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Subject: U.S. TRADEMARK APPLICATION NO. 86862221 - EMENUS - 42941.0001E - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86862221

MARK: EMENUS



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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:** Central Dynamics Corp.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

42941.0001E

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant, Central Dynamics Corp. (hereinafter "applicant"), has appealed the trademark examining attorney's refusal to register the proposed mark "EMENUS" on the Principal Register for "providing temporary use of on-line non-downloadable software for data base management by hotels around the world to enable their clients and guests to see online menus and photos of meals to order" under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). The applicant has also appealed the trademark examining attorney's refusal to accept the applicant's claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f).

It is respectfully requested these refusals be affirmed.

### **FACTUAL BACKGROUND**

On December 30, 2015, the applicant applied to register "EMENUS" (special form) on the Principal Register used in connection with:

*Class 42: Providing temporary use of on-line non-downloadable software for data base management by hotels around the world to enable their clients and guests to see online menus and photos of meals to order*

The application was submitted with a claim of acquired distinctiveness based on five years' use and based on Supplemental Registration No. 3648978.

On April 12, 2016, the examining attorney refused the proposed mark under Section 2(e)(1) as the mark is merely descriptive and rejected the applicant's claim of acquired distinctiveness based on a registration on the Supplemental Register or based on five years' use. A generic advisory was given.

On October 12, 2016, the applicant responded to the April 12, 2016, Office Action, arguing the proposed mark is not merely descriptive and the mark has acquired distinctiveness. The applicant also argued the mark is not generic.

On November 4, 2016, the examining attorney issued a new non-final refusing the mark under Section 2(e)(1) as the mark is generic, in the alternative, maintained the mark is merely descriptive, and rejected the applicant's claim of acquired distinctiveness due to insufficient evidence.

On May 4, 2017, the applicant responded to the November 4, 2016, Office Action, arguing the proposed mark is not generic and that it had established distinctiveness by submitting additional evidence.

On June 9, 2017, the examining attorney issued a Final Office Action refusing the proposed mark under Section 2(e)(1), as the mark is generic, in the alternative, maintained the mark is merely descriptive, and rejected the applicant's claim of acquired distinctiveness due to insufficient evidence.

On December 11, 2017, the applicant filed this appeal without a Request for Reconsideration.

On February 5, 2018, the applicant submitted a request to the Board for an extension to file its brief for ninety days up to and including May 10, 2018.

On May 4, 2018, the applicant submitted a second request to the Board for an extension to file its brief for sixty days up to and including July 9, 2018.

On July 9, 2018, the applicant filed its appeal brief with the Board.

#### **OBJECTION TO APPLICANT'S UNATTACHED EXHIBITS**

The objection to any exhibits other than A, R, S, and Q made in the June 9, 2017, Final Office Action is maintained because the exhibits were not properly made of the record as discussed in the Final Action.

#### **ISSUES ON APPEAL**

There are two issues on appeal: whether the proposed mark is generic when used in connection with the applicant's services; and, has the applicant acquired distinctiveness in the proposed mark? Since the applicant submitted its claim of acquired distinctiveness with the application, and not as an alternative to a descriptive refusal, the applicant has conceded its mark is merely descriptive of its services under Section 2(e)(1) of the Trademark Act.<sup>1</sup> Should the Board determine the proposed mark is

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<sup>1</sup> *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed Cir. 2009); TMEP 1212.02(b).

generic, it does not need to address the second issue as generic terms are incapable of denoting source and are unregistrable with a claim of acquired distinctiveness under Section 2(f).<sup>2</sup>

## ARGUMENT

### **I. The Proposed Mark “EMENUS” is Generic**

The applicant has applied to register “EMENUS” (special form) used in connection with:

Class 42: *Providing temporary use of on-line non-downloadable software for data base management by hotels around the world to enable their clients and guests to see online menus and photos of meals to order*

A generic term is a common name that the relevant public uses or understands primarily as referring to the category or genus of the services in question.<sup>3</sup> Generic terms are by definition incapable of indicating a particular source of services and cannot be registered as trademarks or service marks.<sup>4</sup> Registering generic terms “would grant the owner of [a] mark a monopoly, since a competitor could not describe his goods as what they are.”<sup>5</sup> Here, the proposed mark is a generic term the public uses or understands to primarily refer to the category or genus of the services in question because the purpose of the applicant’s online software is to enable users to see online menus and photos of meals to order.

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<sup>2</sup> *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); TMEP 1209.01(c).

<sup>3</sup> *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *see* TMEP §1209.01(c).

<sup>4</sup> *In re Cordua Rests., Inc.*, 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (quoting *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).

<sup>5</sup> *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

“A mark is generic if its primary significance to the relevant public is the class or category of services on or in connection with which it is used.”<sup>6</sup> Determining whether a mark is generic requires a two-step inquiry:<sup>7</sup>

- (1) What is the genus of services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of services?

Regarding the first part of the inquiry, the genus of the services may be defined by an applicant’s identification of services.<sup>8</sup>

In this case, the application identifies the services as a software platform to enable their clients and guests to see online menus and photos of meals to order, which adequately defines the genus at issue. Moreover, any term that the relevant public understands to refer to a particular genus of services is generic; thus there can be more than one generic term for a particular genus.<sup>9</sup> Therefore, any language synonymous with “eMenus,” such as, “online menus” or “digital menus,” may adequately define the genus of the applicant’s services.

