

**This Opinion is Not a
Precedent of the TTAB**

Mailed: February 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Hy-Vee, Inc.
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Serial No. 86945526
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Timothy J. Zarley of Zarley Law Firm P.L.C.,
for Hy-Vee, Inc.

Lauren E. Burke, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Wolfson, Gorowitz, and Masiello,
Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Hy-Vee, Inc. (“Applicant”) seeks registration on the Supplemental Register of the proposed mark NORI SUSHI in standard characters for “Asian food products, namely, sushi,” in International Class 30.¹

¹ Application Serial No. 86945526 was filed on March 18, 2016 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on Applicant’s asserted *bona fide* intention to use the mark in commerce. Applicant originally sought registration on the Principal Register. Applicant filed an allegation of use on July 7, 2016, stating April 1, 2016 as the date of first use and first use in commerce; and amended the application to request registration on the Supplemental Register.

The Examining Attorney has refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127, on the ground that Applicant's proposed mark is generic and thus incapable of distinguishing the identified goods. The Examining Attorney asserted, as an "alternative" ground for refusal of registration, that the proposed mark is merely descriptive of Applicant's goods under Section 2(e)(1), 15 U.S.C. § 1052(e)(1). When the Examining Attorney made the refusals final, Applicant appealed to this Board. Applicant and the Examining Attorney have filed briefs.

I. Procedural issue.

As an initial matter, we note that the Examining Attorney's "alternative" ground for refusal, under Section 2(e)(1), is procedurally unnecessary. Applicant seeks registration on the Supplemental Register, and the contention that Applicant's mark is merely descriptive of the identified goods is not a ground for refusing registration on the Supplemental Register. *See* Trademark Act Section 23(a) and (c), 15 U.S.C. § 1091(a) and (c).²

Throughout the examination process, Applicant argued that its mark was not merely descriptive but, instead, suggestive. In the face of such arguments, the Examining Attorney might have felt it necessary to maintain a refusal on grounds of mere descriptiveness. Nonetheless, it is clear that Applicant seeks registration on the Supplemental Register only, and that there is no alternative request for registration

² Under Section 23, a mark may be registered on the Supplemental Register provided that it is "capable of distinguishing applicant's goods or services" and not within the enumerated prohibitions set forth in Section 23. Mere descriptiveness is not an enumerated prohibition.

on the Principal Register. In its last submission before bringing its appeal, Applicant stated, “It is further submitted that, *while applicant is merely seeking registration on the Supplemental Register at this point*, the mark is not merely descriptive, but is suggestive of applicant’s goods and services.”³ Where an applicant seeks registration on the Supplemental Register, the question of whether the mark is inherently distinctive or merely descriptive is a nonissue. The only question is whether the mark is “capable of distinguishing applicant’s goods” (and not within one of the enumerated statutory prohibitions). *Cf. Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (in proceedings under Section 2(f), inherent distinctiveness is a nonissue under the statute). Accordingly, we give no further consideration to the Examining Attorney’s alternative refusal under Section 2(e)(1).

II. Applicable Law.

In order to qualify for registration on the Supplemental Register, a proposed mark “must be capable of distinguishing the applicant’s goods or services.” 15 U.S.C. § 1091(c). Generic terms do not so qualify. “[G]eneric terms by definition are incapable of indicating a unique source.” *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1267 (Fed. Cir. 2015) (citing *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987) (“Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.”)). A term is generic if it refers to the class or

³ January 27, 2017 Response, TSDR at 2.

category of goods or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (“*Marvin Ginn*”). The test for determining whether a mark is generic is its primary significance to the relevant public. *In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *Marvin Ginn*, 228 USPQ at 530. Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Marvin Ginn*, 228 USPQ at 530. “A registration is properly refused if the word is the generic name of any of the goods or services for which registration is sought.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1638 (Fed. Cir. 2016), quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:57. The Examining Attorney has the burden of establishing by clear evidence that a proposed mark is generic. *In re Merrill Lynch*, 4 USPQ2d at 1141; *In re Am. Fertility Soc’y*, 51 USPQ2d at 1835. We consider the proposed mark as a whole. See *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1831 (Fed. Cir. 2015), citing *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005).

