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

Proceeding	85214191
Applicant	Cordua Restaurants, LP
Applied for Mark	CHURRASCOS
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Submission	Appeal Brief
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Date	05/24/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In re Cordua Restarants, LP

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Mark: CHURRASCOS (STYLIZED)

Serial No.: 85/214,191

Filed: 1/10/2011

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**APPLICANT'S APPEAL BRIEF**

**BACKGROUND**

Churrascos Restaurant was conceived by Chef Michael Cordúa, who has long been recognized by national, regional and local food press for his Latin cuisine. Chef Cordua is the only chef in Texas to be inducted into Food & Wine magazine's "Hall of Fame," and he was also named a 2011 James Beard Foundation award semifinalist and was the recipient of the Robert Mondavi Award - among other prestigious culinary awards. He is also a founding member of United Airlines Congress of Chefs.

In 1988 (about 25 years ago), the first Chef Michael Cordua developed Churrascos Restaurant was opened, with applicant now operating a number of locations. Churrascos Restaurant is well known nationally, with honors including being featured on Esquire Magazines list "The 20 Best Steaks in America", August 28, 2008.

On January 4, 2000, Rico, Inc, a predecessor company received U.S. Trademark Registration No. 2,305,279 for CHURRASCOS in stylized form for "restaurant and bar services; and catering services" in international class 43, and subsequently did not file a section 8. On October 17, 2000, Rico, Inc., a predecessor company, received U.S. Trademark Registration No. 2,394,571 for CHURRASCOS in stylized form for "restaurant and bar services; and catering services" in international class 43, and subsequently did not file a section 8.

U.S. TM No. 3439321 for CHURRASCOS (standard character mark). At present, applicant owns U.S. Trademark No. 3439321 for CHURRASCOS (standard character mark) for "restaurant and bar services; and catering services", in international class 43, with applicant intending on filing a section 8 on/after June 3, 2013 when allowed.

Applicant makes note that the issue of the mark CHURRASCOS being generic has never been raised previously.

The instant application upon appeal before this Board is for CHURRASCOS in stylized form for “restaurant and bar services; and catering services” in international class 43, in an essentially same stylized form as that of U.S. Trademark Registration No. 2,305,279.

The April 7, 2011, Office Action “found no similar registered or pending mark which would bar registration”, however, refused registration “because the applied-for mark merely describes a feature or characteristic of applicant’s services” (April 7, 2011, Office Action at page 2).

The April 7, 2011 Office action further noted, “The term “churrascos”[1] is generic for a food served in the applicant’s restaurant and catering services.”

Citing caselaw, the April 7, 2011 Office action noted, “A mark that consists of the generic name of a food that is the specialty of the house or a principal attraction of the restaurant has been held merely descriptive of restaurant services. See *In re Fr. Croissant, Ltd.*, 1 USPQ2d 1238 (TTAB 1986) (holding LE CROISSANT SHOP merely descriptive of restaurant services providing croissants); *In re Le Sorbet, Inc.*, 228 USPQ 27 (TTAB 1985) (holding LE SORBET descriptive of restaurant and carryout shops which serve fruit ices); TMEP §1209.03(r).

In the April 7, 2011 Office Action, Trademark Attorney Asmat Khan offered the following:

*Applicant may seek registration on the Principal Register under Trademark Act Section 2(f) by claiming acquired distinctiveness through ownership of U.S. Registration No. 3439321. See 15 U.S.C. §1052(f); TMEP §§1212.04 et seq. To do so, applicant must submit the following statement, if accurate:*

*The mark has become distinctive of the goods and/or services as evidenced by ownership of U.S. Registration No. 3439321 on the Principal Register for the same mark for related goods and/or services.*

On August 1, 2011, per the suggestion of Trademark Attorney Khan, applicant submitted the suggested statement.

Surprisingly, on November 8, 2011, in the subsequent Office Action, Trademark Attorney Khan refused to accept applicant’s statement (that Trademark Attorney Khan suggested that applicant make) because (1) the applied for mark was now considered to be generic, and now amount of acquired distinctiveness could overcome the generic rejection; and (2) the submitted statement was now being declared to be insufficient to overcome a descriptiveness rejection (even though Trademark Attorney Khan earlier stated that it would overcome a descriptive rejection).