In addition to the applicant’s identification defining the genus of the applicant’s services, an applicant’s website may assist in clarifying or refining the genus by providing the context for the terms in the identification.<sup>10</sup> The applicant’s specimen, which is a dated screenshot of the applicant’s website,

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<sup>6</sup> TMEP §1209.01(c)(i) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1600 (TTAB 2014)).

<sup>7</sup> *In re Cordua Rests., Inc.*, 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d at 990, 228 USPQ at 530); TMEP §1209.01(c)(i).

<sup>8</sup> *In re Cordua Rests., Inc.*, 823 F.3d at 602, 118 USPQ2d at 1636 (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

<sup>9</sup> *In re 1800Mattress.com IP, LLC*, 586 F. 3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009).

<sup>10</sup> *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *see In re Empire Tech. Dev. LLC*, 123 USPQ2d 1544, 1547-48 (TTAB 2017).

shows the genus of the applicant's software enables users to see online menus and photos of meals to order. Additionally, the applicant's updated website shows this is a type of software provided by the applicant.<sup>11</sup> The applicant's website clearly demonstrates the genus of the applicant's services as "eMenus is ideal for events, and for online menus aimed at both group and guests." *Id.* This wording, as featured by the applicant on a visualization of its software in action, unequivocally illustrates the genus of the applicant's software is to enable their clients and guests to see online menus and photos of meals to order because the application is displaying an electronic menu. Further, the applicant states the purpose of its software service is to, "[place] your food and beverage offerings front and center with dazzling digital menus." *Id.* Because the applicant identifies its software platform specifically as a particular genus of software, the first prong of the generic test is satisfied.

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified services.<sup>12</sup> In this case, the relevant public comprises ordinary consumers, because the applicant's software is used by anyone receiving hospitality services. ***Even though*** the language in the identification appears to narrow the relevant public to the hospitality industry, this limitation is illusory. While applicant correctly states that the identification expressly recites "providing temporary use of online non-downloadable software for data base management by hotels," this language misleads the Board as the applicant has ***omitted*** the following language in its argument, "to enable their clients and guests to see online menus and photos of meals to order." This language clearly identifies everyone is to use the applicant's software because the software enables their clients and ***guests*** to interact with electronic menus. Moreover, as discussed above, the applicant's specimen and updated website clearly demonstrate the applicant intends for people other than hospitality

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<sup>11</sup> See attached evidence from the Final Office Action dated June 9, 2016.

<sup>12</sup> *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553).

professionals to interact with the applicant's software. For these reasons, the relevant public for determining whether the proposed mark is generic is the ordinary consumer.

In assessing the genericness of a compound term, the evidence of record must show that each of the constituent words is itself generic, and that when combined, the composite lends no additional meaning to the total combination.<sup>13</sup>

The attached evidence from dictionaries and the applicant's identification of services shows that the wording "EMENUS" in the applied-for mark means software for enabling users to see online menus and photos of meals to order and thus the relevant public would understand this designation to refer primarily to that genus of services.

According to the evidence attached in the Office Actions, the letter "e" used as a prefix has become commonly recognized as a designation for services that are electronic in nature or are sold or provided electronically. Specifically, the evidence consists of dictionaries, glossaries, and an acronym finder query which shows "e" is a prefix used to denote something in electronic form.<sup>14</sup> For example, Merriam-Webster defines "e" as "electronic" and provides the example of "e-commerce."<sup>15</sup> A glossary of internet terms shows "e" is a prefix meaning, "electronic for current jargon terms" and provides examples, such as "e-commerce" or "e-business." *Id.* A query from Acronym Finder shows "e" means, "Electronic." *Id.* This evidence establishes the public will understand "E" in the proposed mark to mean, "electronic."

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<sup>13</sup> *In re Gould Paper Corp.*, 834 F.2d 1017, 1018-19, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987); *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1602-03 (TTAB 2014); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010); TMEP §1209.01(c)(i).

<sup>14</sup> See evidence attached in the Office Action dated April 12, 2016, and the Final Office Action dated June 9, 2017.

<sup>15</sup> See evidence attached to the Final Office Action dated June 9, 2017.



When a mark consists of the “e” prefix coupled with a generic word or term for electronic services, then the entire mark may be considered generic.<sup>16</sup> “MENU” is a generic term because the purpose of the applicant’s software is to enable their clients and guests to see menus and photos of meals to order.<sup>17</sup> Terms that identify the function or purpose of a service may be generic.<sup>18</sup> Additionally, the examining attorney has included numerous pieces of dictionary evidence showing a “menu” is “a list of dishes available in a restaurant.”<sup>19</sup> Because the purpose or function of the applicant’s software is to enable their clients and its clients’ guests to see online menus and photos of meals to order, “MENU” in the proposed mark is generic.

When these individual words are combined into one term, i.e., the applied-for mark “EMENU”, the meaning of the compound term is software for enabling users to see online menus and photos of meals to order. The individual words within the composite term retain their original meaning and no additional meaning is created by their combination. As a result, the relevant public would perceive the mark as a whole to be generic when applied to the relevant services. The salience of this argument is underscored by the above referenced holdings in *In re Int’l Bus. Mach. Corp.* and *Cont’l Airlines Inc.* as the marks in those cases were held generic because the prefix “e” was coupled with generic software functions.

