

ESTTA Tracking number: **ESTTA736994**

Filing date: **03/31/2016**

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

Proceeding	91226668
Party	Defendant Giorgifred Company
Correspondence Address	BASSAM N. IBRAHIM BUCHANAN INGERSOLL & ROONEY PC STE 500 1737 KING ST ALEXANDRIA, VA 22314  bassam.ibrahim@bipc.com
Submission	Answer
Filer's Name	Bassam N. Ibrahim
Filer's e-mail	bassam.ibrahim@bipc.com
Signature	/Bassam N. Ibrahim/
Date	03/31/2016
Attachments	Answer to NOO - 91226668.pdf(545191 bytes )

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

In re Serial No. 86/628,500	)	
Filed: May 13, 2015	)	
Mark: <b>GIORGIO CHEESEBURGER BITES</b>	)	
Published: November 3, 2015	)	
	)	
	)	
7-Eleven, Inc.,	)	Opposition No. 91226668
	)	
Opposer,	)	
	)	
v.	)	
	)	
Giorgifred Company,	)	
	)	
Applicant	)	

**ANSWER TO NOTICE OF OPPOSITION**

Applicant Giorgifred Company (“Applicant”) hereby responds to the allegations in Opposers’ 7-Eleven, Inc’s (“Opposer”) Notice of Opposition as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 1, and therefore denies the same. Further, to the extent that an answer is required to the introductory paragraph of the Notice of Opposition, Applicant denies the same.
2. Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 2, and therefore denies the same.
3. Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 3, and therefore denies the same.
4. Applicant lacks knowledge or information to form a belief as to the allegations contained in Paragraph 4, and therefore denies the same.

5. Applicant lacks knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 5, and therefore denies the same.

6. Applicant denies the allegations contained in Paragraph 6.

7. Applicant denies the allegations contained in Paragraph 7 as they relate to the CHEESEBURGER BITE Mark. Applicant lacks knowledge and information sufficient to form a belief as to the remaining allegations contained in Paragraph 7, and therefore denies the same.

8. Applicant denies the allegations contained in Paragraph 8.

9. Applicant denies the allegations contained in Paragraph 9.

10. Applicant lacks knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 10, and therefore denies the same.

11. Admitted.

12. Admitted. Applicant further states that it disclaimed exclusive rights in “CHEESEBURGER BITES” apart from the GIORGIO CHEESEBURGER BITES Mark as a whole in the subject application.

13. Applicant lacks knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 13, and therefore denies the same.

14. Applicant lacks knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 14, and therefore denies the same.

15. Applicant lacks knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 15, and therefore denies the same.

16. Applicant denies the allegations contained in Paragraph 16.

17. Applicant denies the allegations contained in Paragraph 17.

18. Applicant lacks knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 18, and therefore denies the same.

19. Applicant does not need Opposer's permission or approval to use or register the mark GIORGIO CHEESEBURGER BITES Mark.

20. Applicant denies the allegations contained in Paragraph 20.

21. Applicant denies the allegations contained in Paragraph 21.

22. Applicant denies the allegations contained in Paragraph 22.

23. Applicant denies the allegations contained in Paragraph 23.

24. Applicant denies the allegations contained in Paragraph 24.

25. Applicant denies the allegations contained in Paragraph 25.

26. Applicant denies the allegations contained in Paragraph 26.

#### **AFFIRMATIVE AND OTHER DEFENSES**

1. Opposer has failed to state a claim upon which relief can be granted.

2. Applicant's GIORGIO CHEESEBURGER BITES Mark is not confusing similar to the CHEESEBURGER BITES Mark or the 7-Eleven Bite Marks, particularly in light of the weak and diluted nature of the terms "CHEESEBURGER", "BITE", and "CHEESEBURGER BITE."

3. The CHEESEBURGER BITES Mark and the 7-11 Bite Marks are not famous pursuant to 15 U.S.C. § 1125.

4. There is no likelihood of confusion, mistake or deception.

5. Opposer's CHEESEBURGER BITE Mark is generic and/or descriptive and incapable of legal protection under the Trademark and Unfair Competition Laws.

