

## Blog Post

# The Joint is Just a Music Joint, Not a Trademark

March 10, 2020

The Federal Circuit in *In re JC Hospitality LLC* recently affirmed the United States Patent and Trademark Office, Trademark Trial and Appeal Board’s refusal to register the service mark THE JOINT for a venue offering entertainment and restaurant services. The Circuit affirmed the Board’s unusually high evidentiary standards for demonstrating that a trademark has acquired distinctiveness.

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## Background

JC Hospitality, LLC, as the trademark applicant for The Hard Rock Hotel & Casino in Las Vegas (Hard Rock), filed two trademark applications for THE JOINT with the USPTO for its music venue at the casino. The Examining Attorney refused registration on the ground that THE JOINT was descriptive of, and possibly generic for, the applied-for services.

Hard Rock appealed to the Board, which affirmed the Examining Attorney’s refusal. Hard Rock then appealed to the Board’s reviewing court, the Federal Circuit.

## The Circuit Opinion

Trademarks are evaluated for eligibility for registration and protection based on the mark’s placement on the distinctiveness spectrum: generic, “merely descriptive,” suggestive, arbitrary, and

fanciful. Fanciful marks are entitled to the broadest scope of protection. Generic words are never eligible for trademark protection. Descriptive terms can sometimes qualify for trademark protection, if they have acquired distinctiveness over time.

A descriptive term is defined as one that describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. In determining whether a mark has acquired distinctiveness, the USPTO or a court may consider: (1) purchasers' association of a mark with its owner (typically by means of consumer surveys); (2) the length, degree, and exclusivity of use; (3) the amount and manner of advertising; (4) sales and number of customers; (5) intentional copying; (6) unsolicited media coverage of the product or service bearing the mark.

In this case, the USPTO had evidence of common use of the term "joint" describing restaurant and entertainment services, such as dictionary definitions and third party use shown in newspaper articles. Hard Rock argued that, while the USPTO's evidence may have shown that the term "joint" alone – *without* the preceding article "the" – may mean something in the common parlance, its trademark THE JOINT did not. Additionally, Hard Rock argued, its use of "THE JOINT" was not descriptive because it was a double-entendre, as "The Joint" could just as easily mean "prison." Finally, Hard Rock argued, even if THE JOINT was broadly descriptive of restaurant and entertainment services, its own venue was sufficiently well-known to consumers for its trademark THE JOINT to warrant trademark protection based on acquired distinctiveness.

The Court quickly agreed with the Board that substantial evidence supported the USPTO's contention that the public commonly understands the term "The Joint" to refer to a restaurant or entertainment venue. Likewise the Court readily agreed with the Board the "THE JOINT" was not a double-entendre because Hard Rock did not

demonstrate a relationship between prison and the applied-for services. See TMEP 1213.05(c) (For trademark purposes, a ‘double-entendre’ is an expression that has a double connotation or significance as applied to the goods or services).

Most notably, the Court found insufficient evidence to support Hard Rock’s contention that its trademark THE JOINT has acquired distinctiveness. Hard Rock showed that its trademark THE JOINT has been in continuous and exclusive use since 1995, that it has spent more than \$12 million in marketing expenditures for THE JOINT and total gross revenue of more than \$104 million. Hard Rock also showed that a variety of online websites and forums (e.g., Yelp, Trip Advisor, YouTube) demonstrated press and public recognition.

The Court, however, agreed with the Board that such evidence was insufficient. The advertising and revenue figures were unpersuasive because there was no context for how those figures compared to similar restaurants and nightclubs. Further, the unsolicited third party mentions were often connected with other marks such as “HARD ROCK,” making it difficult to determine how consumers viewed the trademark THE JOINT. The Circuit concluded that “the Board’s finding that [Hard Rock] has not demonstrated acquired distinctiveness is supported by substantial evidence.”

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Trademark practitioners often try to demonstrate acquired distinctiveness by adducing evidence of advertising and marketing expenditures related to the applied-for mark. While practitioners commonly know that evidence of these expenditures (as well as unsolicited media mentions) need to relate solely to the mark at issue and cannot be combined with the applicant’s other trademarks, the Board and Circuit here warn that evidence of such expenditures must also be viewed in relation to what the applicant’s competitors spend. It is unclear, however, how an

applicant is expected to have that information. This opinion may make it much more difficult for trademark owners to prove acquired distinctiveness.

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