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<sup>16</sup> *In re Int’l Bus. Mach. Corp.*, 81 USPQ2d 1677 (TTAB 2006) (holding **ESERVER** generic for computer hardware and operating software that allow network connectivity and administration and processing of information); *Cont’l Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (holding **E-TICKET** generic for computerized reservation and ticketing of transportation services)(emphasis added); TMEP §1209.03(d).

<sup>17</sup> See the identification, applicant’s specimen, and evidence from the Final Office Action dated June 9, 2017.

<sup>18</sup> TMEP §1209.03(p); *In re Gould Paper Corp.*, 834 F.2d 1017, 1019, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (holding SCREENWIPE generic for an anti-static cloth used for cleaning computer and television screens); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for sprinklers installed primarily in attics); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389, 1391 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers for use on permanent press products).

<sup>19</sup> See attached evidence in the Office Action dated April, 12, 2016, and the Final Office Action dated June 9, 2017.

Alternatively, in assessing the genericness of a phrase, the evidence of record must show that the composite mark, when viewed as a whole, would be perceived by the relevant purchasing public as generic when used in connection with the relevant services.<sup>20</sup>

The evidence from numerous third-parties, the applicant's specimen, and the applicant's website demonstrate the term "eMenu" is commonly used to reference software that enables the user to see online menus and photos of meals to order.<sup>21</sup> For example, eZee eMenu, Lucid POS, CRS Solutions, Dytel, Bleep, Cube, Advantech, Expodine, BevEat, Restaurant Software Solutions, FireCast, and Layer Tech all provide software for that enables the user to see online menus and photos of meals to order. *Id.* All of these third-parties in the hospitality industry use "eMenu" in a generic manner to identify their software for viewing online menus. As already discussed above, the applicant's specimen and updated website show the purpose of the applicant's software is to enable the user to see online menus and photos of meals to order.<sup>22</sup> This evidence demonstrates "EMENUS", as a whole is a generic phrase for these services because numerous third-parties and the applicant itself use the proposed mark to identify software to enable the user to see online menus and photos of meals to order. Thus, the applied-for mark would be perceived by the relevant public as generic when used in connection with applicant's identified services.

Moreover, the name of an ingredient, a key aspect, a central focus or feature, or a main characteristic of goods and/or services may be generic for those services.<sup>23</sup> Thus, a term does not need

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<sup>20</sup> *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345-46, 57 USPQ2d 1807, 1810-11 (Fed. Cir. 2001) (quoting *In re Am. Fertility Soc'y*, 188 F.3d 1341, 1348-49, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760 (TTAB 2013); TMEP §1209.01(c)(i).

<sup>21</sup> See evidence attached to the April 12, 2016, Office Action and June 9, 2017, Final Office Action.

<sup>22</sup> Evidence from the applicant's website is attached to the June 9, 2017, Final Office Action.

<sup>23</sup> See *In re Cordua Rests., Inc.*, 823 F.3d 594, 604, 118 USPQ2d 1632, 1637-38 (Fed. Cir. 2016) (affirming the Trademark Trial and Appeal Board's holding of CHURRASCOS (a type of grilled meat) generic for restaurant services); *In re Hotels.com LP*, 573 F.3d 1300, 1304, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009) (affirming the Trademark Trial and Appeal Board's holding of HOTELS.COM generic for travel agency services, namely, making reservations and bookings for temporary lodging, and providing information about temporary lodging); *In re*

to be the name of a specific service to be found generic. Like the marks held generic in the *In re Hotels.com LP*, *In re Meridian Rack & Pinion*, *Reed Elsevier Props.*, and *In re Eddie Z's Blinds & Drapery, Inc.*, the proposed mark "EMENUS" is a generic term when used in connection with the applicant's services because the key aspect of the applicant's software is to enable clients and guest to see online menus and photos of meals to order. Further, third-parties use the term "eMenu" to indicate the key aspect of their software is to enable users to see menus and photos of meals to order. The evidence from eZee eMenu, Lucid POS, CRS Solutions, Dytel, Bleep, Cube, Advantech, Expodine, BevEat, Restaurant Software Solutions, FireCast, and Layer Tech all show "eMenu" is generically used to reference software to enable users to see menus and photos of meals to order.<sup>24</sup> Moreover, Restaurant Magazine has published an article on restaurant menu software 'eMenu' is ready to replace traditional paper menus.<sup>25</sup> Because it is commonplace for third-parties to use "eMenu" to identify software functions that enable users to see menus and photos of meals to order, "EMENUS" is generic when used in connection with the applicant's services.

Lastly, the applied-for mark shows the wording in stylized lettering. Stylized descriptive or generic wording is registrable only if the stylization creates a commercial impression separate and apart from the impression made by the wording itself.<sup>26</sup> Common and ordinary lettering with minimal stylization, as in this case, is generally not sufficiently striking, unique, or distinctive as to make an

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*Emergency Alert Sols. Grp., LLC*, 122 USPQ2d 1088, 1091-93 (TTAB 2017) (holding LOCKDOWN ALARM generic for training services focusing on the use of and response to lockdown alarms); *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1465-66 (TTAB 2015) (holding BUYAUTOPARTS.COM generic for on-line retail store services featuring auto parts); TMEP §1209.03(v); *see also A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 292, 1 USPQ2d 1364, 1365 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas). Thus, a term does not need to be the name of a specific product and/or service to be found generic. Any term that the relevant public understands to refer to the genus can be generic. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1367, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018) (quoting *In re Cordua Rests., Inc.*, 823 F.3d at 603, 118 USPQ2d at 1637 (Fed. Cir. 2016)).

