

Response to Office Action for BEEF HOUSE Mark (Serial No. 77/095799)

AMENDMENTS

1. Please amend the identification of goods for class 30 to read: "International Class 030: bread rolls."

2. If necessary (as described below), please amend the Application to include the following: "The BEEF HOUSE mark has become distinctive of the services through the Applicant's substantially exclusive and continuous use in commerce for at least the five (5) years immediately before the date of this statement."

ARGUMENT

This is submitted in response to the Office Action emailed on May 20, 2007, with respect to Trademark Application Serial No. 77/095799 for the BEEF HOUSE mark ("the Mark"). The Examiner has concluded that there are no similar registered or pending marks that would bar registration of the Mark for the goods in classes 29 (jams) and 30 (rolls). However, the Examiner has preliminarily refused registration of the Mark for the goods in class 30 because the term "rolls" is allegedly indefinite. In response, Applicant has amended the identification of goods in class 30, as suggested by the Examiner, to read: "International Class 030: bread rolls." Applicant thanks the Examiner for her helpful suggestion.

In addition, the Examiner has preliminarily refused registration of the Mark for the services in class 43 because of an alleged likelihood of confusion with the mark in U.S. Registration No. 0690009 and because the Mark is allegedly merely descriptive of Applicant's services. In response, Applicant has submitted the remarks below addressing the grounds of refusal and, in the alternative, amended the Application to include a claim of distinctiveness based on Applicant's substantially exclusive and continuous use of the Mark in commerce for at least five (5) years, which is established by the declaration submitted herewith. Based on the declaration and the remarks below, Applicant respectfully submits that each ground of refusal should be withdrawn and therefore respectfully requests reexamination and reconsideration of the Application.

I. THERE IS NO LIKELIHOOD OF CONFUSION WITH RESPECT TO THE CITED MARK.

The Examiner refused registration of the Mark for restaurant services in class 43, under § 2(d) of the Act, because of an alleged likelihood of confusion with the mark in U.S. Registration No. 0690009. For several reasons, Applicant respectfully disagrees that any likelihood of confusion exists.

The issue of whether a likelihood of confusion exists between two marks is determined with reference to a number of factors first set forth by the Court of Customs and Patent Appeals in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). See TMEP § 1207.01.

According to the TMEP, "the following factors are usually the most relevant" for determining the propriety of a § 2(d) refusal:

1. "The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression."
2. "The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use."
3. "The similarity or dissimilarity of established, likely-to-continue trade channels."
4. "The conditions under which and buyers to whom sales are made, *i.e.*, 'impulse' vs. careful, sophisticated purchasing."
5. "The number and nature of similar marks in use on similar goods."
6. "A valid consent agreement between the applicant and the owner of the previously registered mark."

TMEP § 1207.01.

In finding a likelihood of confusion, the Examiner compared only the marks and the identified services. However, Applicant respectfully submits that the Examiner's analysis with respect to the similarity of the marks was improperly abbreviated. Indeed, the Examiner alleged that the Mark is "highly similar" to the cited "HOUSE OF BEEF" mark based on the following: (1) both marks contain the terms "BEEF" and "HOUSE" and (2) the Mark "is essentially a transposition" of the cited mark. Applicant respectfully submits that the Examiner did not separately compare the appearance, sound, connotation, and commercial impression of the two marks, as required under TMEP § 1207.01(b).

To properly determine the similarity or dissimilarity of two marks, the Examiner must assess "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." TMEP § 1207.01(b) (citation and internal quotation marks omitted). "When considering the similarity of the marks, all relevant facts pertaining to the appearance and connotation must be considered." *Id.* (citation and internal quotation marks omitted). A proper analysis of these issues in this case shows that the Mark and the cited mark are quite dissimilar and that no likelihood of confusion exists between them.

First, the marks do not have a similar appearance. The cited mark includes three words, while the Mark contains only two. Indeed, the cited mark reverses the order of the two words of the Mark, and separates the transposed words by adding an additional word between them, causing the two marks to have very different appearances. *Cf. Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 U.S.P.Q.2d 1492, 1508 (TTAB 2005) ("When the terms are reversed, and a word, albeit geographic, is inserted between the reversed words, the marks have very different appearances.").

