

MAR 29 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Consolidated Specialty Restaurants, Inc. : BEFORE THE
Trademark: COLORADO STEAKHOUSE and : TRADEMARK TRIAL
design
Serial No: 75/857797 : AND
Attorney: Gregory B. Coy : APPEAL BOARD
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EXAMINING ATTORNEY'S SUBSTITUTE APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark "COLORADO STEAKHOUSE" and design for "restaurant services" on the grounds that the mark is geographically deceptively misdescriptive under Trademark Act Section 2(e)(3).

I. FACTS

On November 24, 1999, the applicant applied for registration on the Principal Register for the mark "COLORADO STEAKHOUSE" and design for "restaurant services." Registration was refused under Trademark Act Section 2(e)(3), 15 U.S.C. Section 1052(e)(3), because the mark is geographically deceptively misdescriptive of the services. The applicant responded by arguing against the refusal and claiming that the mark "has acquired distinctiveness through its substantially continuous and exclusive use of the mark in commerce." *Applicant's Response of October 23, 2000*, p. 5. In a second Office action, the Examining Attorney refused to register the mark based on Section 2(f)



because a mark is registrable upon a showing of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), only if it became distinctive of the goods or services in commerce before December 8, 1993, the date of the enactment of the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057. In the alternative, the Examining Attorney issued the requirement for a disclaimer of the words COLORADO STEAKHOUSE if the services originate in Colorado. On March 8, 2002, the refusal of the mark as geographically deceptively misdescriptive under Trademark Act Section 2(e)(3) was made final.

On December 30, 2003, the applicant filed an Appeal Brief and on March 10, 2003, the Examining Attorney filed an Appeal Brief solely on the issue of whether the mark is geographically deceptively misdescriptive under Trademark Act Section 2(e)(3). Subsequently, the Examining Attorney requested that the case be remanded for consideration in light of the decision in *In re California Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003). The application was remanded to the Examining Attorney and on November 10, 2003, an Office action was issued maintaining the refusal under Section 2(e)(3) of the Trademark Act.

II. OBJECTION TO EVIDENCE

As a preliminary matter, the Examining Attorney objects to the inclusion into the record the documents attached by the applicant to its first Brief in Support of Appeal filed on December 30, 2002. The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d). The new evidence which the applicant has attempted to introduce should be excluded from the record. These documents are clearly untimely under Trademark Rule 2.142(d) and should not be considered. It is well settled that the record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal will be given no consideration by the Board in reaching its



decision. The applicant could have timely filed any additional evidence as part of its request for reconsideration, but applicant did not avail itself of this opportunity, thereby providing no opportunity for the Examining Attorney to consider the evidence and respond thereto. Therefore, the documents should be given no consideration. *See* Trademark Rule 2.142(d) and TBMP §§ 1106.07(b) and 1207.01; *see also, In re Duofold*, 184 USPQ 638 (TTAB 1974).

III. ARGUMENT

THE PROPOSED MARK OF THE APPLICANT IS GEOGRAPHICALLY DECEPTIVELY MISDESCRIPTIVE OF THE APPLICANT'S SERVICES.

The single issue on appeal is whether the applicant's mark "COLORADO STEAKHOUSE" and design is geographically deceptively misdescriptive of "restaurant services."

To support a refusal to register a mark as primarily geographically deceptively misdescriptive, the following criteria must be met:

- (1) the primary significance of the mark is a generally known geographic location; and
- (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods and/or services bearing the mark, when in fact the goods and/or services do not come from that place; and
- (3) the misrepresentation was a material factor in the consumer's decision.

In re California Innovations, Inc., 329 F.3d 1334, 66 U.S.P.Q. 2d 1853 (CAFC 2003).

A) PRIMARY SIGNIFICANCE OF THE MARK IS GEOGRAPHIC.

The applicant's mark is a composite mark which combines the geographically deceptively misdescriptive word "COLORADO" with the descriptive word "STEAKHOUSE" and a design element which includes the silhouette of a mountain range. A mark is primarily geographic if it identifies a real and significant geographic location, and the primary meaning of the mark is the geographic meaning. In the Office action of April 21, 2000, the Examining Attorney submitted a definition of the word "COLORADO" which reads "a state of the west-central United States." *The American Heritage Dictionary of the English Language, Third Edition* (1992). The primary significance of the word "COLORADO" is geographical. The primary significance of the mark as a whole is likely to be perceived as indicating the geographic origin of the services. Moreover, the additional matter in the mark does not alter the geographic significance of the mark. The word "STEAKHOUSE," which has been disclaimed, would be perceived as merely informational in connection with the services and does nothing to alter the primary geographic significance of the mark. Furthermore, the design element featuring the silhouette of a mountain range in fact reinforces the geographic significance of the mark in that Colorado is home to the well-known Rocky Mountains.

