

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: February 1, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Barteca Restaurants, LLC

Serial Nos. 85202482 and 85202583

Joseph G. Fortner, Jr. of Halloran & Sage LLP for Barteca Restaurants, LLC.

Tracy Cross, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Bucher, Cataldo and Hightower, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Barteca Restaurants, LLC, has filed applications to register on the Principal Register the mark

BARTACO

(in standard characters) and the mark displayed below



both for "restaurant and bar services" in International Class 43.¹

Registration has been finally refused as to the mark in application Serial No. 85202482 under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive of applicant's services. Similarly, registration has been finally refused as to the mark in application Serial No. 85202583 based on applicant's failure to comply with the requirement to disclaim BARTACO on the ground that it is merely descriptive of applicant's services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

Applicant has appealed the refusal to register both applications and the appeals are fully briefed. Because the refusals to register are based upon common issues of law and fact, as well as essentially identical records and briefs, they are hereby consolidated, and we will address them in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 85202482, unless

¹ Application Serial Nos. 85202482 and 85202583 both were filed on December 21, 2010 based upon applicant's assertion of December 18, 2010 as the date of first use of the applied-for mark anywhere and in commerce in connection with the recited services. Application Serial No. 85202583 contains the following statements: "Color is not claimed as a feature of the mark;" and "The mark consists of the single word bartaco with the stylized image of a dragonfly in close proximity."

otherwise noted; however we have, of course, considered all arguments and evidence filed in each case.

The trademark examining attorney argues that the term BARTACO in applicant's marks is merely descriptive of applicant's services inasmuch as the "term TACO is the generic name of a food that is featured at the applicant's bar and is descriptive of the applicant's restaurant and bar services."² The examining attorney further argues that "[b]usinesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials."³

In support of her position, the examining attorney has made of record dictionary definitions of the terms BAR and TACO. According to these definitions, BAR is defined, *inter alia*, as "a counter or place where beverages, esp. liquors, or light meals are served to customers: a *snack bar*, a *milk bar*."⁴ TACO is defined as "a usually fried tortilla that is folded or rolled and stuffed with a mixture (as of seasoned meat, cheese, and lettuce)."⁵ In addition, the examining attorney made of record

² Examining attorney's brief, p. 5.

³ *Id* at 4.

⁴ Dictionary.infoplease.com

⁵ Merriam-webster.com

"screenshots" from applicant's Internet website and social media webpage, as well as Internet articles and blog posts reviewing applicant's services under its marks. From these Internet postings, it is clear that applicant's bar and restaurant menu prominently includes tacos among the various food items available under its involved marks.

Applicant, for its part, argues that the examining attorney has improperly dissected the unitary term BARTACO into two terms, reversed them, and engaged in a "leap regarding which goods and services are offered"⁶ in order to support her refusal to register. Applicant further argues that "the imaginative leap on the part of the prospective purchaser is what makes the mark fanciful, or at the very least suggestive, rather than descriptive as the Examiner suggests."⁷

In support of its position, applicant made of record photographs of its restaurant/bars, copies of its menu, and a sample of the results of its search of the Google search engine for the term "bartaco," with all the results discussing applicant and its services under its marks.

A mark is merely descriptive if "it forthwith conveys an immediate idea of the ingredients, qualities or

⁶ Applicant's brief, p. 3.

⁷ Id.

characteristics of the goods [or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); and *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, ___ F.3d ___, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); and *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998).

If, however, when goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See *In re Abcor Development Corp.*, 200 USPQ at 218; and *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992). To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark, such doubt is resolved in applicant's favor. *In re Atavio*, 25 USPQ2d at 136. The examining attorney bears the burden of showing that a mark is merely descriptive of the

identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

In this case, we are not persuaded by the examining attorney's arguments that BARTACO is merely descriptive of the identified services. First, we observe that the term BARTACO as it appears in both involved marks is unitary, and it is not clear on this record whether prospective consumers will perceive that BARTACO consists of the component terms BAR and TACO, and that the combination of terms merely describes applicant's services. This is not to say that the mere telescoping of the term BARTACO is sufficient to overcome a refusal to register based upon mere descriptiveness. See, e.g., *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (FirstTier, the equivalent of "first tier," is merely descriptive of banking services). Rather, there is no evidence of record to support a finding that consumers will view the term BARTACO or BAR TACO as merely describing restaurant and bar services, even those featuring tacos.



That is to say, even if we accept that BARTACO is a combination of the individual words BAR and TACO, and that these terms have descriptive significance inasmuch as

applicant's restaurant and bar services feature, *inter alia*, tacos on their menu, our analysis does not end here. As the Board stated in *In re Wisconsin Tissue Mills*, 173 USPQ 319, 320 (TTAB 1972):

It does not follow as a matter of law that because component words of a mark may be descriptive, the composite is unregistrable. The established rule is that a composite must be considered in its entirety and the question then is whether the entirety is merely descriptive. (citation omitted).

In this case, there is no evidence to indicate that the relevant purchasers of applicant's services would perceive the term BARTACO as it appears in applicant's marks to be a descriptive term therefor. Simply put, the evidence of record - including evidence consisting of reviews and comments by the customers of applicant's services under its mark - does not establish that BARTACO merely describes them, notwithstanding the dictionary meanings of BAR and TACO and the applicability of those terms to applicant's services.

We note that if the term in question was TACOBAR, we may come to a different result, inasmuch as that combination of terms would immediately describe a feature of applicant's restaurant and bar services featuring tacos. We further note that the mere reversal of those terms into BARTACO does not necessarily avoid a finding of mere

descriptiveness. However, when we consider the term BARTACO in applicant's marks, we find on this *ex parte* record that it is only suggestive of the identified services. We reach this conclusion because of the unnatural order of the words comprising BARTACO in applicant's marks and the fact that some mental reasoning is required in order to determine the nature of applicant's services therefrom.

This conclusion is buttressed by the fact that this term does not appear to be needed by applicant's competitors in order to describe their products or services as it has not been shown that any third party in the crowded field of restaurants and bars has used BARTACO in this manner. *See Minnesota Mining and Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179, 172 USPQ 491 (CCPA 1972) ["SKINVISIBLE" for transparent medical adhesive tape is not needed by competitors]; *Sperry Rand Corp. v. Sunbeam Corp.*, 442 F.2d 979, 170 USPQ 37 (CCPA 1971) ["LEKTRONIC" for electric shavers not needed by competitors]; *Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp.*, 259 F.2d 314, 119 USPQ 61, 63 (2d Cir. 1958) ["SEASON-ALL," unlike the term "ALL-SEASON," is not merely descriptive of aluminum storm windows and doors]; and *In re Reynolds Metals Co.*, 480 F.2d 902, 178 USPQ 296 (CCPA 1973)

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[registration of "BROWN-IN-BAG" for transparent plastic bags is suggestive as it will not prevent competitors from informing buyers that goods may be browned in their bags].

Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the application to publication. See *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

Decision: The examining attorney's refusal of registration is reversed in both cases. Accordingly, the involved applications will be forwarded for publication for opposition in due course.