

HART, BAXLEY, DANIELS & HOLTON

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196000000654

April 1, 1996

Florida Division of Corporations
P.O. Box 6327
Tallahassee, FL 32314

800001863123
-00/20/96--01027--007
*****20.00 *****20.00

Gentlepersons:

My reference 7449 B
State SM Reg. KELLY'S CAJUN GRILL (42)
for restaurant franchising services
featuring fast-food Cajun-style cooking

Enclosed herewith is an Application for Service Mark
Registration of the above referenced mark in the State of
Florida. Also enclosed herewith are three (3) specimens
depicting the mark as well as a check in the amount of \$67.50.

Kindly file the Application among your records and
thereafter forward to me a Certificate of Registration therefor.

Your excellent cooperation is appreciated.

Very truly yours,

Joseph T. Murray

789/743/708/672

enclosures

check \$67.50
specimens (3)
appln (1)

File per
KB & BLT

T96-654

800001763808
-04/04/96--01096--004
*****67.50 *****67.50

W96-8116

Name	
Availability	up to
Document Examiner	NJC
Updater	NJC
Updater Verifier	NJC
Acknowledgment	NJC
W. P. Verifier	NJC



FLORIDA DEPARTMENT OF STATE
Sandra B. Mortham
Secretary of State

April 16, 1996

Joseph T. Murray, Esquire
Hart, Baxley, et al.
59 John Street, 5th Fl.
New York, NY 10038

SUBJECT: KELLY'S CAJUN GRILL
Ref. Number: W96000008116

We have received your document for KELLY'S CAJUN GRILL and your check(s) totaling \$67.50. However, the enclosed document has not been filed and is being returned for the following correction(s):

We must deny registration pursuant to section 495.021(1), Florida Statutes, because the mark is merely descriptive. The mark must be in use five years prior to registration.

Once the mark has been in use for five years you may resubmit the application with proof of substantially exclusive and continuous use and the Department of State will reconsider registration.

Enclosed is an application for refund.

If you have any questions concerning the filing of your document, please call (904) 487-6918.

Nanette Causseaux
Corporate Specialist Supervisor

Letter Number: 896A00017516

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*Called
6/3/96
Need better
specimens. Sending
to my P&C attn.
np*

May 3, 1996

Ms. Nanette Causseaux
Corporate Specialist Supervisor
Florida Department of State
Division of Corporations
P.O. Box 6327
Tallahassee, FL 32314

Dear Ms. Causseaux:

Your reference W96000008116
My reference 7449 B
FL TM Appln KELLY'S CAJUN GRILL

In reply to your letter to me dated April 16, 1996 (enclosed herewith for your ready reference), comments of the Department of State have been reviewed carefully along with pertinent sections of the Florida Trademark Act and relevant decisional law. For reasons hereinafter set forth Applicant requests favorable reconsideration of its Application for service mark registration.

The Florida Department of State maintains that KELLY'S CAJUN GRILL is merely descriptive for services identified thereby. Under section 491.021(e)(1) of the Florida Statutes, a mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. Applicant submits, however, that KELLY'S CAJUN GRILL is not merely descriptive and that it is no more than suggestive of Applicant's restaurant franchising services.

In reaching its conclusion that KELLY'S CAJUN GRILL is merely descriptive of Applicant's services, the Department of State apparently dissected the Mark into two parts, namely KELLY'S and CAJUN GRILL. In determining whether a mark is merely descriptive, however, a composite mark should be considered in its entirety because the commercial impression of a composite mark on an ordinary consumer is created by the mark as a whole, not by its component parts. A mark should not be dissected or split up to determine if it is merely descriptive. Thus, in refusing registration, the Department of State appears to have given far greater weight to the terms CAJUN GRILL, while ignoring significance that the term KELLY'S contributes to the overall impression of Applicant's Mark. KELLY'S is no more descriptive of restaurant franchising services than are the marks McDONALD'S (for

*(OK to file new KB
in 6/3/96 w/ 11/1/96
ltr. - enc. to 11/1/96
of restaurant services)
U &
6/3/96*

75/304

Ms. Nanette Causseaux
Corporate Specialist Supervisor

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Your reference W96000008116
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hamburger restaurants) and DUNKIN (for doughnut shops).

