

# The Trademark Reporter®

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## TRADEMARK PROTECTION FOR RESTAURANT OWNERS: HAVING YOUR CAKE AND TRADEMARKING IT, TOO

*By Lisa K. Krizman\**

### I. INTRODUCTION

Think of what may attract you to a restaurant; a catchy name, a unique and specific décor, imaginatively named menu items and restaurant name, dishes with perhaps a distinctive appearance and served in a distinctive manner, and a well-known chef. This article examines how these elements of a restaurant business may be protectable under trademark law. Specifically, this article addresses case law involving restaurant trade dress, federal trademark registration of menu items and restaurant services, the chef's name as a trademark, using trademark law to protect a claim to fame of being the first to invent a well-known food item, food with unique shapes or packaging, and "signature dishes."

### II. TRADE DRESS

It is well established that the overall atmosphere, decorations, design, and theme of a restaurant constitute trade dress and can give rise to a claim for trademark infringement under Section 43(a) of the U.S. Trademark (Lanham) Act.<sup>1</sup> To receive trade dress protection under Section 43(a), a plaintiff must prove that its trade dress is used in commerce, is nonfunctional, is distinctive, and is recognized among consumers as a symbol of or associated with the source of the goods or services.<sup>2</sup> Discussed below are several cases that illustrate the elements of protectable trade dress with respect

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1. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). "[T]he protection of trademarks and trade dress under § 43(a) [of the Lanham Act] serves the same statutory purpose of preventing deception and unfair competition. There is no persuasive reason to apply different analysis to the two." *Id.* at 773.

2. *Id.*

to restaurants, including a restaurant's design, menu, and look and feel.

In early cases, many claims of trade dress infringement were unsuccessful. In 1983, Shakey's, a nationally franchised pizzeria chain, sued James Covalt, a former franchisee, alleging that after the expiration of the franchise agreement, Covalt, who continued to operate his pizza parlors under different trade names ("Izzy's" and "Suspenders"), still maintained similarities with the former Shakey's operations, which was creating a likelihood of confusion.<sup>3</sup> Shakey's specifically complained about the similarities in menu items, asserting that Covalt copied the franchise menu content, prices, pizza, sandwich ingredients, and style of presentation.<sup>4</sup>

The U.S. Court of Appeals for the Ninth Circuit found that the menu item similarities in *Shakey's*, standing alone, were of little persuasive force, and that it was unlikely that once inside an Izzy's parlor a customer would order an "Izzy's Deli," an "Our Choice," or a "Tacorito" from the Izzy's menu and expect to get a Shakey's product solely because of the alleged similarities between the Izzy's menu names and the Shakey's menu names.<sup>5</sup> The appellate court also established that visual similarities or functional similarities between Izzy's and Shakey's, alone, could not be a valid basis for an unfair competition claim. It further noted that Covalt had taken substantial steps to disassociate his pizza parlors from Shakey's.<sup>6</sup> Therefore, the court ruled in favor of Covalt on the trade dress infringement and unfair competition claims.

3. *Shakey's Inc. v. Covalt*, 704 F.2d 426 (9th Cir. 1983).

4. *Id.* at 430.

5. *Id.* at 431. The following chart compares Shakey's and Izzy's slogans and menu names:

<i>Shakey's</i>	<i>Izzy's</i>
<i>Slogan</i>	
"Shakey's—World's Greatest Pizza"	"Izzy's—Home of the World's Finest Pizza"
<i>Menu Names</i>	
"Manager's Choice"	"Our Choice"
"Royal Canadian"	"Canadian Delight"
"Pizzarito"	"Tacorito"
"Shakey's Special"	"Izzy's Special"
"The Deli"	"Izzy's Deli"

*Id.* at 430.

6. *Id.* at 432. The owner of Izzy's took steps "to remove indicia of her prior affiliation with Shakey's, such as signs and art work, she conducted a leafletting campaign to inform patrons of her parlor's name change and engaged in a costly (\$81,000), multi-media advertising campaign." *Id.* at 432-33.

In 1987, Fuddruckers, a national chain of franchised upscale hamburger restaurants, claimed that a competitor had intentionally copied its restaurant design, concept, and style. Fuddruckers pointed to the overall similarities of the restaurants, as well as the fact that the competitor had expressed an interest in opening a Fuddruckers franchise during the planning stages of the competitor's restaurant.<sup>7</sup> The majority of Fuddruckers restaurants share a large number of common elements, such as food preparation areas that are visible to customers, various food items that are presented in glassed-in display cases, food items that are displayed in bulk in the main part of the restaurant, a bakery in each store called "Mother Fuddruckers," an in-restaurant newspaper, an oversized self-service condiment bar, and dog bones that customers can purchase and take home. Fuddruckers also uses such distinctive design elements as two-by-four white tiles on the walls and the counters, neon signs, mirrors, brown-and-white checked flooring and tablecloths, brown director's chairs, and exterior yellow awnings.<sup>8</sup>

The defendants' restaurant, which operated under the trade name Doc's B.R. Others ("Doc's"), also made its food preparation areas visible to its customers, placed the same white tile on the walls, and used neon, mirrors, and director's chairs as decorations. In addition, Doc's had an in-restaurant newspaper, called its bakery "Mother Other's," and sold dog bones to customers.<sup>9</sup> In the original jury case, the trial court asked the jury to determine whether there was "a likelihood that consumers would believe that Doc's was owned and franchised by Fuddruckers," and the jury returned a verdict in favor of Doc's.<sup>10</sup> Taking a step away from *Shakey's*, the Ninth Circuit found that that jury instruction had been too narrow and that the likelihood of *any* mistaken consumer belief that the two operations had the same parent company or owner could constitute an infringement.

Likelihood of confusion "exists when customers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark." . . . Nothing in the [prior cited case] definition suggests that actionable likelihood of confusion should be limited to consumer belief that the infringer is being operated by the original user. The potential for harm is equally great if the consumers believe that the

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7. Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 840 (9th Cir. 1987).

8. *Id.* at 839-40.

9. *Id.* at 840.

10. *Id.* at 845.

infringer runs the original user. For example, if consumers believe that Doc's runs Fuddruckers, and they are disappointed with the quality of Doc's food or service, they may be deterred from patronizing Fuddruckers.<sup>11</sup>

The Ninth Circuit ultimately remanded the case for a new trial in which the proper jury instruction would be given.<sup>12</sup> However, the court noted that even with the proper jury instruction, given the number of differences between the two establishments and the level of detail involved in Fuddruckers' trade dress, slight variations in color or design might be enough to avoid confusion.<sup>13</sup>

It was not until the U.S. Supreme Court's decision in *Two Pesos v. Taco Cabana*<sup>14</sup> that a restaurant's right to protect its inherently distinctive trade dress was firmly established. In *Two Pesos*, Taco Cabana alleged that the Two Pesos had infringed its trade dress, which consisted of

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.<sup>15</sup>

The district court had instructed the jury to consider "the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the décor, the menu, the equipment used to serve food, the servers' uniforms and other features reflecting on the total image of the restaurant" as elements of trade dress.<sup>16</sup> The jury found that Two Pesos' trade dress was confusingly similar to that of Taco Cabana, and thus Taco Cabana prevailed.<sup>17</sup> The U.S. Supreme Court, in upholding the Fifth Circuit's affirmation of the district court's decision, ruled that a restaurant's trade dress could be inherently distinctive and that there was no need to show secondary meaning (defined as "acquired distinctiveness" in the Lanham Act] to protect a

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11. *Id.*

12. *Id.*

13. *Id.* at 847.

14. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). *See supra* note 1.

15. *Id.* at 765 (quoting *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991)).

16. *Id.* at 764 n.1.

17. *Id.* at 766.

restaurant's trade dress if that trade dress was inherently distinctive.<sup>18</sup>

In 2001, a federal district court in *Vasquez v. Ybarra*<sup>19</sup> added to the *Two Pesos* holding in finding that a restaurant menu, alone, was entitled to protection as trade dress under Section 43(a).<sup>20</sup> The menu was book-style, contained over 100 items, and featured colorful graphics with Mexico-related images.<sup>21</sup> The U.S. District Court for the District of Kansas found that the *menu*, as a whole, conveyed "a festive, Mexican flair," and was protectable as being merely suggestive because it only "subtly connote[d] something about the product" and "require[d] imagination, thought and perception to reach a conclusion as to the nature of goods."<sup>22</sup> Noting that the plaintiff did not allege infringement of product design, the court considered the menu to be a form of product packaging, similar to the restaurant décor in *Two Pesos*.<sup>23</sup> It went on to conclude that the menu was inherently distinctive and thus was entitled to protection under Section 43(a).<sup>24</sup>

Since *Ybarra*, there have been several cases in which the plaintiff restaurant's trade dress was found not to be inherently distinctive. In 2006, in *HI Ltd. Partnership v. Winghouse of Florida, Inc.*,<sup>25</sup> the Eleventh Circuit affirmed a Florida district

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18. *Id.* at 776.

19. 150 F. Supp. 2d 1157 (D. Kan. 2001).

20. *Id.* at 1174. The court also addressed copyright and trade secret issues in this case; it recommended that proprietary elements of recipes, methods of preparing recipes, and food preparation and purchase methods could be more safely protected under confidentiality agreements. *Id.* at 1172.

21. *Id.* at 1162.

22. *Id.* at 1176.

23. *Id.* at 1175 n.18. Product packaging can be an inherently distinctive form of trade dress, but product design must demonstrate secondary meaning to be protected as trade dress under Section 43(a), 15 U.S.C. § 1125(a); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000). In *Wal-Mart*, the U.S. Supreme Court distinguished its holding in *Two Pesos* regarding restaurant décor trade dress, *see supra* note 1, to Wal-Mart's sale of a "knock-off" dress design. *Id.* at 215. The Court reasoned that product *design* is unlike product *packaging* in part because consumers usually view the former as a feature meant to render a product more useful or appealing, but not to identify its source. *Id.* at 213. The Court concluded that restaurant décor is not product *design*, explaining, "[I]t was either product packaging—which, as we have discussed, normally *is* taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging and has no bearing on the present case," and therefore could be inherently distinctive. *Id.* at 215. Relying on this language, the court in *Ybarra* reasoned that a menu is "akin to the restaurant decor in *Two Pesos*, a '*tertium quid*' the [U.S. Supreme] Court found similar to product *packaging*." 150 F. Supp. 2d at 1175 n.18.

24. 150 F. Supp. 2d at 1175 n.18. The court found that an issue of material fact existed regarding the issue of likelihood of confusion and thus denied the defendant's motion to dismiss on that matter. *Id.* at 1177.

25. No. 6:03-cv-116 (M.D. Fla. 2004), *aff'd*, 451 F.3d 1300 (11th Cir. 2006).

court decision that the HOOTERS restaurant could not prevent another restaurant from having the following features: “Winghouse Girls,” wearing uniforms that consisted of black tank tops and running shorts; wooden furniture; sports memorabilia on the walls; vertical paper towel spools on the tables; and a menu that described the restaurant on the reverse side.<sup>26</sup> The court found that all of these features were too generic among sports bars to be worthy of proprietary trade dress protection.<sup>27</sup> Interestingly, while the district court had found that the orange-and-white color combination of the “Hooters Girl” outfit might be worthy of some protection, the concept of the “Hooters Girl” as trade dress was unprotectable as being primarily functional:

Hooters has admitted that the predominant function of the “Hooters Girl” is to provide vicarious sexual recreation, to titillate, entice, and arouse male customers’ fantasies. She is the very essence of Hooters’ business. This essential functionality disqualifies the “Hooters Girl” from trade dress protection.<sup>28</sup>

Thus, Hooters lost on all counts.

Similarly, a 2007 case, *Rodriquez v. Casa Salsa Restaurant*,<sup>29</sup> involved a very broad list of elements that the plaintiff claimed constituted its protectable trade dress. The plaintiff had presented to the Puerto Rico Tourism Company a detailed business plan that described a Puerto Rican-themed restaurant, to be operated under the trade name Rumba, and then later sued, alleging trademark infringement, when a similar Puerto Rican restaurant, trade-named Casa Salsa, was opened in South Beach in Miami by the celebrity Ricky Martin with the help of the very same tourism company.<sup>30</sup> The plaintiff pointed to the defendant’s use of similar concepts in the dance floor, the bar area, the type of cuisine and music featured, and the features advertised to the target clientele.<sup>31</sup> In addition, for a short time at the beginning, the defendant had trade-named its bar Rumba, and then Rum Va, which the plaintiff also argued was an infringement of its Rumba restaurant trade name.<sup>32</sup> However, the U.S. District Court for the

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26. *Id.*

27. *Id.*

28. *Id.*

29. 260 F. Supp. 2d 413 (D.P.R. 2003).

30. *Id.* at 419.

31. *Id.*

32. *Id.*

District of Puerto Rico found that none of these trade dress elements were “unusual or unique” enough to receive protection.<sup>33</sup>

Despite these unsuccessful restaurant trade dress outcomes, there have been two recent cases of note in which the plaintiffs had arguably stronger claims of trade dress infringement and were able secure protection, albeit without establishing a legal precedent.

In June 2007, Rebecca Charles, the owner-chef of the famous New York restaurant Pearl Oyster Bar, alleged that her former employee, sous-chef Edward McFarland, had stolen her restaurant’s “look and feel” by opening a restaurant that was “an exact copy of her restaurant” and calling it Ed’s Lobster Bar.<sup>34</sup> Charles’s lawsuit claimed that McFarland had “copied each and every element” of her restaurant’s trade dress by stealing her concepts, menus, and look and feel.<sup>35</sup> Among those trade dress elements were “the white marble bar, the gray paint on the wainscoting, the chairs and bar stools with their wheat-straw backs, the packets of oyster crackers placed at each table setting and the dressing on the Caesar salad.”<sup>36</sup> *The New York Times* reported:

In recent years, a handful of chefs and restaurateurs have invoked intellectual property concepts, including trademarks, patents and trade dress—the distinctive look and feel of a business—to defend their restaurants, their techniques and even their recipes, but most have stopped short of a courtroom. The Pearl Oyster Bar suit may be the most aggressive use of those concepts by the owner of a small restaurant. Some legal experts believe the number of cases will grow as chefs begin to think more like chief executives.<sup>37</sup>

Charles reportedly filed suit to determine whether recipes and certain design ideas count as trade dress; however, the case was settled out of court in April 2008.<sup>38</sup> The settlement apparently involved menu and décor changes. Ed’s Lobster Bar was repainted, and the menu was reprinted with the addition of new menu items

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33. *Id.* at 421.

