

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

RESPONSE TO OFFICE ACTION

U.S. Application Serial Number: 88598616



Mark:

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ARGUMENTS IN RESPONSE TO OFFICE ACTION

Applicant hereby submits this response to the office action issued on September 19, 2019 (“Office Action”), which raises the following issues:

1. Disclaimer Required
2. Mark Description/Color Claim Amendment Required.

Applicant responds in sequence to each of these issues as follows:

I. APPLICANT’S MARK IS NOT “MERELY” DESCRIPTIVE

The Office Action asserts that Applicant must disclaim the wording “POBLANO CANTINA” because it “merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services, and thus is an unregistrable component of the mark.” However, the Office Action does not provide any evidence indicating that the Spanish wording POBLANO CANTINA *merely* describes Applicant’s *services*. Likewise, the Office Action does not provide evidence indicating that POBLANO CANTINA creates a grammatically or otherwise unitary expression and therefore should be disclaimed as a whole. Applicant respectfully disputes the aforesaid allegations and asserts that the Office Action has provided no substantiation that either the individual components of Applicants mark (i.e. POBLANO and CANTINA), nor the composite result POBLANO CANTINA are descriptive.

Moreover, Applicant respectfully asserts that the evidence presented in the Office Action, indicates that CANTINA does not refer to restaurant services and POBLANO does not refer to a dish.

A. The term “POBLANO” is not descriptive.

The Examiner’s claim of descriptiveness of the term “POBLANO” relies upon (a) the principle that “[a] mark that consists of the generic name of a food or dish that is the specialty of the house or a principal attraction of the restaurant has been held merely descriptive of restaurant services”; (b) the presumption that a poblano “is the specialty of the house or a principal attraction of [Applicant’s] restaurant”; (c) a printout provided by the Examiner from the *Merriam-Webster* online dictionary which defines the noun “POBLANO” as “a large usually mild heart-shaped chili pepper especially when fresh and dark green”; (d) a printout provided by the Examiner from LeCremeDeLaCrumb.com carrying the heading “SOUTHWEST STUFFED POBLANO PEPPERS”; and (e) a printout provided by the Examiner from HostTheToast.com carrying the heading “MEXICAN STUFFED PEPPERS (CHORIZO-STUFFED POBLANOS).” Applicant respectfully asserts that none of this evidence can substantiate the Examiner’s disclaimer requirement.

The *Merriam-Webster* definition referenced in item “(c)” above does not define “POBLANO” as a dish. Thus it cannot support the Examiner’s position that a “POBLANO” “is the specialty of the house or a principal attraction of [Applicant’s] restaurant.”

The printouts referenced in items “(d)” and “(e)” above do not define “POBLANO” as a dish. To the contrary, those printouts identify the dishes “SOUTHWEST STUFFED POBLANO PEPPERS” and “MEXICAN STUFFED PEPPERS (CHORIZO-STUFFED POBLANOS).” Applicant’s mark does not contain any of the terms “STUFFED,” “MEXICAN,” “SOUTHWEST,” or “CHORIZO.” Applicant’s mark is not SOUTHWEST STUFFED POBLANO PEPPERS, and moreover, the covered services do not include any “SOUTHWEST STUFFED POBLANO PEPPERS.” Applicant’s mark is not MEXICAN STUFFED PEPPERS (CHORIZO-STUFFED POBLANOS), and moreover, the covered services do not include any “MEXICAN STUFFED PEPPERS (CHORIZO-STUFFED POBLANOS).” Because the above-referenced items “(c)” and “(d)” do not define the term “POBLANO” as a dish, these printouts cannot support the Examiner’s position that a “POBLANO” “is the specialty of the house or a principal attraction of [Applicant’s] restaurant.”

Even assuming, merely for the sake of argument, that the term “POBLANO” were defined as a dish, that would still not avail for the Examiner. That is because the Examiner has not shown—and cannot show—that a “POBLANO” “is the specialty of the house or a principal attraction of [Applicant’s] restaurant.” In light of the foregoing, the above-listed items “(a)” and “(b)” are unavailing for the Examiner, and the Examiner is unable to support her assertion of the descriptiveness of the term “POBLANO.” See *In re Fr. Croissant, Ltd.*, 1 USPQ2d 1238, 1239 (TTAB 1986) (holding LE CROISSANT SHOP merely descriptive of restaurant services *providing croissants*); *In re Le Sorbet, Inc.*, 228 USPQ 27, 28 (TTAB 1985) (holding LE SORBET descriptive of restaurant and carryout shops *which serve fruit ices*).

