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APRIL 21, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Tops Markets, Inc.

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Serial No. 74/496,826

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M. Bud Nelson of Hodgson, Russ, Andrews, Woods & Goodyear,  
attorney for applicant.

Charles T. J. Weigell, Trademark Examining Attorney, Law  
Office 109 (Deborah S. Cohn, Managing Attorney).

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Before Simms, Hohein and Walters, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Tops Markets, Inc. has filed a service mark application  
to register on the Principal Register the mark CARRYOUT CAFÉ  
for "deli-style retail supermarket services."<sup>1</sup> The

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<sup>1</sup> Serial No. 74/496,826, in International Class 42, filed March 4, 1994,  
based on use of the mark in commerce, alleging dates of first use as of  
December, 1990, and first use in commerce as of June, 1990. We note  
that applicant's alleged first use of its mark in commerce in connection  
with its services predates its alleged first use of its mark anywhere in  
connection with its services. This appears to be a typographical error  
in view of applicant's statements, in its declaration under Section  
2(f), regarding its first use of the mark. Applicant is advised that  
any amendment to correct this apparent error must comply with Trademark  
Rule 2.71(d)(1).

application includes a disclaimer of CARRYOUT apart from the mark as a whole.

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of the services identified in the application. Subsequently, while maintaining that its applied-for mark is inherently distinctive rather than merely descriptive, applicant claimed, in the alternative, that its applied-for mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f). In support of its claim, applicant submitted the declaration of an officer attesting to applicant's substantially exclusive and continuous use of the mark "in block form" in connection with the identified services since March, 1986, and "in logo form" since December, 1990; and attesting to advertising and promotional expenditures in connection with the mark for the past six years of approximately \$1 million per year, or \$6 million total. Additionally, applicant submitted samples of its advertising materials.

The Trademark Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that CARRYOUT CAFE, when used in connection with deli-style retail supermarket services, is generic and, thus, incapable of functioning as

a source-identifying mark; and, alternatively, that CARRYOUT CAFÉ is merely descriptive of such services and that applicant's proof of acquired distinctiveness, under Section 2(f), is insufficient evidence of acquired distinctiveness.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

*Genericness*

The first question before us is whether CARRYOUT CAFÉ as used in connection with deli-style retail supermarket services is generic. If we find that CARRYOUT CAFÉ is not generic, we must then consider whether it is merely descriptive in connection therewith and, if so, whether applicant has established that its mark has acquired distinctiveness.

The Examining Attorney contends that "CARRYOUT CAFÉ merely identifies to prospective customers a genus of carryout food services rendered in a café setting"; that applicant's evidence submitted in connection with its claim of acquired distinctiveness indicates that, in connection with CARRYOUT CAFÉ, applicant offers fresh prepared food for consumption either on or off the premises; that "the term CAFÉ is used to identify sections of a supermarket which feature food and beverages for consumption on or off the premises"; and that both terms comprising applicant's mark

are generic in connection with the identified services and the combination of these terms does not change the generic significance of the individual terms.

Applicant acknowledges that CARRYOUT CAFÉ is "made up of two common words", but contends that the combination of these two words creates an incongruous expression because CARRYOUT connotes taking food off the premises for consumption whereas CAFÉ connotes a restaurant that provides dining on the premises. Applicant argues, further, that the Examining Attorney has not established that CARRYOUT CAFÉ is generic; that the evidence submitted does not show any dictionary definitions, phone book listings or third-party references in articles to the phrase CARRYOUT CAFÉ; that evidence of the use of the phrase in trade publications is not probative of the understanding of the phrase by the relevant purchasing public; and that the availability of the common phrase "takeout café" as an alternative is evidence of nongenericness.

The critical issue in genericness cases is whether members of the relevant public principally use or understand the term sought to be registered to refer to the genus (category or class) of goods in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the

genus (category or class) of goods at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

We begin by taking notice of the following dictionary definitions:<sup>2</sup>

*restaurant* - *n.* an establishment where meals are served to customers.

*café* - *n.* 1. a restaurant, often with an enclosed or outdoor section extending onto the sidewalk.  
2. a restaurant, usually small and unpretentious.

*carry out* - *n. adj.* takeout (*defs 2,3*).

*take out* - *n.* 2. something made to be taken out, *esp.* food prepared in a store or restaurant to be carried out for consumption elsewhere. 3. *Informal.* a store, restaurant or counter specializing in preparing food meant to be carried out for consumption elsewhere.

*delicatessen* - *n.* a store selling foods already prepared or requiring little preparation for serving, as cooked meats, cheese, salads and the like.

In support of his contention that CARRYOUT CAFÉ is generic as used in connection with the identified services,

the Examining Attorney has submitted excerpts from the yellow pages of two telephone books, under the heading "Foods - Carry-Out," showing several listings for establishments using the term CAFÉ in their name.