## DISCUSSION

### Summary

1. In support of the proposition that CHURRASCOS (stylized) may be registered in class 43 for “restaurant and bar services; and catering services”, applicant not only points to its predecessor’s expired Churrascos stylized registrations, but also to its currently registered U.S. Trademark Reg. No. 3439321 for CHURRASCOS (standard character mark) for “restaurant and bar services; and catering services”, in international class 43, with applicant intending on filing a section 8 on/after June 3, 2013 when allowed.
2. The current proposed mark must be examined on the whole, and that would include they stylized elements, and the “s” on the end of the mark.
3. The Trademark Attorney has provided a mere 9 Lexis search results showing the use of “churrasco restaurant” (none ending “s” on churrasco). The Trademark Attorney failed to find a single use of churrascos (ending in “s”), and the “churrasco restaurant” uses were not in applicant’s stylized version. A mere 9 uses seems insufficient for showing that CHURRASCOS is generic.
4. The caselaw supports the proposition that applicant’s mark CHURRASCOS for restaurant services which comprises the generic name of a food which is the specialty of the house is merely descriptive of the restaurant services, be it in English or in a foreign language (of course, applicants believes it can show acquired distinctiveness below). *See, In re France Croissant, Ltd.*, 1 U.S.P.Q.2D (TTAB 1986) 1238 (“As was stated in the case of *In re Le Sorbet, Inc.*, 228 USPQ 27 (TTAB 1985) . . . a mark for restaurant services which comprises the generic name of a food which is the specialty of the house is merely descriptive of the restaurant services, be it in English or in a foreign language.”).
5. Applicant’s mark is distinctive at least because of the submitted statement of ownership of the earlier CHURRASCOS registration, the submitted declaration, and/or the presumption of validity afforded applicant’s earlier registration for the standard character CHURRASCOS enjoys a presumption of validity, including the presumption that CHURRASCOS is distinctive.

## Genericness

A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*.

The United States Patent and Trademark Office has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Thus, determining whether a mark is generic requires a two-step inquiry:

- (1) What is the genus of goods and/or services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services?

Step 1, what is the genus of the services at issue? The application describes the services as “restaurant and bar services; and catering services”. Trademark Attorney Khan proposes that the genus is “restaurant services” to which applicant agrees.

Step 2, does the relevant public understand that CHURRASCOS refers to the genus of restaurant services? This question requires an understanding of the meaning of CHURRASCOS.

The application states that the English meaning for “churrascos” is barbeque. Applicant notes that more correctly, it is “churrasco” (without the “s”) that is barbeque (that is, meat cooked over an open fire).

The following are online dictionary searches for “churrasco” (without the ending “s”), as opposed to applicant’s “churrascos” (ends in an “s”).

Dictionary.com defines “churrasco” as: (1) meat cooked over an open fire; and (2) a large piece of meat suitable for barbecuing. See, <http://dictionary.reference.com/browse/churrasco>.

Oxforddictionaries.com defines “churrasco” as: a South American dish of steak barbecued over a wood or charcoal fire. See, <http://oxforddictionaries.com/definition/english/churrasco>.

Merriam-Webster.com defines “churrasco” as: beef broiled on a spit over an open fire or grilled under an oven flame. See, <http://www.merriam-webster.com/dictionary/churrasco>.

Taken on the whole, applicant’s mark CHURRASCOS is stylized, and ends with an “S”.

The results of Lexis searches were provided in both the 11/8/2011 Office Action and the 6/14/2012 Office Action. There were 5 results provided with the 11/8/2011 Office Action, and 7 results provided with the 6/14/2012 Office Action, with 2 of the results being duplicates. Not one of these search results was for CHURRASCOS (with the ending “S”). Typical of these searches was in the form of “a ‘churrasco restaurant’”. In fact, in the 6/14/2012 Office Action, entitled “The flesh trade BT More July 25, 2009” (result 28 of 102), states, “Their grilling style is churrasco the restaurants are churrascoarias...” This makes it abundantly clear, that a restaurant serving churrasco are “churrascoarias”. Thus, of the 12 “results” provided in the Office Actions of 11/8/2011 and 6/14/2012, 2 are duplicates, and 1 does not use “churrasco restaurant”, leaving only a mere 9 results in using “churrasco restaurant”, and not one single use of CHURRASCOS (with the ending “S”). Also, none of the uses of “churrasco” found by the Trademark Attorney is in the stylized form as applicant’s stylized mark. As the Trademark Attorney has failed to provide even one single use of CHURRASCOS, there appears to be no evidence that the relevant public would understand that CHURRASCOS would refer to “restaurant services”.

Applicant’s mark CHURRASCOS is a version of the Spanish/Portuguese word “churrasco” meaning barbeque, that is, meat cooked over fire. In Spanish/Portuguese, “churrasco” is the meat, “churrascaria” is the restaurant.

