PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78802307
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	

RESPONSE TO OFFICE ACTION
MAILED MARCH 6, 2007 AND
REQUEST FOR RECONSIDERATION

The above-identified application has been carefully reviewed in view of the Official Action mailed March 6, 2007. Reconsideration and withdrawal of the rejection entered by the Examining Attorney is respectfully requested in light of the amendments to the application and the arguments and authorities presented below.

I. Examiner's Refusal under Trademark Action Sections 1, 2, 3 and 45 is Improper

The Examining Attorney continues to maintain that "the proposed mark, as used on the specimen of record, does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate their source." Applicant renews its claim that the Examining Attorney's assertion is improper in view of TMEP 1301.04, which states, in pertinent part, that menus may comprise acceptable specimens for a service mark. Further, TMEP 1301.04 states, "Generally, the applicant is able to submit more varied types of specimens in a service mark application; however, the specimens must evidence use of the mark in the sale or advertising of the recited services . . . The manner of use on the specimens must be such that potential purchasers would readily perceive the subject matter as identifying and distinguishing the applicant's services and indicating their source..." The intent of the TMEP is unambiguous in that Examining Attorneys are directed to allow a wider latitude in the type and nature of specimens permitted in support of service mark applications.

At the suggestion of the Examining Attorney, Applicant submits herewith a substitute

specimen and accompanying declaration under C.F.R. §2.20. As this specimen illustrates use of the subject mark in a more prominent fashion, Applicant respectfully requests that the Examining Attorney reconsider rejection of the subject mark in light of the substitution. Applicant also respectfully suggests that it is therefore incumbent upon the Examining Attorney to apply a practical, real-world assessment of the nature of promotion and sale of restaurant services when considering Applicant's substitute specimen submitted herewith. A menu is used to facilitate most restaurant services, from suggestion and assistance services to preparation and presentation services and indicates to the consumers these various services. The subject mark is prominently featured on the menu for Applicant's "On the Border Grill & Cantina" restaurant and clearly serves as a source identifier for Applicant's restaurant services by virtue of this use.

Moreover, as Applicant stated in its response of January 16, 2007, the subject mark is associated with the waitperson's suggestion, advice, and assistance services in providing patrons with an improved experience in selecting desired items. The BORDER SMART mark is used in association with services at Applicant's "On the Border" restaurants, and potential customers would readily perceive the BORDER SMART mark as identifying and distinguishing the services of Applicant from those of others and indicative of Applicant as the source of the services. The Examining Attorney also fails to consider Applicant's statement that its marks GUILTLESS GRILL (standard characters) and GUILTLESS GRILL (& design) (U.S. Trademark Registration No. 2,134,706 and No. 2,563,670, respectively), which are similarly used in connection with Applicant's restaurant services at Applicant's "Chili's Grill & Bar" restaurants.

Inclusion of the term "BORDER" as a component of the mark incorporates the name of Applicant's restaurant, "On the Border Grill & Cantina," into the mark. In this way, the subject mark directly references Applicant's provision of restaurant, bar and catering services. As such, Applicant respectfully submits that there can be no confusion in the minds of the consumer that the mark BORDER SMART refers to Applicant's services alone.

II. Conclusion

The above-identified application has been carefully reviewed in light of the Office Action mailed March 6, 2007. It is believed that each of the objections raised by the Examiner is satisfied by the present response and the substitute specimen and accompanying declaration submitted herewith. Applicant respectfully requests reconsideration and withdrawal of the present objections. In view of the foregoing, it is believed that the application is ready for publication and subsequent registration. Such favorable action is hereby respectfully requested.

Applicant also advises the Examining Attorney that a Notice of Appeal is submitted to the

Trademark Trial & Appeal Board concurrently with this Response.

Applicant does not believe that a fee is due for this Response, but in the event a fee is required, please withdraw the requisite fee from Hitchcock Evert LLP Deposit Account No. 503374. In the event a refund is owed, please credit any overpayment during the pendency of the application to the above-referenced deposit account.

Applicant's attorney requests that the Examining Attorney contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving the issues pending in this matter.

EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	\\TICRS2\EXPORT13\788\023 \78802307\xml1 \ROA0002.JP G
	\\TICRS2\EXPORT13\788\023 \78802307\xml1 \ROA0003.JP G
DESCRIPTION OF EVIDENCE FILE	executed Declaration in Support of Substitute Specimen
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	043
DESCRIPTION	restaurant and catering services
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 11/14/2005
FIRST USE IN COMMERCE DATE	At least as early as 11/14/2005
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	043
DESCRIPTION	restaurant and catering services
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 11/14/2005
FIRST USE IN COMMERCE DATE	At least as early as 11/14/2005
STATEMENT TYPE	"The substitute specimen(s) was in use in commerce as of the filing date of the application."
SPECIMEN FILE NAME(S)	\\TICRS2\EXPORT13\788\023 \78802307\xml1 \ROA0004.JP G

SPECIMEN DESCRIPTION	scanned menu
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Elisabeth A. Evert/
SIGNATORY'S NAME	Elisabeth A. Evert
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	09/05/2007
RESPONSE SIGNATURE	/Elisabeth A. Evert/
SIGNATORY'S NAME	Elisabeth A. Evert
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	09/05/2007
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Sep 05 16:27:40 EDT 2007
TEAS STAMP	USPTO/ROA-12.191.28.154-2 0070905162740604885-78802 307-380f94215cde38a9b6372 62ef7ea7ac2a6-N/A-N/A-200 70905161742033693

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78802307** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

RESPONSE TO OFFICE ACTION
MAILED MARCH 6, 2007 AND
REQUEST FOR RECONSIDERATION

The above-identified application has been carefully reviewed in view of the Official Action mailed March 6, 2007. Reconsideration and withdrawal of the rejection entered by the Examining

Attorney is respectfully requested in light of the amendments to the application and the arguments and authorities presented below.

I. Examiner's Refusal under Trademark Action Sections 1, 2, 3 and 45 is Improper

The Examining Attorney continues to maintain that "the proposed mark, as used on the specimen of record, does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate their source." Applicant renews its claim that the Examining Attorney's assertion is improper in view of TMEP 1301.04, which states, in pertinent part, that menus may comprise acceptable specimens for a service mark. Further, TMEP 1301.04 states, "Generally, the applicant is able to submit more varied types of specimens in a service mark application; however, the specimens must evidence use of the mark in the sale or advertising of the recited services . . . The manner of use on the specimens must be such that potential purchasers would readily perceive the subject matter as identifying and distinguishing the applicant's services and indicating their source..." The intent of the TMEP is unambiguous in that Examining Attorneys are directed to allow a wider latitude in the type and nature of specimens permitted in support of service mark applications.

At the suggestion of the Examining Attorney, Applicant submits herewith a substitute specimen and accompanying declaration under C.F.R. §2.20. As this specimen illustrates use of the subject mark in a more prominent fashion, Applicant respectfully requests that the Examining Attorney reconsider rejection of the subject mark in light of the substitution. Applicant also respectfully suggests that it is therefore incumbent upon the Examining Attorney to apply a practical, real-world assessment of the nature of promotion and sale of restaurant services when considering Applicant's substitute specimen submitted herewith. A menu is used to facilitate most restaurant services, from suggestion and assistance services to preparation and presentation services and indicates to the consumers these various services. The subject mark is prominently featured on the menu for Applicant's "On the Border Grill & Cantina" restaurant and clearly serves as a source identifier for Applicant's restaurant services by virtue of this use.

Moreover, as Applicant stated in its response of January 16, 2007, the subject mark is associated with the waitperson's suggestion, advice, and assistance services in providing patrons with an improved experience in selecting desired items. The BORDER SMART mark is used in association with services at Applicant's "On the Border" restaurants, and potential customers would readily perceive the BORDER SMART mark as identifying and distinguishing the services of Applicant from those of others and indicative of Applicant as the source of the services. The Examining Attorney also fails to consider Applicant's statement that its marks GUILTLESS GRILL (standard characters) and GUILTLESS GRILL (& design) (U.S. Trademark Registration No. 2,134,706 and No. 2,563,670, respectively), which are similarly used in connection with Applicant's restaurant services at Applicant's "Chili's Grill & Bar" restaurants.

Inclusion of the term "BORDER" as a component of the mark incorporates the name of Applicant's restaurant, "On the Border Grill & Cantina," into the mark. In this way, the subject mark directly references Applicant's provision of restaurant, bar and catering services. As such, Applicant respectfully submits that there can be no confusion in the minds of the consumer that the mark BORDER SMART refers to Applicant's services alone.

II. Conclusion

The above-identified application has been carefully reviewed in light of the Office Action mailed March 6, 2007. It is believed that each of the objections raised by the Examiner is satisfied by the present response and the substitute specimen and accompanying declaration submitted herewith. Applicant respectfully requests reconsideration and withdrawal of the present objections. In view of the foregoing, it is believed that the application is ready for publication and subsequent registration. Such favorable action is hereby respectfully requested.

Applicant also advises the Examining Attorney that a Notice of Appeal is submitted to the Trademark Trial & Appeal Board concurrently with this Response.

