

TTAB

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)
)
 Rodizio Restaurants International, Inc.)
)
 Serial No.: 75/343,660)
)
 Filed: August 19, 1997)
)
 Atty. File No.: 3972-5)
)
 For: **RODIZIO GRILL**)

APPEAL BRIEF

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TRADEMARK TRIAL AND APPEAL BOARD

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO TTA ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513 ON JULY 19, 2002.

SHERIDAN ROSS P.C.

BY: *Bonnie B. Sudlow*

BOX TTAB
 Assistant Commissioner for Trademarks
 2900 Crystal Drive
 Arlington, Virginia 22202-3513



07-22-2002

U.S. Patent & TMOts/TM Mail Rcpt Dt. #74

Dear Sir:

This Appeal Brief is filed in response to the final rejections of registration of the mark RODIZIO GRILL by the Examining Attorney dated November 16, 2001. The issues to be decided on appeal are (1) whether the term RODIZIO is merely descriptive as applied to the services identified in the application and (2) whether Applicant's claim of acquired distinctiveness is sufficient.

I. Arguments Regarding the Merits of the Section 2(e)(1) Refusal

Applicant has filed an application to register the mark RODIZIO GRILL for restaurant services. Applicant has claimed use of the mark at least as early as December 1995 and use in interstate commerce at least as early as January 1996. Registration has been finally refused under Section 2(e)(1) of the Trademark Act of 1946 on the ground that the term RODIZIO is

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merely descriptive of the services, inasmuch as it is a Portuguese word, which is merely descriptive of Applicant's identified services. In this regard, the Examining Attorney has requested a disclaimer of the term RODIZIO.

Under the "doctrine of foreign equivalents," foreign words are translated into English and then tested for descriptiveness or genericness. *Rosenblum v. George Willsher & Co.*, 161 U.S.P.Q. 492 (TTAB 1969); *In re New Yorker Cheese Co.*, 130 U.S.P.Q. 120 (TTAB 1961); *Volkswagenwerk Aktiengesellschaft v. Church*, 150 U.S.P.Q. 338 (S.D. Cal. 1966), *aff'd*, 161 U.S.P.Q. 769 (9th Cir. 1969). The test is whether, to those American buyers familiar with the foreign language, the word would have a descriptive connotation. *In re Hag Aktiengesellschaft*, 155 U.S.P.Q. 598 (TTAB 1967); *In re Zazzara*, 156 U.S.P.Q. 348 (TTAB 1967). The doctrine of foreign equivalents should be viewed merely as a guideline and applied only when it is likely that the ordinary United States purchaser would "stop and translate [the word] into its English equivalent." *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109 (TTAB 1976); *In re Organon Teknika Corp.*, 216 U.S.P.Q. 935 (TTAB 1983). Sometimes, the foreign word will not directly translate into a term descriptive of the goods or services and in such a case the term is only suggestive, not descriptive. *In re Atavio, Inc.*, 25 U.S.P.Q.2d 1361 (TTAB 1992).

The term "rodizio" is a Portuguese term. See Exhibit A attached to previous Response for copy of dictionary definitions. The term "rodizio" is defined in Portuguese as (1) "work shift; turn; rotation; paddle of a waterwheel; furniture caster; collusion;" (2) "water wheel; scheduling of work; round, turn rotation; caster (small swiveled wheel); crooked swap; collusion, connivance;" and (3) "waterwheel, shift, relay work, scheduling of work; turn, rotation; caster (wheel); shady deal; sharp practices."

A term is considered to be descriptive of services within the meaning of Section 2(e)(1) of the Trademark Act, “if it **immediately** describes an ingredient, quality, characteristic or feature thereof, or it directly conveys information regarding the nature, function, purpose or use of the goods or services.” (emphasis added). *In re Intelligent Instrumentation, Inc.*, 40 U.S.P.Q.2d 1792 (TTAB 1996). In other words, a merely descriptive mark conveys a readily understood meaning of the goods or services provided under the mark to the purchaser. A suggestive mark, on the other hand, requires some imagination, thought and perception to determine its meaning in relation to the goods or services. *In re Colonial Ref. & Chem. Co.*, 196 U.S.P.Q. 46 (TTAB 1977).