The caselaw supports the proposition that applicant’s mark CHURRASCOS for restaurant services which comprises the generic name of the food which is the specialty of the house is merely descriptive of the restaurant services, be it in English or in a foreign language (of course, applicant believes it can show acquired distinctiveness below). See, *In re France Croissant, Ltd.*, 1 U.S.P.Q.2D (TTAB 1986) 1238 (“As was stated in the case of *In re Le Sorbet, Inc.*, 228 USPQ 27 (TTAB 1985) . . . a mark for restaurant services which comprises the generic name of a food which is the specialty of the house is merely descriptive of the restaurant services, be it in English or in a foreign language”).

In further support of the proposition that CHURRASCOS (stylized) may be registered in class 43 for “restaurant and bar services; and catering services”, applicant not only points to its predecessor’s expired Churrascos stylized registrations, but also to its currently

registered U.S. Trademark Reg. No. 3439321 for CHURRASCOS (standard character mark) for “restaurant and bar services; and catering services”, in international class 43, with applicant intending on filing a section 8 on/after June 3, 2013 when allowed.

Applicant’s current U.S. Trademark Reg. No. 3439321 for CHURRASCOS (standard character mark) for “restaurant and bar services; and catering services”, in international class 43, enjoys the presumption of validity. As it is a registration for a “standard character mark”, that means that the standard character mark CHURRASCOS has the presumption of being a valid trademark, and as such cannot be generic. Yes, applicant agrees with the Trademark Attorney that “prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office” (see, Request For Reconsideration Denied, 3/23/2013, at 2). However, with regard to applicant’s earlier registration for the standard character CHURRASCOS, and the instant stylized CHURRASCOS in which the Trademark Attorney is raising an issue of genericness, the issues are greatly intertwined, are for the same services and in the same class. Applicant’s earlier registration for the standard character CHURRASCOS enjoys a presumption of validity, including the presumption that CHURRASCOS is distinctive.

Very respectfully, applicant submits that the Office has failed to meet its burden of establishing by clear evidence that a mark is generic and, thus, unregistrable.

From the above, applicant has raised “doubt” on the issue of genericness, and thus the issue of genericness should be resolved in favor of applicant. See, *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). “Doubt on the issue of genericness is resolved in favor of the applicant.”

## Acquired Distinctiveness

Applicant understands that it has the burden of proving its claim the CHURRASCOS has acquired distinctiveness.

In the April 7, 2011 Office Action, Trademark Attorney Asmat Khan offered the following:

*Applicant may seek registration on the Principal Register under Trademark Act Section 2(f) by claiming acquired distinctiveness through ownership of U.S. Registration No. 3439321. See 15 U.S.C. §1052(f); TMEP §§1212.04 et seq. To do so, applicant must submit the following statement, if accurate:*

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In addition to submitting the suggested declaration regarding ownership of the earlier registration for CHURRASCOS (standard character mark), applicant submitted a declaration that included the following (see, Response of 5/8/2012):

2. Applicant owns and operates a chain of restaurants under the name CHURRASCOS.
3. The Churrascos Restaurants enjoy and have enjoyed a nationwide reputation for many years, at least as evidenced by *ESQUIRE* Magazine naming Churrascos Restaurant on the "20 Best Steaks In America" in 2008. See, Exhibit A, attached.
4. Further evidence of the nationwide reputation of the Churrascos Restaurants is evidenced by the 1994 induction of Churrascos Executive Chef Michael Cordura into *FOOD & WINE* Magazine's "Best New Chefs" with Churrascos Restaurant listed among his restaurants. See, Exhibit B, attached.
5. Further evidence of the nationwide reputation of the Churrascos Restaurants is evidenced by Churrascos Executive Chef Michael Cordura's position in the United Airlines "Congress of Chef's", with the Churrascos Restaurants listed among his restaurants. See, Exhibit C, attached.
6. Further evidence of the nationwide reputation of the Churrascos Restaurants is evidenced Churrascos Executive Chef Michael Cordura being named a 2011 James Beard Foundation



Awards Semifinalist as an “Outstanding Restaurateur”, with the Churrascos Restaurants being listed among his restaurants. See, Exhibit D, attached.

7. For the years 2007-2011, Churrascos Restaurants had an average gross annual income of \$8 million per year.

8. For the years 2007-2011, an average of \$79,241 was expended annually on marketing, advertising and promotion of the Churrascos restaurant brand.

In further support of the proposition that CHURRASCOS (stylized) may be registered in class 43 for “restaurant and bar services; and catering services”, applicant not only points to its predecessor’s expired Churrascos stylized registrations, but also to its currently registered U.S. Trademark Reg. No. 3439321 for CHURRASCOS (standard character mark) for “restaurant and bar services; and catering services”, in international class 43, with applicant intending on filing a section 8 on/after June 3, 2013 when allowed.

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May 24, 2013

Respectfully submitted,

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