<sup>24</sup> See evidence attached to the Office Action dated April 12, 2016, and the Final Office Action dated June 9, 2017.

<sup>25</sup> See evidence attached to the Office Action dated April 12, 2016.

<sup>26</sup> See *In re Cordua Rests., Inc.*, 823 F.3d 594, 606, 118 USPQ2d 1632, 1639-40 (Fed. Cir. 2016); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1561, 227 USPQ 961, 964 (Fed. Cir. 1985); TMEP §1209.03(w).

impression on purchasers separate from the wording.<sup>27</sup> Because the proposed mark is minimally stylized, the stylization is not distinctive and does not create a commercial impression separate from the wording. Thus, the minor stylization does not overcome this refusal. The applicant has not contested this assertion in its brief.

The trademark examining attorney has established by “clear evidence” that the applied-for mark is generic; thus the USPTO’s evidentiary burden has been met.<sup>28</sup> Applicant cannot overcome this refusal by submitting a claim of acquired distinctiveness under Trademark Act Section 2(f).<sup>29</sup> Such a claim would be insufficient because “generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be.”<sup>30</sup>

### **Applicant’s Arguments**

The applicant argues the relevant public to determine genericness is hospitality professionals.<sup>31</sup> For the reasons already given above, this argument is unpersuasive.

Next, the applicant argues the proposed mark is not generic because the examining attorney included the word “software” into the definition of “eMenu” and, as a result, the meaning of the compound term “eMenu” is nonsensical. *Id.* To illustrate this point, the applicant claims the definition of “e-mail,” *inter alia*, would be “electronic software mail rather than electronic mail.” The applicant’s assertion is contrary to axiomatic common sense or established case law.

How does a person draft an email? Can a person write an email on a piece of paper or place it in a physical mailbox? How is a person to view an electronic menu? The answer to these rhetorical

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<sup>27</sup> See *In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1487 (TTAB 2012).

<sup>28</sup> *In re Hotels.com LP*, 573 F.3d 1300, 1302, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); TMEP §1209.01(c)(i).

<sup>29</sup> See 15 U.S.C. §1052(f).

<sup>30</sup> *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1370, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018) (quoting *In re Northland Aluminum Prods.*, 777 F.2d 1556, 1558, 227 USPQ2d 961, 962 (Fed. Cir. 1985)); see TMEP §1212.02(i).

<sup>31</sup> See applicant’s brief at page 5.

questions is self-evident: software. A person drafts an email by using software that enables a user to compose and send a message/mail in electronic form. It is impossible to draft or send an email in any other fashion. Correspondingly, it is impossible for a person to write an email on a piece of paper, to place an email in a physical mailbox at the post office, or to view an electronic menu without software. While it is possible to print an email or electronic menu and place the printed email or menu in a mailbox at a post office, a person must use software to accomplish this objective. The applicant is performing linguistic and logical gymnastics to make its quixotic point.

Unnecessary words are commonly omitted from communication when concepts have become defined by a single word or phrase. For example, people worldwide do not communicate by stating, “please use computer hardware and software to draft and send me an electronic message where the Board has held “E” coupled with a generic term renders the entire mark generic;” they simply communicate, “please send an email about trademark cases where the Board has held “E” coupled with a generic term renders the entire mark generic.” The applicant simply vaults over this common sense vernacular to make its argument and examples appear rational or believable and invites the Board to join it in suspending reality, an invitation the Board is not obligated to accept.<sup>32</sup>

Because the presence or omission of “software” in the literal definition of “eMenu” does not determine whether the relevant public will understand the proposed mark to mean software enabling users to see online menus and photos of meals to order, the applicant’s argument is untenable.

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<sup>32</sup> The Trademark Trial and Appeal Board may take judicial notice of commonly known facts. TBMP §1208.04; see *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (taking judicial notice that beer is often relatively inexpensive, subject to impulse purchase, and often ordered orally in a bar or restaurant); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 n.2 (TTAB 2001) (taking judicial notice that “the National League is part of Major League Baseball”); see also Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

The applicant has not challenged the applicability of any of the cases cited by the examining attorney holding the prefix “E” coupled with a generic term renders the entire mark generic or that the cited cases are not analogous to the case at bar because these cases are germane and instructive on the question of genericness. Instead, the applicant attempts to undermine the credibility of the examining attorney’s third-party evidence throughout most of its brief.

Several themes emerge in the applicant’s attempt to undermine the credibility of the examining attorney’s evidence. First, and as already extensively discussed above, the applicant incorrectly claims its services are limited to professionals in the hospitality industry. Second, the omission or designation of a specific industry using the third-parties’ services does not preclude the third-parties from operating in the hospitality industry. Third, any term that the relevant public understands to refer to a particular genus of services is generic; thus there can be more than one generic term for a particular genus.<sup>33</sup> Therefore, terms synonymous for “eMenu” that denote the generic purpose of the applicant’s or third-parties’ software function are probative on the question of whether a proposed mark is generic. When these themes are raised by the applicant to undermine the applicability of the third-party evidence on the question of genericness, they are unpersuasive because the applicant’s services are not limited to the hospitality industry, the third-parties are not precluded from entering the hospitality industry, or there can be more than one generic term for a genus of services.

