PTO- 1960
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	90498047
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION	
MARK	mark
LITERAL ELEMENT	HENRY'S PUFFY TACOS
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
REQUEST FOR RECONSIDERATION OF THE DISCLAIMER REQUIREMENT The Office Action states in part: Applicant must disclaim the wording "PUFFY TACOS" because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of Applicant's goods and/or services. "PUFFY" means: 1a : swollen in size : BLOATED b : having a puffed up form or appearance : soft, light, and fluffy 2 : blowing in puffs : GUSTY a strong, puffy wind 3 : characterized by vanity or ostentation : POMPOUS, SHOWY. See dictionary definition from Merriam-Webster at https://www.merriam-webster.com/dictionary/puffy -:~:text=%3A%20swollen%20in%20size%20%3A%20bloated,blackened%20eyes%2C%20apparently%20taken%2 0aback.. Applicant has responsively disclaimed "TACOS." The requirement to disclaim "PUFFY" is respectfully traversed. Collectively, most of the Office Action's cited Internet sites are completely unrelated to the application mark's services. This record evidence negatives rather than supports the disclaimer requirement. First, a disclaimer requirement is only appropriate if the targeted portion 1s "merely descriptive." If not 100% descriptive, it is not "merely" descriptive. Application of Richardson, Inc., 511 F.2d 559 (C.C.P.A. 1975); Application of Hercules Fasteners, Inc., 203 F.2d 753 (C.C.P.A. 1953). A term is "merely descriptive" only if it immediately describes an ingredient, quality, characteristic, or feature thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the application's goods or services. In re Abcor Development Corp., 588 F.2d 811 (C.C.P.A. 1978); In re Pennzail Products Co., 20 U.S.P.Q.2d 1753 (TT AB 1991). "Puffy" is not merely descriptive of the application's "restaurant services." Second, a mark is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods or services in connection with which it is used. West & Co. v. Arica Institute, Inc., 557 F.2d 338 (2d Cir. 1977). If a mark is a word combination whose import cannot be grasped without some measure of imagination and a "mental pause," then the mark is suggestive rather than descriptive. In re Shutts, 217 U.S.P.Q. 363, 364-65 (TTAB 1983). PUFFY as used in the application mark is suggestive. Third, doubts concerning a mark's descriptiveness are to be resolved in favor of the Applicant during ex parte prosecution. In re Micro Instrument Corp., 222 U.S.P.Q. 252, 255 (TTAB 1984); In re LRC Products, Ltd. , 223 U.S.P.Q. 1250, 1252 (TTAB 1984). Because the line between merely descriptive and only suggestive terms is "so nebulous," the TTAB holds that doubts are resolved in the Applicant's favor. In re Conductive Systems, Inc., 220 U.S.P.Q. 84 (TTAB 1983) (doubts under Section 2(e) about the merely descriptive nature of the term are resolved in favor of the Applicant). Fourth, as discussed in recent In re Lego Juris NS, Serial Nos. 88698784 and 88698804 (May 9, 2022) ("For these reasons, we find that in both of Applicant's marks, KID, and its equivalent that transliterates as XIAO XIA, combine with the other elements of the Serial Nos. 88698784 and 88698804 mark to form "an 'inseparable whole,' [and are] exempted from the disclaimer requirement .... " In re Slokevage, 441 F.3d 957, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006), at pages 10 -11), and its numerous cited cases, the application mark's elements are so merged that the instant required disclaimer of an inseparable element is improper. Fifth, the Trademark Office has the burden to establish a prima facie case of mere descriptiveness. In re Establishments Darty et Fils, 759 F.2d 15 (Fed. Cir. 1985). Applicant submits the Declaration of Imelda Lopez Sanchez as evidence in support of its position, and along with all arguments and evidence previously submitted in this matter, incorporates them herein. Applying the evidence of record to applicable law, the Trademark Office has not met its burden of proof to establish that "PUFFY" in the instant compound word and mark for "restaurant services" is merely descriptive. The record evidence does not carry the Trademark Office's burden for a disclaimer requirement for PUFFY. Applicant respectfully requests the disclaimer requirement for " PUFFY " be withdrawn.	
EVIDENCE SECTION	