Applicant does not believe that a fee is due for this Response, but in the event a fee is required, please withdraw the requisite fee from Hitchcock Evert LLP Deposit Account No. 503374. In the event a refund is owed, please credit any overpayment during the pendency of the application to the above-referenced deposit account.

Applicant's attorney requests that the Examining Attorney contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving the issues pending in this matter.

EVIDENCE
Evidence in the nature of executed Declaration in Support of Substitute Specimen has been attached.
Evidence-1
Evidence-2

CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 043 for restaurant and catering services
Original Filing Basis:
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at

least as early as 11/14/2005 and first used in commerce at least as early as 11/14/2005, and is now in use in such commerce.

Proposed: Class 043 for restaurant and catering services
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 11/14/2005 and first used in commerce at least as early as 11/14/2005, and is now in use in such commerce.
Applicant hereby submits a new specimen for Class 043. The specimen(s) submitted consists of scanned menu.
For an application based on 1(a), Use in Commerce, "The substitute specimen(s) was in use in commerce as of the filing date of the application."
Specimen File1

SIGNATURE(S)
Declaration Signature
If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Elisabeth A. Evert/ Date: 09/05/2007
Signatory's Name: Elisabeth A. Evert
Signatory's Position: Attorney of Record

Response Signature
Signature: /Elisabeth A. Evert/ Date: 09/05/2007
Signatory's Name: Elisabeth A. Evert
Signatory's Position: Attorney of Record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant

in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 78802307
Internet Transmission Date: Wed Sep 05 16:27:40 EDT 2007
TEAS Stamp: USPTO/ROA-12.191.28.154-20070905162774060
4885-78802307-380f94215cde38a9b637262ef7
ea7ac2a6-N/A-N/A-20070905161742033693

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Brinker International Holdings, L.P.
Serial No.:	78802307
Class:	043
Filed:	January 30, 2006
Examiner:	Justine D. Parker, Trademark Attorney Law Office 101 (571)272-2488
For:	BORDER SMART

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

DECLARATION IN SUPPORT OF SUBSTITUTE SPECIMENS

I, Laura C. Richard, state that:

I am Assistant Secretary of Brinker International Holdings, L.P., a Delaware Limited Partnership, whose general partner is BIPC Management, LLC, a Delaware Limited Liability Company, the Applicant in the above-referenced application.

Based on information and belief, the attached substitute specimen was used by the Applicant in interstate commerce at least as early as the filing date of the present application, in the offering of services in International Class 043 for ***restaurant and catering services.***

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statement may jeopardize the validity of the application or any resulting registration, declares that the undersigned is properly authorized to execute this Declaration; the undersigned believes the Applicant to be the owner of

the service mark sought to be registered; and all statements made are of his own knowledge are true and all statements made on information and belief are believed to be true.

Brinker International Holdings, L.P.

Date: 9-5-07

Laura C. Richard

Name: Laura C. Richard

Title: Assistant Secretary

Appetizers
Salads & Soup
Border Smart
Fajita Grill
Off The Grill
Favoritos
Tacos
Burritos & Chimi's
Lunch Menu
Beverages
Desserts
Kids Menu
Party Platters
Bulk Orders - A La Carte

Select Another Location

MENU

Click Here for Printable Menu

Knox
Open Since: 10/28/1982
3130 Knox St.
Dallas, TX 75205
Phone: 214-528-5900
Fax: 214-521-6309
Catering: 888-OTB-CATR
Get a Map | Catering Menu

BORDER SMART

Each item on our Border Smart menu includes less than 800 calories, less than 30% fat, and at least one gram of fiber per 100 calories.

Chicken Salsa Fresca

Mesquite-grilled chicken topped with our own spicy salsa fresca. Served with Mexican rice and grilled vegetables.
$8.99

Jalapeno-BBQ Salmon New

Salmon fillet mesquite-grilled with a mild Jalapeno BBQ glaze. Served with black beans and grilled vegetables.
$11.99

Grilled Fajita Chicken Tacos New

Two soft corn tortillas with mesquite-grilled chicken, lettuce and pico de gallo. Served with black beans, grilled vegetables and a side of our own spicy salsa fresca.
$8.99

Pico Shrimp Tacos New

Two soft corn tortillas with shrimp sauteed in our own spicy salsa fresca. Served with black beans and grilled vegetables.
$9.99

Select a Category:
Appetizers | Salads & Soup | **Border Smart** | Fajita Grill | Off The Grill | Favoritos | Tacos | Burritos & Chimi's | Lunch Menu | Beverages | Desserts | Kids Menu | Party Platters | Bulk Orders - A La Carte

menu | gift cards | catering | locations
news | club cantina | work with us | contact us | guest survey

Copyright 2004 Brinker International. All Rights Reserved.