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Filing date: **05/15/2007**

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

Proceeding	78536106
Applicant	Spring Cafe Realty LLC
Applied for Mark	BARMACHE
Correspondence Address	LISA A. PIERONI KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMI 489 5TH AVE FL 17 NEW YORK, NY 10017-6128 UNITED STATES lap@kirschsteinlaw.com
Submission	Appeal Brief
Attachments	Barmarche brief.pdf ( 4 pages )(1262646 bytes ) Barmarche Trademark History.pdf ( 6 pages )(1451079 bytes )
Filer's Name	Lisa A. Pieroni
Filer's e-mail	lap@kirschsteinlaw.com
Signature	/Lisa A. Pieroni/
Date	05/15/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Trademark Application of  
Spring Café Realty LLC  
Serial No. 78/536,106  
Filing Dt. 12/21/04  
For BARMARCHÉ  
Examining Attorney Tracy Fletcher  
Law Office 115

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

New York, NY  
May 15, 2007

BRIEF ON APPEAL

STATEMENT OF CASE

This application was e-filed on December 21, 2004 to register the mark BARMARCHÉ for restaurant and catering services in Class 43. The application was based on use in commerce. As evidence of use of the mark in commerce, applicant submitted a scanned image of a menu which bore the mark BARMARCHÉ, identical to the copy attached. Upon review of the Data Entry page of the application, it was noticed that there was a typographical error in the application such that the mark read BARMACHÉ. Applicant attempted to immediately correct the typographical error through TEAS; however, since the application was e-filed it was necessary to wait until the application was loaded into the TARR database which generally takes 2-5 weeks (The language on the Preliminary Amendment electronic page specifically states "You must wait approximately 15-30 days after your original submission to file the Preliminary Amendment, because the original application data must first be fully loaded into the USPTO's TARR database."). Applicant duly docketed the application for follow-up and, on January 13, 2005, filed

a Preliminary Amendment through TEAS to correct the typographical error from BARMACHÉ to BARMARCHÉ. A copy of the Preliminary Amendment confirmation is attached herewith.

In the Office Action of August 2, 2005, the Examiner stated that the Preliminary Amendment was unacceptable because it would materially alter the essence or character of the mark and requested that a substitute specimen be submitted which showed use of the mark as it appeared in the original drawing page. In response, applicant timely submitted arguments in the form of a Brief on Appeal presenting arguments which are in essence identical to those presented herewith. Thereafter, the Examiner issued a Final Office Action dated March 19, 2007 which reiterated the same issues raised in the Office Action of August 2, 2005. In response, applicant filed a Notice of Appeal and is hereby submitting this brief in support.

#### ISSUE

The issue is whether the Preliminary Amendment submitted in January, nearly seven (7) months prior to the Office Action, should be accepted.

#### ARGUMENTS

Point 1: The Preliminary Amendment should be accepted since it was submitted prior to examination.

Applicant submits that the Preliminary Amendment was made at the earliest possible time during prosecution to correct a typographical error that was inadvertently made during the filing. Applicant points out that the Amendment was made nearly seven (7) months prior to the date of the Office Action issued and was made before the Examiner performed the initial search which formed the basis for the August 2, 2005 Office Action. Applicant complied with the requirements of filing a Preliminary Amendment as stated on the TEAS website ("use

ONLY if you already filed an application not yet examined by the Office”). Indeed a review of the TDR database indicates that the Examiner performed searches with regard to the present application on July 26 and July 31, 2005, nearly six (6) months after the Preliminary Amendment was submitted (attached).

In addition, the Examiner had notice of actual mark due to the submission of the use specimens which correctly identified the mark as BARMARCHÉ. Therefore, by virtue of the Preliminary Amendment which was filed on January 21, 2005 and the submission of the specimen, the Examiner had adequate notice prior to examination that the mark in the subject application was BARMARCHÉ.

Applicant also submits that if the typographical error did not result in an actual other word, that the Preliminary Amendment would not have resulted in the Examiner’s conclusion that the change was material. For example, the mark as submitted read BARMACHÉ. The term MACHE can refer to a type of lettuce or a corn salad leading the Examiner to conclude that the terms MACHE and MARCHÉ “have very different meanings” and therefore “the commercial impression created by the proposed amendment to the mark is material and cannot be allowed.” However, if the typographical error resulted in a mark that read as “BARMARHÉ” where the word MARHE had no significance, Applicant submits that the conclusion would have been different. In essence, the applicant is being penalized for the typographical error resulting in a word with an understood dictionary meaning as opposed to one that does not.

Point 2: The request by the Examiner that a new specimen be submitted to match the drawing page is not capable of response.

Since the application is based on use, the request that the Applicant submit a

specimen which shows use as it appears in the incorrect drawing page is not capable of being responded to. The Applicant already submitted a valid specimen showing use of the mark in commerce on the drawing page as corrected by Preliminary Amendment nearly 7 months prior to examination. The Examiner is requesting specimens be submitted for a mark that is not used in commerce.

CONCLUSION

It is respectfully submitted that in view of the timely filed Preliminary Amendment prior to examination, the submission of a specimen that bore the mark as used in commerce and the length of time between the Preliminary Amendment and the Office Action, that the Preliminary Amendment be accepted and the "Drawing - Material Alteration" and "Mark in Drawing Differs fro Mark in Specimen" refusals be stricken from the Office Action of March 19, 2007 and/or that the Office Action be withdrawn and reissued based on the mark BARMARCHÉ.