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_38140204114-202305032 04817842862_._Imelda_Sanc hez_Declaration.pdf
CONVERTED PDF FILE(S) (6 pages)	\\TICRS\EXPORT18\IMAGEOUT 18\904\980\90498047\xml12 \RFR0002.JPG
	\\TICRS\EXPORT18\IMAGEOUT 18\904\980\90498047\xml12 \RFR0003.JPG
	\\TICRS\EXPORT18\IMAGEOUT 18\904\980\90498047\xml12 \RFR0004.JPG
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	\\TICRS\EXPORT18\IMAGEOUT 18\904\980\90498047\xml12 \RFR0007.JPG
DESCRIPTION OF EVIDENCE FILE	Declaration of Imelda Sanchez
CORRESPONDENCE INFORMATION	
NAME	CLINE H. WHITE
PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE	cwhiteipdocket@jw.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)	NOT PROVIDED
DOCKET/REFERENCE NUMBER	T-157778.7
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Cline H. White/
SIGNATORY'S NAME	Cline H. White
SIGNATORY'S POSITION	Attorney of record, TX bar member
SIGNATORY'S PHONE NUMBER	210-978-7700
DATE SIGNED	05/03/2023
ROLE OF AUTHORIZED SIGNATORY	Authorized U.S.-Licensed Attorney
SIGNATURE METHOD	Sent to third party for signature
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed May 03 21:04:38 ET 2023
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XXX- 20230503210438292205-9049 8047-8504d23e4707090e7f21 a2171ccc4b58ec3f7bfa761bc c22409670b44eb34832ab-N/A -N/A-20230503204817842862

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Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **90498047** HENRY'S PUFFY TACOS(Standard Characters, see https://tmng-

al.uspto.gov/resting2/api/img/90498047/large) has been amended as follows:

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

REQUEST FOR RECONSIDERATION OF THE DISCLAIMER REQUIREMENT The Office Action states in part: Applicant must disclaim the wording "PUFFY TACOS" because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of Applicant's goods and/or services. "PUFFY" means: 1a : swollen in size : BLOATED b : having a puffed up form or appearance : soft, light, and fluffy 2 : blowing in puffs : GUSTY a strong, puffy wind 3 : characterized by vanity or ostentation : POMPOUS, SHOWY. See dictionary definition from Merriam-Webster at https://www.merriam-webster.com/dictionary/puffy -:~:text=%3A%20swollen%20in%20size%20%3A%20bloated,blackened%20eyes%2C%20apparently%20taken%2 0aback.. Applicant has responsively disclaimed "TACOS." The requirement to disclaim "PUFFY" is respectfully traversed. Collectively, most of the Office Action's cited Internet sites are completely unrelated to the application mark's services. This record evidence negatives rather than supports the disclaimer requirement. First, a disclaimer requirement is only appropriate if the targeted portion 1s "merely descriptive." If not 100% descriptive, it is not "merely" descriptive. Application of Richardson, Inc., 511 F.2d 559 (C.C.P.A. 1975); Application of Hercules Fasteners, Inc., 203 F.2d 753 (C.C.P.A. 1953). A term is "merely descriptive" only if it immediately describes an ingredient, quality, characteristic, or feature thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the application's goods or services. In re Abcor Development Corp., 588 F.2d 811 (C.C.P.A. 1978); In re Pennzail Products Co., 20 U.S.P.Q.2d 1753 (TT AB 1991). "Puffy" is not merely descriptive of the application's "restaurant services." Second, a mark is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods or services in connection with which it is used. West & Co. v. Arica Institute, Inc., 557 F.2d 338 (2d Cir. 1977). If a mark is a word combination whose import cannot be grasped without some measure of imagination and a "mental pause," then the mark is suggestive rather than descriptive. In re Shutts, 217 U.S.P.Q. 363, 364-65 (TTAB 1983). PUFFY as used in the application mark is suggestive. Third, doubts concerning a mark's descriptiveness are to be resolved in favor of the Applicant during ex parte prosecution. In re Micro Instrument Corp., 222 U.S.P.Q. 252, 255 (TTAB 1984); In re LRC Products, Ltd. , 223 U.S.P.Q. 1250, 1252 (TTAB 1984). Because the line between merely descriptive and only suggestive terms is "so nebulous," the TTAB holds that doubts are resolved in the Applicant's favor. In re Conductive Systems, Inc., 220 U.S.P.Q. 84 (TTAB 1983) (doubts under Section 2(e) about the merely descriptive nature of the term are resolved in favor of the Applicant). Fourth, as discussed in recent In re Lego Juris NS, Serial Nos. 88698784 and 88698804 (May 9, 2022) ("For these reasons, we find that in both of Applicant's marks, KID, and its equivalent that transliterates as XIAO XIA, combine with the other elements of the Serial Nos. 88698784 and 88698804 mark to form "an 'inseparable whole,' [and are] exempted from the disclaimer requirement .... " In re Slokevage, 441 F.3d 957, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006), at pages 10 -11), and its numerous cited cases, the application mark's elements are so merged that the instant required disclaimer of an inseparable element is improper. Fifth, the Trademark Office has the burden to establish a prima facie case of mere descriptiveness. In re Establishments Darty et Fils, 759 F.2d 15 (Fed. Cir. 1985). Applicant submits the Declaration of Imelda Lopez Sanchez as evidence in support of its position, and along with all arguments and evidence previously submitted in this matter, incorporates them herein. Applying the evidence of record to applicable law, the Trademark Office has not met its burden of proof to establish that "PUFFY" in the instant compound word and mark for "restaurant services" is merely descriptive. The record evidence does not carry the Trademark Office's burden for a disclaimer requirement for PUFFY. Applicant respectfully requests the disclaimer requirement for " PUFFY " be withdrawn.