A. The genus of Applicant’s goods.

The identification of goods in the application is clear and is a suitable expression of the genus of goods at issue. See *Magic Wand*, 19 USPQ2d at 1552 (“a proper

genericness inquiry focuses on the description of [goods] set forth in the [application or] certificate of registration”) (citing *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Thus, the genus of goods in this case is “sushi,” which is a type of “Asian food product.”

B. Public understanding of the term NORI SUSHI.

We next consider whether NORI SUSHI would be understood by the relevant public to refer to sushi. The Examining Attorney contends that the relevant public comprises “ordinary consumers who purchase [sushi].”⁴ Applicant has not argued against this characterization.

The Examining Attorney has submitted the following dictionary definition of “nori”: “a dried laver seaweed pressed into thin sheets and used especially as a seasoning or as a wrapper for sushi.”⁵ Applicant has submitted additional information regarding “nori”:

What is nori?

Nori (a.k.a. laver) is a paper like, edible, toasted seaweed used in most kinds of sushi. The nori is actually the part that holds the sushi together.

Nori is usually supplied in packs of 10s or 50s. ...

⁴ Examining Attorney’s brief, 6 TTABVUE 6.

⁵ Definition from <merriam-webster.com>, Office Action of June 29, 2016 at 4. We take judicial notice of the definition of “laver” as “any of several common red algae (genus *Porphyra*) with fronds used especially for stewing or pickling.” At <https://www.merriam-webster.com>, accessed January 18, 2018. The Board may take judicial notice of dictionary definitions from references that are the electronic equivalent of a print reference work. *Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

How to use nori?

Nori is used in most kinds of sushi. It provides the roll with a unique seaweed flavor, holds many nutritious benefits and most importantly it plays a functional part by keeping the roll together.

A fresh nori should come dry, very dry. Once it interacts with the moist rice, it becomes sticky, hence when wrapping the rice it acts as a firm yet sticky “skin” for the sushi roll. ...

From the web article “Make my Sushi: Sushi making explained,” at makemysushi.com.⁶

The Examining Attorney, noting the generic nature of the term NORI, argues that “[t]he generic name of an ingredient of the goods is incapable of identifying and distinguishing their source and is therefore unregistrable ...”⁷ This argument is not dispositive, because it fails to take into consideration Applicant’s mark as a whole. Although it is clear from the record that each of the terms SUSHI and NORI are generic terms in the relevant field for sushi and for a dried laver seaweed, in determining whether Applicant’s mark is generic we may not “assume[] the genericness of a phrase as a whole based solely on proof of the genericness of its individual terms.” *Princeton Vanguard*, 114 USPQ2d at 1831. Rather, our determination must be based on “evidence of ... the understanding by the general public that the mark refers primarily to [the] genus of goods ...” *Id.* (internal quotation marks omitted). To demonstrate that NORI SUSHI is the generic name of

⁶ January 27, 2016 Response, TSDR at 7-8.

⁷ Examining Attorney’s brief, 6 TTABVUE 7.

a type of sushi, the Examining Attorney has submitted evidence from the internet, consisting of three recipes, one menu item, and the title of a stock photograph, showing the term “nori sushi” used as follows:⁸

Nori Sushi Rolls

...

Putting Your Nori Rolls Together:

Place your Nori Sheets in front of you, on the worktop with the cutting line vertically placed, not horizontal.

Covering about a 3rd of the sheet, spread a horizontal line of the sunflower seed mayo in the middle of the Nori Sheet; about 3mm thick.

Then place a flat layer of the cauliflower rice (about 4mm thick) on top of the sunflower seed mayo.

Website entitled “Jay Halford live long – eat raw” at jayhalford.com.⁹

Better Than Burritos! Nori Sushi Rolls

...

These easy nori sushi burritos will transform all the random ingredients hanging around your fridge into a meal everyone’s excited about.

...

Nori, a sea vegetable, provides a healthy boost of iron, protein, vitamin B12, and iodine ...

Website entitled “MBG mindbodygreen” at mindbodygreen.com, August 23, 2014.¹⁰

⁸ We have not considered the evidence from deliveroo.co.uk (July 27, 2016 Office Action, TSDR at 5-6), because it appears to be of foreign origin.

⁹ June 29, 2016 Office Action, TSDR at 5.

