

of office action (“Second Office Action”) reiterating her argument that the combined term is “merely descriptive” and including Internet references. For the reasons set forth below, the Examining Attorney’s conclusions remain unpersuasive and should be rejected; and Applicant should be granted full registration of the Mark.

II. ARGUMENT

a) The Combination of the Terms “Gin” and “Palace” Creates a Fanciful Mark

The crux of the Examining Attorney’s conclusion that the Mark is “merely descriptive” is based upon her interpretation that both the terms “gin” and “palace” are generic and when combined, each word retains its descriptive meaning. This is not so. The inclusion of the word “palace” in the Mark transforms it from “merely descriptive” to fanciful and arbitrary. Rarely in the trademark registration process does there exist specific case law and discussion of the exact terms that are the subject of the disputed application. In this matter, such a material exists.

In *Trump v. Caesars World, Inc.*, Donald Trump sought to name one of his Atlantic City casinos “Trump’s Palace.” 645 F. Supp. 1015, 1015 (D.C. N.J. 1986). Caesars World, owner of the marks “Caesar’s Palace” and “The Palace” relating to its high-end hotel properties, argued that “Trump’s Palace” infringed on their marks. Trump argued against protection of the word “palace” claiming that when used in connection with hotel and casino services (the same classification that is sought by Applicant in the instant matter), “palace” was a “generic term signifying an establishment offering luxurious accommodations and entertainment.” *Id.* at 1019. The district court rejected that argument and agreed with the linguistics expert for Caesar’s Palace, Dr. William A. Stewart. Dr. Stewart took issue with Trump’s conclusion that “palace” is a generic word for accommodation and explained that the primary definition is virtually the same in all dictionaries: “the official residence of an emperor, king, pope or other sovereign ruler.” Dr. Stewart concluded that upon hearing the word “palace” one is likely to give it a literal meaning. He tested this opinion by reading two sentences to a group of students, each

containing the word "palace": 1) "I'm flying there tomorrow, and I'll spend the night in a palace and return the next day" and (2) "I lost some money in a palace last week." When asked to make up a story based on these sentences, each student interpreted "palace" in its literal sense. The court concluded that because Caesar's Palace is not the official residence of a sovereign ruler, the use of "palace" in connection with a casino hotel is arbitrary and fanciful and capable of identifying the source of the services offered." *Id.* at 1020.

Here, the logic is identical. The term "palace" when combined with the word "gin" creates an arbitrary and fanciful mark warranting protection. See *Henry Muhs Co. v. Farm Craft Foods*, 37 F. Supp. 1013, 1015 (D.N.Y. 1941) (holding that even if "farm" and "craft" were general terms and available to public, "farmcraft" as applied to cheese, butter, dressed poultry, eggs, and meat products was valid trademark); *In re Colonial Stores, Inc.*, 55 C.C.P.A. 1049, 1053 (C.C.P.A. 1968) (stating that while mark "Sugar & Spice" on bakery products is admittedly composed of two words, each of which alone is descriptive of products, combination of such descriptive terms results in composite mark which could not be said to be merely descriptive). The registration class sought by Applicant is for use of the Mark relating to hotel, motel, restaurant, bar, and catering services. Clearly, the accepted meaning of the term "palace" - the official residence of an emperor, king, pope or other sovereign ruler - has no literal or descriptive meaning in this context, and is therefore a fanciful or arbitrary modifier of the word "gin." *Judson Dunaway Corp. v. Hygienic Products Co.*, 178 F.2d 461, 465 (1st Cir. N.H. 1949) (stating that a composite trademark is valid if, in addition to its descriptive element, it contains fanciful or arbitrary elements sufficient to give it enough individuality so that, viewed as an entirety, it can perform its function of pointing distinctively to origin of goods to which it is applied); *In re Vortex Cup Co.*, 23 C.C.P.A. 1166, 1167 (C.C.P.A. 1936) (stating that "[i]t is well settled in adjudicated cases that a valid trade-mark may be highly suggestive (in our opinion of times the best ones are), without being offensively descriptive").

b) The Examining Attorneys References to Internet Use of the Mark Are Not Significant In Light of Other Marks Granted Protection

The Examining Attorney also based her refusal to grant trademark protection for the Mark because there exists scant Internet references to “gin palaces” or pubs fashioned after the lavish gin-serving pubs that were popular in 19th Century England. As a threshold matter and discussed further in Section III, the intended use of the Mark is not a 19th Century English pub. More importantly, the fact that there exists references to the term on the Internet (predominantly in other countries), or that another establishment has employed the term as a name for a bar (again, in foreign countries) should not preclude registration of the mark. The Board has granted several similar Marks employing the same term “palace” in the face of Internet references memorializing the prior use of those Marks, as illustrated below.¹