The question to be decided here is whether the term RODIZIO is merely descriptive as applied to the restaurant services identified in the application. In this case, the term RODIZIO is a Portuguese word. Therefore, in translation that Portuguese word must merely describe the Applicant’s restaurant services. Considering the foregoing translations, it appears that the word RODIZIO is used to define a broad class or category of rotating apparatus and/or shady business practices. Thus, the term RODIZIO appears to be an inclusive term for a variety of rotating devices rather than a reference to restaurant services. As such, it is not accurate to conclude that RODIZIO is the precise equivalent of restaurant services or that RODIZIO is, therefore, merely descriptive of restaurant services. As noted above, if the foreign word will not directly translate into a term descriptive of the services, the term is only suggestive, not descriptive. *In re Atavio, Inc.*, 25 U.S.P.Q.2d 1361 (TTAB 1992). At most then, the term RODIZIO is suggestive of Applicant’s restaurant services.

A historical perspective may further clarify the issues in this case. Applicant has used

the mark RODIZIO in connection with Brazilian style steak houses since at least as early as December 1995. Mr. Ivan Utrera, the President of Applicant company, is a Brazilian native and immigrant to the United States. Mr. Utrera's desire was to open several Brazilian style steak houses in the United States featuring the "churrasco" or "espeto corrido" styles of dining, which essentially mean "dining carnival style" and "passing of the skewer." A portion of Applicant's menu describing the evolution of churrasco and espeto corrido is excerpted below. (See Exhibit B attached to previous Response for copy of menu.)

"In the early 1900's, Western Europe was sinking into one of the worst depressions in its history. As economic times grew more and more difficult, thousands found themselves without work, unable to feed or clothe their families. In the midst of this despair, many began to dream about the "new world" - the Americas - the land of abundance, rich in resources where an honest person could carve out of the land a good life for himself and his family. Many left Europe in search of their dreams.

Two such groups of immigrants, one German and one Italian, discovered a little know region in southern Brazil with vast grasslands and rich, fertile soil. They named it the "Pampas" - the high plains. Not only did the land provide excellent grazing conditions for their livestock, but because of the relatively mild climate, it also yielded fresh fruits and vegetables in abundance.

To show their gratitude for their good fortune, the people gathered twice each year from miles around to celebrate with a feast of thanksgiving. Fresh vegetables and fruits were harvested, prepared and served at a great table where all could partake. Beef, chicken, pork and even fish caught from the rivers were carefully seasoned and cooked on skewers over open fire pits by the ranchers or "gauchos" as they were called at that time. The Gauchos carried the freshly cooked meats to the various tables where steaming portions were sliced right off the skewer onto each person's plate. Each person could eat as he pleased, choosing one or all of the meats and partaking freely from the fruit and vegetable table. Sweet-breads and pastries were prepared in the European tradition to eat before and after the meal. These celebrations became a time for individuals and families to share the warmth of a good meal with friends and family. Stories were told, songs were sung and friendships were renewed.

As population centers grew, first community centers and then individuals began to open restaurants which provided this same quality of food with even better service. Over the years, these restaurants have become the hearts of their communities. Here it is

that friends and families meet often to celebrate special occasions, to enjoy a business lunch or just spend some time together.

