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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nostalgia Network, Inc.

Serial No. 78147904

Kenneth H. Oh of Baker & Hostetler, LLP for Nostalgia Network, Inc.

Tonja M. Gaskins, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Chapman, Holtzman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 26, 2002, Nostalgia Network, Inc. (applicant) filed an application (Serial No. 78147904) to register the mark EMBASSY CHEFS, in standard character form, on the Principal Register for services ultimately identified as "entertainment services, namely, providing television programs in the field of culture and cuisine broadcast over television, satellite, audio, and video media" in Class 41.

The application contains an allegation that the mark was first used on December 12, 2001, and in commerce on July 8, 2002.¹

The examining attorney refused registration on the ground that the mark was merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), of the services because "the proposed mark merely describes the subject matter of applicant's television program which feature[s] embassy chefs or chefs from various embassies." Brief at 3. The examining attorney also required that applicant submit an acceptable specimen because the original specimen, a memorandum used to solicit vendors, is "an announcement or informational sheet about future services." Brief at 5.

Applicant, on the other hand, argues that the Office has registered similar marks on the Principal Register and the "fact that a chef appears to demonstrate how to prepare the cuisine is ancillary to Applicant's services. As such, the mark should be found suggestive and allowed on the Principal Register." Brief at 2. Regarding the specimens,

¹ The application also originally contained an allegation that applicant had a bona fide intent to use the mark in commerce. Applicant subsequently deleted the intent-to-use basis.

applicant argues that the specimen "is an advertising material that uses the mark EMBASSY CHEFS." Brief at 6.

Descriptiveness Refusal

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). "Such qualities or properties include color, odor, function, dimensions, or ingredients." In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987) (internal quotation marks omitted). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, we must consider whether the mark in its entirety is merely descriptive. P.D. Beckwith, Inc., 252 U.S. at 545-46.

The examining attorney has submitted printouts from the www.goodtv.com website about the "Embassy Chefs"

program.² This is "Applicant's website." Applicant's Brief at 2. The following are descriptions (emphasis added) about the show.³

Embassy Chefs

Satisfy your appetite for international cuisine along with an appreciation of travel, food and culture on GoodLife TV Network's Embassy Chefs. Tour Washington D.C.'s famous Embassy Row and get an insiders look at these remarkable embassies and the fabulous residences of ambassadors while at the same time receiving insight to their country and customs. Then meet the **embassy's chef** and find out how food ties into the national culture as they prepare a menu fit for a state dinner.

Korea ...

Exotic dishes are prepared by the South Korean **Embassy's renowned chef**, Sue Kyung Lee...

Mexico

View the Mexican Cultural Center filled with historic art exhibits, photo galleries and 1500 year old artifacts. Then Lucero Duran, the **Embassy's chef**, will prepare Lime Soup, Salsa Verde, Roasted Pork Tenderloin with Ancho Chile Sauce and for desert; Bunuelos with Chocolate and Nuts.

Ethiopia ...

We will learn from the **Embassy Chef** how to prepare the traditional Ethiopian dishes of Doro Wat, Tibs, Kitfu, and Miser Wat...

Brazil

Receive a personal tour of the Brazilian Ambassador's residence from the Ambassador's wife. We will also explore cuisine and culture of South America's largest country. And the Brazilian **Embassy Chef** will prepare Brazilian Soup, Crab Cakes with Coconut, Farofa with Black Beans and finish with a sorbet made of Brazilian white cheese from the Minas region with a Guava sauce.

² The copyright notice for the webpage identifies the copyright holder as "Nostalgia Network, Inc."

³ The material as quoted contains several examples of non-standard English grammar uses.

Egypt

Explore the cuisine and culture of a country like no other when you tour the Washington, DC residence of the Egyptian ambassador. The **embassy's chef** will prepare Grilled Mullet with Coriander Sauce, Shish Kebab with Oriental Rice and for dessert, Om Ali, a treat with quite a story behind it.

Germany

We will tour the magnificent residence of the German Ambassador, where art, furnishings and structure create an impressive unity of design. Then, the **Embassy's world-class chef** will show us how to prepare his inventive twist on the classic strudel with Lobster Strudel with Riesling Sauce, followed by Seared Venison in a traditional sweet-and-sour sauce, served with Pear Confit, and for dessert, Quark Mousse with Sour Cherries.

Also, the examining attorney included a GoodLifeTV.com list of the network's programs with a description of each. For Embassy Chefs, the program is similarly described as indicated previously: "Tour Washington D.C.'s famous Embassy Row and get an insiders look at these remarkable embassies and the fabulous residences of ambassadors. Meet the embassy's chef as they prepare a menu fit for a state dinner."

Furthermore, the examining attorney points out that "applicant concedes in its response of July 9, 2003, that '... applicant's entertainment services [have] chefs working at various embass[ies].'" Brief at 4.

The evidence makes it clear that embassies often have a chef attached to their staff. These chefs are referred

to as the "embassy's chef" or the "embassy chef."

Applicant's television program will feature, at least in part, a segment where an embassy chef prepares dishes of the embassy's country. Indeed, many of the descriptions of the programs indicate that the show consists of two parts - a tour of the embassy or the ambassador's residence followed by the embassy's chef preparation of that country's dishes. See, e.g., Segments concerning Mexico, Brazil, Egypt, and Germany. We find that the segment where the embassy chef prepares the country's dishes is a significant feature of applicant's EMBASSY CHEFS programs. MBNA, 67 USPQ2d at 1781 ("We therefore conclude that substantial evidence supports the Board finding that MONTANA SERIES and PHILADELPHIA CARD merely describe a significant feature of MBNA's affinity credit card services").

