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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/536106

**MARK:** BARMACHÉ



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

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

**APPLICANT:** Spring Cafe Realty LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

barmache

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

The Office has reassigned this application to the undersigned Trademark Examining Attorney.

Applicant has appealed the Trademark Examining Attorney's final refusal to register the mark BARMACHÉ for "restaurant and catering services," on the grounds that, inter alia, Applicant's attempted amendment of the original mark BARMACHÉ to the proposed amended mark BARMARCHÉ does not constitute a material alteration of the original applied-for mark.

**I. FACTS**

*Pertinent Prosecution History*

Applicant, on December 21, 2004, applied for registration on the Principal Register for the mark BARMACHÉ for "restaurant and catering services."

On January 13, 2005, applicant filed a preliminary amendment seeking to amend its applied-for mark to BARMARCHÉ.

On August 2, 2005, the Trademark Examining Attorney issued an office action requesting that applicant indicate whether the terms BAR, MACHE or BARMACHE have any significance in the relevant trade, any geographical significance, or any meaning in a foreign language. The Trademark Examining Attorney also requested a translation of all foreign wording in the mark BARMACHE and provided an example of the English translation of the word MACHE. The Trademark Examining Attorney also denied Applicant's preliminary and proposed amendment seeking to amend the mark from BARMACHÉ to BARMARCHÉ on the grounds that such an amendment would materially alter the essence or character of the mark and is therefore an unacceptable material alteration of the original mark as filed. Finally, the Trademark Examining Attorney refused Applicant's specimens of record wherein the mark was displayed as BARMARCHE on the grounds that the specimens did not match the drawing of record, namely, BARMACHE thereby noting that an amendment of the drawing to conform to the display of the mark on the specimens where it appeared as BARMARCHE would constitute an impermissible material alteration of the mark, and that substitute specimens would be required.

In support of the material alteration refusal, the Trademark Examining Attorney attached evidence from an online translation service, namely, [www.fr.wordreference.com](http://www.fr.wordreference.com) containing English translations of the French word "mache" to mean "corn salad," and "macher" to mean "chew up." References from the same translation service provided several English translations of the French term "marche" to mean "marching, walking,"

and derivatives thereof. Additional translations reflected “marche” to mean “hard market,” “mart,” “marketing,” “grocery,” “deal,” “marketplace,” and “stock list.”

On March 1, 2006, application serial no. 78/536106 was abandoned for failure to respond to the Trademark Examining Attorney’s August 2, 2005 Office Action. On April 10, 2006, Applicant filed a petition to reinstate indicating that its October 20, 2005 response to the August 2, 2005 Office Action was timely filed, and the Office, on April 20, 2006, granted reinstatement.

On October 20, 2005, in an Office Action Response erroneously entitled “Brief on Appeal,” Applicant argues that its amended drawing submitted by way of the January 13, 2005 Preliminary Amendment should be accepted inasmuch as (1) it was an attempt to correct a typographical error made in the original application; (2) it was made at the earliest possible time during prosecution; and, (3) it was made nearly seven months prior to issuance of the Office Action by the Examiner.

On March 19, 2007, the Trademark Examining Attorney issued a FINAL action on the following grounds:

- (1) maintaining and making FINAL the request that applicant indicate whether the terms BAR, MACHE or BARMACHE have any significance in the relevant trade, any geographical significance, or any meaning in a foreign language;
- (2) maintaining and making FINAL the request that applicant provide a translation of all foreign wording in the mark BARMACHE;
- (3) maintaining and making FINAL the request for specimens that are a substantially exact representation of the mark BARMACHE; and

(4) maintaining and making FINAL the refusal to amend the drawing of the mark from BARMACHE to BARMARCHE on the grounds that such an amendment would constitute an impermissible material alteration of the mark. The Trademark Examining Attorney submitted the following evidence with her FINAL action: MACHE is defined at [www.Dictionary.com](http://www.Dictionary.com) as “corn salad,” a noun, “also called lamb’s lettuce, mache.” The same reference defines “corn salad” as “any of several plants of the genus *Valerianella*, especially a Eurasian annual (*V. locusta* or *V. oleria*), having small, white to pale bluish flowers and edible young leaves used in salads or as a potherb. Also called *lamb’s lettuce, mache.*” An additional reference, namely, [www.en.wikipedia.org](http://www.en.wikipedia.org), defines “corn salad” to include “mache.” This same reference defines MARCHE as “a region of central Italy” which is “divided into five provinces.”

On March 22, 2007, Applicant filed a notice of appeal and fee with the Trademark Trial and Appeal Board (hereinafter “TTAB” or “Board”). On May 15, 2007 Applicant filed its Appeal Brief with the Board.