Second, the marks are not similar in sound. The cited mark contains three syllables; the Mark has only two. *See Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 U.S.P.Q.2d 1492, 1508 (TTAB 2005) (citing a difference in syllables as leading to a difference in sound). The marks also begin and end with very different sounds: the cited mark begins with an "h" sound and ends with an "f" sound, while the Mark begins with a "b" sounds and ends with an "s" sound. *See id.* (determining a difference in sound based on the beginning and ending sounds of two marks). In addition, the two syllables of the Mark blend together because of the ending "f" of the first syllable and the beginning "h" of the second syllable, producing an almost monosyllabic sound (*e.g.*, "beefouse") that is completely absent from the cited mark. Further, the last two syllables of the cited mark end in an alliterate manner, producing a final double "f" sound ("house of f beef") that is completely absent from the Mark. *See id.* (referencing an alliteration to distinguish the different sounds of two marks).

Third, the connotations of the two marks are dissimilar. As explained below, the "BEEF HOUSE" mark may be suggestive of 'a restaurant serving beef' or it may connote 'a shelter for cattle that are reared for their meat.' By contrast, the "HOUSE OF BEEF" mark may connote 'a house made of beef' or 'a house consisting of beef.' Indeed, the use of the phrase "house of" in the cited mark connotes an idea of royalty or nobility, such as in the term "the House of Orange." *See* www.bartleby.com/61/63H0296300, (cited by the Examiner) (defining "house" to include "A family line including ancestors and descendants, especially of a royal or noble family: *the House of Orange*"). This idea of nobility that is conveyed by the use of "house of" in the cited mark is not at all conveyed by the Mark.

Finally, the two marks have overall different commercial impressions. As stated above, the use of the phrase "house of" in the cited mark conveys an idea of nobility that is absent in the Mark (*cf.* "House of Orange" *with* "Orange House"). Although the BEEF HOUSE Restaurant is an establishment of the utmost taste and quality, the BEEF HOUSE mark itself does not create the same highbrow impression that is created by the HOUSE OF BEEF mark. *See* TMEP § 1207.01(b)(vii) ("[I]f the transposed mark creates a distinctly different commercial impression, then confusion is not likely.").

Because the two marks are significantly different in appearance, sound, connotation, and commercial impression, Applicant respectfully submits that a likelihood of confusion does not exist between the two marks. Indeed, Applicant is not aware of any actual confusion caused by the use of the two marks during the more than forty years of co-existence of the marks. (Wright Decl. ¶ 6.) The apparent absence of any instances of actual confusion over such a significant period of time is strong evidence that no likelihood of confusion exists.

II. THE "BEEF HOUSE" MARK IS NOT MERELY DESCRIPTIVE.

The Examiner refused registration of the Mark for services in class 43 (restaurant services), under § 2(e)(1) of the Act, because she alleged that the Mark is merely descriptive of Applicant's services. However, Applicant respectfully submits that the Mark is inherently distinctive, and therefore registrable. Although the Mark is suggestive of the identified services, it is not merely descriptive of those services. *See* TMEP § 1209.01(a).

"To be refused registration . . . under § 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive . . . of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services." TMEP § 1209.01(b). In this case, the Examiner alleges that the Mark merely describes the function of Applicant's services.

The Examiner first argues that each of the terms "beef" and "house" are independently descriptive. In support, she provides internet dictionary citations and "information regarding U.S. Registered marks for restaurant services" wherein either the term "BEEF" or the term "HOUSE" has been disclaimed, allegedly showing that "the pattern of the Office is to consider" both "BEEF" and "HOUSE" to be descriptive of restaurant services. However, Applicant respectfully submits that the evidence shows no such pattern. Attached are several printouts from the USPTO website showing that the terms "BEEF" and/or "HOUSE" were not required to be disclaimed for restaurant services. (*See, e.g.*, U.S. Reg. No. 2965688 for ARRACHERA HOUSE; U.S. Reg. No. 3020996 for WHAT'S YOUR BEEF; U.S. Reg. No. 3011276 for BE FIT. BEEF IT.; U.S. Reg. No. 2323415 for BEEF'S; U.S. Reg. No. 3317681 for SOCIAL HOUSE; U.S. Reg. No. 3247548 for HOUSE OF CRAVE; U.S. Reg. No. 0655350 for BLACKIE'S HOUSE OF BEEF (and design).) Indeed, the mark cited by the Examiner, HOUSE OF BEEF (U.S. Reg. No. 0690009) does not include a disclaimer for either "HOUSE" or "BEEF." Thus, Applicant submits that the Examiner's evidence does not support a finding of merely descriptiveness.

