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March 4, 2021

VIA TEAS

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

Attn: John D. Dwyer, Esq.

Examining Attorney, Law Office 116

Re: Response to September 4, 2020 Office Action issued in connection with Application of Creating Culinary Communities LLC to Register the Mark, CICCIDI CARNE BY DARIO, in cl. 43, Ser. No. 90/040,464

Dear Mr. Dwyer:

In response to the Office Action issued on September 4, 2020 (hereinafter “Office Action”), Creating Culinary Communities LLC (hereinafter “Applicant”) respectfully requests reconsideration of the above-referenced Application (hereinafter “Application”) for the mark CICCIDI CARNE BY DARIO (hereinafter “Mark”) in view of the following Amendments and remarks hereby submitted.

AMENDMENTS

Please enter the following statements into the record:

--“The English translation of CICCIDI CARNE in the mark is “tender, juicy, soft, fat, unctuous chunks or pieces of meat”.--

--“The name shown in the mark identifies a particular living individual whose consent to register is made of record”.--

John Dwyer, Esq.
March 4, 2021
Page 2

REMARKS

In the Office Action, the Examining Attorney requested that Applicant: (i) clarify whether the name DARIO in the Mark identifies a particular living individual; (ii) submit an English translation of the foreign wording in the Mark; (iii) confirm whether its restaurants and/or bars will serve any meat; and (iv) enter a disclaimer for the wording CICCIDI CARNE.

With respect to the first requirement, Applicant submitted a statement confirming that DARIO identifies a particular living individual in the form of a written consent as signed by Dario Cecchini and accordingly has complied with this requirement.

With respect to the Examiner's second request regarding the submission of an English translation of the foreign wording in the Mark, Applicant has elected to enter a more accurate English translation of (and which is the intended meaning behind) the Italian expression CICCIDI CARNE, namely, "tender, juicy, soft, fat, unctuous chunks or pieces of meat". Supportive of the same, attached hereto as Exhibit A, is an affidavit executed by Paolo Lazzarino, Esq., a partner at the Milan, Italy-based Law firm Nctm Studio Legale, an individual born and raised in Italy and whose first language is Italian, in which he affirms the accuracy of the aforementioned translation.

In response to the Examiner's third inquiry requesting clarification as whether Applicant's restaurants and/or bars will serve any meat, Applicant states that while meat will be served at its fast casual restaurants and/or bars, Applicant's CICCIDI CARNE BY DARIO

John Dwyer, Esq.
March 4, 2021
Page 3

branded restaurants and/or bars are not meat-centric restaurants and/or bars as its establishments will also offer pizzas, paninis and pastas, among other types of dishes and offerings.

Finally in the Office Action, the Examining Attorney requested that Applicant disclaim the wording CICC DI CARNE “because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of [A]pplicant’s goods and/or services” (hereinafter “Request for Disclaimer”). In support of the Request for Disclaimer, the Examiner attached dictionary definitions showing that the wording CICC DI CARNE means “chunks of meat” or “pieces of meat” and concludes that such wording merely describes a feature of the Applicant’s services, namely, a feature of Applicant’s restaurant and bar services is food in the nature of chunks or pieces of meat.

Applicant disagrees with the Examiner’s requirement and underlying reasoning and instead, respectfully contends that the wording CICC DI CARNE is not descriptive of its services and as such, should not be disclaimed.

“A term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods or services”. In re Abcor Development Corp., 588 F.2d 811, 814, 200 U.S.P.Q. (BNA) 215, 218 (C.C.P.A. 1978). [Emphasis supplied]. The immediate idea must be conveyed forthwith with a degree of particularity. TMS Corp. of the Americas, 200 U.S.P.Q. (BNA) 57, 59 (T.T.A.B. 1978); In re Entenmann's Inc., 15 U.S.P.Q.2d (BNA) 1750, 1751 (T.T.A.B. 1990), aff'd, 90-1495 (Fed. Cir. 1991). A term is suggestive, on the other hand, if it requires imagination, thought and perception to reach a

John Dwyer, Esq.
March 4, 2021
Page 4

conclusion as to the nature of the goods or services. Abcor, 588 F.2d at 814. Finally, a term is arbitrary if there is no association between the common word or phrase and the goods or services that it designates. DreamWerks Production Group, Inc. v. SKG Studio, 142 F.3d 1127, 1130 (9th Cir. 1998) (finding that the word "dream" was not suggestive but arbitrary when applied to a company that brings sci-fi dreams to life because the word "dream" is used in too many different ways to suggest any particular meaning to the reasonable consumer). **Any doubt as to whether a mark [or term] is suggestive or descriptive must be resolved in favor of the applicant by allowing publication of the mark for opposition.** In re Morton-Norwich Products, Inc., 209 U.S.P.Q. (BNA) 791 (T.T.A.B. 1981). [Emphasis supplied].

