordinary consumers who attend live musical performances, shows, and concerts; and who use nightclub, restaurant, bar, and catering services. That the term THE JOINT may have other meanings (e.g., prison) in different contexts is immaterial, since our genericness inquiry is not conducted in the abstract but focuses on the description of services in the applications, *see Magic Wand*, 19 USPQ2d at 1552, and how consumers would perceive the mark in connection with those services. *See, e.g., Remington Prods. Inc. v. North Am. Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (assessing descriptiveness and genericness by looking at how a consumer would perceive the mark “in connection with the products”). In analyzing the constituent terms THE and JOINT, we consider the meaning of each to the consuming public as indicated by the dictionary definitions and Lexis-Nexis articles. *See Northland Aluminum Prods.*, 227 USPQ at 963. When put together as THE JOINT, both “the” and “joint” retain their meanings and nothing further is added. The addition of the article “the” before “joint” does not expand the meaning of the word “joint” to primarily indicate a prison or jail. Instead, as the evidence shows, “the” is simply a definite article used to modify “joint.” Based upon the definitions and the Lexis-Nexis excerpts, THE JOINT may be primarily defined as a restaurant, bar, nightclub, or other establishment where people meet for eating, drinking, or entertainment – the precise services Applicant

provides.

Applicant argues that its mark “also functions as a double entendre, namely, a potentially playful or ironic reference to ‘prison’.”⁴¹ Even assuming that THE JOINT may in the abstract be a double entendre, we point out that for trademark purposes a double entendre is an expression that has a double connotation or significance as applied to the goods or services. TMEP § 1213.05(c) (Oct. 2017). The multiple interpretations that make an expression a double entendre must be associations that the public would make fairly readily, and must be readily apparent from the mark itself, in relation to the goods or services in the identification. *See In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1287 (TTAB 2006) (finding GALA ROUGE for “wines” is not unitary, and has no pre-existing well-recognized significance with regard to applied-for goods); *In re The Place, Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005) (finding THE GREATEST BAR for “restaurant and bar services” is not a double entendre; “A mark is thus deemed to be a double entendre only if both meanings are readily apparent *from the mark itself*.”); *In re Ethnic Home Lifestyles Corp.*, 70 USPQ2d 1156, 1158-59 (TTAB 2003) (finding ETHNIC ACCENTS for TV programs in the field of home décor merely descriptive and noting, “To have a double entendre, both meanings must be readily apparent, but the meaning suggested by applicant is not apparent upon seeing the mark in connection with the services.”); *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999) (finding in context DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software,

⁴¹ Brief, p. 10 (7 TTABVUE 15).

not “doctor” as shown by dictionary definition); *cf. In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994) (finding MUFFUNS, and design as a double entendre and not merely descriptive of baked mini muffins) (citing *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (finding SUGAR & SPICE not merely descriptive for various bakery products)). Despite Applicant’s argument, there is nothing in the record that would lead us to believe that consumers would associate the concept of “the joint” as a prison with its entertainment services, nightclub services, restaurants, bars, or catering services.

We have not ignored Applicant’s other evidence, including, (1) an entry from nolo.com/legal-encyclopedia, explaining that prisons “(also called penitentiaries and, in slang, ‘the joint,’ ‘the pen,’ ‘the big house,’ or ‘up the river’) are normally operated by the federal and state governments, and their purpose is long-term incarceration;”⁴² (2) an excerpt from folsomprisonmuseum.org showing two photographs under the header “Folsom Prison - As It Looks Now - Around The Joint - Unique Shots;”⁴³ (3) an excerpt from the DNA Bail Bonds website showing use of the tagline “Quick service bail bondsman: your ticket to get out [sic] the joint!”;⁴⁴ (4) a baltimoresun.com article mentioning what happens after Mike Tyson and Martha Stewart “get[] out of

⁴² Exhibit E to November 23, 2015 Response to Office Action at TSDR 31 (from www.nolo.com/legal-encyclopedia/what-s-the-difference-between-jail-prison.html).

⁴³ Exhibit F to November 23, 2015 Response to Office Action at TSDR 33 (from folsomprisonmuseum.org/now/now24.html).

