

This Opinion is not a
Precedent of the TTAB

Mailed: August 17, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Halal Shack Inc.

Serial No. 87633904

David L. Principe of Phillips Lytle LLP,
for The Halal Shack Inc.

John S. Miranda, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Gorowitz, Heasley, and Lynch,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

The Halal Shack Inc. (“Applicant”) seeks registration on the Principal Register of the mark THE HALAL SHACK (in standard characters, with “HALAL” disclaimed) for “restaurant services” in International Class 43.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark

¹Application Serial No. 87633904 was filed on October 4, 2017, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as February 4, 2017.

Page references to the application record are to the .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

under Section 2(e)(1) of the Trademark Act on the ground that it is merely descriptive of its services. 15 U.S.C. § 1052(e)(1). After issuing an initial Office Action on Jan. 12, 2018 refusing registration on the ground of mere descriptiveness,² the Examining Attorney accepted Applicant's disclaimer of "HALAL" apart from the mark as a whole, and approved the application for publication on January 23, 2018.³ But on February 12, 2018, the Examining Attorney withdrew his approval and reinstated the refusal based on mere descriptiveness under Section 2(e)(1).⁴

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

I. Discussion

A. Applicable Law

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act precludes registration of a mark on the Principal Register that is merely descriptive of an applicant's goods or services. 15 U.S.C. § 1052(e)(1). A term is merely descriptive within the meaning of Section 2(e)(1) "if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831

² Jan. 12, 2018 Office Action.

³ Jan. 23, 2018 Notation to File.

⁴ Feb. 12, 2018 Office Action.

(Fed. Cir. 2007)); *see also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). “Whether a mark is merely descriptive cannot be determined in the abstract or on the basis of guesswork. Descriptiveness must be evaluated “in relation to the particular goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use.” *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Bayer AG*, 82 USPQ2d at 1831). In other words, we evaluate whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1810-11 (TTAB 2018).

“It is the Examining Attorney’s burden to show, prima facie, that a mark is merely descriptive of an applicant’s goods or services. *In re Gyulay*, [820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)]; *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2052 (TTAB 2012). If such a showing is made, the burden of rebuttal shifts to the applicant. *In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003). The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant. *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994).” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1512 (TTAB 2016).

While we must consider the impression made by THE HALAL SHACK as a whole, we may preliminarily consider the meanings of the words it comprises. *In re*

Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1374 (Fed. Cir. 2004); *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1779 (TTAB 2017). “THE” is a definite article possessing no trademark significance. *See In Re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

“HALAL” describes the type of food featured in Applicant’s restaurant: “Halal food and meats are sourced and prepared following Islamic dietary guidelines to ensure not only the highest quality but also the humane treatment of the animals they came from.”⁵ A mark that consists of a featured food of a restaurant has been held merely descriptive of the restaurant services provided by the restaurant. *E.g.*, *In re Fr. Croissant, Ltd.*, 1 USPQ2d 1238, 1239 (TTAB 1986) (holding LE CROISSANT SHOP merely descriptive of an eating establishment where croissants are the principal attraction, even though other items are available); *In re Le Sorbet, Inc.*, 228 USPQ 27, 28 (TTAB 1985) (holding LE SORBET descriptive of restaurant and carryout shops that serve fruit ices); *In re General Franchising Corp.*, 169 USPQ 55 (TTAB 1971) (“the identification of a restaurant by the name of the food which is the specialty of the house is merely descriptive of the restaurant...”); *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1637-38 (Fed. Cir. 2016) (finding CHURRASCOS generic for restaurant services specializing in barbecued meat). For this reason, Applicant disclaimed “HALAL” in its application.⁶ *See In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014 n. 4 (TTAB 1988) (disclaimer concedes mere

⁵ Applicant’s website TheHalalShack.com 2/12/2018, Feb. 12, 2018 Office Action TSDR pp. 7-8.

⁶ Application, Oct. 4, 2017.

descriptiveness).

The crux of this dispute centers on the significance of the word SHACK, as used in connection with Applicant's restaurant services.