34. Pete Wells, *Chef Sues Over Intellectual Property (the Menu)*, N.Y. Times, June 27, 2007, available at <http://www.nytimes.com/2007/06/27/nyregion/27pearl.html?scp=1&sq=pearl%20oyster%20bar&st=cse>.

35. *Id.*

36. *Id.*

37. *Id.*

38. Pete Wells, *Chef’s Lawsuit Against a Former Assistant Is Settled Out of Court*, N.Y. Times, Apr. 19, 2008, available at [http://www.nytimes.com/2008/04/19/nyregion/19suit.html?\\_r=1&ref=nyregion&oref=slogin](http://www.nytimes.com/2008/04/19/nyregion/19suit.html?_r=1&ref=nyregion&oref=slogin).

and changes in the names of other menu items.<sup>39</sup> Most notably, the “Lobster Bar Bouillabaisse,” a signature item offered at Pearl’s Oyster Bar, was renamed “New York Shellfish Stew” at Ed’s Lobster Bar.<sup>40</sup>

Similarly, in 2008, a Seattle restaurant, Peso’s Kitchen and Lounge (Peso’s), sued a competitor under almost the exact same factual circumstances.<sup>41</sup> Peso’s claimed that its former employees and independent contractors had jumped ship and had opened a competing restaurant under the trade name The Matador, and had copied the following allegedly distinctive trade dress elements of Peso’s: “ornamentation, designs, and decorative elements in sconces, lighting, chandeliers, wall surface treatment and colors, ceiling panels and colors, furnishings, Mexican ‘Day of the Dead’ themes and the adoption of a matador graphic design and icon on the menu cover. . . .”<sup>42</sup> In an almost exact repeat of the *Pearl Oyster Bar* case, the restaurants eventually reached a settlement that involved (1) substantial changes to The Matador’s decor to address certain Peso’s trade dress elements; (2) changes to menus and menu covers; and (3) a settlement payment amount, reported to be between \$250,000 to \$285,000, that was paid to Peso’s.<sup>43</sup>

While neither of these cases was fully litigated, they both demonstrate a restaurant owner’s power to compel “knock-off” restaurants to make design and menu changes, at least through coerced settlements.

The above trade dress cases also illustrate that trade dress may encompass many elements of a restaurant’s operation in addition to its design. However, the difficulty for restaurant plaintiffs remains proving that restaurant trade dress is inherently distinctive or has developed secondary meaning. In a recent trend, several restaurants have successfully obtained federal registrations for their interior and/or exterior décor as trade dress, which would undoubtedly be useful to any trade dress

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39. *Id.*

40. *Id.*

41. Michael Atkins, *Peso’s Sues Matador in Rare Seattle Restaurant Trade Dress Case*, Seattle Trademark Lawyer, Apr. 10, 2008, available at <http://seattletrademarklawyer.com/blog/2008/4/11/pesos-sues-matador-in-rare-seattle-restaurant-trade-dress-ca.html>.

42. *Id.*

43. Laura Onstot, *Pesos, Matador Settle*, Seattle Weekly, Oct. 28, 2008, available at <http://www.seattleweekly.com/2008-10-29/news/pesos-matador-settle>.

litigant. These restaurants have included Chipotle,<sup>44</sup> Miami Subs,<sup>45</sup> Metropolitan Club,<sup>46</sup> and Fazoli's.<sup>47</sup>

### III. TRADEMARK REGISTRATIONS

Restaurant services may be advertised and rendered identified with a federally registered service mark provided the owner can show some amount of patronage by those traveling in interstate commerce.<sup>48</sup> The interstate commerce requirement is generally not difficult for restaurants to meet. For example, BOZO'S pit barbeque, a single restaurant located about an hour from Memphis, Tennessee, was able to establish use in interstate commerce by establishing that it served some customers that were traveling interstate through the Memphis metropolitan area.<sup>49</sup> Although an opposer who had filed a Notice of Opposition in the Trademark Trial and Appeal Board (Board or TTAB) had argued that serving a few interstate customers was insufficient to demonstrate use in commerce under the U.S. Trademark (Lanham) Act, the U.S. Court of Appeals for the Federal Circuit held that the interstate commerce requirement of the Lanham Act was coextensive with Congress's constitutional powers under the

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44. The mark consists of the appearance and design of the interior of a restaurant evoking a neo-industrial feel through the use of unpainted galvanized or stainless steel metal finishes on table and bar tops, baseboards, wainscots, and trash surrounds; light-colored natural wood finishes as accents on table and/or chair edges, bench seating, wall finishes, and/or chairs; and the use of industrial-look light fixtures with exposed electrical junction box fittings and porcelain keyless bulb sockets suspended from the end of electrical conduit pendants. Reg. No. 3,105,875.

45. The design feature of the mark consists of the configuration of the exterior building design of a one-story restaurant with exterior walls extending beyond the rooftop to form ornamental scalloped design. The drawing is lined for the colors pink and blue for the facade and blue and pink for the awning, blue for the word SUBS, and green in the palm tree. Reg. No. 2,128,013.

46. The mark consists of a depiction of the configuration of the exterior building design of a social club featuring a four-tiered building structure with rectangular, circle, and square designed windows, and a courtyard extending to exterior columns, ornamental gates, and entrance canopy. Reg. No. 2,873,187.

47. The mark consists of a configuration of the building where the services will be rendered. Specifically, it is a rectangular-shaped one-story building with a square tower and a pyramidal red canopy roof near the center of the longer side of the building. The entrance to the restaurant is located in the base of the tower. The building's exterior is a tan-colored stucco finish with red, white, and green awnings over the windows and doors, green shutters, and metal lighting fixtures evenly spaced along the exterior of the building. The mark is lined for the colors red and green. Reg. No. 2,302,979.

48. See *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662 (Fed. Cir.), cert. denied, 502 U.S. 823 (1991).

49. *Id.* at 663.

Commerce Clause.<sup>50</sup> However, where a restaurant provides no evidence of interstate customers or use of its services by those traveling interstate, jurisdiction under the Lanham Act may not be found.<sup>51</sup>

To register the trade name of a restaurant as a service mark, the applicant needs to establish that the trade name is being used to identify, distinguish, and indicate the source of the restaurant services, rather than the food product offered by the restaurant. The names of food products, such as menu items, generally are registrable only as trademarks for goods; however, there are exceptions for menu items that the public also uses to identify, distinguish, and indicate the source of a service. In any case, it is now becoming more common to see trademark symbols appearing after menu item names, whether they are registered as service marks or as trademarks.

The three most frequent issues arising in trademark registration applications made by members of the restaurant industry are: (1) whether the mark is too descriptive to be registrable; (2) whether the mark is registrable as a trademark or as a service mark; and (3) whether there is a the likelihood of confusion among food-related marks.

### *A. Merely Descriptive Restaurant Marks*

A term that is merely descriptive of goods and services is not registrable on the Principal Register as a trademark or service mark without proof of secondary meaning.<sup>52</sup> Overcoming a merely descriptive rejection in the U.S. Patent and Trademark Office is a common obstacle when trying to register the names of food items or restaurant trade names. For example, the TTAB considered the mark CHINA GRILL too descriptive of restaurant services to be registrable. Although it noted that Chinese food and décor might not be the sole areas of emphasis at the applicant's restaurants, the Board found the Chinese influence to be more than "incidental."<sup>53</sup> It therefore determined that "Chinese" was a significant descriptive characteristic of the applicant's restaurants, and refused registration of the mark CHINA GRILL.<sup>54</sup>

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50. *Id.* at 664.

