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UNITED STATES PATENT AND TRADEMARK OFFICE

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MARK: CHINATOWN BRASSERIE



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TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Lafayette Street Partners, LLC

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's refusal to register under Section 2(e)(3) of the

Trademark Act. 15 U.S.C. Section 1052(e)(3).

FACTS

Applicant seeks registration of the composite mark CHINATOWN BRASSERIE and DESIGN for

“restaurant services.” Registration has been refused under Section 2(e)(3) of the Trademark Act on

ground that applicant's mark is primarily geographically deceptively misdescriptive of its services.

Applicant has disclaimed the term BRASSERIE apart from the mark as shown. Although the

application has involved several issues, the above refusal to register is the sole issue in this appeal.

This application was originally based upon a bona fide intention to use in commerce. When the

Office sought a disclaimer of the phrase CHINATOWN BRASSERIE on the ground that it was

believed to be primarily geographically descriptive of the intended services, the applicant responded by filing an amendment to allege use, and indicated that it was not located in

Manhattan's Chinatown and will provide no services there. See Response and Amendment to Allege Use, filed July 17, 2006. It later indicated that it provides no delivery services, so no

deliveries are made by applicant in Chinatown either. See response dated February 12, 2007, page

8.

With its first response, applicant offered evidence showing that the northern border of Manhattan's

Chinatown is Delancey Street, and argued that, since it is located "well north of the northern border

of Chinatown," the term CHINATOWN was not primarily geographically descriptive of its

services and need not be disclaimed. See page 3 of Response dated July 17, 2006. The Office then

refused registration under Section 2(a) and Section 2(e)(3) of the Trademark Act. Although

registration was finally refused under both Section 2(a) and Section 2(e)(3), the refusal under

Section 2(a) was withdrawn after applicant's filing of its Request for Reconsideration, based upon

newly amended TMEP Section 1210.05(a) and the Trademark Trial and Appeal Board's decision

in *In re South Park Cigar, Inc.*, 82 USPQ2d 1507, 1509, n.3 (TTAB 2007).

Applicant's restaurant services are provided from one location, 380 Lafayette Street, in New York

City. In support of its position that its restaurant is not located in Chinatown, applicant has

submitted a *Yahoo!* map showing its location with a star and clearly showing it to be north of

Delancey Street. See Exhibit A with the Response of July 17, 2006. Exhibit C with that same

response is a *Wikipedia* listing establishing Delancey Street as an approximate northern border for

Chinatown. Applicant regards itself as being located in the neighborhood known as NoHo, rather

than in Chinatown, and the Office has respected the assertion of the applicant, which is located in

New York City, that it is not located in Chinatown. In its Appeal Brief, applicant asserts that its

restaurant is at least nine blocks north of Delancey. Note, however, that by utilizing the distance

assistant at the bottom of the map referred to above, 380 Lafayette Street appears to be about a half

mile from Delancey Street.

It is clear from the record that the applicant's restaurant features Chinese food. As applicant states

in the Request for Reconsideration, its menu is based on Chinese-style food. See page 1 of

Request for Reconsideration filed October 9, 2007. Applicant's Appeal Brief also acknowledges

that the restaurant offers a variety of Chinese-fusion style foods. This is further confirmed by the

copy of applicant's menu, made of record by the applicant with its initial response. See Exhibit E

with Response dated July 17, 2006. Notably, the specimen submitted with applicant's amendment

to allege use, also filed on July 17, 2006, bears the phrase "Chinese Barbeque" beneath the mark.

An online review of the applicant's restaurant further confirms the type of fare offered there,

referring to the fare as "a wide variety of both regional Chinese specialties and Chinese American

favorites." See Office action of April 10, 2007.

The record includes exhibits submitted by both the Office and the applicant. The Office has

included a number of exhibits establishing that Manhattan's Chinatown is noted for its restaurants

and Chinese cuisine, and that it is a well-known tourist attraction. Included with the Office action

of August 17, 2006, were two different articles about New York's Chinatown, each of which

indicated that it has the largest concentration of Chinese people in the Western Hemisphere. The

first listed article, by Sarah Waxma, refers to the Chinatown of today as "a tourist attraction"

offering "hundreds of restaurants," even though it comprises just two square miles. The second

article refers to New York's Chinatown as having a variety of Chinese cuisines comprising "a

gastronomic dream list for Asian cuisine lovers." See TICRS page 14, of the August 17, 2006,

Office action. Also included with that Office action was a gazetteer listing for Chinatown,

indicating that it is a southeast section of Lower Manhattan.

