

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re trademark application of:)
)
Consolidated Specialty Restaurants, Inc.)
)
Serial No.: 75/857,797)
)
Filed: November 24, 1999)
)
COLORADO STEAKHOUSE)
And Design)

Examining Attorney:
Michael J. Souders

Law Office 115



04-22-2004

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

April 19, 2004

**APPLICANT'S REPLY TO EXAMINING ATTORNEY'S
SUBSTITUTE APPEAL BRIEF**

BOX TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Dr., Arlington, Virginia 22202-3514 on	
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(Date of Deposit)	
Scott J. Stevens	
Name of Registered Representative	
Signature	
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To the Trademark Trial and Appeal Board:

INTRODUCTION

Applicant has appealed, by Notice of Appeal filed on September 9, 2002, the Examining Attorney's refusal under Section 2(e)(3) of the Trademark Act to register the mark COLORADO STEAKHOUSE and Design for use in connection with "restaurant services." The refusal was made on the grounds that Applicant's mark is geographically deceptively misdescriptive of the identified services. Applicant submitted its original Appeal Brief on December 30, 2002. The file was remanded to the Examining Attorney for reconsideration in

view of the recent CAFC decision in *In re California Innovations, Inc.*, 329 F.3d 1334 (CAFC 2003). The Examining Attorney maintained his refusal to register, and the appeal was resumed. Pursuant to the Board's Order, Applicant filed a Substitute Appeal Brief, and the Examining Attorney followed with his Substitute Appeal Brief, maintaining the position that the mark is geographically deceptively misdescriptive. Applicant continues to believe that the COLORADO STEAKHOUSE and Design mark is entitled to registration, and submits this Reply to the Examining Attorney's Substitute Appeal Brief. Applicant respectfully requests that the Board reverse the Examining Attorney's decision, and allow the mark to pass to publication.

ARGUMENTS

- I. THE REFUSAL TO REGISTER IS IMPROPER BECAUSE THE EXAMINING ATTORNEY DID NOT PRESENT SUFFICIENT EVIDENCE TO SHOW THAT THE CONSUMING PUBLIC IS LIKELY TO BELIEVE THAT THE PLACE IDENTIFIED BY THE MARK INDICATES THE ORIGIN OF THE SERVICES

The Examining Attorney has taken the position that a heightened services-place association exists in the minds of consumers encountering the mark COLORADO STEAKHOUSE and Design, and purports to support that position based on a number of articles and internet references. However, the majority of these references are from publications or entities located in Colorado, and as such are self-serving and do not provide sufficient proof that consumers outside of Colorado form a services-place association with Colorado and beef. Other references cited by the Examining Attorney use the term "Colorado" in a way that does not necessarily indicate a heightened association of consumers, such as a description of a Superbowl bet between Congressmen, "a Long Island duck dinner against a Colorado steak dinner." The mere reference that something called a "Colorado

steak” exists does not make Colorado steaks famous. Applicant does not dispute the fact that beef cattle are raised, butchered and made into steaks in Colorado. Applicant disputes that the evidence presented by the Examining Attorney is not sufficient to show that the general public of consumers values steaks from Colorado more than they value steaks from other cattle-producing states, such that they would specifically search out Colorado beef. As shown in the attachments to Applicant’s Substitute Appeal Brief, the states of Texas, Kansas, Nebraska, Oklahoma, California, South Dakota, Missouri, Iowa, Wisconsin and Montana all raise more cattle than Colorado. Examples of references to Wisconsin steaks, Nebraska steaks, and Iowa steaks, downloaded from the internet and printed by the undersigned attorney for Applicant, are attached to this Reply and demonstrate that a mere reference to the fact that a given location produces beef does not in itself establish the strong services-place association that is necessary to prove a mark is geographically deceptively misdescriptive under *In re Les Halles*. The Examining Attorney has not presented any evidence that shows **why** steaks from Colorado would be more sought after than steaks from Wisconsin, Nebraska, Iowa, or Texas, for example, or even that they are more sought after at all.

Additionally, the Examining Attorney’s refusal now only focuses on the geographic source of the steaks in Applicant’s restaurant. The Court in *In re Les Halles*, however, described components other than the source of the food itself that can be used in determining a services-place association for restaurants, such as where the chefs were trained, or where the menu items originated. It has long been Applicant’s position is that the Examining Attorney has not considered the variety of components that make up a consumer’s notion of restaurant services in the United States, which has led to the Examining Attorney applying Section 2(e)(3) too narrowly, as well as too narrowly interpreting the Court’s instructions in *In re Les Halles*.