¹⁰ *Id.* at 6.

Raw Rainbow Nori Sushi Garden Rolls (GF and Vegetarian!)

...

Sometimes a meal just leaves you feeling better, happier, and more energized after you eat it. Nothing beats that feeling! That was exactly the case with these super healthy vegetarian nori sushi rolls. I can't even imagine the nutrients in these raw rainbow rolls!

Website entitled "Tasting Everything" at tastingeverything.com.¹¹

LA MENU

...

Cali Roll

nori sushi with fresh coconut. dulce. pine nuts. cucumber. bell pepper. served with pickled ginger and tamari sauce

Raw

Restaurant menu at aulac.com.¹²

Sticky rice and mango rolls, nori sushi, mango sushi and tofu skin sushi.

Title of stock photograph at stockfood.com.¹³

The Examining Attorney argues that "the Internet evidence clearly shows that the general public perception of the term 'NORI SUSHI' is as a generic type of sushi, as it has been used as a menu item and a recipe heading."¹⁴ We do not agree that these five examples of usage constitute sufficient evidence to clearly establish that

¹¹ July 27, 2016 Office Action, TSDR at 7.

¹² *Id.* at 4.

¹³ *Id.* at 8.

¹⁴ Examining Attorney's brief, 6 TTABVUE 8.

NORI SUSHI is generic. Considering that sushi rolls are common consumer items that are abundantly available in the marketplace, five examples are scant evidence to prove that they are called “nori sushi.” These examples are ambiguous, and could be interpreted as use of NORI SUSHI as a descriptive phrase for sushi that contains nori as one of its ingredients, rather than as the name of a class of sushi. Some of the examples refer to products that may not be conventional sushi: one product is a hybrid “sushi burrito”; another is a hybrid sushi roll/garden roll. In other words, these examples appear to show use of NORI SUSHI to describe something other than sushi. Such evidence casts doubt on whether the term is the common name of a class of sushi. In some examples, the writers use other terms as alternatives for “nori sushi,” such as “nori rolls,” “garden rolls,” and “raw rainbow rolls.” The record also shows that sushi wrapped in nori is sometimes referred to as “Maki-Sushi.”¹⁵ Such evidence suggests that the writers believe that words other than NORI SUSHI are necessary to convey the intended meaning, rendering the evidence equivocal. In the title of the photograph “Sticky rice and mango rolls, nori sushi, mango sushi and tofu skin sushi,” it is not clear whether the items are identified by generic terms or by descriptive wording. Ultimately, it remains unclear from the context in which “nori sushi” is used in these examples whether the writers understand the term to be a class of sushi or merely descriptive of sushi that is made with a seaweed wrapper.

The Examining Attorney has the burden of establishing by clear evidence that a proposed mark is generic. *In re Merrill Lynch*, 4 USPQ2d at 1141. On this record, the

¹⁵ June 29, 2016 Office Action, TSDR at 7.

Examining Attorney has not demonstrated by clear evidence that NORI SUSHI is generic as applied to Applicant's goods, and thus has failed to demonstrate that the mark is ineligible for registration on the Supplemental Register. We note, however, that on the present record it is manifest that SUSHI is generic as applied to the goods, which are identified as "sushi." Accordingly, registration of the mark on the Supplemental Register is not appropriate without a disclaimer of the exclusive right to use SUSHI apart from the mark as a whole. The Board, therefore, requires that Applicant enter such a disclaimer as a precondition to registration of the mark on the Supplemental Register. *See* Trademark Act Section 6(a), 15 U.S.C. § 1056(a); Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g) ("An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Director ..."); TBMP § 1218 (June 2017). Therefore, the Board will provisionally affirm the refusal of registration, pending the submission and entry of the required disclaimer. **Applicant is allowed THIRTY (30) DAYS** from the mailing date of this decision to enter a disclaimer in the following form:

No claim is made to the exclusive right to use SUSHI apart
from the mark as shown.

Once the disclaimer is entered, this decision will be set aside and the application will proceed to registration on the Supplemental Register.

Decision: The refusal to register Applicant's mark is AFFIRMED, subject to the entry of a disclaimer of the exclusive right to use SUSHI apart from the mark as shown. Upon entry of the required disclaimer, this decision will be set aside.