## **II. ARGUMENT**

### ***A. Proposed Amendment of Mark Constitutes a Material Alteration***

Applicant, on December 21, 2004, applied for registration on the Principal Register for the mark BARMACHÉ for “restaurant and catering services.”

On January 13, 2005, Applicant filed a preliminary amendment seeking to amend its applied-for mark to BARMARCHÉ.

The Trademark Examining Attorney denied Applicant's preliminary and proposed amendment seeking to amend the mark from BARMACHÉ to BARMARCHÉ on the grounds that such an amendment would materially alter the essence or character of the mark and is therefore an unacceptable material alteration of the original mark as filed.

Applicant's sole arguments in its Appeal Brief on the issue of material alteration of its proposed amended mark are summarized as follows: (1) it was an attempt to correct a typographical error made in the original application; (2) it was made at the earliest possible time during prosecution; and, (3) it was made nearly seven months prior to issuance of the Office Action by the Examiner. All of Applicant's arguments in support of registrability are irrelevant when viewed in light of applicable statutes and case law governing the issue of material alteration of a mark.

Inasmuch as Applicant has not cited any applicable rules in this case, or any case law or other authority in support of its position that its amendment of the original mark BARMACHÉ to the proposed amended mark BARMARCHÉ was not a material alteration of the original mark, the Trademark Examining Attorney will discuss the history of this issue, including relevant statute, case law and analysis governing resolution of the issue of material alteration.

The applicable rule governing the Board's decision in this case is Trademark Rule 2.72(a), which was amended, effective October 30, 1999. The new Trademark Rule 2.72, in its entirety, reads as follows:

**§2.72 Amendments to description or drawing of the mark.**

(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens originally filed, or substitute specimens filed under §2.59(a), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(b) In an application based on a bona fide intention to use a mark in commerce under section 1(b) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens filed with an amendment to allege use or statement of use, or substitute specimens filed under §2.59(b), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(c) In an application based on a claim of priority under section 44(d) of the Act, or on a mark duly registered in the country of origin of the foreign applicant under section 44(e) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The description or drawing of the mark in the foreign registration certificate supports the amendment; and

- (2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

[48 FR 23134, May 23, 1983, as amended at 54 FR 37593, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

Thus, under the Trademark Rules of Practice, an amendment to the drawing of the mark may be allowed only if the amendment does not materially alter the mark.<sup>1</sup> As set forth by the Board in *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211 (TTAB 2000):

The test for determining whether an amendment is a material alteration was articulated in *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983): “The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.” *220 USPQ at 743*. “That is, the new and old forms of the mark must create essentially the same commercial impression.” *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988).

*Id.*

In this case, the Trademark Examining Attorney submits that Applicant’s proposed amendment of its mark from BARMACHÉ to BARMARCHÉ constitutes a material alteration of the mark and is impermissible under Trademark Rule 2.72, as amended and prior thereto. The modified mark is unacceptable because it carries new meaning, generates a new overall commercial impression and does not contain the essence of the original mark BARMACHÉ.

In other words, the new form of the mark, namely, BARMARCHÉ, does not create the impression of being essentially the same mark.

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<sup>1</sup> Former Trademark Rule 2.72(a) provided, *inter alia*, that “amendments may not be made to the description or drawing of the mark if the character of the mark is materially altered.” Current Trademark Rules 2.72(a)(2), 2.72(b)(2) and 2.72(c)(2) [as amended October 30, 1999] provide, *inter alia*, that “...the applicant may amend the description or drawing of the mark only if ...[t]he proposed amendment does not materially alter the mark.”



Applicant argues that in response to a typographical error in its original application for BARMACHÉ, Applicant immediately filed a preliminary amendment seeking registration of BARMARCHÉ. The immediacy of Applicant's filing of the Preliminary Amendment is irrelevant because it did not change the material alteration of the original mark and did not cure the historical concern for providing notice to third parties. Specifically, it is in the public interest not to accept amendments that materially alter the mark on the original drawing because accurate public notification of the filing of applications is important. Other reasons aside, third parties rely on the search of Office records, and may innocently begin using a mark that conflicts with the amended mark but not with the original mark. It is essential that third parties have accurate information about earlier-filed applications. The fact that the Trademark Examining Attorney's Office Action was issued several months after the USPTO's receipt of Applicant's Preliminary Amendment is likewise irrelevant as it does not take into account the actual differences between the mark, i.e., the material alteration standard that governs such amendments, and third party reliance on the original mark as filed.

Applicant further argues that "the Examiner had notice of [the] actual mark due to the submission of the use specimens which correctly identified the mark as BARMARCHÉ." However, the issue of whether or not the Trademark Examining Attorney had notice of the proposed amended mark is likewise irrelevant. Trademark Rule 2.72 was enacted, in part, to provide notice to third parties.