II. THE REFUSAL TO REGISTER IS IMPROPER BECAUSE THE EXAMINING ATTORNEY DID NOT PRESENT SUFFICIENT EVIDENCE TO SHOW THAT THE SERVICES-PLACE ASSOCIATION WAS A MATERIAL FACTOR IN THE CONSUMER'S DECISION TO VISIT APPLICANT'S RESTAURANTS

The Court in *In re Les Halles* admitted that “geographic marks in connection with services are less likely to mislead the public than geographic marks on goods.” *In re Les Halles*, 67 U.S.P.Q.2d 1539, 1542 (CAFC 2003). To create an inference of materiality, a very strong services-place association must be established. As stated above, Applicant does not believe that the Examining Attorney has shown that even a weak services-place association exists, much less that the association is very strong. “Without a particularly strong services-place association, an inference would not arise, leaving the PTO to seek direct evidence of materiality.” *Id.* at 1542. The Examining Attorney has presented no evidence that consumers viewed the geographic source of steaks important in deciding to patronize Applicant's restaurants, and he certainly has not presented evidence that consumers viewed Colorado as a preferred source of beef over other beef-producing states.

As further support, Applicant suggests that it would not be disputed that Paris, France is famous for its food, certainly much more so than Colorado is well-known for its steaks. Yet the Court found that without evidence of a material deception of consumers, the mark LE MARAIS (a well-known area of Paris) was not geographically deceptively misdescriptive for restaurant services. The Court also states that “[a]t best, the evidence in the record shows that Les Halles' restaurant conjures up memories or images of the Le Marais area of Paris. This scant association falls far short of showing a material services-place association.” *Id.* at 1542. Similarly, the Examining Attorney in the present case has not presented any evidence of a material deception of consumers, either, and consequently, the mark COLORADO STEAKHOUSE and Design cannot be found to be geographically deceptively misdescriptive.

III. THE REFUSAL TO REGISTER IS IMPROPER BECAUSE CERTAIN COMPONENTS OF RESTAURANT SERVICES, NAMELY, THEME, STYLE AND CONCEPT OF THE SERVICES, ARE SUFFICIENT TO OVERCOME A REFUSAL UNDER SECTION 2(E)(3) AND SUCH COMPONENTS OF APPLICANT'S SERVICES IDENTIFIED BY THE SUBJECT MARK DO ORIGINATE IN COLORADO

The Court in *In re Les Halles*, in describing the factors that could be used to establish materiality for restaurant services in the minds of consumers, was clear that the source of the food was only one factor, stating “[t]he importation of food and culinary training are only examples, not exclusive methods of analysis, as already noted.” *Id* at 1542. Although the Examining Attorney has used other factors in earlier Actions, e.g., the location of the restaurant’s headquarters, to determine the source Applicant’s services, he now relies solely on the source of the food, i.e., steaks, as the only basis for which Applicant’s mark may be judged under Section 2(e)(3).

As recognized in prior opinions cited in the record of this case, the "origin" of restaurant services can be considered to involve a variety of elements, such as, but not limited to, the origin of the recipes, the origin of the restaurant concept (which encompasses the ambience and the images created in the minds of consumers), or the place where the fixtures and decorations were designed or made. As is clear in the record, Applicant’s restaurants embody a number of these elements and, as such, its mark COLORADO STEAKHOUSE and Design cannot be found to be geographically deceptively misdescriptive.

In view of the above, Applicant submits that consumers of its services are not deceived in any way by the mark COLORADO STEAKHOUSE and Design. In the present case, the style of cooking, the atmosphere or ambience, the concept, and at least some of the fixtures and decorations come from or have their designs originating in Colorado. This is

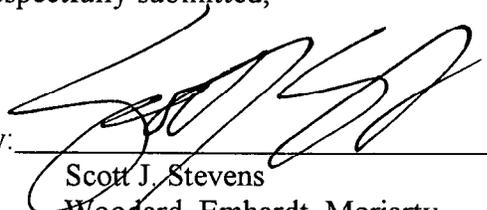
consistent with what consumers would expect from a restaurant. Applicant therefore submits that its mark cannot properly be found to be geographically deceptively misdescriptive under section 2(e)(3).