Applicant responds to this evidence by arguing that "the U.S. Trademark Office database of registered trademarks lists numerous marks on the Principal Register that are similar to Applicant's mark." Brief at 3. We begin by noting that the Federal Circuit has held that "[e]ven if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind

the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Therefore, even if these other registrations were relevant, they certainly do not support the registration of a term that the evidence shows is merely descriptive. Next, we point out that none of these registrations contains the word "embassy." Third, several of the listed trademarks are for applications that have not registered. An application does not have much probative value. Zappia-Paradiso, S.A. v. Cojeva Inc., 144 USPQ101, 102 n.4 (TTAB 1964) ("Opposer has also submitted in evidence a copy of the file of an application for registration ..., but such material is incompetent as proof of anything other than the fact that such an application for registration was filed in the Patent Office"). Therefore, the third-party registrations for other trademarks do not indicate that applicant's mark is not descriptive.

In this case, we are persuaded that the term EMBASSY CHEFS when used in connection with television programs in the field of culture and cuisine would immediately inform potential users of the services that the programs involve chefs from embassies creating their national dishes. The description of the contents of the television program is a significant feature of applicant's mark. Accord Gyulay, 3

USPQ2d at 1010 ("Clear error has not been shown that the term APPLE PIE conveys the key characteristic of the potpourri, its scent); In re Andes Candies Inc., 478 F.2d 1264, 178 USPQ 156, 157 (CCPA 1973) ("We think the only possible reaction of purchasers, upon being presented with CREME DE MENTHE chocolate wafers, is the expectation that the wafers will have a mint taste something like that of creme de menthe liqueur. Surely, the purchasers would not expect to find a cherry or rum or butterscotch flavor in the candies"). Applicant's reference to Stork Restaurant, Inc. v. Sahati, 166 F.2d 348, 76 USPQ 374 (9th Cir. 1948) is inapposite. In that case, the court found that:

"The Stork Club" is a trade name that, in the language of the books, might well be described as "odd," "fanciful," "strange," and "truly arbitrary." It is in no way descriptive of the appellant's night club, for in its primary significance it would denote a club for storks. Nor is it likely that the sophisticates who are its most publicized customers are particularly interested in the stork."

Id. at 379. Unlike that case, here there is nothing odd or fanciful about referring to a show that features embassy chefs as EMBASSY CHEFS. As such, the term EMBASSY CHEFS is merely descriptive of applicant's services, and we affirm the examining attorney's refusal.

Specimen Requirement

Next, we address the examining attorney's second refusal to register applicant's mark. The Trademark Act (15 U.S.C. § 1051(a)(1)) requires applicants asserting use in commerce to submit "such number of specimens or facsimiles of the mark as used as may be required by the Director." The Trademark Rules (37 CFR § 2.56(a)) specify that applicants must submit "one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce."

Here, the examining attorney required applicant to submit an acceptable specimen because the original specimen "does not show use of the mark in the sale or advertising of services rendered in commerce. Instead, the specimen is an announcement or informational sheet about future services." Brief at 5. Applicant responds by merely asserting that the "specimen, as originally submitted, is an advertising material that uses the mark EMBASSY CHEFS in connection with its services." Brief at 6. The specimen contains the following statements (emphasis added):

Embassy Chefs

GoodLife TV Network *proposes* a unique program designed to foster understanding and celebrate the varied cultures of the world we share through the fellowship of food.

"Embassy Chefs," a half-hour program produced by GoodLife TV Network and hosted by antiques expert and former restaurateur Christopher Kent, will take viewers on tours of individual embassies located in Washington, D.C., during which an embassy representative will immerse them in that country's culture and history. Every tour will end in the Embassy kitchen where the resident chef will create his or her national dishes and toast the diplomacy of breaking bread together.

We agree with the examining attorney that the specimen is referring to future programming and not to services that were being offered at that time. Other than traversing the examining attorney's refusal, applicant has not submitted any evidence that contradicts the statements in the specimen that refer to future services. Our case law has held that specimens that refer to services that will be performed in the future are not acceptable specimens.

A service mark means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others. The specimens submitted are nothing more than announcements of applicant's prospective change of name. At best, the specimens are an indication of applicant's adoption of the subject matter of the application for future use as a service mark but they do not show use thereof in the sale or advertising of a service. Mere adoption does not give rise to a right of registration. It is concluded that the specimens do not support the applicant's right to register.

In re Nationwide Mutual Ins. Co., 124 USPQ 465, 465
(TTAB 1960).

The question to be determined in this case is whether use of [a] mark in connection with the advertising of services to be available at some time in the future, but not yet available at the time of the filing of applicant's application for registration thereof, can serve as a basis for registration of the mark. We hold that it cannot.

In re Cedar Point, Inc., 220 USPQ 533, 535 (TTAB 1983).

Applicant's specimen "proposes a unique program." The proposed program "will take viewers on tours of individual embassies" and it "will promote the culture and cuisine unique to each country." Clearly, applicant's specimen frequently refers to its program in the future tense. Given its ordinary meaning, this verb usage indicates something that will occur in the future. While the use of the future tense is not per se fatal to specimens being acceptable, an applicant would need to provide some evidence that explains how the specimens were used at least as early as the filing date of the application. The cryptic statement by applicant's counsel in its brief that the "specimen, as originally submitted, is an advertising material that uses the mark EMBASSY CHEFS in connection with the services" hardly resolves the issue, even if it were considered to be evidence. There is no indication that applicant's entertainment services were in existence at the time the application was filed. "The use of a mark

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in connection with advertising, promotion and preparatory activities for services to be available at some time in the future cannot support registration." In re The Port Authority of New York, 3 USPQ2d 1453, 1455 (TTAB 1987).

Therefore, we affirm the examining attorney's refusal to register because applicant's specimen is not acceptable.

Decision: The refusals to register are affirmed.