51. *In re* Application of Bookbinder's Rest., Inc., 240 F.2d 365 (C.C.P.A. 1957).

52. *In re* Bright-Crest. Ltd., 204 U.S.P.Q. 591 (T.T.A.B. 1979). The Board has also held that menu item descriptions generally are not protected under copyright. *Vasquez v. Ybarra*, 150 F. Supp. 2d 1157, 1169 (D. Kan. 2001). The words used to describe a dish are considered utilitarian and within the *scènes à faire* doctrine.

53. *In re* China Grill, Inc., 1999 TTAB LEXIS 358 (T.T.A.B. Aug. 4, 1999).

54. *Id.*

Likewise, the TTAB held the mark DOUBLE CERTIFIED ORGANIC to be merely descriptive of pasta<sup>55</sup> and the mark RAIN FOREST TILAPIA to be merely descriptive of fish.<sup>56</sup> YOU PICK TWO also failed as a service mark for restaurant services, because the Board viewed it as more of an “informational slogan” than a service mark.<sup>57</sup> On the other hand, menu items that should be considered arbitrary, such as WHOPPER,<sup>58</sup> or suggestive, such as BLOOMIN’ ONION,<sup>59</sup> are more easily registrable as trademarks if there are no other confusingly similar marks.

Merely descriptive terms for food items have, however, been deemed to be registrable on the Supplemental Register, as in the case of SINGLE, DOUBLE, and TRIPLE for pizza<sup>60</sup> and WHITE CHOCOLATE CARAMEL LATTE CHEESECAKE for cheesecakes (with a disclaimer of “cheesecake”),<sup>61</sup> or even on the Principal Register upon presentation of evidence of secondary meaning for some of the terms in a multiple word mark, as in the case of the mark WHITE CHOCOLATE RASPBERRY TRUFFLE for cheesecakes when accompanied by a disclaimer of the exclusive right to use “white chocolate raspberry.”<sup>62</sup>

Adding a house mark to the food item name also can help an applicant to obtain registration. For example, the Cheesecake Factory registered trademarks for several of its dishes when coupled with its house mark, including the mark THE CHEESECAKE FACTORY CHEESECAKE TRUFFLE with a

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55. *In re* Eden Foods Inc., 24 U.S.P.Q.2d 1757 (T.T.A.B. 1992).

56. *In re* RFA Inc., 2004 TTAB LEXIS 654 (T.T.A.B. Oct. 26, 2004).

57. *In re* Panera, Inc., 2002 TTAB LEXIS 703 (T.T.A.B. Nov. 14, 2002).

58. Reg. No. 0,899,775.

59. Reg. No. 1,532,205.

60. Reg. Nos. 1,149,441, 1,149,439, 1,149,440.

61. Reg. No. 3,226,044.

62. Reg. No. 1,883,744. The U.S. Patent and Trademark Office accepts applications for marks on two different registers—the Principal and the Supplemental. The Principal Register offers procedural and substantive benefits for marks that are not available to those on the Supplemental Register. 15 U.S.C. § 1094. A mark that is accepted on the Principal Register is considered distinctive of an applicant’s goods or services, whereas a mark on the Supplemental Register is considered only “merely descriptive” of the applicant’s goods or services but is “capable” of distinguishing them. 15 U.S.C. § 1091; *see In re* Bush Bros. & Co., 884 F.2d 569, 570 (Fed. Cir. 1989); *In re* Wella Corp., 565 F.2d 143, 144 (C.C.P.A. 1977). As opposed to the Principal Register, registration on the Supplemental does not serve as evidence of ownership, validity, or an exclusive right to use the mark, or confer any substantive rights beyond those under common law. *See* 15 U.S.C. ¶ 1057; *Clairol, Inc. v. Gillette Co.*, 389 F.2d 264, 267 (2d Cir. 1968). However, registration on the Supplemental Register does, *inter alia*, enable the registrant to sue for infringement in federal court, *Bush Bros.*, 885 F.2d at 569 n.2, and can be cited against subsequent third-party applications for registration on either the Supplemental or the Principal Register. *See In re* Clorox Co., 578 F.2d 305, 308-09 (C.C.P.A. 1978).

disclaimer of the exclusive right to use “cheesecake” and “cheesecake truffle.”<sup>63</sup>

Finally, one option is to license the use of a trademark that has already been registered for use on or in connection with common food items, such as T.G.I. Friday’s does with the mark JACK DANIEL’S.<sup>64</sup>

### ***B. Service Mark or Trademark?***

It is possible for a menu item to function as both a trademark and a service mark if it is not merely descriptive of the goods or services and if it is used to identify, distinguish, and indicate the source of both goods and services.<sup>65</sup> To obtain registration of a menu item as a service mark, the applicant must show that the mark is used in the performance of labor for the benefit of another<sup>66</sup> and that it is used in such a manner that it would be readily perceived as identifying the source of the services.<sup>67</sup> With some exceptions,<sup>68</sup> the TTAB is unlikely to grant a service mark registration for a menu item unless there has been extensive advertising, and possibly even a “family” of marks. This is demonstrated by the initial denial and then later grant of McDonald’s U.S. registration applications for EGG MCMUFFIN and SAUSAGE MCMUFFIN as service marks.<sup>69</sup>

McDonald’s had already registered the mark EGG MCMUFFIN for a breakfast food combination sandwich, but was trying to register it as a service mark.<sup>70</sup> In its initial decision the TTAB refused to register EGG MCMUFFIN in stylized lettering “for the sale and promotion of a breakfast food combination sandwich specially prepared as part of a restaurant service.”<sup>71</sup> In support of its registration application, McDonald’s submitted specimens of newspaper advertisements, claiming that the

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63. Reg. No. 2,312,373.

64. Reg. No. 3,592,706.

65. See *In re El Torito Rests., Inc.*, 9 U.S.P.Q.2d 2002 (T.T.A.B. 1988); *In re Brown & Portillo, Inc.*, 5 U.S.P.Q.2d 1381 (T.T.A.B. 1987).

66. *In re Canadian Pacific Ltd*, 754 F.2d 992, 994 (Fed. Cir. 1985).

67. *In re Adver. & Mktg. Dev., Inc.*, 821 F.2d 614 (Fed. Cir. 1987).

68. See PIG SANDWICH for restaurant services (with a disclaimer of “sandwich”), Reg. No. 0,921,278. In 1992, the owners of the mark successfully obtained an injunction preventing the Hard Rock Cafe from using it as the name of a barbeque pork sandwich on their menu. No damages were awarded. *Texas Pig Stands, Inc. v. Hard Rock Café Int’l*, 951 F.2d 684 (5th Cir. 1992).

69. *In re McDonald’s Corp.*, 818 F.2d 875 (Fed. Cir. 1987), *rev’g without opinion* 230 U.S.P.Q. 210 (T.T.A.B. 1986).

70. *In re McDonald’s Corp.*, 230 U.S.P.Q. 210 (T.T.A.B. 1986).