Applicant respectfully submits that the CICC DI CARNE is not merely descriptive as initially opined by the Examiner because it does not communicate to the average consumer an immediate thought as to any "ingredients, qualities or characteristics of the goods or services". Abcor, 588 F.2d at 814.

It is well settled that in resolving the merely descriptive issue, it must be decided whether the mark at issue conveys to purchasers and potential purchasers, who are unfamiliar with Applicant and its services, an immediate understanding of the ingredients, qualities, functions, or characteristics of the services. Stix Products, Inc. v. United Merchants & Mfrs., Inc., 160 U.S.P.Q. (BNA) 777, 784 (S.D.N.Y. 1968).

Additionally, the Court of Customs and Patent Appeals has indicated that a suggestive mark can be "highly suggestive" but still not so powerfully point to the goods or

John Dwyer, Esq.
March 4, 2021
Page 5

services rather than the source so that it falls in the category of descriptiveness. See Astra Pharmaceutical Products, Inc. v. Pharmaton, S.A., 145 U.S.P.Q. 461, 466 (C.C.P.A. 1965). It is also recognized that a minor degree of descriptiveness present in a mark will not otherwise destroy suggestive trademark significance. Q-Tips, Inc. v. Johnson & Johnson, 206 F.2d 144, 146-147, 98 U.S.P.Q. 86, 88 (3rd Cir.), cert. denied, 346 U.S. 867 (1953) (Q-Tips for cotton swabs held valid). Indeed, the Court of Customs and Patent Appeals has repeatedly stated that in its opinion the best marks are often highly suggestive. Minnesota Min. and Mfg. Co. v. Johnson and Johnson, 454 F.2d 1179, 1180, 172 U.S.P.Q. 491 (C.C.P.A. 1972); Continental Scale Corp. v. Weight Watchers Int'l Inc., 517 F.2d 1378, 1380, 186 U.S.P.Q. 988 (C.C.P.A. 1975).

Accordingly, judicious application of that principle does not call for an analysis of the term and application of it to its services, as such an analysis will lead only to a deduction that it is descriptive of some subjective characteristic or quality of the services. Such a conclusion is not apparent on its face, but only determined after a mental operation, which removes the objection to “descriptiveness”. Here, the wording CICC DI CARNE does not immediately reveal the true nature of the restaurant and bar services offered by the Applicant. Rather, consumers must follow a multi-step reasoning process to understand the nature of Applicant’s services and even at that point, may not understand the exact nature of the services. While it may be possible for a consumer to eventually discern the nature of Applicant’s services, this is not immediately apparent from the wording CICC DI CARNE. The wording CICC DI CARNE also does not limit its competitors. When a consumer encounters the wording CICC DI CARNE,

John Dwyer, Esq.
March 4, 2021
Page 6

it will not immediately think of Applicant's services. When viewed in relation to the applied for services, it certainly cannot be contended that the wording CICC DI CARNE describes the services set forth in the Application. The wording CICC DI CARNE at most, is suggestive since it requires imagination, thought and perception to reach a conclusion as to the nature of Applicant's services. In other words, additional information or the use of multilevel reasoning would be required to determine the nature of Applicant's services. As the need for such reflection is the hallmark of a suggestive mark, it is therefore clear that the wording CICC DI CARNE is not merely descriptive and, at most, is suggestive of the relevant services.