EVIDENCE
Evidence has been attached: Declaration of Imelda Sanchez
Original PDF file:
evi_38140204114-202305032 04817842862_._Imelda_Sanc hez_Declaration.pdf
Converted PDF file(s) (6 pages) Evidence-1Evidence-2Evidence-3Evidence-4Evidence-5Evidence-6

Correspondence Information
CLINE H. WHITE
PRIMARY EMAIL FOR CORRESPONDENCE: cwhiteipdocket@jw.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): NOT PROVIDED

The docket/reference number is T-157778.7.

Requirement for Email and Electronic Filing: I understand that a valid email address must be maintained by the owner/holder and the owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /Cline H. White/ Date: 05/03/2023
Signatory's Name: Cline H. White
Signatory's Position: Attorney of record, TX bar member

Signatory's Phone Number: 210-978-7700 Signature method: Sent to third party for signature

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: CLINE H. WHITE
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Serial Number: 90498047
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b-N/A-N/A-20230503204817842862

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE	
IN RE APPLICATION OF: Henry's Puffy Tacos, Inc. SERIAL NO.: 90/498,047 FILED: January 29, 2021 MARK: HENRY'S PUFFY TACOS	ATTY DKT NO. T-157778.7 EXAMINER: William Rossman LAW OFFICE NO. 109
TO: Commissioner for Trademarks – No Fee P.O. Box 1451 Alexandria, VA 22313-1451	

DECLARATION OF IMELDA LOPEZ SANCHEZ

I make the following declaration:

A. Identification

1. My name is Imelda Lopez Sanchez.

2. I have personal knowledge of the facts stated herein.

3. I am the Vice President of Operations of Henry's Puffy Tacos, Inc., the Applicant.

4. I am familiar with Applicant's use of HENRY'S PUFFY TACOS (the "Mark") to identify its restaurant services ("Applicant's services").

B. Purchasers in Applicant's restaurant in the United States (1) perceive HENRY'S PUFFY TACOS as being a brand name which is suggestive of a restaurant with a unique "Henry" and a unique "Puffy," and not as the name of a well know type of taco, and (2) believe the "restaurant services" they are purchasing (and the food therein) originate from the Applicant because of the unique name. Patrons are familiar with the name HENRY'S PUFFY TACOS because of Applicant's long use and not because of the term "PUFFY" being commonly be used in connection with similar restaurant services as a feature of what is served. In fact, I am only aware of one (1) other restaurant with "PUFFY" in the name – and that is owned by a family member. If consumers recognize the term "Puffy Taco" it is due to Applicant's use. "Puffy" is not normally associated with a type of taco

except through Applicant's use and copies of Applicant's use.