6. Opposer's CHEESEBURGER BITE Mark is not inherently distinctive and has not acquired secondary meaning. Indeed, the USPTO has issued an office action against Application No. 86/779,759 by Opposer for the mark CHEESEBURGER BITE in connection with

“sandwiches” in Class 30 on the ground that “CHEESEBURGER BITE” is merely descriptive of Opposer’s goods. A copy of the Office Action is attached hereto as Exhibit A.

7. The relief sought by Opposer is barred, in whole or in part, by the doctrines of fair use, nominative fair use, and/or descriptive use.

8. The relief sought by Opposer is barred because Opposer has failed to establish injury.

WHEREFORE, Applicant requests that the Board deny the request for relief, that the Opposition be denied, and that Application Serial No. 86/628,500 be allowed to register, and for such further relief as may be deemed just proper.

Respectfully submitted,

GIORGIFRED COMPANY

By:



---

Bassam N. Ibrahim  
Bryce J. Maynard  
Laura K. Pitts  
Attorneys for Applicant  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, Virginia 22314-2727  
Telephone: 703-836-6620

Date: March 31, 2016

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing ANSWER TO NOTICE OF  
OPPOSITION was served this 31st day of March, 2016 via first class mail on:

Steven M. Espenshade, Esq.  
Stephen P. Meleen, Esq.  
Pirkey Barber PLLC  
600 Congress Avenue, Suite 2120  
Austin, TX 78701

  
Florence Goodman

# EXHIBIT

A

---

**To:** 7-Eleven, Inc. ([trademarks@7-11.com](mailto:trademarks@7-11.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86779759 - CHEESEBURGER BITE - N/A  
**Sent:** 12/16/2015 5:37:49 PM  
**Sent As:** ECOM117@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)

---

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86779759

MARK: CHEESEBURGER BITE

**\*86779759\***

**CORRESPONDENT ADDRESS:**

ALLISON MCDADE  
7 Eleven  
1722 Routh St Ste 1000  
Dallas, TX 75201-2506

**CLICK HERE TO RESPOND TO THIS LETTER:**  
[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: 7-Eleven, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

[trademarks@7-11.com](mailto:trademarks@7-11.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 12/16/2015

This Office action supersedes the previous Office action issued on December 2, 2015 in connection with this application.

Applicant must address all issues raised in this Office action. The issue raised in the previous December 2, 2015 Office action is as follow and is withdrawn: the requirement for a disclaimer.

Upon further review, the examining attorney notes the additional issue below, and apologizes for the delay in its raising.

Applicant must respond to all issues raised in this Office action within six (6) months of the date of issuance of this Office action. 37 C.F.R. §2.62(a). If applicant does not respond within this time limit, the application will be abandoned. 37 C.F.R. §2.65(a).

**SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE**

Registration is refused because the applied-for mark merely describes a feature or characteristic of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Applicant's applied-for mark is "CHEESEBURGER BITE" for "sandwiches" in Class 30.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75

USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes, because “each component term retains its merely descriptive significance in relation to the goods, resulting in a mark that is also merely descriptive”); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant’s goods and/or services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and/or services. Specifically, the word “CHEESEBURGER” refers to a type of hamburger and “BITE” means something that can be bitten off into a mouthful or morsel. *See* attached evidence. Taken together, “CHEESEBURGER BITE” is merely descriptive of a feature or characteristic of applicant’s sandwiches, which can be in the nature of a cheeseburger that can be eaten in small morsels.

Therefore, registration is refused pursuant to Trademark Act Section 2(e)(1).

Although applicant’s mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

#### Section 2(f) and Supplemental Register

The applied-for mark has been refused registration on the Principal Register. Applicant may respond by submitting evidence and arguments against the refusal. In addition, applicant may respond by doing one of the following: (1) amending the application to seek registration under Trademark Act Section 2(f), or (2) amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §§1052(f), 1091.