Moreover, the wording CICC DI CARNE should not be translated literally as "pieces or chunks or meat" but is an Italian expression meaning "tender, juicy, soft, fat, unctuous chunks or pieces of meat" (see Exhibit A) which in this case is used to express Applicant's passion for Italian cuisine. Applicant offers no dish consisting solely of "pieces or chunks of meat". As such, the Italian expression, CICC DI CARNE, does not strictly describe the services, namely, restaurant and certainly not bar services. In fact, the more predominantly recognized meaning for the Italian expression CICC DI CARNE eliminates any possibility for "descriptive" significance (as summarily and erroneously concluded by the Examiner) because the term CICC DI CARNE is not initially understood by consumers as referring to "restaurants and bars".

Further supportive of the above is the well-established proposition that "a mark that connotes at least two meanings - one possibly descriptive, and the other suggestive of some

John Dwyer, Esq.
March 4, 2021
Page 7

other association - can be called suggestive, as the mark is not ‘merely’ descriptive”. See McCarthy on Trademarks § 11:19. For example, the mark POLY PITCHER on polyethylene pitchers both connotes a description of the plastic ingredient of the product and also is reminiscent or suggestive of Molly Pitcher of Revolutionary time. The court concluded in Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 131 U.S.P.Q. (BNA) 55 (2d. Cir. 1961), that the mark was “an incongruous expression” and has the “characteristics of a coined or fanciful mark.” Similarly, the mark SUGAR & SPICE for bakery products not only suggested ingredients, but stimulates an association with nursery rhyme “Sugar and Spice and Everything Nice...” In holding this use not a merely descriptive one, the court emphasized this “reminiscent, suggestive, or associative connotation” with a non-descriptive idea. See In re Colonial Stores, Inc. 394 F.2d 549, 157 U.S.P.Q. (BNA) 382 (C.C.P.A. 1968) See also American Historic Racing Motorcycle Ass’n, Ltd. V. Team Obsolete Promotions, 33 F.Supp.2d 1000, 49 U.S.P.Q.2d (BNA) 1844 (M.D. Fla. 1998), aff’d, 233 F.3d 577 (11th Cir. 2000) (BEARS, an abbreviation for the descriptive “British-European Racing Series” is arbitrary, not descriptive, because of the double entendre of an animal and an abbreviation.) Similarly in this case, given that the term SKATE connotes multiple meanings, one possibly descriptive (as contended by the Examiner), and the others suggestive or non-descriptive or suggestive at all (as submitted by Applicant), the Mark should be deemed suggestive, as the mark is not ‘merely’ descriptive.

Another mark, which was held registerable after overcoming the examiner's objection on the ground of descriptiveness, is "DRI-FOOT" for an anti-perspirant deodorant for

John Dwyer, Esq.
March 4, 2021
Page 8

feet. There, applicant argued that DRI-FOOT is a combination of two ordinary words forming a unitary designation which suggests, but does not necessarily "merely describe," the character of the goods; and that applicant has used and promoted DRI-FOOT in a trademark sense and not in a descriptive sense. The Board, while finding the mark highly suggestive of applicant's goods, found it not "merely descriptive". The Board noted that its decision was within the rational of prior court decisions: The Fleetwood Co. v. The Mitchum Co., 139 U.S.P.Q. (BNA) 281 (C.C.P.A. 1963) ["FAYD" for skin cream]; In re Sunbeam Corp., 152 U.S.P.Q. (BNA) 116 (C.C.P.A. 1967) ["SPRAY MIST" for electric pressing irons]; In re Colgate-Palmolive Co. 160 U.S.P.Q. (BNA) 733 (C.C.P.A. 1969) [CHEW'N CLEAN" for dentifrice]; In re Colonial Stores Inc. 157 U.S.P.Q. (BNA) 382 (C.C.P.A. 1968) ["SUGAR&SPICE" for bakery products]; In re Majestic Distilling Co., 164 U.S.P.Q. (BNA) 386 (C.C.P.A. 1970) ["CHARRED KEG" for bourbon whiskey]; In re The Chesapeake Corp. of Virginia, 164 U.S.P.Q. 395 (C.C.P.A. 1970) ["SUPERWATERFINISH" for craft paper]; and Pacific Industires, Inc. v. Minnesota Mining and Manufacturing Co., 165 U.S.P.Q. (BNA) 631 (C.C.P.A. 1970) ["IMPACT for carbonless transfer copy paper].