A consumer without prior knowledge of the services being offered in conjunction with Applicant's mark might very well believe that KELLY'S CAJUN GRILL describes a charcoal barbecue or the front end of an automobile. Indeed, that consumer might conclude reasonably that KELLY'S CAJUN GRILL indicates something altogether different than restaurant franchising services.

A key factor in determining a mark's suggestiveness is the thought process that connects a mark with the goods or services that mark identifies. Applicant respectfully submits that one must exercise perception, thought and imagination to connect KELLY'S CAJUN GRILL with restaurant franchising services and that said mark does not convey immediately information about Applicant's services. The thought process that connects KELLY'S CAJUN GRILL with restaurant franchising services commences by defining KELLY'S, taken arguendo as a given name for person or a shade of the color green and adding to it the words CAJUN GRILL.

One must first determine what meaning of KELLY'S the Mark contemplates. Then one must determine what meaning of CAJUN GRILL the Mark contemplates: a charcoal barbecue, a part of an automobile, or a type of restaurant. One next makes an additional mental step to determine how KELLY'S CAJUN GRILL applies to restaurant franchising services. Thus, because of the multi-staged reasoning process that connects KELLY'S CAJUN GRILL to restaurant franchising services, the Mark cannot be said to convey immediately information of the character or quality of Applicant's services. It is this multi-staged reasoning process that under Florida Trademark Law makes KELLY'S CAJUN GRILL suggestive rather than merely descriptive.

In analyzing an allegation of mere descriptiveness, one begins with Section 495.021 of the Florida Statutes, which provides as follows:

(1) A mark . . . shall not be registered if it:

(e) Consists of a mark which, (1) when applied to goods or services of the applicant is merely descriptive or deceptively misdescriptive of them

Ms. Nanette Causseaux
Corporate Specialist Supervisor

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Your reference W96000008116
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A mark is merely descriptive if it immediately conveys information of the ingredients or qualities of goods services it identifies. In re Application of Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 U.S.P.Q. 505 (C.C.P.A. 1980). Words that describe, contrasted with words that identify, are those which refer to any feature of an article or establishment, such as its purpose or function. Palmer v. Ford Motor Co., 138 U.S.P.Q. 479 (E.D. Mich. 1963). Words that describe only one quality or property of goods may be descriptive. Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 U.S.P.Q. 293 (C.C.P.A. 1959).

Courts have distinguished between merely descriptive terms and terms which are suggestive of the nature of and applicant's goods or services. E.g., In re Colonial Stores, Inc., 394 F.2d 549 (C.C.P.A. 1968). Suggestive marks are entitled to protection under Florida trademark law.

Two problems arise immediately. First, the best marks tend to be highly suggestive. In Van Kemp Seafood v. Alexander B. Stewart Organizations, 50 F.2d 976 (C.C.P.A. 1931), the mark CHICKEN OF THE SEA for canned tuna was held to be suggestive, not merely descriptive. In that decision, the Court of Customs and Patent Appeals stated:

Every good trademark is suggestive; once seen or heard, its association with the product is readily fixed in the mind. If there were no association of ideas between the two, it would require independent effort of memory to recall the connection. It is not necessary to the validity of a trademark that it should be utterly devoid of aptitude. It is enough that it leaves open to everyone all words that are really descriptive.

Second, it is manifest that the term "descriptive" and "suggestive" are not mutually exclusive. In Q-Tips, Inc. v. Johnson & Johnson, Inc., 206 F.2d 144 (3d Cir. 1953), the United States Court of Appeals for the Third Circuit stated: "There must be some description in almost any suggestion or the suggestion process will not take place. So what we have is a matter of judgment as to what side of the line the questioned mark falls upon." See generally Seidel, Trademark Law and Practice § 605 (1963).