The Office action of April 10, 2007, contains numerous pertinent articles. One notes that New

York's Chinatown neighborhood "is known for its excellent Chinese cuisine," while another

article having a "top ten" list of recommended Chinatown restaurants indicates how "Chinatown

dining is a great choice for visitors to New York City," and further confirms that the location is a

popular tourist destination. Another article with the April 10, 2007, Office action, entitled

"Chinese Cuisine in New York," states, "[F]or authentic Chinese food, New York's Chinatown

refuses to be rivaled." Another article with the same Office action confirms that "over 500

restaurants grace Chinatown's bustling streets, with hotspots like Mott Street literally lined with

enticing places to eat." Yet another article refers to how "Chinatown is famous for its reasonably

priced restaurants featuring Chinese cuisine." An encyclopedia listing further confirms that New

York City, itself, is a major tourist attraction, drawing millions of tourists a year. And one of

applicant's own submissions indicates that tourism and restaurants are "major industries" in

Chinatown. See Exhibit C with Response dated July 17, 2006, TICRS page 12.

In addition to the evidence referenced earlier, applicant has included a number of third-party

registrations and other listings of restaurants having names with geographic terms as elements

thereof, in an effort to establish that restaurants often use geographic terms to reflect the theme of

the restaurant, rather than as geographic indicators. Applicant has also offered a copy of a third-

party registration for restaurant services in which no disclaimer of CHINATOWN appears. See

Exhibit C of the October 9, 2007, Request for Reconsideration. Note, however, that also of record

are copies of two other third-party registrations wherein disclaimers of CHINATOWN do appear.

See Office action of February 14, 2006.

ARGUMENT

APPLICANT'S MARK IS PRIMARILY GEOGRAPHICALLY DECEPTIVELY MISDESCRIPTIVE OF ITS RESTAURANT SERVICES, WHICH ARE PROVIDED AT A LOCATION IN MANHATTAN THAT IS NOT IN MANHATTAN'S CHINATOWN

A prima facie case for refusal under Section 2(e)(3) that the mark is primarily geographically

deceptively misdescriptive of the goods or services requires a showing that (1) the mark's primary

significance is a generally known geographic location; (2) the relevant public would be likely to

believe that the goods [or services] originate in the place named in the mark when in fact the

goods [or services] do not come from that place; and (3) the misrepresentation is a material factor

in the consumer's decision. See *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853

(Fed. Cir. 2003); and *In re South Park Cigar Inc.*, 82 USPQ2d 1507, 1509 (TTAB 2007).

Two significant cases deal with the application of the above test to restaurant services, the services

for which registration is sought herein. In *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67

USPQ2d 1539 (Fed. Cir. 2003), the Court noted that a customer typically receives services,

particularly in the restaurant business, at the location of the business. Thus, the customer who goes

to the location of the restaurant would normally be aware when he or she is not in the location

named in the mark. Thus, for cases involving services, the second prong of the above test requires

some additional reason for the consumer to associate the services with the place named in the

mark. For restaurant services, the Court reasoned that the record must support a finding that

patrons would likely be misled to make some meaningful connection between the restaurant (the

service) and the relevant place.

The Court then went on to give examples of what would constitute a sufficient services/place

association for the second prong of the test in the case before it, which involved a restaurant

located in New York, but a mark, LE MARAIS, designating a neighborhood in Paris:

“For example, the PTO might find a services-place association if the record shows that patrons, though sitting in New York, would believe the food served by the restaurant was imported from Paris, or that the chefs in New York received specialized training in the region in Paris, or that the New York menu is identical to a known Parisian menu, or some other heightened association between the services and the relevant place. This court does not decide whether these similarities would necessarily establish a services-place association or presume to limit the forms of proof for a services-place association with these examples. Rather, this court only identifies some potential showings that might give restaurant patrons an additional reason beyond the mark itself to identify the services as originating in the relevant place.” *Id.*, at 67 USPQ2d 1541.

The Court then addressed the third prong of the test, materiality, indicating that to raise an

inference of deception or materiality for a service mark, the PTO must show some “heightened

association” between the services and the relevant geographic denotation and indicated that an

inference of materiality arises in the event of a very strong services-place association. Without a

particularly strong services-place association, the PTO would need other evidence of materiality,

such as evidence that customers would patronize the restaurant because they believed the food was

imported from, or the chef was trained in, the place identified by the restaurant's mark. *Id.* at 67

USPQ2d 1542.