B. The Examining Attorney's and Applicant's Arguments

The Examining Attorney contends that "SHACK" merely describes the nature of the venue in which applicant's restaurant services are provided."⁷ Restaurants provide their services in a wide variety of buildings, he argues, including a SHACK, defined as "a simple, small building."⁸ In support of this position, the Examining Attorney adduces an article from Thrillist, an online media website covering food, drink, travel and entertainment, entitled "The 21 Best SEAFOOD SHACKS in America."⁹ The Thrillist article (updated, with some changes, in the Huffington Post)¹⁰ provides brief reviews of the restaurants, some of which have the word SHACK in their names, such as "The Clam Shack", "Da Poke Shack", "The Crab Shack", and "Flo's Clam Shack." In further support of his position, the Examining Attorney cites a dozen third-party registrations in which the term SHACK has been treated descriptively, e.g.:

- Reg. No. 4915681 for the mark "RAMEN SHACK" for "Restaurant services" with RAMEN disclaimed, on the Supplemental Register.¹¹

⁷ Examining Attorney's brief, 9 TTABVUE 3.

⁸ Id. 9 TTABVUE 9 citing Dictionary.Cambridge.org 3/26/2018, March 26, 2018 Office Action TSDR p. 11.

⁹ Thrillist.com 3/5/2018, March 5, 2018 Office Action TSDR pp. 14-48.

¹⁰ Huffingtonpost.com 3/5/2018, March 5, 2018 Office Action TSDR pp. 49-58.

¹¹ Office Action of March 26, 2018, TSDR pp. 6-7.

• Reg. No. 5238173 for the mark “MARY’S SLICE SHACK” for “Restaurant services”, which includes a disclaimer of “SLICE SHACK.”¹²



• Reg. No. 5254254, for the word and design mark , featuring the literal element “SURF SNACK SHACK & Design” for “Restaurant services; Restaurant services featuring sandwiches; Restaurant services featuring acai bowls, paninis, smoothies, and coffee.; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Fast casual restaurants”, which disclaims “SURF SNACK SHACK.”¹³

• Reg. No. 5326004 for the mark “THE POKE SHACK” for “Food preparation services featuring raw fish; Restaurant; Restaurant services featuring raw fish; Restaurant services”, with POKE disclaimed, on the Supplemental Register.¹⁴

• Reg. No. 5351138 for the mark “CRAZY CRAB SHACK” for “Restaurant and café services; Restaurant and catering services; Restaurant services featuring seafood; Restaurant services, including sit-down service of food and take-out restaurant services; Mobile restaurant services”, which includes a disclaimer of “CRAB SHACK.”¹⁵

¹² Office Action of March 5, 2018, pp. 6-7.

¹³ Id. pp. 8-10.

¹⁴ Id.

¹⁵ Office Action of February 12, 2018, pp. 14-16.

From this evidence, the Examining Attorney infers that the term SHACK “is frequently used by third parties in describing characteristics of their restaurants, and thus there is a competitive need to the use of this term in the restaurant industry,” in order “(1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits”¹⁶

Applicant counters that the term SHACK, as used in the context of its mark, is suggestive, not descriptive, of its restaurant services. Unlike a merely descriptive term, which *immediately* conveys knowledge, “THE HALAL SHACK only *indirectly* suggests information about the qualities or characteristics of Applicant’s services,” Applicant insists.¹⁷ “[R]estaurants do not provide their services literally in shacks,” Applicant argues.¹⁸ A “shack” is the same as a “shanty” or a “hut,”¹⁹ i.e., “an often small and temporary dwelling of simple construction: shack.”²⁰ “Food service is a highly regulated industry for obvious reasons and a ‘shack’ according to its commonly understood definition would not pass inspection by any state or local authority and certainly would not be a place that would be desirable for serving food,” Applicant states. “A restaurant may choose to use a rustic décor that resembles the appearance of a ‘shack’ in some aspects, but to state that food is being literally being served in

¹⁶ Examining Attorney’s brief, 9 TTABVUE 4, 8; March 5, 2018 Office Action TSDR p. 4, *citing In re Abcor Dev. Corp.*, 200 USPQ at 217.

¹⁷ Applicant’s brief p. 8, 7 TTABVUE 13.

¹⁸ *Id.* at p. 6, 7 TTABVUE 11.

¹⁹ Merriam-Webster.com/dictionary/shack 1/12/2018, Jan. 12, 2018 Office Action TSDR p. 15.

²⁰ March 6, 2018 Response to Office Action TSDR p. 6 citing Merriam-Webster.com/dictionary/hut.

shacks is not accurate.”²¹ For example, in the article(s) cited by the Examining Attorney, the term “shack” is used “about seaside restaurants many of which include the term ‘shack’ in their names or have a rustic décor intended to resemble a shack. ... In fact, some of the restaurants included in the list are in nice buildings that would never be descriptively referred to as ‘shacks,’” Applicant argues.²² For example:



²¹ Applicant’s brief p. 6, 7 TTABVUE 11.

²² Id. p. 5, 7 TTABVUE 10.