Ms. Nanette Causseaux
Corporate Specialist Supervisor

May 3, 1996
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Your reference W96000008116
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In Stix Products, Inc. v. United Merchants & Manufacturers, Inc., 295 F. Supp. 479 (S.D.N.Y. 1968), Judge Edward Weinfeld of the United States District Court for the Southern District of New York offered perhaps the most frequently quoted explanation of the difference between the terms "descriptive" and "suggestive." In Judge Weinfeld's view, a term is "descriptive" in nature if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." Id. Stated differently, a term is descriptive when it conveys "the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is." Id. Contrast the foregoing with a "suggestive" term, which "requires imagination, thought and perception to reach a conclusion as to the nature of the goods." Id. See In re Aid Laboratories, Inc., 223 U.S.P.Q. 357 (T.T.A.B. 1984).

To arrive at an accurate determination as to whether a particular mark is merely descriptive of the services in question, the mark should be analyzed not in the abstract, but in relation to the Applicant's services, the context in which the mark is used, and the possible significance that the mark would have to the typical purchaser of such services. In re Capital Formation Counselors, Inc., 219 U.S.P.Q. 916, 918 (T.T.A.B. 1983); In re Abcor Development Corp., 588 F.2d 813 (C.C.P.A. 1978); Florists' Transworld Delivery Ass'n v. Teleflora, Inc., 208 U.S.P.Q. 858 (T.T.A.B. 1980).

In the refusal, the Department of State did not even allege that KELLY'S CAJUN GRILL immediately describes the restaurant franchising services. Thus, the Department ignored the time response necessary for casual consumers to analyze two components of a mark which each have multiple diverse and distinct meanings. The expression KELLY'S CAJUN GRILL cannot be said properly to merely describe any particular quality of Applicant's services to consumers, who after all are interested primarily in the services, not in analyzing terms. Thus, Applicant's mark KELLY'S CAJUN GRILL reflects little more than a desire, wishful thinking on the part of both Applicant and consumers. Accordingly, the expression KELLY'S CAJUN GRILL cannot fairly be categorized as merely describing even a quality of Applicant's services to consumers.

The foregoing exercises are the sort of mental gymnastics which traditionally have led the courts to find that a mark is

HART, BAXLEY, DANIELS & HOLTON

Ms. Nanette Causseaux
Corporate Specialist Supervisor

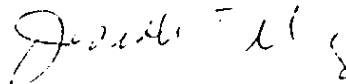
May 3, 1996
Page 5

Your reference W96000008116
My reference 7449 B
FL TM Appln KELLY'S CAJUN GRILL

suggestive in nature. If the consumer must exercise mature thought, or follow a multi-staged reasoning process to determine the nature of the services, a term will be deemed suggestive, not merely descriptive.

In view of the foregoing explanation, Applicant, through its Attorney, believes that the mark KELLY'S CAJUN GRILL is registrable under Florida Trademark law. Accordingly, an early notice of registration will be appreciated.

Respectfully,



Joseph T. Murray

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OF COUNSEL
THOMAS F. FARLEY
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CABLE: LEVERAY
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TELEPHONE: (212) 791-7276

June 3, 1996

Ms. Nanette Causseaux
Corporate Specialist Supervisor
Florida Department of State
Division of Corporations
P.O. Box 6327
Tallahassee, FL 32314

Dear Ms. Causseaux:

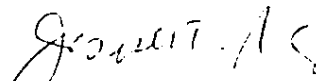
Your reference W96000008116
My reference 7449 B
FL TM Appln KELLY'S CAJUN GRILL

Thank you for your telephone call today wherein you indicated that the Florida Department of State has accepted registration of the mark KELLY'S CAJUN GRILL for restaurant franchising services featuring fast-food Cajun-style cooking.

In accordance with your request for substitute specimens depicting Applicant's mark, enclosed herewith are three (3) identical copies of a recent advertisement in a local newspaper.

Please call me if you have any questions on the foregoing. Your courtesy and cooperation are appreciated.