The applicant has objected to some of the examining attorney’s evidence because the evidence does not include the entire web page or home page. The applicant has not provided any legal basis for its objection. Contrary to the applicant’s implication, the examining attorney has complied with the requirements for submitting electronic evidence as the URL and date were included in the evidence.<sup>34</sup>

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<sup>33</sup> *In re 1800Mattress.com IP, LLC*, 586 F. 3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1464 (TTAB 2015).

<sup>34</sup> *In re Canine Pet Foods, Inc.*, 126 USPQ2d 1590, 1594 (TTAB 2018).

Because the examining attorney has complied with the requirements for submitting electronic evidence, the applicant's objection to particular pieces of evidence should be dismissed.

Another theme raised by the applicant is that the third-parties are using "eMenu" as a brand name, and therefore, they are not using the term generically. The applicant's argument is unpersuasive because this is generic usage of "eMenu" to identify the generic function of the software would appear no different from other generic usages of additional terms to identify the generic goods/services. For example, John Doe's wine or Jane Doe's legal services all identify the source followed by the generic term. Moreover, when consumers view the same terms used by multiple sources to identify the same software functions, consumers interpret the shared wording as generically identifying the function of the software. Because the third-parties are not using "eMenu" as an exclusive brand name or consumers will interpret the shared term as identifying the generic software function, the applicant's argument is not convincing.

For the first time during prosecution, the applicant in its brief argues the third-party evidence comprising downloadable software is not probative on the question of genericness for software provided as a service. This distinction is irrelevant because the third-parties' goods and the applicant's services are software. Further, it is commonplace for software developers to manufacture the downloadable goods and provide the equivalent software as a service online. For example, Microsoft provides its Office suite in a downloadable and non-downloadable form. Apple, numerous social networking websites, and gaming applications provide their software in downloadable and non-downloadable form. Moreover, the relatedness of downloadable and non-downloadable software has been established by the CAFC and the Board when determining likelihood of confusion under Section 2(d) of the Trademark Act.<sup>35</sup> Finally, the applicant's assertion that downloadable software and online

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<sup>35</sup> The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have held that various electronic goods are sufficiently related to computer or technology-related services such that a likelihood of

non-downloadable software are unrelated is unsupported by evidence. Because the third-parties and the applicant are providing software, it is commonplace for software developers to provide downloadable and non-downloadable software, or the CAFC or the Board precedence has established downloadable or non-downloadable software is related under Section 2(d), the applicant's argument is unpersuasive.

Because all of the submitted third-party evidence uses "eMenu" or synonymous terms to identify a generic software function for users to see online menus and photos of meals to order, the evidence overwhelmingly supports the refusal of the proposed mark under Section 2(e)(1) as the mark is generic when used in connection with the applicant's software services.

The applicant argues the presence of Supplemental Registration No. 3648978 is evidence the proposed mark is not generic because marks on the Supplemental Register must be capable of distinguishing the applicant's services. As a result of this registration, "EMENUS" cannot be a generic term. Contrarily, the Board held in *In re Medical Disposables Co.* that a registration on the Supplemental Register is **not** prima facie proof that a mark is not generic.<sup>36</sup>

Applicant has argued that its registration on the Supplemental Register provided prima facie proof that the phrase is not generic. However, applicant is advised that a registration issued on the Supplemental Register is not entitled to the presumption of Section 7(b) of the statute. It does not constitute prima facie evidence of registrant's ownership of the mark, or of its

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confusion exists when the marks at issue are otherwise identical or highly similar. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (holding PACKARD TECHNOLOGIES, with "technologies" disclaimed, for "electronic transmission of data and documents via computer terminals" to be sufficiently related to HEWLETT PACKARD marks for facsimile machines, computers, and computer software such that confusion would be likely where the marks at issue convey a similar commercial impression); *MSI Data Corp. v. Microprocessor Sys., Inc.*, 220 USPQ 655, 659-60 (TTAB 1983) (holding MSI for "computer hardware manufacturing services to the order of or specification of others" likely to be confused with MSI for "electronic ordering systems for gathering and transmitting source data comprising a recorder-transmitter and data receiver").

<sup>36</sup>*In re Medical Disposable Co.*, 25 USPQ2D 1801, 1805 (TTAB 1992)(Citing *Copperweld Corporation v. Arcair Company*, 200 USPQ 470 (TTAB 1978) and cases cited therein).



exclusive right to use the mark in commerce. In fact, it is not prima facie evidence of anything except that the registration issued.

Moreover, a term that was once arbitrary or suggestive, may lose its distinguishing and origin-denoting characteristics through use in a descriptive sense over a period of time, and may come to be regarded by the purchasing public as nothing more than a descriptive designation.<sup>37</sup>

Thus, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal.<sup>38</sup> In the applicant's case, Supplemental Registration No. 3648978 was filed in 2007. As the evidence indicates, software for viewing online menus has proliferated over the past decade. Because software for enabling users to see online menus or photos of meals to order is now commonplace, there is no guarantee the applicant's prior Supplemental Registration would be registerable today, and hence, the reason for this appeal.