⁴⁴ Exhibit G to November 23, 2015 Response to Office Action at TSDR 35-36 (from dnabailbondsn.com/quick-service-bail-bondsman-your-ticket-to-get-out-the-joint/).

the joint;”⁴⁵ and (5) an article from hiphopearly.com about Gucci Mane’s plans “when he does get out of the joint.”⁴⁶ The first of these exhibits reveals that “the joint” is but one of several slang terms for a prison, the second exhibit uses “the joint” in reference to a specific prison, and the remaining exhibits reference a phrase “get out of the joint” in context of being released from prison. None of the exhibits appears to bear on the primary public perception of the term THE JOINT to ordinary consumers who attend live musical performances, shows, and concerts or who use nightclub, restaurant, bar, and catering services; except perhaps the Gucci Mane article which, by its very subject (i.e., Gucci Mane, a musician, as indicated in the letter he wrote from prison) relates to a musical artist. Once again we remind Applicant that our genericness inquiry is not conducted in the abstract but is focused on the description of services in the applications and how consumers would perceive the mark in connection with those services. Four of these exhibits have nothing to do with the services, and are not probative of the perception of ordinary consumers who attend live musical performances, shows, and concerts, or who use nightclub, restaurant, bar, and catering services. A single article about a musician’s “plans for when he does get out of the joint” is insufficient to persuade us that the relevant public’s primary perception of THE JOINT would be prison – not nightclubs, restaurants, bars, or other establishments where people meet for eating, drinking, or entertainment, as

⁴⁵ Exhibit H to November 23, 2015 Response to Office Action at TSDR 38-40 (from articles. baltimoresun.com/2005-02-07...).

⁴⁶ Exhibit I to November 23, 2015 Response to Office Action at TSDR 42-44 (from news. hiphopearly.com/Gucci-mane-writes-fans-nadwritten-letter-prison/).

clearly demonstrated by the dictionary definitions and article excerpts taken from the Lexis-Nexis database.

During prosecution of the applications, Applicant submitted approximately 60 third-party registrations for marks containing the word JOINT and covering services in Class 41, and approximately 30 third-party registrations covering restaurant services in Class 43.⁴⁷ The sole reference to these registrations in its appeal brief is the following sentence found in the “procedural background” section: “Applicant submitted evidence of third party registrations incorporating JOINT in Class[es] 41 [and 43] which did not receive a genericness refusal to register.”⁴⁸ Applicant otherwise makes no argument in its brief related to the third-party registrations. Nonetheless, we note that when Applicant submitted the third party registrations it made two primary arguments related thereto.

For the Class 41 registrations, Applicant argued that because most of the registrations are for medical or educational services rather than entertainment services,⁴⁹ they demonstrate that JOINT is not widely used or recognized for nightclub or entertainment services; and that it is inconsistent and illogical for Applicant’s mark THE JOINT to be considered generic while the third-party marks

⁴⁷ See January 17, 2017 Request for Reconsideration 4 TTABVUE 7-9 (list of registrations) and 4 TTABVUE 16-437 (registrations, as Exhibits 1-60) for Class 41; and January 17, 2017 Request for Reconsideration for Application Serial No. 86525431 at 7 TTABVUE 7-9 (list) and 16-551 (registrations, as Exhibits 1-32) for Class 43.

⁴⁸ Brief, p. 3 (7 TTABVUE 8).

⁴⁹ A review of the Class 41 third-party registrations quickly reveals that most of the registrations, as Applicant has itself stated, do not contemplate entertainment or nightclub services.

are considered, at most, merely descriptive of entertainment and educational services. 4 TTABVUE 10. As to the first argument, Applicant provided no authority for the idea that when a word is not routinely registered as part of a mark for certain services, it therefore follows that the word is not generic for those services. Indeed, as we noted *supra*, “[t]here is usually no one, single and exclusive generic name for a product. Any product may have many generic designations. Any one of those is incapable of trademark significance.” See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:9 (5th ed., Sept. 2017 update). The absence of frequent registration of a term does not mean that the term is not generic. As to the second argument, educational services are not at issue or probative of the question of whether THE JOINT is generic for Applicant’s identified entertainment services. Of the third-party registrations that cover entertainment services, many do not contemplate live musical performances, shows, concerts, or nightclub services.⁵⁰ For those registrations that do contemplate live musical performances, shows, concerts, or nightclub services, some of the marks may be considered unitary or

