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

**In re the application of:**  
The Original Philadelphia Cheesesteak Co.

**: Law Office: 101**

**Serial No.:**  
76/126,277

**: Examiner: Tanya L. Amos**

**Filed:**  
September 12, 2000

**: Docket No.: 20211.TUS**

**For: Trademark**  
**PHILADELPHIA CHEESESTEAK CO.**

07-15-2003

U.S. Patent & TMO/tm Mail Rpt Dt. #22

**REQUEST FOR RECONSIDERATION**

Appellant hereby requests reconsideration of the final refusal for Registration on the basis that the above-identified mark has become distinctive of Appellant's goods in commerce and under § 2(f) of the Trademark Act is entitled to Registration. 15 U.S.C. § 1052(f). Appellant submits evidence of this distinctiveness in its brief, filed concurrently herewith.

Respectfully submitted,

[Signature]  
**EUGENE E. RENZ, JR.**  
Attorney for Appellant  
Registration No. 19,557

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September 12, 2000

: **Docket No.:** 20211.TUS

**For:** Trademark  
PHILADELPHIA CHEESESTEAK CO.

**REQUEST FOR ORAL HEARING**

Appellant hereby requests an oral hearing pursuant to 37 C.F.R §2.142(e)(1).

Respectfully submitted,

**EUGENE E. RENZ, JR.**  
Attorney for Appellant  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>In re the application of:</b>	:	<b>Law Office:</b> 101
The Original Philadelphia Cheesesteak Co.	:	
	:	
<b>Serial No.:</b>	:	<b>Examiner:</b> Tanya L. Amos
76/126,277	:	
	:	
<b>Filed:</b>	:	<b>Docket No.:</b> 20211.TUS
September 12, 2000	:	
	:	
<b>For:</b> Trademark	:	
<b>PHILADELPHIA CHEESESTEAK CO.</b>	:	

**BRIEF FOR APPELLANT**

**INTRODUCTION**

Appellant hereby appeals from the Examiner’s refusal to register the above-identified mark filed on September 12, 2000, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examiner’s decision. Appellant respectfully requests the Trademark Trial and Appeal Board suspend the Appeal, so that Appellant can request reconsideration of the present refusal by the Examining Attorney. In addition, an oral hearing is requested by a separate notice filed

concurrently herewith. Accordingly, this Brief is submitted herewith in triplicate.

### **APPLICANT'S TRADEMARK**

Applicant seeks registration on the Principal Register of its mark:

**PHILADELPHIA CHEESESTEAK CO.**

### **THE REJECTION**

The Examiner refused registration of Applicant's mark contenting that the mark is merely descriptive under Trademark Act § 2(c)(1), 15 U.S.C. 1052(e)(1).

### **ARGUMENT**

#### **1. APPELLANT'S MARK HAS DEVELOPED A SECONDARY MEANING.**

Over the five (5) years appellant has been using its mark exclusively and continuously in the market for prepared foods, namely meats. Throughout Appellant's exclusive and continuous use of the mark, Appellant has incurred on average approximately Five Hundred Seventy Thousand Dollars (\$570,000) on marketing and advertising expenditures annually. In addition, Appellant respectfully submits charts of Appellant's annual sales from inception of the mark to present, attached hereto as Exhibit "1". In this chart, the board will note that during Appellant's use of the mark, Appellant's company experienced a substantial sales growth between the second and third year of approximately 70%. Appellant's average annual growth under the mark is in the 30<sup>th</sup> percentile. Appellant also

encloses a Declaration under 37 C.F.R. § 2.20 attesting to Appellant's exclusive and continuous use of the mark as early as 1998, attached hereto as Exhibit "2".

In addition to the sales charts submitted, Appellant also submits a print out of Appellant's website, <[phillycheesesteak.com](http://phillycheesesteak.com)>. Under the hyperlink, LOCATIONS, Appellant currently markets its goods and products in thirty-five (35) states in the United States, the United States Territory of Puerto Rico, and Canada, attached hereto as Exhibit "3". Appellant offers these Exhibits as evidence that Appellant's mark is exclusively associated with Appellant, as the single source of the mark, **PHILADELPHIA CHEESESTEAK CO.**

### **CASE LAW**

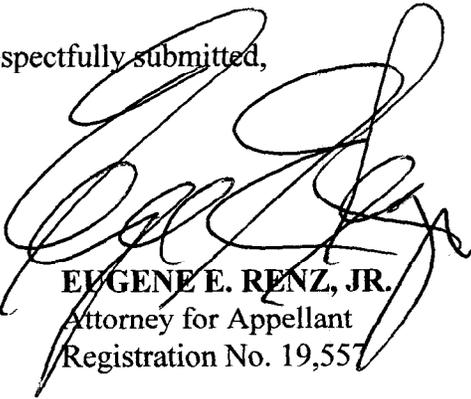
Under Trademark Act § 2 (f), U.S.C. § 1052 (f), a mark which has become distinctive of the applicant's goods in commerce shall not be prevented from registering the mark. Courts recognize that direct proof of secondary meaning is difficult to obtain. *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 596 (6<sup>th</sup> Cir. 1989). Instead, courts must draw reasonable inferences from a variety of factors, including length and manner of use, extent of advertising, sales volume, others' efforts to copy, and testimony from consumers and distributors. *See id.* at 596; *Sprinklets Water Center, Inc. v. McKesson Corp.*, 806 F.Supp. 656, 661 (E.D.Mich.1992); *see also Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 291-94 (7th Cir.1998), *Yamaha Intern. Corp v. Hoshino Gakki Co.*, 840 F.2d 1572 (Fed. Cir. 1988) (Court held that proof based on advertising and promotion in conjunction with other circumstantial factors was sufficient to establish secondary meaning and there is no obligation to introduce survey evidence).

**CONCLUSION**

For the reasons set forth hereinabove, Appellant submits that the mark has developed secondary meaning in the consumer market and has become distinctive and identifies Appellant as the source of the goods sold under the mark. Accordingly, Appellant's mark is entitled to registration under 15 U.S.C. § 1052(f).

The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Appellant's mark.

Respectfully submitted,



**EUGENE E. RENZ, JR.**  
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