C. Applicant Has Invested Substantial Money and Effort to Make HENRY'S PUFFY TACOS Distinctive of Applicant's Goods and Services

1. Since at least as early as April of 1989, Applicant has continuously used HENRY'S PUFFY TACOS in advertising and marketing to (a) identify Applicant's services, (b) identify Applicant as their source, and (c) distinguish Applicant's services from competitive services of other businesses in this line of commerce.

2. Applicant has achieved substantial brand recognition for its HENRY'S PUFFY TACOS services due in part to advertising and marketing, and due in part to "word of mouth" communications about Applicant's HENRY'S PUFFY TACOS services by Applicant's customers who use HENRY'S PUFFY TACOS in their communications to identify Applicant's services. Additionally, third-party publications use HENRY'S PUFFY TACOS to identify Applicant's goods and distinguish Applicant's goods from those of Applicant's competitors and to identify Applicant's HENRY'S PUFFY TACOS goods as originating from Applicant.

3. Applicant has spent substantial sums of money in the United States on marketing which uses HENRY'S PUFFY TACOS to identify Applicant as the source of Applicant's goods.

4. Based on Applicant's many years of using HENRY'S PUFFY TACOS to identify its services and brand recognition accumulated through Applicant's marketing of its HENRY'S PUFFY TACOS services, HENRY'S PUFFY TACOS has acquired distinctiveness as identifying and distinguishing Applicant's services. Consumers associate HENRY'S PUFFY TACOS exclusively with Applicant's services.

5. Applicant has continuously used HENRY'S PUFFY TACOS to identify Applicant's goods and to distinguish Applicant's services from those of Applicant's competitors

and to identify its services as originating from Applicant by using HENRY'S PUFFY TACOS at Applicant's website, www.henryspuffytacos.com.

D. The Relevant Consuming Public Recognizes HENRY'S PUFFY TACOS as Identifying Applicant's Goods

1. The relevant consuming public has come to recognize HENRY'S PUFFY TACOS as a trademark which identifies Applicant's services and Applicant as the source of HENRY'S PUFFY TACOS services. This is due in part to Applicant's advertising and marketing its HENRY'S PUFFY TACOS goods, and due in part to "word of mouth" communications about Applicant's HENRY'S PUFFY TACOS goods by Applicant's customers who use HENRY'S PUFFY TACOS in their communications to identify Applicant's goods. Additionally, HENRY'S PUFFY TACOS has a mascot – named Henry the Puffy Taco - that performs at the San Antonio Missions professional baseball games, as well as other events. Additionally, third-party publications use HENRY'S PUFFY TACOS to identify Applicant's services and distinguish Applicant's goods from those of Applicant's competitors and to identify Applicant's HENRY'S PUFFY TACOS goods as originating from Applicant.

2. Third party communications regularly HENRY'S PUFFY TACOS to identify Applicant's goods and identify Applicant as the source of Applicant's HENRY'S PUFFY TACOS goods. Examples are attached.

3. Applicant's HENRY'S PUFFY TACOS business success shows the public's acceptance of HENRY'S PUFFY TACOS as an indication of particular quality beers originating from a single source, namely, Applicant.

E. HENRY'S PUFFY TACOS is Substantially Exclusively Used by Applicant in Applicant's Line of Commerce

1. To the best of Applicant's knowledge, prior to Applicant's use of HENRY'S PUFFY TACOS to identify its restaurant services, HENRY'S PUFFY TACOS was not used by any competitive businesses to identify competitive goods other than a family member.

2. Applicant's use and advertising of HENRY'S PUFFY TACOS to identify Applicant's goods and distinguish its goods from the competitive goods of others has been and is substantially exclusive in Applicant's line of commerce.

3. The term "HENRY'S PUFFY TACOS" is not a term or phrase that competitors in this line of commerce need to use.

F. HENRY'S PUFFY TACOS is Distinctive of Applicant's Goods

1. The "HENRY'S PUFFY" portion of HENRY'S PUFFY TACOS's is of primary significance in minds of the relevant public is to identify Applicant's goods -

2. HENRY'S PUFFY TACOS does not primarily describe Applicant's or any competitor's goods.

Applicant's Declaration

Applicant has submitted a Declaration of Imelda Sanchez to the effect that Applicant's consuming public recognizes Applicant's use of HENRY'S PUFFY TACOS to identify its services.