Mr. Utrera opened his first Brazilian style steak house under the mark RODIZIO in Denver, Colorado and has since opened additional restaurants in Colorado, Utah, and Texas. Applicant's restaurants specialize in the churrasco and espeto corrido dining experience described above. Applicant's restaurants feature an all-you-can-eat menu at a fixed price, usually \$14.00 per person for lunch and \$19.00 per person for dinner. Upon being seated in one of Applicant's restaurants, four different appetizers are brought to the table. Following the appetizers, customers are directed to the salad bar which features an assortment 35 different traditional and exotic salads. The salad bar also includes four or five hot dishes, such as a traditional South American stew, beef stroganoff and rice. When customers are ready, they may turn the wooden spool on the table from red to green to signal the meat servers, who are dressed like gauchos, to come to the table. The meat servers come to the table with sword like skewers and offer customers a variety of grilled meats, one after the other. The variety of meats is extensive and includes beef tenderloin, top sirloin, tri-tip, ham, ribs, sausage, lamb, bison, chicken and turkey. Finally, as a finishing touch, customers may choose from a selection of desserts.

All of Applicant's RODIZIO restaurants are based on the Brazilian churrasco and espeto corrido all-you-can-eat concept. The theme of each restaurant is identical, including the churrasco and espeto corrido style meats carved table-side, the gaucho costumes worn by the waiters and the red and green spool used by the customers to signal the waiters.

As can be seen, the restaurant concept developed by Applicant is reminiscent of the well known

Brazilian churrasco and espeto corrido dining styles. As stated previously, the term RODIZIO is not descriptive of restaurant services in Portuguese or English. The Brazilian terms churrasco and espeto corrido, however, are accurately descriptive of Applicant's restaurant services. As such, Applicant submits that this historical perspective further supports Applicant's position that the term RODIZIO is not merely descriptive when used in connection with restaurant services.

Furthermore, in determining whether a mark should be classified as descriptive, the Examining Attorney must consider the evidence of record and focus on how the mark is used in context, rather than on its use in the abstract. *In re Noble Co.*, 225 U.S.P.Q. 749 (TTAB 1985). The Examining Attorney should also pay particular attention to the goods or services for which registration is sought, the context in which the mark is being used on or in connection with those goods or services, and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of use. See *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (TTAB 1979); *In re Consolidated Cigar Co.*, 35 U.S.P.Q.2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 U.S.P.Q.2d 1753 (TTAB 1991).

The mark RODIZIO GRILL as used in connection with Applicant's services is quite distinctive. As indicated by the specimens and attached menu, the term RODIZIO is accompanied by the English word GRILL and a stylized depiction of a bull. Applicant has used the stylized bull design in connection with its restaurant services for several years as evidenced by U.S. Registration No. 2,050,684. Consumers have come to recognize the stylized bull design, both alone and in connection with the terms RODIZIO GRILL, as indicating Applicant as the source of restaurant services. Given the context in which the term RODIZIO is used, it is unlikely that the ordinary American consumer would recognize the term RODIZIO as a foreign

term, or stop and consider translating the word RODIZIO into English. See *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109 (TTAB 1976); *In re Organon Teknika Corp.*, 216 U.S.P.Q. 935 (TTAB 1983).

Finally, the Examining Attorney has submitted several Lexis-Nexis News Articles and internet web sites showing use of the term RODIZIO in an attempt to demonstrate the descriptive nature of the term RODIZIO. Several of the articles/web sites provided by the Examining Attorney specifically reference Applicant and properly identify RODIZIO as a trademark owned by Applicant by capitalizing the mark or otherwise setting the mark apart from the other text in the article. These articles/web sites demonstrate that third parties recognize RODIZIO as a trademark used in connection with specific restaurant services offered by Applicant and further support Applicant's contention that the term RODIZIO is distinctive in nature. Contrary to the Examining Attorney's position, the remaining articles/web sites are merely probative at best of the misappropriation by others of Applicant's restaurant concept and trademark. Applicant has used the mark RODIZIO in connection with restaurant services since at least as early as December 1995, and believes that it was the first entity to use the mark RODIZIO and introduce Brazilian style steak house concept to the United States. Since Applicant's adoption of the RODIZIO mark, several third parties have attempted to misappropriate Applicant's trademark and restaurant concept. As such, Applicant is of the opinion that those articles/web sites not specifically referencing Applicant are demonstrative of the misappropriation by others of Applicant's trademark and are not probative as to the descriptiveness of the term RODIZIO.