The Board has applied the above rationale in *In re Consolidated Specialty Restaurants, Inc.*, 71

USPQ2d 1921 (TTAB 2004), finding COLORADO STEAKHOUSE and DESIGN primarily

geographically deceptively misdescriptive of restaurant services not provided in Colorado. In

addressing the second prong of the test, the Board found that the “additional reason” beyond the

mark itself to identify the services as originating in the place named was established by the PTO’s

evidence that Colorado was known for its steaks, reasoning that consumers would wrongly believe

that applicant’s steakhouse served steaks from Colorado. The Board then further stated that this

evidence created “a very strong services-place association,” thus satisfying the “heightened

association” requirement for the third prong of the test, materiality.

As is clear from the FACTS section of this case, the record establishes that the term

CHINATOWN is a well-known geographic identifier for a place in Manhattan, New York. See

Exhibit C of Applicant’s Response of July 17, 2006, and the Office’s submissions throughout

prosecution. The fact that there may be other places named CHINATOWN in other geographic

locations does not necessarily detract from the term’s primary geographic significance. See, e.g., *In*

re Loew’s Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (DURANGO held

primarily geographically deceptively misdescriptive of chewing tobacco not grown in Durango,

Mexico, where the evidence of record showed that tobacco is a crop produced and marketed in that

area, even though there is more than one place named Durango); *In re Cambridge Digital Systems*,

1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design held primarily

geographically descriptive of computer systems and parts thereof, where applicant's place of

business is Cambridge, Massachusetts, even though there is more than one Cambridge). This is

especially true here, where applicant's restaurant services are offered from but one location in

Manhattan, just a number of blocks from what applicant regards as the northern border of

Manhattan's Chinatown. Note that in *In re MCO Properties, Inc.*, 38 USPQ2d 1154 (TTAB

1996), the term FOUNTAIN HILLS was held primarily geographically descriptive of real estate

development services offered in the named location. There, the Trademark Trial and Appeal Board

held that a geographical term need not be widely recognized across America for a refusal to be

justified under Section 2(e)(2). The association between the term and the services was obvious

because the real estate to be developed was located in Fountain Hills. Similarly here, because of the

strictly local nature of the applicant's services, purchasers encountering its mark as applied to a

restaurant located so close to Manhattan's Chinatown would be unlikely to associate the

geographic term with any other Chinatown located in some other city or geographic area. It is

submitted that the evidence establishes that, when viewed in the context of the local services

provided by the applicant herein, CHINATOWN would signify a geographic location generally

known to the prospective class of consumers.

The record also establishes the “additional reasons” for consumers to associate the applicant’s

restaurant services with the term CHINATOWN necessary to establish the services-place

association required herein. As the various articles comprising the Office’s evidence show,

Chinatown is “known for its excellent *Chinese cuisine*,” “is famous for its reasonably priced

restaurants featuring *Chinese cuisine*,” has a variety of Chinese cuisines comprising “a gastronomic

dream list for *Asian cuisine* lovers;” and “refuses to be rivaled” for “authentic *Chinese food*.”

(Emphasis added). Applicant’s restaurant, in turn, features Chinese food as well. As in

Consolidated Specialty Restaurants, applicant’s restaurant features the very type of food for

which the place named in the mark is known. As in *Consolidated*, this establishes a strong services-

place association.

The services-place association is further strengthened in the present case because, not only is

Chinatown a place where applicant’s type of cuisine can be found, it is also well-known for having

restaurant services involving such foods, the very services provided by applicant. In this way, the

facts of this case actually go beyond those in *Consolidated*, which relied heavily upon the fact that

the applicant's steakhouse featured the type of goods, steaks, for which Colorado was known. In

addition to the articles referred to above, there is evidence here of how Chinatown is a tourist

attraction having hundreds of restaurants, that Chinatown dining is a "great choice for visitors to

New York," and that it has "over 500 restaurants", with "hotspots like Mott Street literally lined

with enticing places to eat." See FACTS section. Even Exhibit C with applicant's Response of July

17, 2006, acknowledges that tourism and restaurants are "major industries" in Chinatown. This

contributes to the services-place association herein.

Further, the significance of Chinatown as a tourist attraction located in close proximity to

applicant's location cannot be discounted. As the record shows, New York City, as a tourist

attraction, draws millions of tourists a year. As mentioned in the FACTS section, a number of

articles refer to how Manhattan's Chinatown itself is such a tourist attraction. The class of

purchasers for restaurant services in New York City will include a number of tourists from outside

the city, many of whom may have far less familiarity with the borders between the sections of the

city than those who live within the New York area themselves. Unlike the normal situation

referred to in the *Les Halles De Paris* case, where the Court noted that a customer of services

would be aware when he or she is not in the location named in the mark, this may not be the case

for many tourists unfamiliar with the nuances of where the borders of various New York neighborhoods fall. Due to the close proximity of applicant's restaurant to Chinatown, this case presents possibilities beyond the norm.