B) A SERVICES/PLACE ASSOCIATION EXISTS

The second prong of the test is whether the consuming public is likely to believe that the geographical location identified in the mark indicates the origin of the services,

when in fact the services do not come from that place. This test is essentially a test of whether a public association exists in the minds of consumers between the applicant's services and Colorado. Here, a public association exists between the applicant's services and Colorado because purchasers are likely to believe that the services originate in Colorado. Included in the Office action of March 8, 2001, was evidence that a services-place association exists between restaurant services, specifically steakhouses, and the State of Colorado. The evidence of record demonstrates that there are steakhouses in Colorado. The Examining Attorney attached excerpts from the websites www.gjcolorado.com and www.restauranteur.com to the Office action mailed on March 8, 2001, as evidence that a services-place association exists between restaurants and Colorado. However, this evidence alone is not enough to establish the services-place association under the test set forth in *In re California Innovations*.

In re Les Halles de Paris J.V., 67 U.S.P.Q. 2d 1539 (CAFC 2003) was decided subsequent to *In re California Innovations* and addressed the question of a refusal under Section 2(e)(3) as it applies to services. The court stated:

In the case of a services-place association, however, a mere showing that the geographic location in the mark is known for performing the service is not sufficient. Rather the second prong of the test requires some additional reason for the consumer to associate the services with the geographic location invoked by the mark. *Id* at 1542.

In the present case, the additional reason for the consumer to associate the services with the geographic location named in the mark is that the State of Colorado is noted for its steaks. The Examining Attorney has submitted evidence that Colorado is known for its steaks. In the Office action of March 8, 2001, the Examining Attorney

attached excerpts from the websites WWW.CHAPARRALSTEAKHOUSE.COM and WWW.WINTERPARK-INFO.COM as well as the LEXIS/NEXIS articles as evidence that Colorado is known for its steaks. The Examining Attorney attached additional LEXIS/NEXIS articles to the Office action of October 28, 2002, and more excerpts from websites were attached to the Office action of November 10, 2003. This evidence establishes the services-place association between the restaurant services and Colorado because consumers will believe that the steaks served in the applicant's restaurants originate in Colorado.

The applicant has questioned the quality of the evidence submitted by the Examining Attorney by noting that much of it emanates from Colorado and is "self-serving" to the Colorado advertisers. *Applicant's Substitute Appeal Brief*, p. 6. While it is true that some of the evidence is in the nature of advertisements for Colorado restaurants, the Examining Attorney notes that the website WWW.CITYSPIN.COM attached to the November 10, 2003 action is from a restaurant located in Chicago, Illinois. This website states that the restaurant "specialties include prime *Colorado steaks* [emphasis added]." The website WWW.CHAPARRALSTEAKHOUSE.COM is from a restaurant located in Orlando, Florida and indicates that they serve "only the finest aged choice grade *Colorado steaks* [emphasis added]." Moreover, the LEXIS/NEXIS articles that have been made of record include articles from *The Washington Post*, *Texas Monthly*, *Albuquerque Journal*, *Capital Times* (Madison, Wisconsin), *The Salt Lake City Tribune*, *Nation's Restaurant News*, *Sun-Sentinel* (Fort Lauderdale, Florida), *USA Today*, and *The New York Times*. The evidence demonstrates that consumers across the United States recognize the quality of Colorado steaks and are likely to seek them out.

The court in *In re Les Halles* stated that the Examining Attorney must show that consumers “will likely be misled to make some meaningful connection between the restaurant (the service) and the relevant place.” *In re Les Halles de Paris J.V.* at 1542. The court goes on to provide examples of the ways in which the Trademark Office might establish the services-place association. The court states, in pertinent part, as follows:

For example, the PTO might find a services-place association if the record shows that patrons, though sitting in New York, would believe the food served by the restaurant was imported from Paris, or that the chefs in New York received specialized training in the region in Paris, or that the New York menu is identical to a known Parisian menu, or some other heightened association between the services and the relevant place. *Id* at 1543.

In the present case, the services-place association has been established by the fact that the State of Colorado is so well known for its steaks. Because of this notoriety, consumers patronizing the applicant’s steakhouse named for Colorado will expect that the steaks served by the restaurant come from Colorado.

The Court of Appeals for the Federal Circuit has held that geographic regions noted for certain products or services are likely to expand from their traditional goods or services into related goods or services. *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001). The court held that “the registrability of a geographic mark may be measured against the public’s association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there.” *Id* at 1355. Because the State of Colorado is well known for its steaks, consumers dining in the applicant’s restaurants will expect that the services or the items featured on the menu originate in Colorado.

Marks that are primarily geographically deceptively misdescriptive are not permitted to register because such marks mislead the public into believing that the goods or services originate in the geographic location named in the mark when in fact they do not originate in that location. The services of the applicant do not originate in Colorado. The applicant's address is in Indianapolis, Indiana. Moreover, in the Office action of October 28, 2002, the Examining Attorney highlighted the fact that the applicant's menu indicates that all of its restaurants are located in Indiana and Illinois.