In conclusion, when the term RODIZIO is used in connection with Applicant's restaurant

services, it does not immediately convey with any degree of particularity a readily understood meaning of the services provided under the mark. The term RODIZIO, while possibly suggestive, is not merely descriptive of the identified services. As such, Applicant requests reconsideration of the disclaimer requirement as it pertains to the term RODIZIO.

II. Claim of Section 2(f) Distinctiveness in the Alternative

Applicant maintains that the Examining Attorney's refusal under Trademark Act Section 2(e)(1) is improper and alternatively seeks registration pursuant to Trademark Act Section 2(f) in the interest of advancing the prosecution of the application. As noted in TMEP Section 1212.02(c), the alternative claim of acquired distinctiveness does not constitute a concession that the matter sought to be registered is not inherently distinctive. See *In re ES Robbins Corp.*, 30 U.S.P.Q.2d 1540(TTAB 1994); *In re Professional Learning Centers, Inc.*, 230 U.S.P.Q. 70 (TTAB 1986).

Applicant respectfully submits that the mark RODIZIO has acquired distinctiveness pursuant to Section 2(f) of the Trademark Act by reason of substantially exclusive and continuous use in commerce for five (5) years. In support of Applicant's Section 2(f) claim, Applicant submitted a Declaration, in accordance with 37 C.F.R. Section 2.20, signed by Ivan R. Utrera, President of Rodizio Restaurants International, Inc. As stated in the Declaration, Applicant believes that the term RODIZIO is distinctive, as applied to Applicant's restaurant services, by reason of substantially exclusive and continuous use of the mark in commerce since December 1995. See 37 C.F.R. Section 2.41(b) and TMEP Section 1212.05.

In further support of Applicant's belief that the term RODIZIO is distinctive as applied to

Applicant's restaurant services, Applicant has provided actual evidence of acquired distinctiveness including, advertising expenditures, samples of such advertising including television commercials, restaurant reviews, news articles, customer comments, and revenues figures. See 37 C.F.R. Section 2.41(a) and TMEP Section 1212.06. As noted in the Declaration of Ivan R. Utrera, Applicant spends over \$400,000 annually on advertising and generates well over 13 million dollars in annual revenues. Additionally, Applicant's restaurants have been granted several awards and much recognition, including being voted Hot Concept '99 by *Nation's Restaurant News*, and *Washington Post's* Best Place to Eat in Denver. Applicant has also been given favorable reviews by restaurant critics and consumers, as demonstrated by the attachments to the Declaration.

In view of Applicant's long use of the mark RODIZIO, the substantial amount of evidence submitted in support of Applicant's claim of acquired distinctiveness, and the persuasiveness of such evidence, Applicant believes it has provided sufficient evidence to support a claim of acquired distinctiveness.

The Examining Attorney, however, is of the opinion that Applicant's claim of acquired distinctiveness is insufficient due to the existence of U.S. Registration No. 2,030,646 for the mark STEAK MASTERS RODIZIO STYLE, wherein the registrant disclaimed the term RODIZIO. Applicant notes that this registration was filed after Applicant's application and therefore, should not have been granted registration in view of Applicant's prior pending applications for RODIZIO, RODIZIO GRILL and RODIZIO GRILL & Design. In sum, Applicant does not believe adequate consideration has been provided Applicant's claim of acquired distinctiveness.

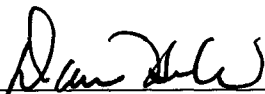
III. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration of the Examining Attorney's final rejections of registration. Specifically, Applicant requests reversal of the refusal to register under Section 2(e)(1), or alternatively, registration of the mark pursuant to Section 2(f). Should the Board affirm the disclaimer requirement, Applicant respectfully requests time in which to amend the application to enter the disclaimer pursuant to Section 6 of the Act and Trademark Rule 2.142(g).

Respectfully submitted,

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Date: July 19, 2002

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