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In the case of those restaurants, as in Applicant’s case, the use of the word “SHACK” is at most suggestive of the relevant services, requiring imagination, thought, and perception to determine the nature of those services, Applicant submits.²⁴

To demonstrate the suggestive, and therefore inherently distinctive, nature of the word SHACK as used in the context of restaurant services, Applicant adduces eleven active third-party registrations on the Principal Register in which the term SHACK was not disclaimed:

²³ March 5, 2018 Office Action TSDR pp. 37-38, 50, 56.

²⁴ Id. p. 9, 7 TTABVUE 14.

Mark	Reg. No.	Supplemental or 2(f)	Services	Disclaimer
BURGER SHACK	4,575,716	No	Restaurant services	"Burger"
FRAPPE SHACK	4,280,430	No	Restaurant	"Frappe"
GRUB SHACK	5,297,337	No	Restaurant services	"Grub"
GYRO SHACK	4,221,410	No	Restaurant services	"Gyro"
SALAD SHACK	4,333,188	No	Restaurant services	"Salad"
SLIDER SHACK	4,474,565	No	Restaurant services	"Slider"
THE BAGEL SHACK	4,894,747	No	Restaurant services	"Bagel"
SHAKE SHACK	3725489	No	Restaurant services	"Shake"
	3853559	No	Restaurant services	"Shake"
	3853578	No	Restaurant services	"Shake"
	5377896	No	Restaurant services	"Halal"

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In these registrations (the last of which is its own registration), Applicant notes that the registrants were not required to disclaim SHACK, just as other restaurant service providers were not required to disclaim HUT. For example:

- Reg. No. 729847 for the mark PIZZA HUT for “restaurant services” (PIZZA disclaimed),
- Reg. No. 4806789 for the mark CRAB HUT for inter alia “restaurant and catering services” (CRAB disclaimed),
- Reg. No. 4631795 for the mark SHRIMP HUT for “restaurant services” (SHRIMP disclaimed),

²⁵ March 6, 2018 Response to Office Action TSDR p. 4.

- Reg. No. 4334540 for the mark BAGEL HUT for “restaurant services, namely, providing of ready-made food, bagels and baker goods for consumption on and off the premises” (BAGEL disclaimed).²⁶

These examples treat SHACK or HUT as inherently distinctive, not requiring a disclaimer, Applicant observes. In contrast, many of the registrations cited by the Examining Attorney, such as “MARY’S SLICE SHACK”, “CRAZY CRAB SHACK”,



and , include additional distinctive terms and/or designs that make acceptance of a disclaimer less of an issue for their respective applicants.²⁷ In any event, Applicant argues, if one construes the Section 2(e)(1) mere descriptiveness provision in light of its purposes—(1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits—disclaimer of SHACK is not required in any of these restaurant service registrations “because ‘shack’ is highly dilute based on widespread use by so many third parties as a part of composite marks for restaurant services. Allowing the Applicant to obtain a registration for its composite mark without disclaiming ‘shack’ will not prevent anyone from using ‘shack’ in a different composite mark for restaurant services.”²⁸

The Examining Attorney maintains, however, that diluted or weak marks are still

²⁶ March 6, 2018 Response to Office Action TSDR pp. 9-12, Applicant’s brief p. 5, 7 TTABVUE 10.

²⁷ Applicant’s brief pp. 4-5, 7 TTABVUE 9-10.

²⁸ Id. at 6, 7 TTABVUE 11.

entitled to protection under Section 2(d) against registration by a subsequent user of a similar mark for closely related services, citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (CCPA 1974) and *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010), “and accordingly, applicant’s claim that allowance of its mark ‘will not prevent anyone from using “SHACK” in a different composite mark’ is not true, since applicant’s mark could serve as the basis for Section 2(d) refusals in the future.”²⁹

Moreover, the Examining Attorney maintains, other registrations are not conclusive on the question of mere descriptiveness.³⁰ See *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977). For example, during prosecution of Applicant’s Principal Register Registration No. 5377896 for the word and design



mark , the Office required a disclaimer of the literal portion, THE HALAL SHACK; Applicant made the disclaimer and the application was approved for publication; following receipt of a post-publication amendment, the disclaimer was amended to delete reference to “SHACK.” The Examining Attorney states that “[i]t is unclear if the application processing steps provided in TMEP §§ 1501.01(b) and 1505.02(e) were followed in that case.”³¹ Furthermore, Applicant owns Supplemental

²⁹ Examining Attorney’s brief, 9 TTABVUE 9.

³⁰ Id. 9 TTABVUE 5.