The applicant has argued that its restaurant services originate in Colorado because "that is the location from which the restaurant concept originates." *Applicant's Response of September 10, 2001*, p. 5. The applicant continues by arguing that its restaurants include Colorado Rocky Mountain, western and Colorado ski-lodge themes and feature "décor and artwork" that furthers these themes. *ID* at 5.

The applicant's argument that restaurant services can be said to originate from a geographic location based on a "theme" or "concept" established by décor and artwork is without merit. Establishing atmosphere and theme with décor and artwork evoking a geographic location do not equate with the origination of the services. In fact, in this case the décor and artwork further the geographically deceptively misdescriptive nature of the mark because they promote the idea that the restaurant services are from Colorado. The mark is geographically deceptively misdescriptive precisely because it promotes a connection with Colorado where none in fact exists.

The applicant continues this line of argument in its Brief. The applicant states that the "style of cooking, the atmosphere, the concept and at least some of the fixtures and decorations come from or originate in Colorado." *Applicant's Substitute Appeal*

Brief, p. 12. As argued above, fixtures and decorations evoking Colorado do not serve to identify the geographic location from which services originate. To the contrary, decorations and fixtures suggesting a connection to a geographic location where none exists further the geographically deceptively misdescriptive nature of the mark in relation to the services. In short, the record herein strongly supports the conclusion that applicant's restaurant theme, as discussed by the applicant in its responses and briefs, encourages the services-place association.

In addition, the applicant's argument that the mark describes a "style of cooking" is unpersuasive. The applicant must put forth evidence demonstrating that there is a "Colorado style" of cuisine for the restaurant services at issue. *In re Wada*, 194 F.3d 1297, 194 USPQ2d 1539 (Fed. Cir. 1999). The applicant has not submitted any evidence that a Colorado "style of cooking" or cuisine exists. There is nothing in the record to suggest that the geographic term COLORADO describes a style of cooking. The fact that Colorado is known for steaks is not the same as Colorado being known for a style of cooking. Therefore, on the basis of the foregoing, an association exists between the applicant's restaurant services and Colorado under Section 2(e)(3) of the Trademark Act.

C) MISREPRESENTATION IS A MATERIAL FACTOR IN THE CONSUMER'S DECISION

Lastly, in order to establish that a mark is geographically deceptively misdescriptive within the meaning of Section 2(e)(3), the Examining Attorney must establish that the misrepresentation is a material factor in the consumer's decision to

purchase the services. *In re California Innovations* at 1859. In other words, the Examining Attorney must demonstrate that the geographically misdescriptive word “Colorado” in the mark will be a material factor in the consumer’s decision to patronize the applicant’s restaurants. Once again, the Court in *Les Halles de Paris* provided guidance as to establishing materiality:

For restaurant services, the materiality prong might be satisfied by a particularly convincing showing that identified the relevant place as famous for providing the specialized culinary training exhibited by the chef, and that this fact is advertised as a reason to choose this restaurant. In other words, an inference of materiality arises in the event of a very strong services-place association. Without a particularly strong services-place association, an inference would not arise, leaving the PTO to seek direct evidence of materiality. In any event, the record might show that customers would patronize the restaurant because they believe the food was imported from, or the chef was trained in, the place identified by the restaurant’s mark. *Id* at 1543.

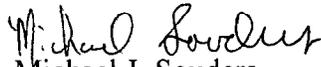
As suggested by the court, materiality might be demonstrated by a very strong services-place association. The evidence of record is replete with examples demonstrating that Colorado is well known for steaks and its steakhouses. This evidence provides a heightened association between the services and the geographical denotation Colorado. As indicated above, one way to demonstrate “materiality” is to demonstrate that the purchasing public will believe that the food was “imported” from the geographical location named in the mark. The evidence of record establishes that the State of Colorado is renowned for its steaks. “Steakhouse” restaurants specialize in steak and people go to these restaurants to dine on steak. Consumers will patronize the applicant’s restaurants because they realize that the State of Colorado is known for the quality of its steaks and they believe that the steaks served by a restaurant named

COLORADO STEAKHOUSE are Colorado steaks. The geographically deceptively misdescriptive word "COLORADO" will induce consumers to patronize the applicant's restaurants believing that the services originate in Colorado and that they will be served steaks from Colorado.

IV. CONCLUSION

Based on the evidence of record, the proposed mark COLORADO STEAKHOUSE is geographically deceptively misdescriptive of the applicant's services. The significance of the mark is primarily geographic but the services do not originate in the place named. Despite the applicant's arguments, no evidence has been submitted indicating that the applicant's restaurant services originate in Colorado. For the foregoing reasons, the refusal to registration under Section 2(e)(3) of the Trademark Act, 15 U.S.C. Section 1052 (e)(3) should be affirmed.

Respectfully submitted,


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