⁵⁰ See JOINTS CHIEF OF STAFF (Exh. 2, 4 TTABVUE 21), JUKE JOINT PRODUCTIONS (Exh. 15, 4 TTABVUE 110), A SPIKE LEE JOINT (Exh. 29, 4 TTABVUE 203), POETS JOINT (Exh. 38, 4 TTABVUE 271), JOINT OPERATIONS (Exh. 39, 4 TTABVUE 278), CREAKYJOINTS (Exh. 48, 4 TTABVUE 342), CRAZY JOINT (Exh. 49, 4 TTABVUE 350), JOINT SERVICE OPEN HOUSE ANDREWS AIR SHOW (Exh. 53, 4 TTABVUE 377), and THE JOINT (Exh. 54, 4 TTABVUE 383).

contain a unitary phrase,⁵¹ and others have disclaimed the word “joint.”⁵² There is no third-party registration for Applicant’s exact mark for Applicant’s exact services; therefore, no third-party registration reveals that the Office has previously considered THE JOINT to be, at most, merely descriptive of the specific entertainment services identified in Applicant’s application.⁵³

Similarly, for the Class 43 registrations, Applicant argued that the Office “has repeatedly found the word JOINT to be, at most, descriptive rather than generic of services in Class 43.” 7 TTABVUE 7 (for 86525431). In support of this argument, Applicant attached Office actions from the application files underlying third-party

⁵¹ See THE JOINT CHIEFS (Exh. 18, 4 TTABVUE 130), JUKE JOINT FESTIVAL (Exh. 21, 4 TTABVUE 148), JUKE JOINT FESTIVAL (Exh. 22, 4 TTABVUE 156), JOINT DAMAGE (Exh. 25, 4 TTABVUE 177), JOINT MOVEMENT PRODUCTIONS (Exh. 28, 4 TTABVUE 197), JOINT SUPERCHIEFS: ARMO, NAVO, MARINO, AIRFO (Exh. 30, 4 TTABVUE 209), JOINT’S JUMPIN’ (Exh. 45, 4 TTABVUE 322), and JOINT HEIRS (Exh. 52, 4 TTABVUE 371). A disclaimer of a nondistinctive component of a unitary mark is not required. See TMEP §§ 1213.05(b) *et seq.* (Unitary Phrases).

⁵² See JUKE JOINT PROPHETS (Exh. 4, 4 TTABVUE 35; disclaimer of JUKE JOINT), JUKE JOINT JOKERS (Exh. 20, 4 TTABVUE 142; disclaimer of JUKE JOINT), SOUL SISTA’S JUKE JOINT (Exh. 33, 4 TTABVUE 236; disclaimer of JUKE JOINT), JOINT BASE LEWIS-MCCHORD SOLDIERS & AIRMEN DEFENDING AMERICA (Exh. 46, 4 TTABVUE 328; disclaimer of JOINT BASE and unrelated meaning).

⁵³ We are aware of Exhibit 54 (4 TTABVUE 383), print outs for Registration No. 2652379 for the mark THE JOINT for “entertainment services, namely, providing audio programs featuring music, sports, talk, news and data via satellite and via a global communication network” – different, but possibly related services. The Examining Attorney did not cite this registration as a bar to registration of either application. The Board may remand an application for further examination where an issue not previously raised may render the mark unregistrable. Trademark Rule 2.142(f), 37 CFR § 2.142(f). Because that issue is not before us on appeal, this case is ripe for decision, and in view of our determination below, we do not remand for consideration of that registration. We note, however, in the event this decision is reversed in any further appeal, and Registration No. 2652379 is still registered, Application Serial No. 86525425 (covering Applicant’s Class 41 services) should be remanded for consideration by the Examining Attorney as to whether Registration No. 2652379 could present a further bar to registration under Section 2(d).