Additionally, the Examining Attorney has submitted excerpts from the LEXIS/NEXIS database of articles from various newspapers and publications. The following are several examples of excerpts of articles from the LEXIS/NEXIS database:

"Chock Full O'Nuts opens coffee cafes" - The mini cafes are designed for carryout food and beverage service, with limited on-premise seating. [*Nation's Restaurant News*, February 6, 1995.]

The Glasz Café is primarily a gourmet carryout, but tables and chairs will be coming soon. [*The Baltimore Sun*, January 27, 1995.]

. . . Meyer decided to create Ebbitt Express, a carryout/café concept, to attract nearby office workers, shoppers and museum goers. [*Restaurant and Institutions*, August 1, 1994.]

For real multiculturalism, though, you've got to check out Irina's. In this funky carryout-café, you can chow down on borscht and Singapore curried noodles while listening to zydeco music. [*The Baltimore Sun*, March 27, 1994.]

. . . Block . . . recently opened the Eating Well, a carryout food service and café. [*Chicago Tribune*, September 30, 1993.]

Fish, Wings & Tings - This tiny café-carryout brings the colors of the Caribbean to Adams Morgan with trend-resistant honest cooking. [*Washingtonian*, April, 1993.]

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<sup>2</sup> *The Random House Dictionary of the English Language*, 2nd ed., 1987.

. . . in the Continental Bank building on South La Salle Street. A smaller operation, the 40-seat Italian café, is not full service and emphasizes carryout. [*Nation's Restaurant News*, June 15, 1992.]

The recently opened carryout Lucky's Café is taking no chances. [*The Washington Times*, May 2, 1991.]

Vivande, in San Francisco, is the ne plus ultra of café carryout operations, as it has not one but three California Culinary Academy graduates preparing meals alongside owner-chef . . . [*Cosmopolitan*, February 1989.]

The following are excerpts from a *Washington Post* article of October 14, 1992, which is specifically about "supermarket dining":

This day, the pair decide to bypass the fast food chains they usually frequent and try the just-opened Fresh Bite Café.

Tucked in the corner of the newest Fresh Fields health foods supermarket in Annandale, the 50-seat café not only provides Miller and Van Massenhove with a quiet place to talk but, more importantly, with a wide selection of food - virtually anything in the store.

This latest bit of culinary civilization is cropping up in a number of supermarkets around the country as grocers try to ring up more business by capitalizing on their growing array of freshly prepared foods.

Up to now, most of these foods were made for shoppers to take home and eat. But in an effort to distinguish themselves from their competitors . . . some grocers are creating small dining areas to enable customers to buy their food and eat it too - without ever leaving the store.

In some cases, such as Safeway's stores on the West Coast, the dining areas are simply a handful of tables and chairs set up near the deli.

. . .

Still other chains, such as Fresh Fields and the 21-store Ukrop's in Richmond, are creating a new kind of eatery - one that "is a level between fast food and a decent sit-down restaurant" . . .

It is customers like Scherling that make the café concept particularly attractive to the supermarkets.

. . .

No wonder then, that some food industry officials call these supermarket cafes the contemporary American equivalent of a French bistro.

The first step in our analysis is to determine the genus (category or class) of services herein. In this regard, we note that while supermarket services traditionally involve the sale of food products for preparation and/or consumption off the premises, the evidence of record indicates that a recent trend is for supermarkets to also offer dining areas where patrons may purchase and eat prepared food. Further, the evidence submitted by applicant in connection with its claim of acquired distinctiveness indicates that applicant's identified services, "deli-style retail supermarket services," encompass the sale of food for consumption either on or off the premises.<sup>3</sup> Thus, in view of the noted definition of "delicatessen," the genus (category or class)

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<sup>3</sup> The advertisements submitted in connection with applicant's claim of acquired distinctiveness include the following statements: "For your convenience, we have added a sit-down area" [Erie, PA store]; and "Take Out or Eat In" [The Buffalo News].



of services herein is the sale of prepared food to the ultimate consumer for consumption on or off supermarket premises.

We turn, then, to consider whether the relevant purchasing public would understand CARRYOUT CAFÉ as referring to such services. The evidence of record establishes that a "café" is a small, sometimes informal, restaurant and that the term "restaurant" encompasses both sit-down and carryout food service; that many small restaurants which are named or described as cafes commonly offer both on-site dining and carryout services; that at least one establishment described in the record as a cafe offers only carryout food service; that, as discussed herein, retail supermarkets commonly offer prepared food to carry-out and/or tables for eating such items purchased on the premises; and that the term CAFÉ is used to describe such services in retail supermarkets. In fact, the evidence leads us to conclude that CAFÉ is a generic term used to describe a broad range of establishments where prepared food is sold for consumption either on or off the premises, or both; and that CARRYOUT is a generic term used to describe a food service wherein prepared food is sold for consumption off the premises.