In light of the foregoing, the Examiner’s disclaimer requirement of the term “POBLANO” lacks substantiation.¹ For this independently-sufficient reason, the Examiner’s disclaimer requirement must be withdrawn.

B. The term “CANTINA” is not descriptive.

The Examiner’s claim of descriptiveness of the term “CANTINA” relies upon the definition that the Examiner presented for that term. However, a printout provided by the Examiner from the *Merriam-Webster* online dictionary actually shows that the first definition of the noun “CANTINA” is “a pouch or bag at the pommel of a saddle.” That printout also shows that the second definition of the noun “CANTINA” is “a small barroom.” This printout from the *Merriam-Webster* online dictionary does not support the Examiner’s position at all. Neither the first nor second definition is descriptive of Applicant’s covered services. Applicant is not providing “a pouch or bag at the pommel of a saddle.” Applicant is not providing “a small barroom.” Therefore, the Examiner’s disclaimer requirement of the term “CANTINA” lacks substantiation.² For this independently-sufficient reason, the Examiner’s disclaimer requirement must be withdrawn.

In light of all the foregoing, Applicant respectfully states that the Examiner has not shown—and cannot show—the descriptiveness of either of the two terms which comprise Applicant’s mark. Therefore, Applicant respectfully asserts that the Examiner’s disclaimer requirement is lacking in substantiation and thus must be promptly withdrawn.

C. The phrase “POBLANO CANTINA” cannot be descriptive.

For reasons which have been set forth above, the individual terms which comprise Applicant’s mark—namely, the terms “POBLANO” and “CANTINA”—cannot be descriptive on their own. However, even assuming for the sake of argument that either or both of these

¹ Even assuming for the sake of argument that the term “POBLANO” were descriptive, the term “CANTINA” would still not be descriptive.

² Even assuming for the sake of argument that the term “CANTINA” were descriptive, the term “POBLANO” would still not be descriptive.

terms was descriptive on its own, the two-word phrase “POBLANO CANTINA” would still be non-descriptive.

In *In Re Shutts*, 217 U.S.P.Q. 363, 1983 WL 51780, *1 (T.T.A.B. Feb. 25, 1983), the Board held that the mark SNO-RAKE was not descriptive in connection with “a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs.” The Board stated in part: “We believe that it would be rare (indeed, close to non-existent) in contemporary usage to request someone to ‘rake snow’ from either a large or small surface or to refer to any long or short-handled snow removal tool (e.g., an auto windshield scraper) as a ‘rake’ and evoke an understanding of this as a natural language usage.” *Id.*, at *2.

In *In Re Getz Found.*, 227 U.S.P.Q. 571, 1985 WL 71933 (T.T.A.B. Oct. 10, 1985), the Board held that the mark MOUSE HOUSE was fanciful for museum services featuring mice figurines made up to appear as human beings. The Board stated in part: “Viewed in the abstract, ‘mouse house’ has no realistic meaning in relation to any products or services. Mice reside in burrows, not houses, and while mice find their ways into barns and other structures as uninvited guests, it would be incongruous and fanciful to refer to a barn, for example, as a ‘mouse house.’” *Id.* at *1.

In *In Re Simon Prop. Grp., L.P.*, No. 86341571, 2016 WL 3912938 (T.T.A.B. July 7, 2016),³ the Board held that the phrase “LOOKBOOK LIVE” was not descriptive for “organizing and conducting entertainment events at shopping malls, namely, fashion shows, educational presentations and demonstrations in the field of beauty and styling techniques and fashion and beauty trends, and promotional giveaways and sweepstakes.” *Id.*, at *1. The Board held that even though the individual terms “LOOKBOOK” and “LIVE” were to be deemed descriptive on their own, nevertheless the two-word phrase “LOOKBOOK LIVE” was not descriptive, “because it is an incongruous unitary phrase.” *Id.*, at *8. The Board agreed with the applicant’s reasoning that “the combining of the words ‘LOOKBOOK’ and ‘LIVE’ creates an internal

³ This decision is available at <http://TTABVUE.USPTO.GOV/ttabvue/v?pno=86341571&pty=EXA&eno=10>.

contradiction ... a ‘lookbook’ cannot be ‘live.’” *Id.* Due to this “imaginative twist,” the two-word phrase was not descriptive. *Id.*, at *9.