71. *Id.* at 211.

advertisements promoted its overall services, such as breakfast, and thus its restaurant services. The Board nevertheless refused registration, finding that the specimens lacked a direct association between the marks and the identified services, and thereby failed to function as service marks within the meaning of Sections 2, 3, and 45 of the Lanham Act.<sup>72</sup>

However, the Federal Circuit reversed the Board and allowed the marks to be registered as service marks.<sup>73</sup> While that decision was handed down without a published opinion, the TTAB, in *In re Brown & Portillo, Inc.*,<sup>74</sup> reasoned that the deciding factor was that the specimens and other materials submitted in the registration applications for the marks EGG MCMUFFIN and SAUSAGE MCMUFFIN, and in particular the television storyboards, showed use of the marks in the advertising of restaurant services to identify and distinguish McDonald's restaurant services from those of others.<sup>75</sup>

Despite McDonald's success in registering EGG MCMUFFIN and SAUSAGE MCMUFFIN as service marks, it has proven very difficult to obtain other service mark registrations for menu items. For example, the Board refused to register CHICKEN FLAMEANTE as a service mark.<sup>76</sup> Although the applicant argued that its television commercials and table tent pictures advertised a number of food items offered by the applicant such that the term functioned as a mark that identified restaurant services, the Board concluded that the public would perceive CHICKEN FLAMEANTE as it was used in the specimens of its use, that is, as referring to a menu item rather than to the restaurant services.<sup>77</sup>

Similarly, in *Brown & Portillo*, the applicant sought to apply the McDonald's EGG MCMUFFIN and SAUSAGE MCMUFFIN cases to its application to register the mark HEARTY BASKET for a basket of chicken and rolls.<sup>78</sup> The applicant argued that it provided restaurant services, that the goods delivered to the consumer were an integral part of those services, and that it was impossible for a customer to purchase a particular tangible menu item apart from the restaurant services rendered by the applicant. The Board disagreed and upheld the refusal of registration, noting

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72. *Id.*

73. *In re McDonald's Corp.*, *supra* note 69.

74. 5 U.S.P.Q.2d 1381 (T.T.A.B. 1987).

75. *Id.*

76. *In re T.C. Mgmt, Inc.*, 1996 TTAB LEXIS 403 (T.T.A.B. Oct. 10, 1996).

77. *Id.* at \*6.

78. *In re Brown & Portillo, Inc.*, *supra* note 74.

that the menu specimens and brochures incorporating the menu item were insufficient to establish service mark use.<sup>79</sup>

An instructive analysis of the scrutiny applied to specimens in connection with registering food items as service marks was seen more recently when an applicant sought to register the mark SCRAMBLED SENSATIONS for restaurant services.<sup>80</sup> The TTAB found that specimens consisting of “New Scrambled Sensations. A delicious scrambled-up omelet without the fold” were sufficient to demonstrate trademark use and that specimens consisting of “New Scrambled Sensations. Basic American cooking at sensible prices. Village Inn. The time. The place.” demonstrated service mark use.<sup>81</sup>

The Board reasoned that the latter advertisement demonstrated a direct association between the mark and the services, and thus functioned as both a service mark and a trademark.<sup>82</sup> However, it found that in this particular case the only service demonstrated was “cooking scrambled eggs for others,” and because the applicant had applied for registration of the mark for the much broader “restaurant services,” the service mark application was denied.<sup>83</sup>

In light of these cases, it is generally not recommended that a restaurant attempt to register a menu item as a service mark.

### *C. Likelihood of Confusion*

When advising clients about potential trademark conflicts involving food items, beverages, and restaurant names, one should consider the following guidelines relating to the issue of likelihood of confusion.

#### **1. Food Marks**

There is no automatic rule that the sale of food items under similar trademarks will result in a finding of likelihood of confusion just because both items are sold in the same store.<sup>84</sup> Indeed, the TTAB has held that the different marketing conditions that exist even between unrefrigerated and refrigerated food items in the same grocery store can lessen the likelihood of confusion

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79. *Id.*

80. *In re Vicorp Rests., Inc.*, 1996 TTAB LEXIS 287 (T.T.A.B. Sept. 20, 1996).

81. *Id.* at \*7-8.

82. *Id.*

83. In a footnote, the Board noted that VILLAGE INN was the service mark for the “restaurant services” of the applicant. *Id.* at \*4 n.3.

84. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098 (C.C.P.A. 1976).

between unrefrigerated and refrigerated goods. For example, the Board found that the mark QUALITY CLASSIC SELECTION (with a disclaimer of the exclusive right to use “quality”) for drinking water was not confusingly similar to the mark CLASSIC SELECTIONS for frozen entrees because consumers would not believe that these goods would emanate from the same source and frozen food entrees are not within the natural zone of expansion of drinking water.<sup>85</sup> The Board reasoned that drinking water is a nonperishable item and would be displayed in an area of the store separate from the perishable frozen entrees.

The differences in the goods are also reflected in how they are managed in the retail food industry, specifically, they are separated into different categories of goods and handled by different personnel in view of the different functionality of the goods and consumer’s shopping habits.<sup>86</sup>

Thus, the Board found no likelihood of confusion.<sup>87</sup>

## 2. Food Marks vs. Beverage Marks

Similarly, there is no automatic rule that food and beverages are always related. For example, the mark ZINGERS for cakes was found not to be confusingly similar to the mark RED ZINGER for herb tea upon a finding that the presence of the word RED in the RED ZINGER mark, given the difference in the products, was enough to preclude any likelihood of confusion.<sup>88</sup>

## 3. Food and Beverage Marks vs. Restaurant Service Marks

Determining the likelihood of confusion between marks involving food or beverage products and marks for restaurant services requires “something more” than just the fact that the marks are similar or even identical.<sup>89</sup> For example, the mark BOSTON TEA PARTY for tea was found not to be confusingly similar to the mark BOSTON SEA PARTY for restaurant services because the Board believed that consumers would not be confused between a very familiar term, BOSTON TEA PARTY, and a novel one, BOSTON SEA PARTY; especially when one was applied to

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85. 7-Eleven, Inc. v. HEB Grocery Co., 2007 TTAB LEXIS 74 (T.T.A.B. Jan. 8, 2007) (not precedential).

86. *Id.* at \*14.

87. *Id.* at \*24.

88. Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926 (C.C.P.A. 1978).

89. Jacobs v. International Multifoods Corp., 668 F.2d 1234, 1236 (C.C.P.A. 1982).

restaurant services and the other was applied to a food product.<sup>90</sup> In another, similar case, the mark POSADA (stylized) for Mexican-style frozen enchiladas was found not to be confusingly similar to the mark LA POSADA for lodging and restaurant services.<sup>91</sup>

The extent of the “something more” test was illustrated in detail in *In re Coors Brewing Co.*,<sup>92</sup> in which the U.S. Court of Appeals for the Federal Circuit held that the fact that many restaurants sell beer does not mean that restaurants and beer are related for likelihood of confusion purposes.<sup>93</sup>

The case began when Coors applied to register the mark BLUE MOON for beer. The examining attorney found that the mark was likely to be confused with preexisting BLUE MOON marks for both wine and restaurant services. On appeal, the TTAB reversed the examining attorney’s refusal to register the mark for wine, but not for restaurant services.<sup>94</sup>

The Board found that beer and restaurant services were related, based on the evidence submitted showing that (1) a number of brewpubs are also restaurants, (2) some restaurants that are not brewpubs nonetheless sell their own private-label beer, and (3) some businesses have obtained registrations for beer and restaurant services under the same mark.<sup>95</sup> Under this line of reasoning, the Board concluded that consumers were likely to assume that Coors’s beer and the restaurant services offered by the registrant emanated from the same source, even though there was no evidence that the registrant brewed its own beer.<sup>96</sup>

One of the Board’s administrative judges strongly dissented:

Many restaurants serve an extremely wide array of food and beverage items. If the mere fact that many restaurants serve a particular food or beverage items was sufficient to meet the “something more” requirement, then the “something more” requirement would become meaningless. Virtually every food or beverage item could be found in a substantial number of restaurants, and most food and beverage items could be found in the majority of restaurants. In finding no likelihood of confusion when the identical mark was used for restaurant services and an array of food items, another Court of Appeals

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90. *Id.* at 1236-37.