³¹ Id. 9 TTABVUE 4 n. 1. The cited TMEP sections, *inter alia*, generally require republication if a post-publication amendment deletes a disclaimer.

Register Registration No. 5331791 for THE HALAL SHACK (in standard characters); following a final refusal under Section 2(e)(1), Applicant amended that application to seek registration on the Supplemental Register on September 18, 2017; yet barely two weeks later, on October 4, 2017, it filed the present application to register the same word mark on the Principal Register, without a showing of acquired distinctiveness under Section 2(f).³²

We address the significance of these considerations, as well as others in the briefs and record, next.

C. Analysis

To distinguish terms that are merely descriptive from marks that are suggestive, the Federal Circuit has explained:

The line between a mark that is merely descriptive and may not be registered absent secondary meaning, and one that is suggestive and may be registered, is that a suggestive mark requires imagination, thought and perception to reach a conclusion as to the nature of the goods [or services], while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services].

DuoProSS Meditech v. Inviro Med. Devices, 103 USPQ2d at 1755 quoted in *Earnhardt v. Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (internal citations and quotation marks omitted). See also *In re Gyulay*, 3 USPQ2d at 1009-10.³³ These categories are in actuality “central tones in a spectrum,” *id.* at 1010 (citing

³² *Id.*; March 5, 2018 Office Action TSDR pp. 61-62.

³³ “The three-part test described in *No Nonsense Fashions* has been superseded in the Federal Circuit by the rule ... enunciated in *In re Gyulay*, 3 USPQ2d 1009, *In re Chamber of Commerce of the U.S.*, 102 USPQ2d 1217, and *DuoProSS*, 103 USPQ2d 1753; see *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (rejecting the tests set out in *No Nonsense Fashions*.” *In re Fat Boys Water Sports*, 118 USPQ2d at 1514.

Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 207 USPQ 278, 282 (5th Cir. 1980), cert. denied, 450 U.S. 981, 210 USPQ 776 (1981). “On the spectrum of distinctiveness, the dividing line between merely descriptive and suggestive is a fine one.” *In re Future Ads LLC*, 103 USPQ2d 1571, 1574 (TTAB 2012).

The Board’s reasoning in *In re Recovery, Inc.*, 196 USPQ 830, 831-32 (TTAB 1977) is helpful in determining the side of the line on which Applicant’s term falls:

It has been recognized that there is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness The difficulty in determining the suggestiveness or descriptiveness of a mark is vividly demonstrated in this case. The term ..., when considered in light of applicant’s services appears, at first blush, to possess a descriptive significance. But, to articulate the manner in which the term ... describes those services, one cannot come up with an immediate response, but rather must engage in a mental process involving imagination, speculation, and possibly stretching the meaning of the word to fit the situation.

Id., quoted in *In re Universal Water Systems, Inc.*, 209 USPQ 165, 167 (TTAB 1980).

Here, as in *In re Recovery*, the term SHACK, as used in connection with Applicant’s restaurant services, appears at first blush to describe the sort of building in which the services are provided. But to articulate the way the term conveys information about the restaurant services, one must engage in a mental process involving imagination, thought and perception, realizing that the term is more figurative than literal, more connotative than denotative, conveying the commercial impression of informal ambiance. As Applicant correctly observes, the “seafood shack” article and its reprint, included in the record as the only evidence of

descriptiveness, apart from third-party registrations, uses the term “seafood shack” in reference to a variety of restaurants, some of which are neither small nor simple. The term “seafood shack”, as used in the article, is not literal, but figurative, implying that the restaurant services will be provided in an informal atmosphere. This figurative significance of “shack” as used in the article does not suffice as a basis for finding that “shack” is merely descriptive—i.e., that it immediately and directly conveys information about Applicant’s restaurant services. Rather, as in *In re Recovery*, the term conveys its connotation to consumers indirectly and inferentially—in a word, suggestively. *Compare In re Dean S. Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009) (URBANHOUSING “will be immediately and directly perceived by consumers as the equivalent of the admittedly descriptive term URBAN HOUSING....”) with *In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796, 1798 (TTAB 2017) (“On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.”).