Further, the Examiner's internet dictionary citations do not support her refusal under § 2(e)(1). The citations show that the term "BEEF HOUSE" can have at least two different meanings in connection with the identified services, only one of which has been argued to be merely descriptive. *See* TMEP § 1213.05(c) ("The mark that comprises the 'double entendre' will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods and services."). As shown by the Examiner's internet dictionary citations, the term "BEEF" can refer to "cattle that are reared for their meat" and the term "HOUSE" can refer to "[a] building that functions as the primary shelter or location of something: *a carriage house; the lion house at the zoo.*" Thus, the term "BEEF HOUSE" can refer to 'a shelter or location of cattle that are reared for their meat.' Applicant submits that this meaning is not merely descriptive of restaurant services because the dining public would not expect live cattle – even cattle reared for their meat – to dwell at a location that provides restaurant services. Consequently, Applicant respectfully asserts that the Mark is inherently distinctive and respectfully requests that the refusal be withdrawn. *See* TMEP § 1213.05(c).

III. IF THE EXAMINER MAINTAINS HER SECTION 2(e)(1) REFUSAL, THE MARK SHOULD NEVERTHELESS BE REGISTERED BECAUSE IT HAS ACQUIRED DISTINCTIVENESS.

As discussed above, Applicant asserts that the Mark is registrable because it is inherently distinctive. However, in the alternative, Applicant respectfully submits that the refusal under § 2(e)(1) should be withdrawn because the Mark has acquired distinctiveness through its many years of use. *See* § 2(f) of the Act, 15 U.S.C. § 1052(f).

According to the TMEP, "Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless become distinctive of the applicant's goods in commerce. Thus, Section 2(f) . . . is a provision under which an applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused." TMEP § 1212 (citation and internal quotation marks omitted). Indeed, a § 2(e) refusal should be withdrawn upon a *prima facie* showing of acquired distinctiveness. See TMEP § 1212.02(h) ("If the examining attorney is persuaded that a *prima facie* case of acquired distinctiveness has been established, the examining attorney will approve the application for publication under §2(f).").

An applicant may prove a *prima facie* case of acquired distinctiveness by submitting "proof of substantially exclusive and continuous use" of the Mark in commerce "for the five years before the date on which the claim of distinctiveness is made." TMEP § 1212.05 (quoting 15 U.S.C. § 1052(f)). Such substantially exclusive and continuous use is usually proved by the submission of a declaration signed by the applicant. See TMEP § 1212.05(d).

Attached to Applicant's response is a declaration signed by Mr. Robert Wright, who is Applicant's President. Mr. Wright's declaration establishes that Applicant has used the Mark in interstate commerce in connection with providing restaurant services since 1964. (Wright Decl. ¶ 3.) Further, the declaration proves that the use has been "substantially exclusive and continuous" and has caused the Mark to become distinctive of Applicant's services. (*Id.*) Mr. Wright's declaration also establishes that, as a result of Applicant's long-standing use of the mark, a significant number of consumers recognize the Mark and associate the Mark with Applicant and the services Applicant provides under the Mark. (*Id.* at ¶ 7.)

The Trademark Act suggests that five years of use may be sufficient to establish acquired distinctiveness. See TMEP § 1212.05. In this case, Applicant has proven over forty years of substantially exclusive and continuous use of the Mark, which is more than eight times the statutory suggested standard. Accordingly, Applicant respectfully submits that its long-standing use of the Mark undoubtedly establishes a *prima facie* case of acquired distinctiveness under § 2(f) of the Act. Applicant therefore respectfully requests that the refusal based on § 2(e) be withdrawn.

IV. CONCLUSION

In view of the foregoing amendments and remarks, Applicant believes that it has resolved all of the issues raised by the Examiner in the Office Action. Applicant therefore respectfully submits that the Mark is registrable and should proceed to publication. If any issues remain, the Examiner is invited to contact Applicant's attorney.