91. *In re Central Soya Co.*, 1984 TTAB LEXIS 202 (T.T.A.B. Jan. 18, 1984).

92. 343 F.3d 1340, 1345 (Fed. Cir. 2003).

93. *In re Coors Brewing Co.*, 2002 TTAB LEXIS 497 (T.T.A.B. July 31, 2002).

94. *Id.* at \*24-26.

95. *Id.* at \*12.

96. *Id.* at \*13.

summed matters up nicely when it stated that “about the only things they have in common are that they are edible.”<sup>97</sup>

Agreeing with the dissent, the Federal Circuit Court reversed the TTAB.<sup>98</sup> Coors had introduced as evidence the ratio of the number of brewpubs, microbreweries, and regional-specialty breweries in the United States to the number of restaurants, and had demonstrated that even if all brewpubs, microbreweries, and regional-specialty breweries featured restaurant services, those establishments would constitute fewer than one in 500. The evidence also showed that only a very small number of restaurants actually brew their own beer or sell house brands of beer. Thus, the court found that it was uncommon for restaurants and beer to share the same trademark, and it concluded that the degree of overlap between restaurant services and beer with respect to source was *de minimis*.<sup>99</sup> The court also noted that to uphold the Board’s finding of confusion would effectively overturn the *Jacobs* requirement for “something more.”<sup>100</sup> It did, however, note that the outcome would have been different had the registrant’s mark been used for a brewpub or for restaurant services and for beer.<sup>101</sup>

In contrast, in 2007, the TTAB sustained a Section 2(d) opposition to the registration of the mark EL MAGO for restaurant services, finding the mark confusingly similar to an identical mark registered for rice and rice mixes.<sup>102</sup> The Board noted evidence of a “growing trend” among restaurants to license the use of their food item marks, as well as an increase in the number of registrations in which the registrant uses the same mark for both restaurant services and a variety of products. According to the Board, those circumstances created a sufficient likelihood of confusion.<sup>103</sup> The outcome in the EL MAGO case, combined with the increase in licensing and diversification in the restaurant industry, will likely make the *Jacobs* “something more” test easier to overcome for many restaurants. Thus, one can expect to see an increasing number of holdings of likelihood of confusion between restaurant service marks and food marks.

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97. *Id.* at \*32 (quoting *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 261, 205 U.S.P.Q. 969, 977 (5th Cir. 1980)).

98. *In re Coors Brewing Co.*, 343 F.3d 1340 (Fed. Cir. 2003).

99. *Id.* at 1346.

100. *Id.* at 1347. See *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234 (C.C.P.A. 1982).

101. *Id.*

102. *Riviana Foods Inc. v. Romero-Nuneez*, Opposition No. 911167098 (T.T.A.B. July 24, 2007) (not precedential).

103. *Id.*

Restaurant services and food item marks are also likely to be found confusingly similar when the marks involved are unique and there are no other similar third-party marks. This was the case when the mark MUCKY DUCK for mustard was found to be confusingly similar to THE MUCKY DUCK restaurant.<sup>104</sup> Marks for restaurant services and food and beverage items that involve identical cuisine are also more likely to be found to be confusingly similar, such as when the mark AZTECA MEXICAN RESTAURANT was found to be confusingly similar to the mark AZTECA for Mexican food items.<sup>105</sup>

Finally, the number of cases finding a likelihood of confusion may rise because of the overlap between the food industry, the entertainment industry, and merchandising.

For example, the celebrity chef Rachel Ray has several trademarks for a wide range of goods and services, including kitchen appliances, information about food preparation, magazines, cookbooks, educational programs, and charitable fundraising.<sup>106</sup> This diversification by food professionals and restaurants is likely to create a large zone of expansion for any given mark, and the food industry is likely to run into a higher number of future conflicts with trademarks in traditional entertainment and media fields.<sup>107</sup>

#### 4. Restaurant Trade Names

Restaurant trade names that are not registered as federal trademarks are also protected under common law trade name rights, in which geographical proximity is a factor. However, the fact that two similarly named restaurants are geographically removed from one another does not necessarily mean there is no violation of trade name rights.<sup>108</sup> For example, a restaurant in New

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104. *In re Mucky Duck Mustard Co.*, 6 U.S.P.Q.2d 1467 (T.T.A.B. 1988).

105. *In re Azteca Rest. Enters., Inc.*, 50 U.S.P.Q.2d 1209, 1212 (T.T.A.B. 1999).

106. These registrations include YUM-O, Reg. Nos. 3,485,852, 3,485,851, 3,485,840; EVERY DAY WITH RACHEL RAY, Reg. No. 3,143,630; RACHEL RAY 30 MINUTE MEALS, Reg. No. 3,263,247; and others. See also HARD ROCK CAFE for acoustic and electric guitars, Reg. No. 3,081,882; restaurant services, Reg. No. 1,397,180; T-shirts, Reg. No. 1,408,637; entertainment services, Reg. No. 2,006,584; and toys, Reg. No. 2,052,776.

107. Indeed, restaurant owners should be wary of choosing restaurant names taken from songs. See *James W. Buffett v. Cheeseburger in Paradise, Inc.*, Civ. A. No. CV 98-1730 CM (C.D. Cal. June 8, 1999), where the U.S. District Court for the Central District of California determined that Jimmy Buffett had priority to use the trademark CHEESEBURGER IN PARADISE, having coined the phrase in a song he wrote and recorded before the opposer began using the name for restaurant and bar services. However, it is unclear whether the priority was based on the mere recording of the song or whether Mr. Buffett had actually used that phrase for restaurant services before the other party did.

108. *Lincoln Rest. Corp. v. Wolfies Rest., Inc.*, 291 F.2d 302, (2d Cir. 1961).

York named Wolfies was found to be palming off the Wolfies restaurant in Miami Beach;<sup>109</sup> the Stork Club, a New York nightclub, obtained an injunction against a San Francisco tavern, thereby preventing the tavern's use of the same trade name;<sup>110</sup> and Paris's Maxim's restaurant obtained an injunction against a New York restaurant that was using the same trade name and design features as the Parisian restaurant.<sup>111</sup>

#### IV. USING A TRADEMARK REGISTRATION TO SECURE AN ADVERTISING CLAIM REGARDING A FOOD ITEM

Restaurants often boast in their advertising that they were the first to invent a certain food item. A clever way to secure such a claim is to incorporate it right in the restaurant's trademark. Then, if another restaurant attempts to make the same claim of being "the first," the trademark owner can allege trademark infringement, which may be easier to prove than a claim of false advertising.

