

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: January 17, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Restaurant Company

Serial No. 77508734

Scott J. Major of Millen, White, Zelano & Branigan, PC for The Restaurant Company.

Jeffrey C. Coward, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Lykos, and Shaw, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark CHA CHA,¹ in standard character form, for "restaurant services" in International Class 43.²

The Trademark Examining Attorney has issued a final refusal to register applicant's mark on the ground that applicant has

¹ Applicant originally applied to register the mark CHA CHA'S pursuant to Section 1(b). The application was approved for publication, and subsequently published for opposition on November 25, 2008. On June 15, 2009, applicant filed a statement of use. After reviewing the statement of use, the examining attorney advised applicant that the mark on the drawing (CHA CHA'S) disagreed with the mark as displayed on the specimens of record (CHA CHA). On January 4, 2010, applicant responded by amending the proposed mark to CHA CHA which was accepted by the examining attorney.

failed to submit an acceptable specimen demonstrating use of the mark as a service mark. Trademark Act Sections, 1, 3 and 45, 15 U.S.C. §§ 1051, 1053 and 1127; Trademark Rules 2.88(b)(2) and 2.56(b)(2), 37 C.F.R. §§ 2.88(b)(2) and 2.56(b)(2).

Applicant has appealed the final refusal. For the reasons discussed below, we affirm the refusal to register.

The Trademark Act defines a "service mark" (in pertinent part) as "any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." Trademark Act Section 45. To register a service mark, the applicant must submit a specimen of use which shows the mark as actually used in the sale or advertising of the services. Trademark Rules 2.88(b)(2) and 2.56(b)(2).

An asserted service mark will be found to function as a service mark only if purchasers will directly associate the asserted mark with the services in question. This "direct association" requirement is implicit in the statute's requirement that the asserted mark "identify and distinguish" the services. See *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); *In re Adair*,

² Application Serial No. 77508734.

45 USPQ2d 1211 (TTAB 1997). To establish the requisite "direct association," it is not sufficient merely to show that the applicant in fact is rendering the services and is using the asserted mark in some manner in connection with or in the course of rendering and/or advertising the services. Rather, the asserted mark must be used specifically in such a manner that purchasers will directly associate the asserted mark with the services per se, i.e., they will use the mark to identify the services and will readily perceive and understand the asserted mark to be a source-indicator for those services. See *In re Advertising and Marketing Development Inc.*, *supra*; *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); *In re Brown & Portillo Inc.*, 5 USPQ2d 1381 (TTAB 1987). "As has often been stated, a term may serve as both a trademark and a service mark depending on how it is used as evidenced by the specimens of record." *In re Brown & Portillo Inc.*, *supra*, at 1382. See also *In re Adair*, *supra*; *In re Niagara Frontier Services, Inc.*, 221 USPQ 284 (TTAB 1983).

Applicant's specimen of use, which applicant describes in its statement of use as "a photograph of various promotional materials" is reproduced below:



It is well established that a proposed mark that serves only to identify an item on a menu does not function as a service mark for restaurant services. See e.g., *In re Brown & Portillo Inc.*, *supra*; *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988).

The examining attorney maintains that the specimens of record clearly show that the proposed mark is simply being used to identify a menu item in the applicant's restaurant. Applicant, however, contends that "[t]he mark CHA CHA is prominently featured at the top of the specimens in a manner that is conceptually separable from all surrounding material." In response, the examining attorney notes that every use of the proposed mark appears in connection with the term "wings" (i.e., "CHA CHA WINGS"), and that many of the specimens include the additional wording "all natural citrus marinated fire roasted

lime flavored" to describe the wings. The examining attorney further points to the fact that the price and available number of "CHA CHA Wings" appear on two of the specimens (i.e., 6 pc. \$3.49 - 12 pc. \$6.49), and a picture of the menu item appears on four of the specimens.

Applicant argues that because the word "wings" appears in a smaller typeface and different color and font style, the proposed mark simultaneously "promotes [a]pplicant's [restaurant] services while also emphasizing wings as a particular menu item." Applicant's Brief, p. 1. The examining attorney, while acknowledging that term "wings" appears below the wording "CHA CHA" in a different color and font in all but one of the specimens, maintains that this is of "little, if any relevance in this context." The examining attorney asserts that the relevant inquiry is not whether "CHA CHA" is the dominant wording on the specimens, but rather whether the term is being used a service mark to identify the listed services, and that here the proposed mark is not used to promote applicant's restaurant services.

Lastly, applicant contends that "the inclusion of the well-known ARBY's mark in the corner of the specimen reinforces the idea that the specimens refer not just to particular menu items," but restaurant services as well. Applicant's Brief, p. 1. Again, the examining attorney maintains that this question

is irrelevant and that the only relevant question is whether the proposed applied-for mark (i.e., CHA CHA) itself is being used to identify and distinguish applicant's restaurant services as displayed in the specimens of record.

For the reasons articulated above by the examining attorney, we agree that applicant's proposed mark CHA CHA identifies a particular food item (wings) served in applicant's restaurant as opposed to applicant's restaurant services. We find the Board's decision in the case of *In re Brown & Portillo Inc.*, *supra*, particularly instructive. In that case, the applicant sought to register the mark HEARTY BASKET for restaurant services. The specimens of use submitted by the applicant were menus which showed use of the mark to identify a particular combination of food products sold in the applicant's restaurant consisting of "a basket containing two pieces of chicken, french fried potatoes, cole slaw and a roll." *Id.* at 1383. The Board found that the mark served only as a trademark to identify the entree, not a service mark for applicant's restaurant services. As the Board explained, "it does not logically follow that any arbitrary designation used in a menu to identify a particular food or beverage available in that restaurant also necessarily performs a service mark function to identify the restaurant services." *Id.* The Board found that the mark as used on the specimen "identifies no service" but

rather served only "to identify an entrée available in the restaurant." *Id.* Also, in *Brown & Portillo*, the applicant had argued that its specimen was sufficient for its restaurant services because the specimen showed "that the goods delivered to the consumer are an integral part of those services and that it is impossible for a customer to purchase a particular tangible menu item so designated apart from the restaurant services rendered by applicant." The Board specifically rejected that argument.

As with the case of *Brown & Portillo*, applicant's specimens of use identify only a particular item served at the restaurant - wings - and not the restaurant services. The other matter appearing on the specimens consists of either photographs of the wings, words describing the wings, or pricing information. As such, purchasers would not directly understand and perceive the mark as it appears on the displays as a source-indicator for the restaurant services. This is so, even though purchasers obviously are aware that applicant is rendering restaurant services because they are in the restaurant when they encounter the mark and can purchase wings while eating in the restaurant. Such a generalized association in the purchaser's mind between the product mark and the restaurant services does not suffice as the requisite "direct association" between the mark and the

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services which would make the asserted mark a service mark for the restaurant services themselves.

Decision: The refusal to register is affirmed.