In light of the above, there is clear ambiguity as to what the wording CICC DI CARNE describes since it is vague and indirect and brings to mind the Italian expression referring to Applicant's passion and devotion for Italian cuisine. Accordingly, the finding that the verbiage CICC DI CARNE is "merely" descriptive cannot therefore be sustained.

John Dwyer, Esq.
 March 4, 2021
 Page 9

Finally, the Examining Attorney asserts that the wording CICC DI CARNE refers to chunks or pieces of meat which is a feature of Applicant’s restaurant and bar services and is therefore merely descriptive and should be disclaimed. Applicant disagrees with this reasoning. While it is not necessary that a term describe all of the purposes, functions, characteristics, or features of a product to be considered merely descriptive; it must at least describes one significant function, feature, or property. In re Chamber of Commerce, 675 F.3d at 1300, 102 U.S.P.Q.2d at 1219. Here, pieces or chunks of meat (i.e. CICC DI CARNE per the Examiner’s literal translation) may only be served or used as an ingredient at Applicant’s restaurants and bars. The wording CICC DI CARNE therefore does not describe or serve to identify a significant feature of Applicant’s services or principal food item served at Applicant’s restaurants, which is necessary to qualify the wording CICC DI CARNE as merely descriptive. See In re The Registry Hotel Corporation, 216 U.S.P.Q. 1104 (T.T.A.B. 1983) (LA CHAMPAGNE was found not merely descriptive of restaurant services). Furthermore, a very brief search of the USPTO records revealed numerous registrations for marks that identify food ingredients or menu items at restaurants including the following:

Mark	Reg. No.¹	Menu²
FIG & OLIVE®	2,981,952	https://www.figandolive.com/nyc-fifth-avenue-menus/
Menu includes figs and olives as ingredients.		
GREEN TOMATO GRILL®	4,395,586	https://www.greentomatogrill.com/menu-stews-soups

¹ TSDR printouts for each of the registrations are attached hereto as Exhibit B.

² Printouts of the online menus for each of the restaurants are attached hereto as Exhibit C.

John Dwyer, Esq.
 March 4, 2021
 Page 10

Menu includes tomatoes as ingredients		
LA TOMATE <i>with Design</i> ®	2,251,078	https://www.latomatebistro.com/#menus/dinner
Tomatoes are a primary ingredient/menu item at Italian-style restaurants; Menu includes tomatoes as ingredient.		
MUSTARDS GRILL®	3,379,983	http://mustardsgrill.com/content/hot-grill
Menu includes mustards as ingredient.		
OLIVES & PEPPERS®	4,641,015	https://www.olivesandpeppers.com/penn-trafford
Olives and peppers are a primary ingredient/menu item at Italian-style restaurants; Menu includes olives and peppers as ingredient.		
PICKLES&SWISS®	4,239,210	https://www.picklesandswiss.com/menu
Pickles and Swiss cheese are popular ingredients and/or menu item at delis/sandwich restaurants; Menu includes pickles and Swiss cheese as ingredients.		
SWEET PEPPERS®	2,736,596	http://sweetpeppersdeli.com/sandwiches/peppers-beef/
Sweet peppers are popular ingredients and/or menu item at delis/sandwich restaurants; Menu includes sweet peppers as ingredient.		

The foregoing is merely a sampling of references that is further supportive of Applicant's position, and unlike some of these examples, the wording CICC DI CARNE does not identify a primary or significant feature of Applicant's services, which is required to find a term merely descriptive. These third-party registrations clearly support the determination that marks identifying ingredients (as could be with the wording CICC DI CARNE) or even menu items at a restaurant could not be considered merely descriptive.

Accordingly, Applicant hereby submits that the Examining Attorney's findings are misplaced in the present case and respectfully requests that the Request for Disclaimer be withdrawn and that the Application be approved for publication at the earliest possible date.

John Dwyer, Esq.
March 4, 2021
Page 11

CONCLUSION

In view of submission of the aforesaid Amendments and Remarks responsive to the issues raised in the Office Action, Applicant believes that the instant Application is now in condition for publication. Favorable action is therefore solicited.

Should there be any remaining questions or comments, or if there are any additional issues that can be resolved through an Examiner's Amendment, the Examining Attorney is encouraged to telephone the undersigned at the below-referenced number.

Respectfully submitted,

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