This occurred in a recent lawsuit over who had the right to claim that he was the first to invent the Philadelphia cheesesteak sandwich and to use a trademark that incorporated this claim.<sup>112</sup> This was no small matter for the litigants: cheesesteaks, a Philadelphia-originated food composed of a combination of fried steak with melted cheese and fried onions on a roll, are credited with drawing more than 27 million tourists to the city.<sup>113</sup> The litigants, the owners of Pat's King of Steaks ("Pat's") and Rick's Original Philly Steaks ("Rick's"), were both grandsons of Pat Olivieri, the individual credited with inventing the Philadelphia cheese steak sandwich in the 1930s. The lawsuit erupted after the owner of Rick's made references to Pat's during a nationally broadcast television interview, allegedly linking himself to Pat's and, in doing so, creating a connection between Rick's and Pat Olivieri. Pat's asserted that only Pat's could be known as the restaurant associated with the original inventor of the Philadelphia cheesesteak sandwich. As a result, Pat's sued Rick's

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109. *Id.*

110. *Stork Rest. v. Sahati*, 166 F.2d 348 (9th Cir. 1948).

111. *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332, 20 Misc. 2d 757 (Sup. Ct. 1959).

112. *Cousins Feud in Philly Cheesesteak Suit*, Wash. Post, Oct. 18, 2008, available at <http://washingtonpost.com/wp-dyn/content/article/2006/10/18/AR2006101802108>; see also Jef Feely, *Philadelphia Food Fight Lands Cousins' Cheesesteaks in Court*, Bloomberg.Com, Dec. 7, 2006, available at <http://www.bloomberg.com/apps/news?pid=20601109&sid=aBUu3DF33W.8&refer=news>.

113. *Id.*

for trademark infringement, trade name infringement, and unfair competition, including allegations of the infringement of the marks PAT'S KING OF STEAKS ORIGINATORS OF THE STEAK SANDWICH and PAT'S KING OF STEAKS.<sup>114</sup> Pat's asked the court to enjoin Rick's from using the mark PAT'S KING OF STEAKS or any other confusingly similar mark. Unfortunately, the issues ultimately went undecided. On January 15, 2008, the U.S. District Court for the Eastern District of Pennsylvania determined that the action could not proceed to trial and disposition because of a pending resolution on the issue of ownership of Pat's corporation.<sup>115</sup>

The case is intriguing, because, rather than relying solely on a Lanham Act Section 43 false advertising claim<sup>116</sup> surrounding its product (e.g., being the first to invent something), Pat's used a trademark registration to support its claim of being the first to create the Philadelphia cheesesteak sandwich and to gain an additional basis for seeking an injunction against a competitor. This appears to be one of the few trademarks of its kind in the restaurant industry. Therefore, restaurant owners who want to assert a claim of being the first at anything should consider including this claim in their registration applications, as Pat's did.

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114. Reg. Nos. 2614975, 1017732.

115. *Pat's King of Steaks, Inc. v. Rick's Original Philly Steaks, Inc.*, No. 06-4613 (E.D. Pa. 2008). Compare *Great Am. Rest. Co. v. Domino's Pizza LLC*, 2008 U.S. Dist. LEXIS 32495 (E.D. Tex. Apr. 21, 2008), where the U.S. District Court for the Eastern District of Texas held that a Brooklyn pizzeria holding the mark BROOKLYN'S OLD NEIGHBORHOOD STYLE PIZZERIA was unable to prevent Domino's from using the slogan Brooklyn Style Pizza because the slogan was generic and/or descriptive, and that there was no likelihood of confusion based on the differences between the restaurants (one was a sit-down high-quality pizzeria; the other was primarily a takeout/delivery service).

116. Section 43(a) provides:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

## V. THE NAME OF THE CHEF AS A TRADEMARK

In what seems to be a developing trend within the universe of celebrity chefs, several famous chefs, such as Emeril, Paul Prudhomme, and Bobby Flay, have registered their names for use in connection with restaurant services, food preparation and food demonstration, television shows, spices, and dinnerware.<sup>117</sup> As professional food celebrities proliferate, even some lesser-known chefs are beginning to assert their own trademark rights. Carl Lewis, an executive chef in a private catering business, recently sued his former employer for continuing to reference his name in the former employer's wedding package advertising materials, alleging false advertising under Lanham Act Section 43(a)(1).<sup>118</sup> The defendant argued, among other things, that the chef's name was not a valid and legally protectable mark. However, the court found that the chef's experience, his length of time in the industry, his customary interactions with the public to promote his wedding packages, and the commercial success of those wedding packages all contributed to the creation of the public's association of the name of the chef and the chef's services, and thus arguably created a secondary source-identifying meaning in the chef's name.<sup>119</sup> The court stated that a personal name can serve as a protectable trademark if the name can be shown to identify services (e.g., catering or event planning) at the time the employer begins using it.<sup>120</sup> Therefore, employers hiring a well-known chef should consider obtaining a license for use of the chef's name as a trademark.

When such issues are not appropriately addressed contractually, courts are hesitant to allow companies to continue to use the name of an individual after that individual's employment with the company ends. A case involving the professional ice skater John Curry is illustrative of this issue, and the court's holding should be applicable to the restaurant industry.<sup>121</sup> Curry left a company with which he had a three-year agreement for an ice skating show that featured the use of his name: "The John

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117. See EMERIL'S for restaurant and bar services, Reg. No. 2,176,213; EMERIL for dinnerware, glassware, pots and pans, Reg. No. 2,467,770; EMERIL for cooking demonstrations; entertainment services in the nature of a television series featuring food, Reg. No. 3,388,339; CHEF PAUL PRUDHOMME'S for seasonings, Reg. No. 1,433,127; CHEF PAUL PRUDHOMME'S ALWAYS COOKING! for entertainment services, namely, a television series in the field of cooking, Reg. No. 3,400,217; FOOD NATION WITH BOBBY FLAY for a television series featuring food and the culinary arts, Reg. No. 2,869,910.

118. *Lewis v. Marriott Int'l, Inc.*, 527 F. Supp. 2d 422 (E.D. Pa. 2007).

119. *Id.* at 427.

120. *Id.* at 426.

121. *John Curry Skating Co. v. John Curry Skating Co.*, 626 F. Supp. 611 (D.D.C. 1985).

Curry Skating Company” and “The John Curry Skaters.” When Curry joined another ice show that featured his name, his former company sought an injunction. After considering the contractual and Lanham Act issues, the U.S. District Court for the District of Columbia refused to enjoin Curry from using his name with the new company, finding that his former employer had failed to develop a secondary source-identifying meaning in Curry’s name.<sup>122</sup> The court found, moreover, that the contract between the parties was for the personal services of Curry and not for the sale of his skating skills, his name, or the goodwill that existed in his name.<sup>123</sup> The right to use Curry’s name for three years was coterminous with his performance of services under the contract.<sup>124</sup> The court stated, “The interest an individual has in conducting an enterprise under his own name, using his own skills and knowledge, is protected by the Courts, and his right to use his name will not be lightly wrested from him.”<sup>125</sup>

## VI. THE SIGNATURE DISH

The idea of a “signature dish” raises a combination of trademark and trade dress issues. Wikipedia, the Internet’s community encyclopedia, defines “signature dish” as follows:

[A] recipe that identifies an individual chef. Ideally it should be unique and allow an informed gastronome to name the chef in a blind tasting. It can be thought of as the culinary equivalent of an artist finding their own style, or an author finding their own voice. . . . In a weaker sense, a signature dish may become associated with an individual restaurant, particularly if the chef who created it has since moved on or died.<sup>126</sup>

It is clear from the cases discussed above that the name of a signature dish may be protected as a trademark if it is not merely descriptive of the dish and otherwise serves to identify it, distinguish it, and indicate its source; but what of the taste and presentation of the dish? It remains to be seen how much protection the courts will be willing to give to any signature dish; however, aspects of the appearance and presentation of the dish should be protectable as trade dress.