CONCLUSION

For all of the above reasons, Applicant submits that the Examining Attorney's refusal to register the mark COLORADO STEAKHOUSE and Design under Section 2(e)(3) of the Trademark Act is in error and should be reversed. Applicant submits that continued refusal to register the mark would do an injustice to the Applicant and that Applicant's mark is not geographically deceptively misdescriptive of the services identified. Applicant therefore respectfully requests that the Trademark Trial and Appeal Board reverse the decision of the Examining Attorney, and allow the Applicant's mark COLORADO STEAKHOUSE and Design to pass to publication.

April 19, 2004

Respectfully submitted,

By: 

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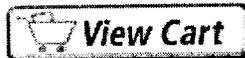


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- Filet Mignon
- Boneless Ribeye Steak
- Porterhouse
- Ribeye
- Top Sirloin

RELATED

- Iowa Beef Industry Council
- National Cattle Beef Association
- FoodS
- Iowa Office



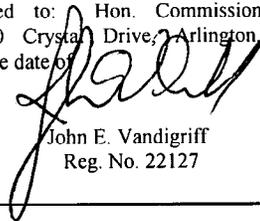
04-22-2004

Serial No. 78/116593

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Active Organics, Inc.	
Filed: March 21, 2002	BEFORE THE TRADEMARK TRIAL
Serial No. 78/116593	AND
Mark: ACTIVE ORGANICS	APPEAL BOARD ON APPEAL

I certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Hon. Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Va., 22202-35 13, on the date of 
 April 19, 2004
 John E. Vandigriff
 Reg. No. 22127

THE TRADEMARK TRIAL
 AND
 APPEAL BOARD
 2900 Crystal Drive
 Arlington, Va., 22202-3513

REPLY BRIEF ON APPEAL

Sir:

This Appeal Brief is being filed in response to the communication mailed on November 19, 2004.

The Examining Attorney rejected the application as follows:

FINAL REFUSAL TO REGISTER THE MARK UNDER SECTION 2(d)

Comments of the Examining Attorney

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 2,392,412 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive.

Serial No. 78/116593

Reply to the Examining Attorney's Comments

Registration No. 2,392,412, is in only one class. The present mark is used in other classes as listed below. The mark of the present application should, at a minimum, be registered in those classes in which the above referenced mark is not registered.

BOTANICAL EXTRACTS

International Class: 001

First Use Date: 1981-12-10

First Use in Commerce Date: 1981-12-10

NATURALLY DERIVED MATERIALS USED ALONE OR AS INGREDIENTS IN THE PREPARATION OF COSMETIC

International Class: 003

First Use Date: 1981-12-10

First Use in Commerce Date: 1981-12-10

PHARMACEUTICAL

International Class: 005

First Use Date: 1981-12-10

First Use in Commerce Date: 1981-12-10

FOOD SUPPLEMENT PRODUCTS

International Class: 030

First Use Date: 1981-12-10

First Use in Commerce Date: 1981-12-10

Priority and prior used should be considered

It should be noted that the first use in commerce was December 10, 1981. There has been continuous use since that time. The mark has become well known and associated with Applicant and its products for this twenty-two year period. It is believed that since there has been this extended use of the mark, and its association with Applicant, there should be no confusion. Also, if Applicant elected to have the mark registered under the Supplemental Register, the normal five years of use has been greatly exceeded and it would be transferred to the Principal Register.

The owner (Registrant) Registration No. 2392412 has only used the mark in commerce since November 24, 1999. The owner of this registration has not requested that Applicant not use the mark since they know they would lose because of Applicant's prolonged use. Further, Registrant has registered only in Int. class 003, whereas Applicant has and used the mark in Int. Classes 001, 003, 005 and 030. This gives Applicant a wider exposure to the various industries who recognize and associate the mark with the Applicant. Based upon the above, it is believed that Applicant's mark should be registered in the requested International classes.

Serial No. 78/116593

The Examining Attorney has also refused the mark as follows.

FINAL REFUSAL TO REGISTER THE MARK UNDER SECTION 2(e) (1)

Registration was refused under Trademark Act Section 2(e) (1), 15 U.S.C. §1 052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified goods.

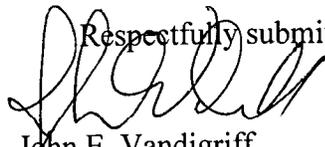
The argument of the examiner is not appropriate since Registration No. 2,392,412, has been registered. It was not found to be "merely descriptive of the identified goods". It is the same mark!

Identification of Goods

The Examining Attorney has accepted the amendments to the identification of goods.

Summary

Based upon the continued use since 1981, and the product acceptances of the industry, and since the mark is not descriptive of the products, it is respectfully requested that the Examiner be reversed, the mark be allowed for publication.

Respectfully submitted,

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