registrations of marks incorporating the word “joint” for restaurant services, which Applicant claims show that the respective examining attorneys “deemed JOINT to be merely descriptive, rather than generic, of the recited services or not even descriptive at all.” *Id.* Of the approximately 30 registrations submitted, only seven have no disclaimer of the word “joint” and in each the word “joint” may be considered part of a unitary phrase.⁵⁴ For the remaining registrations for which an Office action issued during examination of the underlying applications in which the respective examining attorneys required a disclaimer of the word “joint” because that word merely describes the services, Applicant’s argument that the examining attorneys deemed “joint” to be merely descriptive rather than generic is spurious. “A generic term is . . . ‘merely descriptive’” and “is in fact the ultimate in descriptiveness.” *Marvin Ginn*, 228 USPQ at 532. Use by examining attorneys of the word “descriptive” when requiring a disclaimer does not mean that a mark or portion thereof to be disclaimed is not generic; indeed, generic words *are* descriptive. *Id.* It is examination procedure to initially refuse registration of an unregistrable term on the Principal Register as merely descriptive, and refuse based on genericness only after an applicant asserts acquired distinctiveness under Section 2(f). TMEP § 1209.02(a). This procedure is also applicable to a requirement for a disclaimer of a term. At any rate, the existence

⁵⁴ See A BURGER JOINT WITH A PASSION FOR CRAFT BEER (Exh. 2, 7 TTABVUE 31), BLUNT BROS. A RESPECTABLE JOINT (Exh. 4, 7 TTABVUE 71), THE GIN JOINT (Exh. 11, 7 TTABVUE 205), BGR THE BURGER JOINT ON TOUR (Exh. 17, 7 TTABVUE 290), A FUN, CASUAL JOINT (Exh. 19, 7 TTABVUE 345), MICKEY & MOOCH THE OTHER JOINT (Exh. 20, 7 TTABVUE 355), JAVA JOINT (Exh. 22, 7 TTABVUE 378; Supplemental Register), and FISHERMAN’S MARKET & GRILL “THE FRESH FISH JOINT” (Exh. 32, 7 TTABVUE 542).

of third-party registrations for other marks that include the word JOINT does not require a finding that Applicant's mark THE JOINT is not generic when used in connection with live musical performances, shows, and concerts, and nightclub, restaurant, bar and catering services.

In sum, the record demonstrates that the primary consumer perception of the term THE JOINT, as a whole, is that of a common name for the identified services, namely, nightclubs, restaurants, and bars. In light of the evidence of record, including dictionary definitions and evidence showing that members of the consuming public use the term "the joint" and the word "joint" itself to describe entertainment and eating establishments, including nightclubs, restaurants, and bars, we find that the Examining Attorney has clearly demonstrated that Applicant's proposed mark is a generic name for Applicant's services; and that relevant customers would understand the term THE JOINT primarily to refer to a nightclub, restaurant, or bar.⁵⁵ We therefore AFFIRM the refusal to register Applicant's proposed mark on the ground that it is generic.

⁵⁵ Although these services represent only a portion of Applicant's entire recitations of services, a refusal on the ground of genericness is proper with respect to all of the identified services in an International Class if the mark is generic for any of the identified services in that class. *In re Cordua Rests.*, 118 USPQ2d at 1638 ("A registration is properly refused if the word is the generic name of any of the goods or services for which registration is sought." (quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:57)). Having found THE JOINT generic for some of the services in both refused Classes 41 and 43, we find that registration is appropriately denied for the entire classes. *See In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (unpublished).

III. Refusal on Grounds of Mere Descriptiveness and Lack of Acquired Distinctiveness

For completeness we turn next to the Examining Attorney's refusal to register the mark on grounds that it is merely descriptive of the identified services under Section 2(e)(1) and has not acquired distinctiveness under Section 2(f). During prosecution of the applications, Applicant maintained that its mark was not merely descriptive of the identified services.

A. Mere descriptiveness

A term is merely descriptive under Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). A mark need not immediately convey an idea of each and every specific feature of the services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the services. *See In re Gyulay*, 3 USPQ2d at 1010.

Implicit in our holding that THE JOINT is generic for Applicant's services is a holding that the mark is at least merely descriptive of the services under Section 2(e)(1). As noted above, "[t]he generic name of a thing is in fact the ultimate in descriptiveness." *Marvin Ginn*, 228 USPQ at 530. The dictionary evidence alone demonstrates that Applicant's mark immediately conveys the idea of a business establishment that provides live musical performances, shows, and concerts, and nightclub, restaurant and bar services.