An applicant may generally amend an application to seek registration on the Principal Register based on a claim of acquired distinctiveness under Section 2(f) by (1) submitting actual evidence that the mark has acquired distinctiveness of the goods and/or services, (2) claiming ownership of a prior U.S. registration for the same mark and the same or related goods and/or services, or (3) providing the following verified statement: “**The mark has become distinctive of the goods and/or services through the applicant’s substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least five years immediately before the date of this statement.**” *See* 15 U.S.C. §1052(f); 37 C.F.R. §2.41(a)(1)-(3); TMEP §§1212 *et seq.*

To amend the application to the Supplemental Register, applicant must request such an amendment. TMEP §816.01; *see* 15 U.S.C. §1091; 37 C.F.R. §2.47.

Applicant is advised that, if the application is amended to seek registration on the Principal Register under Trademark Act Section 2(f) or on the Supplemental Register, applicant will be required to disclaim “CHEESEBURGER” because such wording appears to be generic in the context of applicant’s goods and/or services. *See* 15 U.S.C. §1056(a); *In re Wella Corp.*, 565 F.2d 143, 144, 196 USPQ 7, 8 (C.C.P.A. 1977); *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986); TMEP §1213.03(b).

The following is the standardized format for a disclaimer:

**No claim is made to the exclusive right to use “CHEESEBURGER” apart from the mark as shown.**

#### **RESPONSE GUIDELINES**

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. *See* TMEP §§705.02,

709.06.

**TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE:** Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

/Karen S Dindayal/  
Examining Attorney  
Law Office 117  
571-272-8208  
karen.dindayal@uspto.gov

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.



Dictionary > Thesaurus > Translator > Scrabble > Word Lovers' blog > New >

English > English for Learners > French > German > Spanish > Italian

**American English Dictionary**  
Pioneers in dictionary publishing since 1819

American English Dictionary  
British English > American English  
Browse The American Dictionary (A-Z)

**WE MEAT AGAIN!** 

Recipes  
for Easy  
Meals

Food Lion  
has  
Delicious  
Recipes.  
Download &  
Start  
Shopping

Home > American English Dictionary > cheeseburger

Your search results: [cheeseburger](#) / [hamburger](#) / [burger](#) / [burgers](#)

**cheeseburger** (ˈtʃiːzˌbɜːɡər ˈtʃɜː )

• Definitions

noun  
a hamburger with a slice of cheese melted onto the bread patty

• Word Origin

cheese + burger

Word Frequency



Get Skunkier ready this Christmas  
[Play like a pro this Christmas](#)



Translations for 'cheeseburger'

American English: cheeseburger A cheeseburger is a hamburger with a slice of cheese on top, served on a bun. cheeseburgers

- Brazilian Portuguese: cheeseburger
- European Spanish: hamburguesa con queso
- Italian: cheeseburger
- Korean: 치즈버거
- Spanish: hamburguesa con queso
- Chinese: 奶酪汉堡/酪汁汉堡
- French: cheeseburger
- German: Cheeseburger
- Japanese: チーズバーガー
- Portuguese: cheeseburger

Example Sentences Including 'cheeseburger'

"I'd like a cheeseburger, medium well with cheddar." Mrs. Morgan said. Isabel Bird CIRCLE OF THREE: BOOK 2 BLUE MOON (2006)



Comments  
Log in to comment on this word.



Christmas  
The Scrabble Word Champ reveals the words you need to beat the family.



Lucy Mangan Returns  
Lucy Mangan takes a look at your monthly word submissions.

Find us on Facebook



---

**To:** 7-Eleven, Inc. ([trademarks@7-11.com](mailto:trademarks@7-11.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86779759 - CHEESEBURGER BITE - N/A  
**Sent:** 12/16/2015 5:37:52 PM  
**Sent As:** ECOM117@USPTO.GOV  
**Attachments:**

---

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON 12/16/2015 FOR U.S. APPLICATION SERIAL NO. 86779759

Please follow the instructions below:

**(1) TO READ THE LETTER:** Click on this link or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

**(2) TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from 12/16/2015 (or sooner if specified in the Office action). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

**Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response** because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp).

**(3) QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For technical assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail [TSDR@uspto.gov](mailto:TSDR@uspto.gov).

**WARNING**

**Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application.** For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

**PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION:** Private companies not associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see [http://www.uspto.gov/trademarks/solicitation\\_warnings.jsp](http://www.uspto.gov/trademarks/solicitation_warnings.jsp).