G. Declaration

All statements made herein are of my own knowledge are true and all statements made on information and belief are believed to be true. These statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Signed this 3rd day of May, 2023.

Imelda Lopez Sanchez

Imelda Lopez Sanchez

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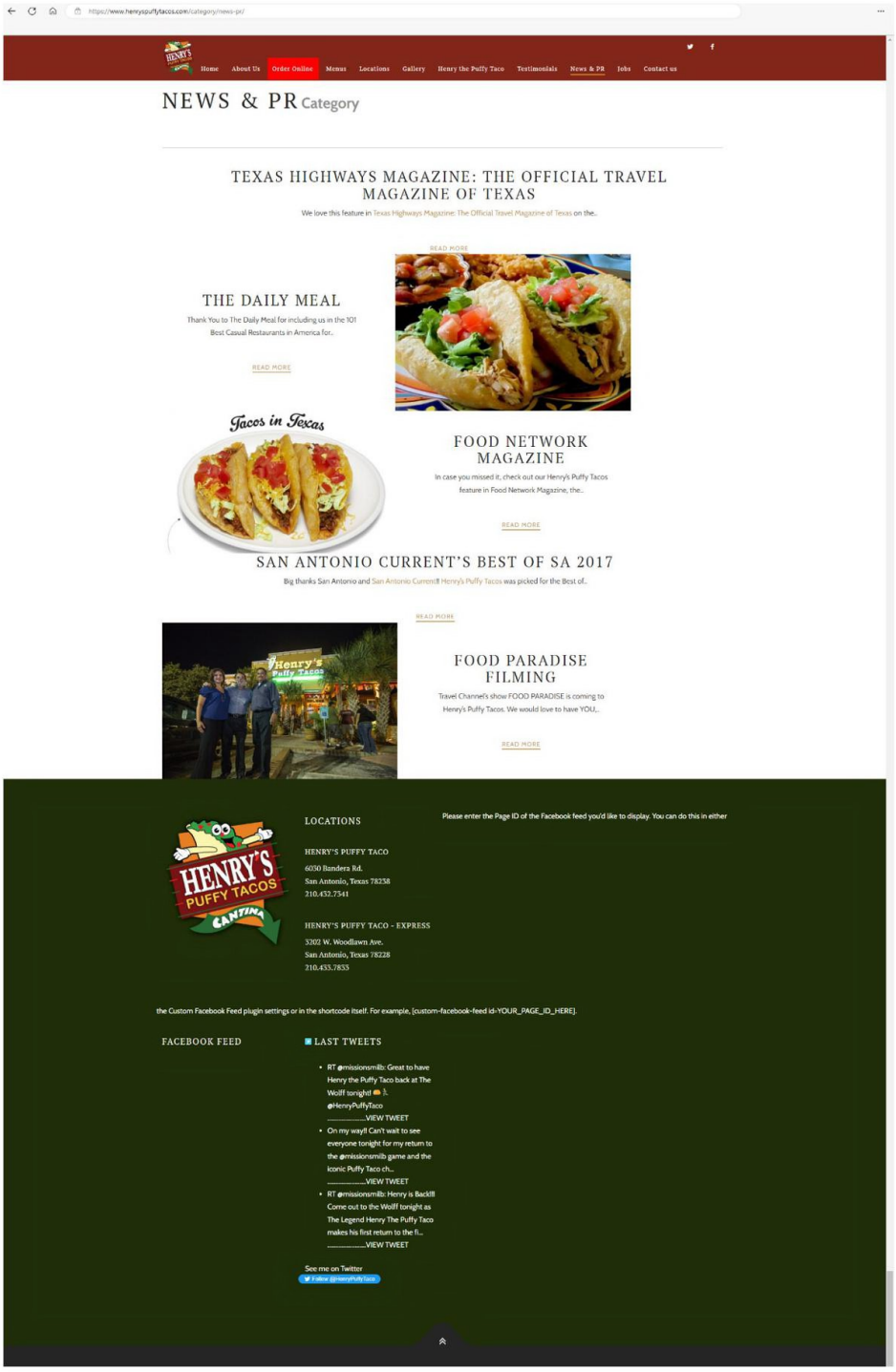
Examples of Third Party Use