Registration No.	Mark	Relevant Goods/Services
RN: 0937471	Crystal Palace	Chandeliers and Glassware
RN: 3378736	Jewel Palace	Jewelry
RN: 3881075	Palace of Sweets	Retail Candy Store
RN: 3672559	Gem Palace	Jewelry
RN: 3517786	Hot Dog Palace	Restaurant services

The term “palace” carries with it a unique meaning in the English lexicon. It is often combined with a variety of different nouns to create an image, a feeling, or some other sensory notion. The court in *Trump*, stated it the best in concluding that “a modifying adjective or noun is employed in connection

¹ While Applicant is aware that the Board is averse to granting significant weight to third party registrations, the similarity of granted registrations in this case is persuasive. Indeed, the United States Court of Appeals for the Federal Circuit stated that “this court encourages the PTO to achieve a uniform standard for assessing registrability of marks.” *In re Nett Designs, Inc.*, 236 F.3d 1336, 1342 (2001).

with "Palace" in order to transform the primary meaning of "Palace" to the metaphorical one[.]" *Trump*, 645 F. Supp. at 1019. A random sampling of searches on the Internet reveals that almost any noun when combined with the term "palace" yields results in numbers equal to and in most cases far greater than the results returned by a search of the term "gin palace." The randomly selected term "hot dog palace" yields 197,000 results the vast majority of which have no affiliation with the trademark holder. (Ex. 1). The term "jewel palace" yields 604,000 results; again, the overwhelming results have no affiliation with the trademark holder. (Ex. 2). The term "gin palace" yields only 156,000 results, far less than the other examples provided. (Ex. 3). Similarly, the following terms, which are randomly selected, yield enormous search results when combined with the word "palace": "pizza palace" – 801,000 results; "painting palace" – 256,000 results; or "gold palace" – 276,000 results. (Ex. 4). Thus, that the Examining Attorney has found other references to "gin palace" on the Internet should not be dispositive of Applicant's trademark application.

Furthermore, the Examining Attorney's Internet results that include the term "Gin Palace" are all outside the United States and refer to a handful of foreign bars that either are called "Gin Palace" or reference the term "gin palace." As a threshold issue, as discussed above, results of the term "palace" combined with any noun can be found on the Internet. If the simple existence of Internet results was the standard for the granting of trademark applications, no word combined with "palace" could ever be successful; yet review of the trademark registry demonstrates that this is not the case. More importantly, the Examining Attorney's decision to reject the Application is based on the conclusion that the term is "merely descriptive." Yet, her examples of Internet results are predominantly foreign bars called "Gin Palace," thus, she is using examples where the term "Gin Palace" is used as a proper noun to argue that it is a merely descriptive common phrase.

Finally, to the extent that there are references in the United Kingdom and Australia to a "gin palace" in a descriptive sense, these terms are archaic and no longer included in today's English lexicon.

Le Blume Import Co. v. Coty, 293 F. 344, 358-359 (2d Cir. N.Y. 1923); *McGraw-Edison Co. v. Walt Disney Productions*, 787 F.2d 1163, 1171 (7th Cir. Ill. 1986) (stating that fanciful or arbitrary marks are also comprised of words which are completely out of use at the time, as with obsolete or scientific terms); *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 8 (1st Cir. R.I. 1981) (stating that where a generic association of a word or term has become obsolete and is discoverable only by resort to historical sources or dictionaries compiled on historical principles to preserve from oblivion obsolete words, then, from the viewpoint of trademark and like law, the word or term is no longer a generic word). This is demonstrated, if by nothing else, by the clear omission by the Examining Attorney of any current mention of the term “gin palace” in a descriptive context.

III. DISCLAIMER

The Examining Attorney takes issue with Applicant’s disclaimer of the term “palace.” The sole disclaimer that should be included in the application is as follows: no claim is made to the exclusive right to use “gin” apart from the mark as shown.

IV. REQUIRED INFORMATION ABOUT SERVICES

Gin Palace is to be a restaurant dedicated to foods, both sweet and savory, that include as an ingredient spirits derived from grain and juniper berries. (Gin Palace menu and recipes, Ex. 5). Three examples of menu items (included in Ex. 5) are: (1) Tuna tartar with gin basil aioli and sweet potato chips; (2) Roasted Lamb shank with fennel orange gin reduction; and (3) Sticky gin pudding. Gin Palace will also serve as a New York East Village Rock ‘n Roll Music sanctuary. (Example literature, Ex. 5). Organized by an East Village band affiliated with the venue, Gin Palace will cater to artists dedicated to producing good music. In this respect, Gin Palace will be a mix between a Hard Rock Café, high-end restaurant Daniel, the House of Blues and the Rock ‘n Roll Hall of Fame. (Websites of similar concepts, Ex. 6). Targeted customers include food aficionados, wine fans and music lovers located in the greater

New York City area. Channels of trade run parallel with concert event itineraries and music and food trade shows.

V. CONCLUSION

For the above-referenced reasons, Examining Attorney's conclusions should be rejected and full registration should be awarded to Applicant

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