B. Acquired distinctiveness

Applicant argues, in the alternative, that its mark has acquired distinctiveness as Applicant's source indicator. Acquired distinctiveness is generally understood to mean an acquired "mental association in buyers' minds between the alleged mark and a single source of the product." 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (5th ed., March 2018 update). *See also In re Steelbuilding.com*, 75 USPQ2d at 1422 ("To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.") *quoted in Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1851 (TTAB 2017).

We determine whether Applicant's mark has acquired distinctiveness based on the entire record, keeping in mind that Applicant has the "ultimate burden of persuasion" as to acquired distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). The kind and amount of evidence necessary to establish that a proposed mark has acquired distinctiveness in relation to goods or services depends on the nature of the proposed mark and the circumstances surrounding its use. *In re Steelbuilding.com*, 75 USPQ2d at 1424 ("the applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning."). *See also Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381, 383 (CCPA 1960).

Applicant initially filed a verified declaration of Charles Smith, its Vice President of Entertainment, averring not that the mark had become distinctive, but that “substantial good will has been built up in the mark” as a result of exclusive and continuous use in commerce since March 10, 1995 (para. 3) (the “First Smith Declaration”).⁵⁶ We agree with the Examining Attorney that Applicant’s bare statements of use of the mark since 1995 are otherwise insufficient in these consolidated cases where the mark is highly descriptive (if not generic), to demonstrate that Applicant’s mark has acquired distinctiveness. *See, e.g., In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (“the Board was within its discretion not to accept [applicant’s] alleged five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness.”).

Applicant subsequently submitted a more extensive declaration of Mr. Smith (the “Second Smith Declaration”).⁵⁷ Mr. Smith once again claims that “substantial good will has been built up in the mark” as a result of substantially exclusive and continuous use in commerce since March 10, 1995 (para. 3). Mr. Smith also attests to the nature of Applicant’s venue (paras. 4-5); that Applicant has spent more than \$12 million on sales and marketing of its venue (para. 6) and generated more than \$104

⁵⁶ Exhibit J to November 23, 2015 Response to Office Action at TSDR 45.

⁵⁷ June 15, 2016 Response to Office Action at TSDR 11-14. Although Applicant submitted the Second Smith Declarations in the incorrect files (i.e., the declaration covering the Class 41 services was filed in the Class 43 application, and vice-versa), we have nonetheless considered the revised declarations and exhibits thereto for the correct applications, as the declarations and exhibits are otherwise identical.

million in gross revenue between 2009 and June 2016 (para. 7); that Applicant's website receives approximately 31,700 visitors per month (para. 8); that Applicant's Facebook page has received 99,154 "likes" and 152,118 "visits" (para. 9); that Applicant's Twitter account has 24,900 followers and 1,903 "likes" (para. 10); that Applicant has received widespread unsolicited recognition of its mark as indicated by at least 123 consumer reviews on a Yelp review website under the heading "THE JOINT AT HARD ROCK" (para. 11); that a travel review page at TripAdvisor displays at least 127 reviews under the heading "The Joint at Hard Rock" (para. 12); and that a video website at YouTube displays at least 30,400 video results for a search of "the joint' hard rock" (para. 13). Applicant attached various exhibits to the Second Smith Declaration in support of its statements.

Having carefully reviewed the totality of the evidence of record, we find that Applicant has failed to establish acquired distinctiveness of its proposed mark within the meaning of Section 2(f). Although Applicant has used its mark since 1995, the mark is highly descriptive (if not generic) for the services. While Applicant expended approximately \$12 million on sales and marketing between 2009 and 2016 and generated more than \$107 million in gross revenue for that same time, Applicant provided no context for how these figures compare to the volume of sales and revenue by other nightclubs and restaurants. We similarly cannot ascertain the reach of Applicant's advertising. But even if those figures prove to be substantial, it is not in itself necessarily enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales of

approximately 85 million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark). Moreover, Applicant's services appear limited to a single venue within the Hard Rock Hotel and Casino in Las Vegas, Nevada,⁵⁸ and there is no information regarding the market share occupied by Applicant in the United States.