Applicant's restaurant isn't that far from the Delancey Street border of Chinatown referred to by

the applicant and relied upon by it in refusing to disclaim CHINATOWN as a geographically

descriptive term. A tourist visiting Chinatown who looked for applicant's restaurant in Chinatown

would never find it there. It is even possible 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. Note, for example, how the *Yahoo!* map referred to above, although showing the

location of applicant's restaurant, does not delineate the border of Chinatown. One unfamiliar with

the area, or with the other evidence of record regarding where the approximate border of

Chinatown lies, would have little way of telling from the map alone whether applicant was located

in Chinatown. However, even for those out-of-town tourists who, upon arrival at applicant's

restaurant, determine that they are not in Chinatown, there exists the very real possibility that

deception has already occurred at an earlier juncture, when they may have made reservations by

telephone or other means and already relied upon the false information in the applicant's mark

about its location. Because of the reputation of Chinatown for quality Chinese cuisine and quality

Chinese restaurants, this false information could be significant in the consumer's decision to order

the applicant's service.

Based upon these additional reasons for consumers to associate the term CHINATOWN with the

applicant's services, it is believed that the record supports a finding that patrons will likely be

misled by applicant's use of the term CHINATOWN to make a meaningful connection between the

restaurant and the place named. They could easily believe that the fare at the restaurant originated

in Chinatown, a place noted for the type of cuisine served at the applicant's restaurant, or that the

restaurant is affiliated with other restaurants actually existing in Chinatown, due to the fact that the

area is noted for its restaurant services. Of course, for any tourists making reservations for or

visiting the restaurant, believing that it is located in Chinatown, the deception is obvious. Based

upon all of the above, it is believed that a very strong services-place association exists here,

satisfying the second prong of the primarily geographically deceptively misdescriptive test as

applied to the services.

The third prong, materiality, requires a showing of a heightened association between the services

and relevant geographic location. As mentioned earlier, this can be inferred where there is a very

strong services-place association. As was the case in *Consolidated Specialty Restaurants*, such is

the case here.

Note further that applicant's inclusion of its design element does not remove this case from the

realm of Section 2(e)(3). Although the mark has been reviewed as a whole, the literal element is

quite dominant and would be relied upon for its geographic significance. See TMEP 1210.06(b).

Applicant argues in its Appeal Brief that the term CHINATOWN is not geographic because it

connotes a style of food, not a location. Note initially, however, that applicant's first response

stated that "CHINATOWN is not a recognized term to describe Chinese-style food." See

Response of July 17, 2006, page 3. However, it nonetheless asserts that the use of the term by

others in relation to their restaurants somehow removes the geographic significance from the word.

In support of this, it offers a list of New York area restaurants purportedly not located in

Chinatown, utilizing CHINATOWN as part of their restaurant names. See Exhibit D with Request

for Reconsideration filed October 9, 2007. Applicant further asserts that others often incorporate

other geographic names into their marks, offering a few third-party registrations and other listings

of restaurants having geographic terms in their restaurant names, stating that "[e]veryone

understands that the name of a restaurant likely suggests the menu theme and not a physical

location.” Applicant’s Appeal Brief, page 8.

With respect to the directory type listings for restaurants having the term CHINATOWN or other

geographic terms in their names, many of these listings in applicant’s exhibits do not provide an

adequate context for comparison, since the marks have not been subject to Office scrutiny

regarding any possible statutory prohibition to registration. Further, for any of the listings for

restaurants using geographic terms that don’t appear to be located in the places named, there is

little way of telling whether the restaurants actually have ties to the places named. For those

restaurants utilizing other geographic terms that don’t have any ties to the places named, there is

also little way of knowing what evidence could be available to show a sufficient services/place

association to support a refusal like that herein in each of the cases. Further still, not all of the

limited number of third-party registrations made of record appear supportive of applicant’s position

herein. The mark in U.S. Registration No. 2260760 (CAFE LUXEMBOURG), for example, is

registered pursuant to the provisions of Section 2(f) of the Trademark Act, while U.S. Registration

No.2900824 (UNO CHICAGO GRILL) includes a disclaimer of CHICAGO GRILL.