The applicant argues "evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by customers, publishers, and third parties" is sufficient to save its mark from being held generic.<sup>39</sup> While this passage from *America Online* may be applicable in some cases, it is not applicable here. The case at bar is not analogous to *America Online* for several reasons. First, the marks in *America Online* revolved around the proposed mark "INSTANT MESSENGER".<sup>40</sup> This case involves a proposed mark that couples the prefix "E" with the generic term "MENUS". For the reasons already given above when a proposed mark

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<sup>37</sup> *In re Digital Research, Inc.*, 4 USPQ2d 1242, 1243 (TTAB 1987); *In re Int'l Spike, Inc.*, 190 USPQ 505, 507 (TTAB 1976).

<sup>38</sup> *In re Chippendales USA Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969).

<sup>39</sup> *In re America Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006).

<sup>40</sup> *In re America Online, Inc.*, 77 USPQ2d 1618, 1619 (four copending applications were consolidated).

couples a generic term with the prefix “E” and is used in connection with electronic services, the entire mark is generic. Obviously, this was not the case in *America Online*.

Second, the applicant in *America Online* submitted numerous pieces of evidence to rebut the examining attorney’s established prima facie case that “INSTANT MESSENGER” is generic when used in connection with the applicant’s services.<sup>41</sup> For example, the applicant submitted approximately 70 articles from NEXIS that showed 43 of those 70 correctly displayed the proposed mark.<sup>42</sup> The applicant also indicated it had over 125 million registered users that sent approximately a billion messages a day and that “INSTANT MESSENGER” receives over 28 million hits per day.<sup>43</sup> The “impressive” rebuttal of the examining attorney’s evidence created a “mixed record” on the question of genericness.<sup>44</sup> Because there was a mixed record on the question of genericness, the Board reversed the examining attorney’s determination that the proposed mark was generic. ***However***, the Board cautioned that a mixed record does not necessitate a reversal of a generic refusal.<sup>45</sup> In the case at bar, this applicant has not submitted “impressive” evidence to overcome the examining attorney’s generic refusal. Unlike the applicant in *America Online*, this applicant hasn’t submitted ***any*** evidence showing its proposed mark is not generic; instead, it has solely attacked the evidence provided by the examining attorney and all the evidence presented by the applicant is used to support its claim of acquired distinctiveness. For reasons discussed below, evidence supporting a claim of acquired distinctiveness does not *ipso facto* render the 2(f) evidence probative on the question of genericness.<sup>46</sup> Because the applicant has not provided any

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<sup>41</sup> *Id* at 1623.

<sup>42</sup> *Id* at 1622.

<sup>43</sup> *Id* at 1621.

<sup>44</sup> *Id* at 1623.

<sup>45</sup> *Id*. “We add that the mere fact that a record includes evidence of both proper trademark use and generic use does not necessarily create a mixed record that would overcome an examining attorney’s evidence of genericness.”

<sup>46</sup> *Id*. “Quite simply, it would be fairly easy for a well-heeled applicant to ensure that there were at least some stories that would properly use an applicant’s mark.” (Discussing a mixed record of evidence).

evidence rebutting the examining attorney's generic refusal like the applicant in *America Online*, the applicant's reliance on *America Online* is misplaced.

As immediately mentioned above, evidence supporting a claim of acquired distinctiveness is not inherently probative on the question of genericness because no amount of purported proof that a generic term has acquired secondary meaning can transform a term into a registerable service mark.<sup>47</sup> The examining attorney in *America Online* did not question the applicant's assertion that its marks had acquired distinctiveness and only relied on the generic evidence. Similarly and transpositionally to the examining attorney actions in *America Online*, the applicant has relied solely on its 2(f) evidence and has not provided evidence to rebut the generic argument made by this examining attorney. This is pertinent because the examining attorney in this case has contested the relevance of all the applicant's evidence used to support its claim of acquired distinctiveness. Because the applicant has only provided evidence to support its claim of acquired distinctiveness, which is challenged below, the applicant's case is not analogous to *America Online*.

Finally, the applicant in *America Online* provided evidence that it actively policed its mark and made several attempts to limit incorrect usage of "INSTANT MESSENGER". This applicant has not provided any evidence showing it is actively policing its mark nor has it provided any evidence that it is taking measures to stop or limit incorrect usage of the proposed mark. Because the applicant has not undertaken any of these actions, this case is not a corollary of *America Online*.

For all of these reasons, the case at bar is dissimilar to *America Online*.

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<sup>47</sup> *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1365, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)).

For the reasons given above, the examining attorney requests that the generic refusal be sustained.

## II. The Proposed Mark “EMENUS” Has Not Acquired Distinctiveness

An applicant bears the burden of proving that a mark has acquired distinctiveness under Trademark Act Section 2(f).<sup>48</sup> “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.”<sup>49</sup>

The amount and character of evidence required to establish acquired distinctiveness under Trademark Act Section 2(f) depends on the facts of each case and particularly on the nature of the mark sought to be registered.<sup>50</sup> An applicant’s evidentiary burden of showing acquired distinctiveness increases with the level of descriptiveness of the mark sought to be registered; a more descriptive term requires more evidence.<sup>51</sup> However, “generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be.”<sup>52</sup> The ultimate test in determining acquisition of distinctiveness under Section 2(f) is not applicant’s efforts, but applicant’s success in educating the public to associate the claimed mark with a single source.<sup>53</sup>

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<sup>48</sup> *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)); TMEP §1212.01.

<sup>49</sup> *In re Steelbuilding.com*, 415 F.3d at 1297, 75 USPQ2d at 1422.

