

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

Applicant: Lafayette Street Partners, LLC :
Serial No.: 78/678,314 :
Filed: July 26, 2005 : Steven Foster
Mark: CHINATOWN BRASSERIE : Examining Attorney
Our Ref: LAFA 05/07832 : Law Office 106

APPLICANT'S REPLY BRIEF ON APPEAL

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04-11-2008

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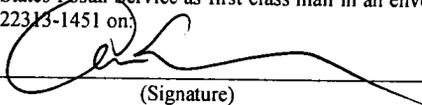
The Examining Attorney's Appeal Brief was mailed on March 20, 2008. Applicant hereby timely responds to that brief.

The Examining Attorney, in his brief, relied heavily on hypothetical situations and speculations and attempts to divorce the CHINATOWN mark from its context in order to assert that customers will mistakenly believe that Applicant's restaurant is in Chinatown. The Examining Attorney has not provided sufficient evidence to meet his burden of proof in this case, and ignores strong evidence establishing that the term CHINATOWN is evocative of a cuisine type and is not merely a geographic indicator, and that third party uses of the term CHINATOWN outside of "Chinatown" has stripped the term of any such geographic meaning.

Applicant respectfully requests that his decision be reversed on appeal.

ARGUMENT

In In re Consolidated Specialty Restaurants, Inc., 71 U.S. P.Q. 2d 1921 (TTAB 2004), the TTAB is clear regarding the burden of proof for establishing a goods-place association: "[t]o

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ensure a showing of deceptiveness and misleading before imposing the penalty of non-registrability, the PTO may not deny registration without a showing that the goods-place association made by the customer is material to the consumer's decision to purchase the goods." 71 U.S.P.Q. 2d at 1923. For the case of a *services*-place association, the standard is even higher. The Examining Attorney must establish that "(1) the primary significance of the mark is a generally known geographic location." Further, it must be shown that:

In the case of a *services*-place association, however, a mere showing that the geographic location in the mark is known for performing the services 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... [Further, beyond] the second prong, however, the misleading *services*-place association must be a material factor in the consumer's decision to patronize the restaurant.

71 U.S.P.Q.2d at 1924 (emphasis added). The Examining Attorney fails to meet this burden.

As previously stated, the mark CHINATOWN BRASSERIE is suggestive of a Chinese-influenced cuisine, and would not be perceived as denoting the location of Applicant's restaurant. Notably, the Examining Attorney does not directly address Applicant's argument that CHINATOWN has lost its geographic significance due to, among other things, the large number of CHINATOWN-formative restaurants that are located outside of Chinatown. While the Examining Attorney cites some cases stating that geographical misdescriptiveness has been found where a geographical name, such as "Cambridge" is physically located in more than one geographical area, those cases are not on point. Here, there is indisputable proof in the record that there are a number of restaurants which contain the term CHINATOWN as part of their trademarks, which are not physically located within Chinatown. The reasonable customer, after encountering such a large number of "Chinatown" restaurants outside of Chinatown, ceases to associate the term "Chinatown" with a defined geographical area, and will instead interpret it to be evocative of a Chinese or Asian-influenced cuisine. In other words, a reasonable customer

would not exclusively associate the term CHINATOWN with restaurants located in the “Chinatown” area of New York since there are a large number of CHINATOWN-formative restaurants that are, in fact, outside of Chinatown. This fact alone is enough to show that there is no “additional” reason, nor any reason at all, for a customer to associate restaurant services with Chinatown, as required by the services-place association test.

This is aptly illustrated by U.S. Registration No. 1,053,107, which is the Principal Register registration for CHINATOWN EXPRESS & Design for restaurant services located on Seventh Avenue, not in Chinatown. When seeing this mark, the consumer would assume that the restaurant featured quickly prepared Chinese-style food. This mark is precisely analogous to Applicant’s mark CHINATOWN BRASSERIE & Design, as to which the consumer would assume that the restaurant features Chinese-style food in a brasserie setting, with a French fusion style. Although the Examining Attorney guesses that the CHINATOWN EXPRESS & Design mark was allowed on the Principal Register on the basis of acquired distinctiveness (there is no Section 2(f) claim in the record), such guessing is pure speculation and does nothing to meet the Examining Attorney’s burden of proof.

The Examining Attorney also makes the unsubstantiated argument that non-native New Yorkers will be confused and surprised to find out, upon arrival at the Applicant’s CHINATOWN BRASSERIE restaurant on Lafayette Street, that they are not in Chinatown. This argument, which is not supported by any evidence, wrongly presupposes that travelers and tourists are naïve and unsophisticated. Tourists visiting New York, in order to find the CHINATOWN BRASSERIE restaurant, would need to consult guidebooks and Internet resources, all of which would indicate the address and neighborhood of the restaurant (see Ex. A, previously submitted with Applicant’s Response to Office Action, which clearly labels the

restaurant as located in NoHo). The Examining Attorney even states that “some tourists might not know that they aren’t within the actual geographic boundaries of Chinatown even after taking a cab to Applicant’s restaurant.” Aside from the fact that this is purely speculative on the part of the Examining Attorney, and presupposes the state of a tourist’s mind, one of the hallmarks of the Chinatown district is the fact that it is heavily Chinese, that is, signs and advertisements are in Chinese, the population is more heavily Chinese and the language spoken is occasionally Mandarin or Cantonese Chinese. There can be no mistaking whether or not one is in Chinatown, as even the neighborhood directly across the street from the physical boundary of Chinatown looks vastly different. Given these visual, aural and cultural differences between this area of the city and others, it would be immediately apparent to even a naïve tourist arriving in NoHo that they were not in Chinatown. Such speculation, without evidence, is not sufficient to meet the burden of proof here.