Similarly, there is no context for the short interview with Mr. Smith, appended as Exhibit B to his second declaration.⁵⁹ We cannot ascertain how many people may have read the interview online (the exhibit was printed from the web), or if the interview was printed in a published magazine in addition to appearing online, and, if so, the circulation and geographical reach thereof. Judging from the website's domain name ("lasvegasmagazine.com") it appears to be a city-based magazine as opposed to a national publication.

The IMDb web page reveals the title of a 28-minute live performance concert film to be "Aerosmith: Rockin' the Joint - Live at the Hard Rock Hotel, Las Vegas (2005)."⁶⁰ We note that the word "the" is not capitalized on the IMDb page, and Applicant has provided no information regarding public exposure to the video or as to how the mark may be used within the video. In addition, two other marks appear in the film title

⁵⁸ Exh. A (Wikipedia page) to Second Smith Declaration, TSDR 16-17.

⁵⁹ Exh. B ("Vice president of entertainment is all about the music - Las Vegas Magazine") to Second Smith Declaration, TSDR 19-23.

⁶⁰ Exh. C to Second Smith Declaration, TSDR 24-27.

(i.e., Aerosmith and Hard Rock Hotel) so it is difficult to know which mark attracts public attention.

Applicant's website receives 31,700 visits per month.⁶¹ Applicant has not provided any context for this figure, so we cannot measure it against how many website visits its competitors may have received. Also, because Applicant provided only a number of website visits "per month," we cannot determine whether such a number of visits is an average or part of an increasing trend. Further, Applicant does not indicate whether the number of visits were from different individuals or multiple visits from the same individuals. In addition, the website prominently displays the mark Hard Rock Hotel & Casino, and judging from the domain name ("hardrockhotel.com") it appears to be one of many pages within the Hard Rock Hotel and Casino's website; therefore, it is unclear which mark on the page attracts public attention.

While Applicant has an active social media presence on Facebook and Twitter, and there are active Yelp and TripAdvisor review pages for Applicant's venue, the exhibits have limited probative value in the absence of information regarding public exposure.⁶² Applicant has not provided any context for the number of "likes," "visits," followers, or reviews, so we cannot measure them against other brands. We are simply without enough information to determine the degree to which Applicant's Facebook "likes" and "visits," Twitter "likes" and followers, and Yelp and TripAdvisor reviews are significant.

⁶¹ Second Smith Declaration, para. 8.

⁶² Exh. E (Facebook page) to Second Smith Declaration, TSDR 32-41; Exh. F (Twitter page) TSDR 42-52; Exh. G (Yelp page) TSDR 53-92; and Exh. H (TripAdvisor page) TSDR 93-98.

Similarly, the results from a YouTube search for “the joint’ hard rock” (including screen shots of apparent YouTube videos presumably filmed at Applicant’s venue) have limited utility to show acquired distinctiveness given the nature of the evidence and images, which lack sufficient context.⁶³ *Cf., In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006) (Board rejected an applicant’s attempt to show weakness of a term in a mark through citation to a large number of GOOGLE “hits” because the results lacked sufficient context). *See also, In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (truncated results from search engines are entitled to little weight). Without more than the screen shots, titles, dates, number of views, and short summaries we cannot begin to ascertain what kind of commercial impression the videos made. There is no indication that THE JOINT appears while viewing the videos, and no way of knowing how the viewers came upon or searched for the videos (e.g., by searching for a band or artist, by searching the Hard Rock hotel/casino name, or by recommendation from YouTube after watching other unrelated videos).

For the reasons stated, Applicant has not shown that the term THE JOINT will be perceived as identifying the source of Applicant’s services. Accordingly, we find that it has not acquired distinctiveness.

IV. Decision

The refusals to register Applicant’s proposed mark THE JOINT on the ground that it is generic are AFFIRMED as to both applications. The refusals to register the

⁶³ Exh. I to Second Smith Declaration, TSDR 99-105.

mark on the ground that it is merely descriptive under Section 2(e)(1) and has not acquired distinctiveness under Section 2(f) are AFFIRMED as to both applications.