However, Applicant does make two highly relevant statements in its Appeal Brief. Interestingly, Applicant admits that the two words, BARMACHÉ and BARMARCHÉ have different meanings, a finding that is central to this case and the

standards governing its resolution. In its Appeal Brief, Applicant submits that “if the typographical error did not result in an actual other word, [that] the Preliminary Amendment would not have resulted in the Examiner’s conclusion that the change was material.” Or, “[i]n essence, the applicant is being penalized for the typographical error resulting in a word with an understood meaning as opposed to one that does not.” The Trademark Examining Attorney respectfully submits that the Board take notice of Applicant’s concession that the mark as originally filed and that as proposed have different meanings.

The Trademark Examining Attorney submits that Applicant’s proposed amendment of its mark from BARMACHÉ to BARMARCHÉ constitutes a material alteration of the mark and is impermissible under Trademark Rule 2.72, as amended and prior thereto, because, among other things, the modified mark carries new meaning. As seen by the evidence of record in this case, which is incorporated by reference herein, portions of the marks BARMACHE and BARMARCHE indeed have different meanings.

For example, the evidence included with the Trademark Examining Attorney’s First Office Action and Final Refusal is supportive of the different meanings of the two marks. As part of the initial Office Action, the Trademark Examining Attorney included evidence from a French dictionary, namely, [www.fr.wordreference.com](http://www.fr.wordreference.com) that defined MACHE as “corn salad.” The same reference defined MARCHE as “marching,” “walking (foot travel),” as well as “march,” “stair,” “walk (long walk),” and “stroll (leisurely walk).” Additional translations of MARCHE include “hard market,” “mart,” “marketing,” grocery (marketplace),” “deal,” “marketplace

(commercial activity),” and “stock list.” In connection with the FINAL Office Action, the Trademark Examining Attorney submitted evidence that MACHE is defined at [www.Dictionary.com](http://www.Dictionary.com) as “corn salad,” a noun, “also called lamb’s lettuce, mache.” The same reference defines “corn salad” as “any of several plants of the genus *Valerianella*, especially a Eurasian annual (*V. locusta* or *V. oleria*), having small, white to pale bluish flowers and edible young leaves used in salads or as a potherb. Also called *lamb’s lettuce, mache.*” An additional reference, namely, [www.en.wikipedia.org](http://www.en.wikipedia.org), defines “corn salad” to include “mache.” This same reference defines MARCHE as “a region of central Italy” which is “divided into five provinces.” In view of the evidence of record, it is indisputable that the terms BARMACHE and BARMARCHE have different meanings.

In addition, Applicant, in its Appeal Brief, has conceded that the marks have different meanings by way of the following submissions, namely, that “[i]f the typographical error did not result in an actual other word, [that] the Preliminary Amendment would not have resulted in the Examiner’s conclusion that the change was material,” and “[i]n essence, the applicant is being penalized for the typographical error resulting in a word with an understood meaning as opposed to one that does not.” The Trademark Examining Attorney respectfully submits that the Board take notice of Applicant’s statements that the mark as filed and that as proposed have different meanings and that the Board treat this issue as conceded by the Applicant.

In addition, the mark, as modified, generates a new overall commercial impression and does not contain the essence of the original mark BARMACHE. The insertion of the letter “R” in the attempted amendment of BARMACHE to

BARMARCHE results in a portion of the mark, namely, MACHE and MARCHE, which is a different word entirely with a different appearance and commercial impression.

The new form of the mark, namely, BARMARCHE, does not create the impression of being essentially the same mark.

As discussed, the modified mark must contain the essence of the original mark, namely, BARMACHE, and the proposed amended mark must create the impression of being essentially the same mark.

In this case, Applicant has attempted to amend the original mark BARMACHE by adding an “R” to the second portion of the original mark, namely, BARMARCHE, with the result that a distinctly new mark is created, changing the commercial impression and meaning of the original mark, and thereby losing the essence of the original mark.

When we compare the marks in the original and proposed drawings, BARMACHE and BARMARCHE, we see that they do not create the same overall commercial impression, and, therefore, the mark in the amended drawing has lost the essence of that depicted in the original and would constitute a material alteration of the mark in the original drawing.

Moreover, if republication of the amended mark would be necessary in order to provide proper notice to third parties for opposition purposes, then the mark has been materially altered and the amendment is not permitted. *In re Who? Vision Systems Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000). “The modified mark must contain the essence of the original mark, and the new form must create the impression of being essentially the same mark.” *Visa International Service Association v. Life Code Systems, Inc.*, 220 USPQ 740, 743 (TTAB 1983). “That is, the new and old forms of the mark must create

essentially the same commercial impression.” *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988).