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122. *Id.* at 615.

123. *Id.* at 616.

124. *Id.*

125. *Id.* at 615 (citation omitted).

126. [http://wikipedia.org/wiki/signature\\_dish](http://wikipedia.org/wiki/signature_dish) (last visited July 13, 2009).

Distinctive product shapes and packaging of a signature dish may also be protectable through trademark law. Pepperidge Farm was successful in obtaining trademark protection for the shape of its famous goldfish crackers, and it was able to prevent Nabisco from selling similarly shaped crackers.<sup>127</sup> Pepperidge Farm moved for a preliminary injunction against Nabisco's use of fish-shaped crackers in its snack product and marketing materials, alleging trademark infringement and trademark dilution. The Nabisco snack product was a joint venture between Nabisco and the cable television channel Nickelodeon, in which Nabisco created crackers that resembled characters from Nickelodeon's cartoon show *CatDog*, including a fish-shaped cracker. The U.S. District Court for the Southern District of New York found no likelihood of confusion between Nabisco's use of a fish-shaped cracker and Pepperidge Farm's GOLDFISH trademark, but it upheld the injunction based on Pepperidge Farm's dilution claim.<sup>128</sup>

Affirming the lower court's decision, the U.S. Court of Appeals for the Second Circuit found that the goldfish shape of Pepperidge Farm's product was "reasonably distinctive" based on the following factors: the massive marketing for the product; the trademark registrations for the word mark and the design; the fact that a fish shape has no logical relationship to a cheese cracker; and the fact that there were no other similar types of crackers.<sup>129</sup> Nabisco argued that its use of a fish-shaped cracker was not a trademark use, but the court disagreed, finding that Nabisco's relationship with promoting trademarked Nickelodeon characters through fish-shaped crackers constituted actionable trademark use.<sup>130</sup> This case indicates that restaurant owners wishing to protect a distinctive food shape should attempt to register the food item in the form of a design mark and promote the food shape sufficiently to create secondary meaning.<sup>131</sup>

In *In re World's Finest Chocolate, Inc.*,<sup>132</sup> a candy manufacturer was allowed to register a design trademark for the package of its candy bar when (1) the package identified and distinguished the manufacturer's goods, (2) the record did not establish the use of such packaging by its competitors, and (3) the design was not so functionally oriented as to require denial of the

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127. *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999), *overruled in part on other grounds by* *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

128. *Id.* at 214.

129. *Id.* at 217-18.

130. *Id.* at 223.

131. Pepperidge Farm's design trademarks for its goldfish shape are Reg. Nos. 1,640,659 and 1,845,811.

132. 474 F.2d 1012 (C.C.P.A. 1973).

private right to exclusive use in favor of a more pressing public interest in copying.<sup>133</sup>

Thus, a “unique shape of food” or “unique food packaging” can be added to the list of possible things that restaurateurs can claim as a proprietary trademark.<sup>134</sup> However, as with any trademark, it is essential that the unique shape or packaging of the food perform the function of identifying, distinguishing, and indicating the source of the goods or services; guaranteeing their quality; or possessing inherent advertising appeal that serves to create a market for the dish. A design of a food or packaging will not be considered to serve as a trademark if the shape is considered to be merely functional.<sup>135</sup>

This reasoning should apply to a chef’s signature dish as well. Although a chef would never be able to trademark a piece of lasagna in the shape of a square, trademark principles suggest that a chef should be able to trademark lasagna that is shaped, for example, like a car, provided the car-shaped lasagna serves to identify the chef, to distinguish the chef from other chefs, and to indicate the chef as the source of car-shaped lasagna. The car shape of the lasagna would not perform any function, and as long as the shape performed an identifying function, it should not be viewed as merely ornamental.

In addition, there is an argument that a decorative ingredient used in a signature dish could be protected under trade dress principles. For example, if it could be demonstrated that the appearance of an unusual food—say, a glob of grape jelly on top of a piece of lasagna—created a visual effect that served to identify and distinguish the signature dish and its source, one could argue that this particular combination of foods acted as distinctive trade dress or packaging.<sup>136</sup> Indeed, in *Nabisco*, the court noted the color

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133. *Id.*

134. Section 45 of the Lanham Act provides, in relevant part: “The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” Under Section 2 of the Act, generally, “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature. . . .”

135. See *Liberty Mut. Ins. Co., v. Liberty Ins. Co.*, 185 F. Supp. 895, 902 (E.D. Ark. 1960).

136. If the grape jelly were used as an ingredient of the dish, rather than simply placed on top of the dish, it is very likely that such use would be viewed as functional and denied trademark protection. However, a recipe for a signature dish may be protectable under trade secret law, 18 U.S.C. § 1832, and the design of the dish may be protectable under copyright law if it contains sufficient creativity and is original to the chef. 17 U.S.C. § 102.

and taste of the food item in its determination of trademark protection, going so far as to describe Pepperidge Farm's the mark as consisting of an "*orange, bite-sized, cheddar cheese-flavored, goldfish-shaped cracker*"<sup>137</sup> (emphasis added) in discussing why Nabisco's sale of a similar type of cracker would be considered actionable trademark use.

Based on the cases above, the name, shape, and packaging of the signature dish may be protectable as trademarks, and other distinctive elements of the signature dish may be protectable as trade dress.

## VII. CONCLUSION

In summary, restaurant owners should look at *all* the elements of their operations, including the literal, visual, and edible forms, and plan for ways to protect them under trademark law. They should review their restaurant to determine which elements thereof could be categorized as their trade dress. They should seek federal registration of the trade name of their restaurant as a service mark, their menu item names as trademarks, and their décor as trade dress. If any of their key menu items contain merely descriptive terms, they should work to develop a secondary source-identifying meaning in those descriptive items.

In addition, the owners should seek to register as trademarks any distinctive food shapes or packaging appearing in their menus. They should also engage in cross-branding of products with their restaurant trade name to strengthen their service mark status. They should consider adding any advertising claims, such as being the first to invent a food item, to a word mark registration application. If they employ a well-known chef, they should secure their right to use the chef's name through a trademark license that will extend beyond the chef's employment and work to develop a secondary source-identifying meaning in those chef names.

Finally, the owners should strive to make as many elements of their restaurants as distinctive as possible. In general, the more distinctive the elements, the more likely it is that they will be protectable from misappropriation under the trademark laws.

In addition to the trademark issues covered in this article, restaurant owners should also consider protecting the elements of their businesses under copyright, trade secret, and general contract law principles as well.

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137. Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 212 (2d Cir. 1999).