Furthermore, the fact that other parties may use geographic terms as parts of their marks does not

prove that the term CHINATOWN in this case would be recognized as identifying a theme, as

opposed to a geographic location. Under applicant's theory, the existence of such restaurant names

automatically translates into a presumption that all geographic terms are "themes" as applied to

restaurant services, eliminating their significance as geographic indicators. The Board specifically

rejected an argument quite similar to this in *In re Consolidated Specialty Restaurants, Inc.*, supra.

There the applicant submitted evidence of third-party registrations similar in nature to the

applicant's evidence herein, claiming that they show that "a customer who visits a restaurant

having a geographic name and theme is expecting to find an atmosphere, ambience or decor that

suggests to them the type of restaurant they would expect to find in the particular city or region

identified in the name," and that "the name, therefore, provides an association with the geographic

identifier by way of its concept or theme only." The Board specifically rejected the notion that the

existence of the third-party registrations establishes what consumers perceive or expect regarding

the ambience and decor of restaurants, and noted that it is not privy to the records in the third-party

registration files.

Applicant also contests whether there is a services/place association in the present case, pointing

out that Chinatown has many other types of businesses beyond restaurants, and that restaurants are

but one aspect of the area. However, the record here shows that the restaurant industry is of

particular importance in Chinatown. It need not be the only industry there to justify a services-

place association. If this were the law, it would be virtually impossible to hold any mark primarily

geographically deceptively misdescriptive, because, under the applicant's theory, the geographic

area named in the mark would have to be virtually devoid of any economic activity beyond the

type of services offered by the applicant in order for the refusal to be justified.

Applicant also argues that the existence of restaurants in other locations in New York City outside

of Chinatown somehow diminishes the services-place association in this case. In doing so, it relies

upon an exhibit made of record for the first time on appeal, Exhibit E, filed with its Appeal Brief.

Exhibit E was not made of record during prosecution and is hereby objected to on that basis. The

record must be complete prior to appeal. 37 C.F.R. Section 2.142(d). Any factual assertions based

upon Exhibit E are without support in the record. It is also pointed out, though, that the refusal

herein is not based upon the mere fact that Chinatown has restaurants, as most geographic places

do, but rather on the specifics applying to this particular location referred to earlier in this brief.

Applicant further argues that the combining of the terms CHINATOWN and BRASSERIE

somehow creates a combination that is “inherently incongruous with a location in Chinatown,”

alleging that the term BRASSERIE evokes European cuisine. However, the term “brasserie”

appears in the English dictionary as meaning, “a restaurant serving alcoholic beverages, especially

beer, as well as food,” and would no doubt be viewed for its ordinary meaning in English. See the

dictionary definition of “brasserie” with the Office action dated February 14, 2006. Note also that

the applicant disclaimed BRASSERIE upon the initial filing of its application. Since the term

CHINATOWN would also be understood in English, the mark herein merely combines ordinary

terms for their ordinary meanings. Nothing in the phrase CHINATOWN BRASSERIE appears

inherently incongruous.

Lastly, applicant points to the existence of one third-party registration, U.S. Registration No.

1053107, wherein CHINATOWN EXPRESS and DESIGN was registered for restaurant services

on the Principal Register with no disclaimer. However, it is noted that this is an old registration, with the mark having been registered in 1976. There was a period of time in the past when the

Office did not print Section 2(f) notations. Therefore, the absence of a “Section 2(f)” notation on an

older registration does not necessarily mean that the mark was registered without resort to Section

2(f). TMEP Section 1212.10. However, even if the registration did not rely upon Section 2(f) in

part, there are two other registrations of record, U.S. Registration Nos. 2389653 (CHINATOWN

and DESIGN, with “Chinatown” disclaimed) and 2421145 (RRD’S CHINATOWN CAFE and

DESIGN, with “Chinatown Cafe” disclaimed) that appear supportive of the position that the term

CHINATOWN would be viewed as a geographical term. See Office action of February 14, 2006.

CONCLUSION

As applied to the applicant’s restaurant services, provided in Manhattan in close proximity to New

York City’s famed Chinatown, the term CHINATOWN is primarily geographically deceptively

misdescriptive of restaurant services not provided in, originating from, or having any connection

with Chinatown. Although the undersigned cannot attribute a motive to the applicant regarding the

selection of its service mark, its use of the phrase CHINATOWN BRASSERIE associates it with a

geographic location where it does not provide its services. It is submitted that the record herein

provides good reasons why it would be advantageous for a restaurant to associate itself with the

CHINATOWN area; the geographic term used by applicant denotes an area noted for the quality of

its Chinese cuisine and its Chinese restaurants.

For the reasons set forth in the foregoing pages, it is urged that the refusal to register under Section

2(e)(3) of the Trademark Act be affirmed.

Respectfully submitted,

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