<sup>50</sup> *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017) (citing *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960)); TMEP §1212.01.

<sup>51</sup> *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1365, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)).

<sup>52</sup> *Id.* at 1370, 127 USPQ2d at 1048 (quoting *In re Northland Aluminum Prods.*, 777 F.2d 1556, 1558, 227 USPQ2d 961, 962 (Fed. Cir. 1985)); see TMEP §1212.02(i).

<sup>53</sup> *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1856 (TTAB 2017) (citing *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985); *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1208 (TTAB 2016); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1760-61 (TTAB 1991)); TMEP §1212.06(b).

If the applied-for mark is ultimately determined to be merely descriptive and not generic, the Section 2(f) evidence of record shows that applicant's use of the mark is not substantially exclusive, and thus consumers are unlikely to view the proposed mark as an indicator of origin. The trademark examining attorney has provided evidence showing that others use the wording "EMENUS" to identify generic software services. In particular, the third-parties eZee eMenu, Lucid POS, CRS Solutions, Dytel, Bleep, Cube, Advantech, Expodine, BevEat, Restaurant Software Solutions, FireCast, and Layer Tech all use "eMenus" to identify the generic function of their software. This evidence demonstrates consumers are confronted with numerous entities using the wording "eMenus" in relation to software to enable users to see online menus and photos of meals to order such that the wording does not identify any particular source, much less that applicant is the source of the services.<sup>54</sup> Because the applicant is not exclusively using "EMENUS" in connection with software enabling users to see online menus and photos of meals to order, its Section 2(f) claim of distinctiveness is rejected.

Additionally, the declaration provided by Michael Bennett, Senior Vice-President of Global Marketing and Business Development for the applicant, is not persuasive because Mr. Bennett's declaration is self-serving. Although consumer affidavits and declarations that assert recognition of a mark as an indicator of source are relevant in establishing acquired distinctiveness, affidavits and declarations of an applicant's employees, officers, and attorneys are usually self-serving and entitled to little weight.<sup>55</sup> As such, Mr. Bennett's declaration is entitled to little weight because his declaration is self-serving.

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<sup>54</sup> See *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.")(additional case citations omitted); TMEP §1212.

<sup>55</sup> Trademark Act, Section 2(f); *In re David Crystal, Inc.*, 296 F.2d 771, 773, 132 USPQ 1, 2 (C.C.P.A. 1961); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987); *In re Cent. Counties Bank*, 209 USPQ 884, 888 (TTAB 1981); TMEP §1212.06(c).

Allegations of sales and advertising expenditures do not per se establish that a term has acquired significance as a mark.<sup>56</sup> Applicant's purported extensive sales and promotion may demonstrate the commercial success of applicant's services, but not that relevant consumers view the matter as a mark for these services.<sup>57</sup> Similarly, applicant's advertising expenditures are merely indicative of its efforts to develop distinctiveness; not evidence that the mark has acquired distinctiveness.<sup>58</sup> Here, the applicant's sales figures and advertising expenditures provided in Mr. Bennett's declaration are unpersuasive because the applicant has not provided any industry context for the figures. Because the applicant has not provided any industry context for its sales or marketing figures, the Office cannot determine if the applicant's sales or marketing figures are significant. Even if the applicant had provided industry context for its figures, sales of less than a million dollars and a marketing budget of \$5,000 dollars is minimal and does not establish consumers will identify the proposed mark as a source-identifier. Thus, the sales and marketing figures are insufficient to establish the proposed mark has acquired distinctiveness.

An applicant must also provide the actual advertising material so that the examining attorney may determine how the term is used, the commercial impression created by such use, and the significance the term would have to prospective purchasers.<sup>59</sup> In this case, the advertising banners labeled collectively as Exhibit A are unpersuasive because this material does not demonstrate consumers identify "EMENUS" as the source of the applicant's services. Instead, consumers will identify "CENDYN"/"CENDYN ARCANEO" as the source of the services, not "EMENUS" as the term appears as one of many generic software functions. Because the advertising banners do not show consumers will

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<sup>56</sup> See TMEP §1212.06(b).

<sup>57</sup> *In re Boston Beer Co.*, 198 F.3d 1370, 1371-73, 53 USPQ2d 1056, 1057-58 (Fed. Cir. 1999); *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1132-34 (TTAB 2000).

<sup>58</sup> See *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1757-58 (TTAB 1991).

<sup>59</sup> *In re Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984); TMEP §1212.06(b).

identify “EMENUS” as indicating the source of the applicant’s services, the exhibits collectively labeled as Exhibit A do not establish the proposed mark has acquired distinctiveness.

Aside from Mr. Bennett’s declaration and the exhibits collectively labeled as Exhibit A, the remaining exhibits provided by the applicant are comprised of press releases. *In re Tennis Industry Association*, the Board enumerated several factors to consider when determining whether submitted press releases or other marketing material have established a proposed mark has acquired distinctiveness.<sup>60</sup> The relevant factors from *Tennis* in the case are: the number of press releases spanning a period of time, the contextual information provided by the applicant about the press releases that demonstrates the manner and extent of the press releases or to whom they are directed, and whether an article focuses on the proposed mark or mentions the proposed mark within a larger context of stories concerning other entities or marks. *Id.*

In *Tennis* the applicant provide nearly 500 articles over an approximately 16 year period. The Board determined that 500 articles over a 16 year period is not necessarily compelling evidence that the relevant public recognizes the proposed mark as a source-identifier. *Id.* Here, the applicant has provided three press releases over approximately 12 years use. If 500 articles over 16 years is insufficient to demonstrate a proposed mark has acquired distinctiveness as in *Tennis*, then three press releases over 12 years use is even less demonstrative that a proposed mark has acquired distinctiveness.