Respectfully submitted,

KIRSCHSTEIN, OTTINGER,  
ISRAEL & SCHIFFMILLER, P.C.  
Attorneys for Applicant  
489 Fifth Avenue  
New York, N.Y. 10176  
(212) 697-3750

By 

Lisa A. Pieroni

## *dinner*

### *starters*

butternut squash soup with amaretto crumble	6
potato leek soup with sautéed mushrooms and chili oil	6
pine island oysters with red pepper mignonette	12
roasted garlic and herb hummus with pita crisp	8
fluke sashimi with baby arugula salad	10
spicy tuna tartar with apple-fennel slaw and wasabi tobiko	10
roasted asparagus with shaved pecorino and herb salad	8
mussels with white wine, garlic, tomato and herbs	11
artichoke, ricotta cheese and sun dried tomato pizzetta	8
maine crab cake with mango-tomato salsa and avocado	11
fried calamari with roasted jalapeno remoulade	9

### *salads*

mesclun with house vinaigrette	7
roasted pear, endive, spiced walnuts and roquefort salad	9
beet and warm goat cheese salad with citrus vinaigrette	9
grilled baby octopus over mediterranean salad	12
grilled skewered shrimp with warm white bean salad and arugula	12
seared tuna nicoise salad	14

### *mains*

ricotta cheese ravioli with asparagus and shitake	14
penne with fresh pesto, haricot vert and grilled chicken	12
spaghetti with basil, tomatoes, olives and roasted garlic oil	11
cheeseburger on fresh brioche bun	11
butternut squash risotto with spiced shrimp and mushrooms	14
pan roasted monkfish with bacon, brussel sprouts and gremolata	16
tapenade crusted salmon with leek fondue	16
roast chicken with braised artichokes and polenta cake	15
seared duck breast and leg confit with pomegranate sauce	22
grilled dry aged strip steak with garlic herb pomme frites	25
braised beef short ribs with white beans, eggplant and roasted garlic	20
lavender-mustard glaze pork loin with caramelized endive and cremini	18

### *sides*

garlic pomme frites
haricot vert
polenta cake
sautéed wild mushrooms

**barmarché**

Success!

We have received your Preliminary Amendment Form for serial number 78536106. We will send an Email summary of the Preliminary Amendment data to 'lap@kirschsteinlaw.com', which will be your official confirmation of receipt.

TEAS support team

Thu Jan 13 10:47:36 EST 2005

STAMP: USPTO/PA-64496412-20050113104736833003-78536106-200c4b53bec9924E26136c4d3c39b8f2c9-N-14-20050113104635840015



Trademark Electronic Application System (TEAS) service  
U.S. Patent and Trademark Office  
[teas@uspto.gov](mailto:teas@uspto.gov)

**Lisa Pieroni**

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**From:** TEAS@uspto.gov  
**Sent:** Thursday, January 13, 2005 10:48 AM  
**To:** lap@kirschsteinlaw.com  
**Subject:** Received your Preliminary Amendment Form for 78536106

We have received your Preliminary Amendment Form below.

Please amend application serial no. **78536106** as follows:

**Mark**

Applicant proposes to amend the mark as follows:

Original: BARMACHÉ (standard characters)

Proposed (USPTO generated image): BARMARCHÉ (Standard Characters)

The mark consists of standard characters, without claim to any particular font, style, size, or color.

**Preliminary Amendment Signature**

Signature: /Lisa A. Pieroni/ Date: 01/13/2005

Signatory's Name: Lisa A. Pieroni

Signatory's Position: Attorney

=====TEAS XML RESPONSE=====

78536106

BARMACHÉ

<http://tess2.uspto.gov/webaka/images/78536106.jpg>

BARMACHÉ

BARMARCHÉ

mark.jpg

1/13/2005

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Restaurant and catering services

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NoDeclaration/0/

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1

/Lisa A. Pleroni/

20050113

Lisa A. Pleroni

Attorney

20050113104736833003-78536106

20050113 10:46:35

Thu Jan 13 10:47:36 EST 2005

USPTO/PA-64496412-20050113104736833003-78536106-200c4b53bec9924526136c4d3c39b8f2c9-N-N-200501131

Preliminary Amendment Form Filing

lap@kirschsteinlaw.com

TEAS support team

Thu Jan 13 10:47:36 EST 2005

STAMP: USPTO/PA-64496412-20050113104736833003-78536106-200c4b53bec9924526136c4d3c39b8f2c9-N-N-20050113104635840015



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28-Sep-2005	Drawing Special Scan	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
02-Aug-2005	Offc Action Outgoing	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
31-Jul-2005	XSearch Search Summary	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
31-Jul-2005	XSearch Search Summary	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
26-Jul-2005	XSearch Search Summary	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
26-Jul-2005	XSearch Search Summary	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
13-Jan-2005	Amended Drawing	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
13-Jan-2005	drawing	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
13-Jan-2005	Preliminary Amendment	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
21-Dec-2004	drawing	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
21-Dec-2004	Specimens	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
21-Dec-2004	Trademark Application	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

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