In addition to failing to establish that the primary significance of the term CHINATOWN as part of the mark CHINATOWN BRASSERIE & Design is a geographic one, the Examining Attorney has also failed to establish the requisite association between CHINATOWN and the services offered. In In re Consolidated Specialty Restaurant, the Examining Attorney established as to the mark COLORADO STEAKHOUSE & Design that there was an association between Colorado and steakhouses by, among other things, submitting printouts of web pages and news articles which discuss “Colorado steaks.” Id. at 1924-25. Here, the Examining Attorney attempts to argue that Chinatown is known to have many restaurants within its borders, and that, therefore, there is a heightened association between the two items. Applicant’s restaurant, however, while serving Chinese-influenced food, does not offer pure, classic Chinese cuisine. As Applicant has argued in its prior briefs, CHINATOWN BRASSERIE serves Chinese-themed

fusion food, with strong European influences (as indicated by the term BRASSERIE at the end of the mark). Chinese fusion food is not exclusively offered in Chinatown, nor is there a heightened association between CHINATOWN and Chinese-influenced fusion food. The fusion element – evoked by the salient term BRASSERIE – would convey to a customer that they are not necessarily within the geographic realm of Chinatown. The mark does not speak to the physical location of the restaurant, but rather, the style of food offered there.

Further, as far as Applicant is aware, there has never been reference to a “Chinatown” Chinese cuisine. As previously mentioned in Applicant’s brief, Chinatown is known for a lot of services, including jewelers, and banks, etc.; restaurants are but a subset of a bustling mini-city within a city. To say that Chinese restaurants are exclusively associated with Chinatown is to ignore the evidence that Chinese restaurants are ubiquitous not only throughout New York, but throughout the country. Chinatown is not a known descriptor or adjective of a type of Chinese food, in the same way that Colorado is used to describe a type of steak. There is not a scintilla of evidence in the record that a customer would request “Chinatown” Chinese food.

Finally, the Examining Attorney offers no evidence to support the argument that being in Chinatown is “a material factor in the consumer’s decision to patronize the restaurant.” The Examiner offers a hypothetical speculation, among others, that a customer making a reservation via telephone in isolation of any other information would be shocked to discover that Applicant’s food did not originate from Chinatown. However, the Consolidated Specialty Restaurants case is clear that speculation is not enough to meet the burden of proof. Nor has the Examining Attorney established the heightened services-place association required to meet this element.

In a major metropolitan location such as New York City, tourists and locals take cues as to the food styles from the names, and not the location of the restaurant itself. As with the other

major restaurants containing geographically sounding terms in their names (e.g., SoHo Cupcakes), CHINATOWN BRASSERIE does no more than suggest or evoke the type of cuisine to be served in the restaurant. Applicant's design elements, as well as its use of the term BRASSERIE, strongly suggest the European-style fusion cuisine to be found at the restaurant and is in no way geographically misdescriptive.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that its mark be allowed to proceed to registration, and that the Examining Attorney's refusal to register be reversed.

Dated: New York, New York
April 8, 2008

Respectfully submitted,

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EXHIBIT A



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- ▶ Caribbean (3)
- ▶ Cheesesteaks (1)
- ▶ Chicken (1)
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- ▶ Desserts & Bakeries (22)
- ▶ Dim Sum (1)
- ▶ Diners & Coffee Shops (11)
- ▶ Eastern European (1)
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- ▶ English (1)
- ▶ Ethiopian (1)
- ▶ French (18)
- ▶ Greek (2)

Chinatown Brasserie (\$\$\$\$)

Chinese, Dim Sum

380 Lafayette St, New York 10003
At Great Jones St

[OpenTable Reservation](#)

Phone: 212-533-7000
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Posted by Joost is Pissed on 03/17/2008

Epitome of bad service

We were meeting another couple here at 8, we arrived first, told the hostess that we would be at the bar to which she responded that we should come and get her once the other half of the party arrived. Once our friends did show up and we told the hostess, she had apparently forgotten who we were, or marked that we had shown up or done something because she read the situation as if we didn't have a reservation. So they made us wait another two minutes while they "accommodated" our table. Everything was going fine, it was 8:30, the waiter had taken our drink orders, our appetizers were on the way, things were rolling. Two out of my party finished their drinks and to everyone's chagrin, their glasses stayed on the table with no refreshing as our waiter had flat out disappeared. The food

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Table of Cases and Sources

In re Consolidated Specialty Restaurants, Inc., 71 U.S. P.Q. 2d 1921 (TTAB 2004).