The third-party registrations cited above send mixed signals. Third-party registrations can “show the sense in which ... a mark is used in ordinary parlance” and “are relevant to prove that some segment of the composite [mark] . . . has a normally understood and **well recognized descriptive or suggestive meaning.**” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (emphasis added; citing 2 MCCARTHY ON TRADEMARKS AND UNFAIR

COMPETITION § 11:90 (4th ed. 2015)). The third-party registrations cited by the Examining Attorney show the term SHACK treated as descriptive, either in Supplemental Register registrations or disclaimed, often in composite marks with other distinctive terminology. See *In re American Furniture Warehouse Co.*, 126 USPQ2d 1400, 1404 (2018) (“However, ‘[s]uch third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services’....”) (quoting *Institut National des Appellations D’Origine v. Vintners Int’l Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992)). But the third-party registrations cited by Applicant demonstrate a nearly equal number of marks for restaurant services treating the term SHACK as inherently distinctive; and eight of those marks consisted simply of the name of a food or beverage (e.g., BURGER or SHAKE, disclaimed) coupled with SHACK (not disclaimed). We agree with the proposition cited by the Examining Attorney that third-party registrations are not conclusive on the question of descriptiveness, and each case must stand on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Scholastic Testing Serv.*, 196 USPQ at 519. Here, it appears to us, the third-party registrations, taken together, demonstrate that SHACK is not necessarily descriptive of restaurant services, and may, depending on the record, be found inherently distinctive.

Applicant’s two registrations, one for THE HALAL SHACK and Design, the other a word mark in standard characters, warrant the same conclusion: The first

registration, on the Principal Register, implies that SHACK is inherently distinctive; the second registration, on the Supplemental Register, implies the opposite. Each registration has a different record. A mark owner's acceptance of registration on the Supplemental Register constitutes an admission that the mark is descriptive at the time of registration. *E.g.*, *In re Future Ads*, 103 USPQ2d at 1574; *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978); *see generally* 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:43 (5th ed. June 2018 update); A. Gilson LaLonde and J. Gilson, "The United States Supplemental Register: Solace, Substance, or Just Extinct?" 103 Trademark Reporter 828, 875 (2013). "In any event, neither the Board nor the Supplemental Registrant is bound by such an 'admission.'" *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1744, n. 5 (TTAB 2016).³⁴ Applicant's prior registration on the Supplemental Register does not prevent it from contending that its mark is inherently distinctive in this application. 15 U.S.C. § 1095; *see In re Hester Industries, Inc.*, 230 USPQ 797, 798 (TTAB 1986). If its acceptance of the Supplemental Register registration is taken as an admission that SHACK is merely descriptive, its registration on the Principal Register stands for the opposite. So as with the third-party registrations cited above, Applicant's own registrations are inconclusive on whether SHACK is descriptive or suggestive of restaurant services.

³⁴ *See also In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars).

In this case, based on this record, we find that Applicant’s word mark, THE HALAL SHACK, taken as a whole, falls more on the suggestive than the descriptive side of the spectrum. The evidence before us indicates that the term SHACK does not so much directly describe a restaurant venue as figuratively suggest an informal ambiance. Where, as here, “the use is figurative or poetic, the term is necessarily suggestive unless it can be shown that the term is used in the trade or by the public to describe.” *In Re Aga Aktiebolag*, 159 USPQ 55, 56 (TTAB 1968). The Examining Attorney had the opportunity and the burden of proving that the figurative term SHACK had, through common usage, become descriptive of certain restaurant services such as Applicant’s. *See In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681,1686-87 Fed. Cir. (2010) (“A term or device that was once inherently distinctive may lose its distinguishing characteristics over time.”) (citing *Remington Products Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1449 (Fed. Cir. 1990) (“It is very easy for marks consisting of common, simple English words having connotations related to the products on which they are used, their properties, or uses to slip out of their origin-indicating role into the vernacular as descriptive terms and once that happens the possibility of registration as trademarks under the Lanham Act vanishes.”)). But the evidence adduced in the record—a single updated article and inconclusive third-party registrations—is too meager to carry this burden. Furthermore, the term SHACK, when coupled with HALAL, which describes food sourced and prepared following strict Islamic dietary guidelines, creates a degree

of incongruity that carries the mark as a whole even further across the fine line dividing the merely descriptive from the suggestive.

While a different record, such as might be adduced in an opposition proceeding, might very well yield a different result, based on the record in this case we cannot find that THE HALAL SHACK is merely descriptive of Applicant's services. Based on the record evidence, the applied-for mark appears to us to be highly suggestive and commercially weak, and thus easily distinguished from other composite marks by minor differences, but it is nonetheless inherently distinctive, and eligible for registration on the Principal Register. *See In re The Realistic Co.*, 440 F.2d 1393, 169 USPQ 610 (1971) (highly suggestive mark not so descriptive as to preclude registration).

II. Conclusion

For the foregoing reasons, on consideration of all the arguments and evidence of record, we find that the applied-for mark is not merely descriptive under Section 2(e)(1).

Decision: The refusal to register Applicant's mark THE HALAL SHACK is reversed.