Very truly yours,


Joseph T. Murray

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June 13, 1996

Ms. Nanette Causseaux
Corporate Specialist Supervisor
Florida Department of State
Division of Corporations
P.O. Box 6327
Tallahassee, FL 32314

Dear Ms. Causseaux:

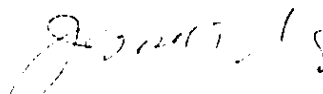
Your reference W96000008116
My reference 7449 B
FL TM Appln KELLY'S CAJUN GRILL

Thank you for your telephone call this week wherein you indicated that the service mark KELLY'S CAJUN GRILL will be registered with the Florida Department of State.

In accordance with your request, enclosed herewith is a check in the amount of \$20.00 to cover the balance of filing fees due in this Application.

Your courtesy and cooperation are appreciated.

Best regards,


Joseph T. Murray

enclosure
chk \$20.00

Florida Department of State

APPLICATION FOR THE REGISTRATION OF A TRADEMARK OR SERVICE MARK

PURSUANT TO CHAPTER 495, FLORIDA STATUTES

TO: Division of Corporations
Post Office Box 6327
Tallahassee, FL 32314

Name & address to whom
acknowledgement should be sent:

Charles E. Baxley, Esq.

59 John Street, 5th Flr.

New York, NY 10038

(212) 791-7200

Daytime Telephone number

PART I

1. (a) Applicant's name: Kelly's Cajun Grill Franchise Corporation
- (b) Applicant's business address: 1957 71st Street
Miami Beach, FL zip: 33141
- (c) Applicant's telephone number: (305) 867-8999

☐ Individual ☒ Corporation ☐ Joint Venture ☐ Other: _____
☐ General Partnership ☐ Limited Partnership ☐ Union

If other than an individual,

- (1) Florida registration number: P95000072131 ✓
- (2) Federal Employer Identification Number: 65-0645714
- (3) Domicile State: Florida

2. (a) If the mark to be registered is a service mark, the services in connection with which the mark is used: (i.e., furniture moving services, diaper services, house painting services, etc.)

Restaurant franchising services featuring fast-food

Cajun-style cooking.

- (b) If the mark to be registered is a trademark, the goods in connection with which the mark is used: (i.e., ladies sportswear, cat food, barbeque grills, shoe laces, etc.)

- (c) The mode or manner in which the mark is used: (i.e., labels, decals, newspaper advertisements, brochures, etc.)

on menus, napkins, signs, printed materials and advertisements

(d) The class(es) in which goods or services fall:
International Class 35 (US Class 101)

PART II

1. Date first used by the applicant, predecessor, or a related company (must include month, day and year):

(a) Date first used anywhere: March 6, 1996

(b) Date first used in Florida: March 6, 1996

PART III

1. The mark to be registered is: (If logo/design is included, please give brief written description which must be 25 words or less.)

(The words only) KELLY'S CAJUN GRILL

2. DISCLAIMER (if applicable)

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE TERM " _____
_____ " APART FROM THE MARK AS SHOWN.

I, KELLY YEUNG, being sworn, depose and say that I am the owner and the applicant herein, or that I am authorized to sign on behalf of the owner and applicant herein, and no other person except a related company has the right to use such mark in Florida either in the identical form or in such near resemblance as to be likely to deceive or confuse or to be mistaken therefor. I make this affidavit and verification on my/the applicant's behalf. I further acknowledge that I have read the application and know the contents thereof and that the facts stated herein are true and correct.

Kelly's Cajun Grill Franchise Corporation

Typed or printed name of applicant

X Kelly Yeung A/K/A President
Applicant's signature or authorized person's signature
(List name and title)

KELLY YEUNG a/k/a HOI SANG YEUNG, President

STATE OF FLORIDA

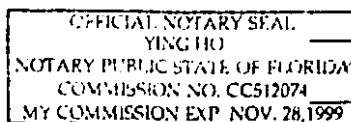
COUNTY OF DADE

On this 27th day of MARCH, 1996, HOI SANG YEUNG
personally appeared before me,



who is personally known to me

whose identity I proved on the basis of _____



Ying Ho Notary Public Signature

YING HO
Notary's Printed Name

Seal

My Commission Expires: NOV. 28, 1999

FEE: \$87.50 per class

P6 Sunday, May 19, 1996



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