As previously noted, a printout provided by the Examiner from the *Merriam-Webster* online dictionary defines the noun “POBLANO” as “a large usually mild heart-shaped chili pepper especially when fresh and dark green.” As also previously noted, a printout provided by the Examiner from the *Merriam-Webster* online dictionary shows that the first definition of the noun “CANTINA” is “a pouch or bag at the pommel of a saddle,” and that the second definition of the noun “CANTINA” is “a small barroom.” When the nouns “POBLANO” and “CANTINA” are combined into the two-word phrase “POBLANO CANTINA,” that resulting two-word phrase means essentially “a pepper pouch or bag at the pommel of a saddle” or “a small pepper barroom.” *Neither* of those meanings makes sense in natural language usage in English. Therefore, the phrase “POBLANO CANTINA” is incongruous. Viewed in the abstract, the phrase “POBLANO CANTINA” has no realistic meaning in relation to any products or services. And, indeed, it is incongruous and fanciful to use the noun “POBLANO” to modify the noun “CANTINA.” Thus, the phrase “POBLANO CANTINA” is internally incoherent from a linguistic perspective. As a result, “POBLANO CANTINA” cannot be descriptive.

For this independently-sufficient reason, the Examiner’s disclaimer requirement must be withdrawn.

D. A consumer encountering the phrase “POBLANO CANTINA” could not reach a conclusion as to the nature of the covered services without a significant exertion of imagination, thought, and perception.

“A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *In Re S. Nat’l Bank of N. Carolina*, 219 U.S.P.Q. 1231, *1 (T.T.A.B. May 31, 1983) (internal quotation marks omitted) (internal citations omitted). In contrast, if a term “requires imagination, thought and perception to reach a conclusion as to the nature of goods,” then the term is not descriptive. *Id.* (internal quotation marks omitted) (internal citations omitted); *see also Habitat Design Holdings Ltd. v. Habitat, Inc.*, 196 U.S.P.Q. 425,

436 F. Supp. 327, 331 (S.D.N.Y. 1977), *aff'd as modified*, 573 F.2d 1290 (2d Cir. 1978) (HABITAT not descriptive in connection with home furnishings).

Here, the phrase “POBLANO CANTINA” certainly cannot forthwith convey an immediate idea of the ingredients, qualities, or characteristics of the services. When one encounters the phrase “POBLANO CANTINA,” one cannot reach a conclusion as to the nature of the covered services without at least a significant exertion of imagination, thought, and perception. Moreover, even with such a significant exertion of imagination, thought, and perception, it would still remain unlikely that one could reach a conclusion as to the nature of the covered services.

In light of the foregoing independently-sufficient reason, the mark cannot be descriptive of the services, and thus the Examiner’s disclaimer requirement must be withdrawn.

E. Even if the mark’s distinctiveness were in doubt, that doubt would still need to be resolved in Applicant’s favor.

Applicant respectfully asserts that there should be no doubt about the non-descriptive character of Applicant’s mark. However, even if there were any such doubts, that would not change the result, as any “doubts about the ‘merely descriptive’ character of the mark ... are to be resolved in favor of applicants.” *Shutts*, 217 U.S.P.Q. 363, 1983 WL 51780, *3 (T.T.A.B. Feb. 25, 1983) (internal citations omitted).

In light of the foregoing independently-sufficient reason, the mark cannot be deemed descriptive of the services, and thus the Examiner’s disclaimer requirement must be withdrawn.

In light of all the foregoing, Applicant respectfully asserts that the Office Action’s conclusion that the mark POBLANO CANTINA is descriptive is unsubstantiated and has no valid basis. The Office Action has not met—and cannot meet—its burden to substantiate the allegation that the term “POBLANO CANTINA” is not inherently distinctive in connection with

Applicant's covered services. Therefore, Applicant respectfully requests that Applicant's mark be promptly published for opposition.

II. MARK DESCRIPTION/COLOR CLAIM AMENDMENT REQUIRED

The Office Action states that the color white appears within an enclosed space within the drawing of Applicant's mark, but the color claim omits white. Applicant would like to make clear that white represents background and is not claimed as a feature of the mark.

The Office Action is suggesting the following Mark Description: "The mark consists of the dark green wording POBLANO CANTINA in a circular shape around a stylized image of a light green pepper with dark green outlining and a white center, with two light green dots appearing in the midpoint of the circle, one on right and one on left." Applicant agrees to the proposed description.

III. CONCLUDING REMARKS.

In light of all the foregoing, Applicant respectfully requests that the Application be promptly approved for publication.