Moreover, like the applicant in *Tennis*, the applicant has not provided any contextual information about the manner and extent of its press releases nor whom they were directed. It is common knowledge that the internet permits anyone to post and make public anything. However, just because anyone can post anything doesn’t mean anyone has viewed the posting or has heard about it. Because the applicant has not provided any contextual information about its press releases, the Office

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<sup>60</sup> *In re Tennis Industry Association*, 102 USPQ2d 1671, 1681 through 1682.

cannot discern how the applicant's press releases were disseminated, nor can it determine whom the press releases were directed. Thus, the press releases comprising Exhibits Q, R, and S are of little probative value when determining if the proposed mark has acquired distinctiveness under Section 2(f).

Finally, Exhibit R appears to be the only unsolicited third-party publication. Despite this, the applicant is simply mentioned in the larger context of stories concerning other entities in the hospitality industry. Because the applicant is mentioned along with several other entities in the article, the applicant's mark is not likely to be noted by consumers.

For these reasons, this evidence is insufficient to show the proposed mark has acquired distinctiveness under Section 2(f).

### **Applicant's Arguments**

The applicant argues the Board's holding in *In re Uncle Sam Chem. Co.*, entitles it to a "presumption of secondary meaning" due to its years of use in commerce.<sup>61</sup> Nowhere in this case does the Board hold an applicant is entitled to a presumption of secondary meaning due to an extended time period of use in commerce. Unlike this case, the applicant in *Uncle Sam* showed it was exclusively using its mark in commerce. Here, there is ample evidence demonstrating the applicant is not exclusively using its mark in commerce. Therefore, any reliance on *Uncle Sam* is misplaced and the applicant is not entitled to a presumption of secondary meaning due to its use of the mark in commerce over a period of time.

Next, the applicant argues Mr. Bennett's declaration should be given significant weight when determining whether the proposed mark has acquired distinctiveness because even though Mr. Bennett is employed by the applicant, there isn't any evidence of actual bias. The Court of Appeals for the

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<sup>61</sup> *In re Uncle Sam Chem. Co.*, 229 USPQ 233 (TTAB 1986).



Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney's action.<sup>62</sup> The examining attorney doesn't have the resources to investigate Mr. Bennett or submit interrogatories to Mr. Bennett for the purposes of establishing actual bias. Despite this, and for the reasons already given above, Mr. Bennett's declaration is entitled to little weight when determining if a proposed mark has acquired distinctiveness.

The applicant has relied on *Kellog Co. v. General Mills, Inc.*, to argue Mr. Bennett's testimony is entitled to significant weight because the examining attorney has not provided evidence of Mr. Bennett's bias.<sup>63</sup> However, the applicant's reliance on *Kellog* is misplaced because *Kellog* is an *inter partes* case. Unlike this *ex parte* case, the applicant and opposer in *Kellog* were represented by legal counsel having the full array of litigation tools, including discovery. Because the inherent structure of *inter partes* and *ex parte* proceedings differ, the examining attorney does not have the capability to and cannot engage in the same litigation maneuvers as counsel in an *inter partes* proceeding. Therefore, the applicant's reliance on *Kellog* is misplaced.

Finally, the applicant argues its press releases are validated and should be given substantial weight because the examining attorney has not provided evidence that questions the authenticity of professional's comments in the press releases. As already mentioned, the Office has limited resources for obtaining the evidence and doesn't perform cross examinations. This red herring does not permit the applicant to dismiss its failure to provide contextual information about its press releases, nor does it

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<sup>62</sup> See *In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (citing *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985)); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.4 (TTAB 2016) (quoting *In re Budge Mfg., Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260-61 (Fed. Cir. 1988)); TBMP § 1208 nn.2 & 9.

<sup>63</sup> *Kellog Co. v. General Mills, Inc.*, 82 USPQ2d 1766, 1772 (TTAB 2007).

validate the probity or increase the significance of its press releases when determining if a mark has acquired distinctiveness. For the reasons given above, the press releases are entitled to little weight when determining whether the proposed mark has acquired distinctiveness.

Because the totality of the evidence provided by the applicant to support its claim of acquired distinctiveness is self-serving, it is insufficient to support the applicant's claim of acquired distinctiveness.

### **CONCLUSION**

The proposed mark "EMENUS" is generic because it is a type of function or genus of the services identified in the application and the relevant public would primarily understand it as such. Therefore, it must be refused registration under Trademark Act Section 2(e)(1) because generic designations can never acquire distinctiveness.

In the alternative, the proposed mark is refused registration under Trademark Act Section 2(e)(1) because the applicant has failed to demonstrate the highly descriptive "EMENUS" mark has acquired distinctiveness under Trademark Act Section 2(f).

For the foregoing reasons, the Examining Attorney respectfully requests the refusal of registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and the refusal to accept the claim of acquired distinctiveness based on Section 2(f) of the Trademark Act, 15 U.S.C. Section 1052(f), be affirmed.

Respectfully submitted,

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