Further, the terms CARRYOUT and CAFÉ are often used together to describe aspects of a single establishment, as

evidenced in the excerpts of articles in the record - for example, "carryout/café," "a café carryout," "carryout food service and café." Contrary to applicant's contention, we find nothing incongruous in applicant's combination of these two common generic terms in the applied-for mark CARRYOUT CAFÉ when considered in connection with applicant's services. See, *In re Gould Paper Corp.*, 5 USPQ2d 1110 (Fed. Cir. 1987). While, by placing CARRYOUT before CAFÉ, the term CARRYOUT could be perceived as an adjective modifying CAFÉ, there is no incongruity in such placement since the evidence establishes that cafes often offer dining on the premises as well as carryout services; and that there may be establishments with the term café in their name that offer only carryout service.

Thus, we find that the evidence establishes that the relevant public will understand the term CARRYOUT CAFE in its generic sense when considered in connection with applicant's identified services, notwithstanding applicant's criticism of the evidence of record. Regarding applicant's concerns, we note, first, that while some of the articles excerpted in the record are from trade publications, the majority of the articles, as well as the telephone book references, are from publications available to the general public, which is clearly the relevant purchaser of applicant's services. Further, the readers of trade

publications are also members of the general public and the excerpts from these publications are not technical in nature, showing use of the terms CARRYOUT and CAFÉ in essentially the same manner as these terms are used in the other publications of record.

Similarly, applicant's additional arguments that there is no evidence of generic use of the actual phrase CARRYOUT CAFÉ and that "takeout café" is an alternative descriptive term available to the public are unavailing.<sup>4</sup> It is sufficient that the Examining Attorney has established, as discussed herein, that the individual terms CARRYOUT and CAFÉ are generic; that the two terms are often used together in a variety of ways to describe characteristics of a single establishment; and that the combination of the two generic terms in the applied-for mark is not incongruous and does not alter the generic quality of either term. It is equally true that a term does not lose its generic significance simply because there are other synonymous generic expressions available for the public to use.

*Descriptiveness and Acquired Distinctiveness*

If, ultimately, the applied for mark is found not to be generic, we would need to address the questions of whether CARRYOUT CAFÉ is merely descriptive as used in connection

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<sup>4</sup> Likewise, we acknowledge that a number of excerpts submitted by the Examining Attorney refer specifically to applicant. However, we find sufficient other evidence in the record to support our conclusion that the applied-for mark is generic.

with deli-style retail supermarket services and, if so, whether applicant has established that CARRYOUT CAFÉ has acquired distinctiveness. Therefore, in order to render a complete opinion, we consider these issues now. The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

As discussed in connection with the question of genericness, there is ample evidence in the record to support the conclusion that the individual terms CARRYOUT and CAFÉ are merely descriptive in connection with the

identified services. We find that, when applied to applicant's services, the combination of these terms to create the phrase CARRYOUT CAFÉ is not incongruous and the terms retain their descriptive significance. Thus, we find the applied-for mark is merely descriptive. It immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely that applicant's identified services feature the sale in a specialized setting of food for consumption on or off the premises. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term CARRYOUT CAFÉ as it pertains to deli-style retail supermarket services.

Further, we find that applicant's evidence under Section 2(f) is insufficient to establish that its applied-for mark has acquired distinctiveness in connection with the identified services. While applicant has provided a declaration indicating use since 1986 and general advertising figures, along with several copies of newspaper ads, applicant has not provided any evidence of the amount of sales in connection with the mark or of consumer perception. In view of the highly descriptive nature of the mark, the evidence of record is insufficient to establish

that CARRYOUT CAFÉ has acquired distinctiveness in connection with deli-style retail supermarket services.

*Decision:* The refusal to register on the ground that the mark herein is generic of the identified goods is affirmed. Alternatively, should applicant ultimately prevail on the issue of genericness, the refusal to register, under Section 2(e)(1) of the Act, on the ground that the mark herein is merely descriptive in connection with the identified services is affirmed inasmuch as applicant's claim under Section 2(f) is insufficient evidence of acquired distinctiveness herein.

G. D. Hohein

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board

Simms, Administrative Trademark Judge, concurring:

If applicant's asserted mark were "CARRYOUT/CAFÉ" or "CARRYOUT-CAFÉ", I believe that the public would perceive these terms as merely indicating that applicant was operating a carryout and a café, in other words, a place where one could purchase food (and perhaps beverages) for consumption either off (carryout) or on (café) the premises. These terms would simply

not be perceived as service marks indicating origin but rather as designations of a type or category of business establishment, albeit in a supermarket setting. In other words, these words would be generic. An applicant should not be able to obtain a registration for such terms merely by a "misspelling", if you will -- by omitting the punctuation mark ("/" or "-"). See J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §12:38 (4<sup>th</sup> ed. 1997). Further, the availability of alternative generic expressions (such as "takeout café") is irrelevant. As we and others have stated in the past, all generic terms for a product or service should be freely available to competitors. In re Sun Oil Co., 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970), Rich, concurring ("All of the generic names for a product belong in the public domain.")

R. L. Simms

Administrative  
Trademark Judge