*B. Unacceptable Specimen Issue*

37 C.F.R. Section 2.51(a) provides that “[i]n an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods or services.”

Applicant originally filed for the mark BARMACHÉ and after filing, by way of a preliminary amendment, attempted to amend its mark to BARMARCHÉ, which was an unacceptable material alteration of the original mark as filed. In view thereof, the Trademark Examining Attorney refused applicant’s specimens of record wherein the mark was displayed as BARMARCHÉ on the grounds that the specimens did not match the drawing of record, namely, BARMACHÉ, thereby noting that an amendment of the drawing to conform to the display of the mark on the specimens would constitute an impermissible material alteration of the mark, and that substitute specimens would be required. Applicant has not provided substitute specimens.

A drawing depicts the mark sought to be registered. 37 C.F.R. Section 2.52, Trademark Rule 2.52. “The drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” 37 C.F.R. Section 2.51(a)(1). Therefore, the initial question is whether the drawing submitted by Applicant wherein the mark appears as BARMACHÉ is a substantially exact representation of the mark on the specimen, namely, BARMARCHÉ. It is the position of the Trademark Examining Attorney that the mark as it appears on the

drawing, namely, BARMACHÉ, is not a substantially exact representation of the mark as it appears on the specimen, namely, BARMARCHÉ. The next question is whether Applicant could submit a substitute drawing showing the mark as it appears in the specimen of record. As discussed in the previous section, this is not an option for Applicant inasmuch as such an amendment would constitute an impermissible material alteration of the original applied-for mark, namely BARMACHÉ. Trademark Rule 72(a) (37 C.F.R. Section 2.72(a)) addresses when an applicant can submit a new drawing and specifically states that a proposed amendment may not materially alter the mark. In this case, Applicant's mark on the drawing is unequivocally for the mark BARMACHÉ. The mark shown on the specimen, however, is for the proposed mark BARMARCHÉ. Thus, the mark shown in the specimens is materially different from the mark in the drawing and Applicant cannot submit a substitute drawing in this instance. Applicant has not complied with the Trademark Examining Attorney's request for substitute specimens that match the drawing of record.

C. Applicant's Failure of Provide Requested Information

The Trademark Examining Attorney twice requested that applicant indicate whether the terms BAR, MACHE, or BARMACHE have any significance in the relevant trade, any geographical significance, or any meaning in a foreign language as well as a translation of all foreign wording in the mark BARMACHE. Applicant has refused to comply with these requests. Failure to respond to a request for information can be grounds for refusing registration. *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003).

In this case, Applicant has not complied with the Trademark Examining Attorney's repeated requests for information as to the significance of the terms BAR, MACHE and BARMACHE as well as translations thereof. It is submitted that the Trademark Examining Attorney's requests for this information were proper under Trademark Rule 2.61(b) as the information requested is directly relevant to the question of material alteration of the mark in issue. Applicant has not contended otherwise. Applicant does not dispute that it has not complied with the Examining Attorney's requests for specific information intended to assist in the disposition of this case. Applicant has ignored the Trademark Rule 2.61(b) requirement altogether.

Information and materials provided by an Applicant in response to a Trademark Rule 2.61(b) requirement can be extremely useful in the Board's review on appeal of the Trademark Examining Attorney's refusals and requirements. This is especially so in a matter involving wording that is unfamiliar or of a foreign origin. The Board encourages Trademark Examining Attorneys to require such information and materials of the Applicant under Trademark Rule 2.61(b) and looks with disfavor on an Applicant's failure to comply with such requirement fully and in good faith. *Id.*, at n. 3.

The Trademark Rules of Practice have the effect of law, and failure to comply with a request for information is grounds for refusal of registration. *Id.*, citing *In re SPX Corporation*, 63 USPQ2d 1592 (TTAB 2002); *In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999); *In re Babies Beat, Inc.*, 13USPQ2d 1729, 1731 (TTAB 1990); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371 (TTAB 1978); *In re Air Products and Chemicals, Inc.*, 192 USPQ2d 84, 85-86 (TTAB 1976); *In re Morrison Industries, Inc.*, 178 USPQ

432, 433-34 (TTAB 1073); *Chrysler Corp. v. Brown*, 441 U.S. 281, 295 (1979) (agency regulations have the force and effect of law).

The Trademark Examining Attorney submits that Applicant's noncompliance with the Trademark Examining Attorney's lawful requirement under Trademark Rule 2.61(b) warrants a separate ground for rejection of the application in issue in this case.

### **III CONCLUSION**

For the foregoing reasons, the Examining Attorney respectfully requests that the refusal of registration based on the grounds that Applicant's attempted amendment of the original mark BARMACHÉ to the proposed amended mark BARMARCHÉ constitutes a material alteration of the original applied-for mark; that applicant has not provided specimens of record that are a substantially exact representation of the drawing of the mark; and, that applicant is not in compliance with Trademark Rule 2.61(b) be affirmed.

Respectfully submitted,

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