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RESTAURANTS and TRADEMARKS: A Lesson from the Real World

By RIW on October 26, 2016



There have been two intriguing local trademark cases involving restaurants lately, both of which provide a useful lesson in trademark law.

First, there was the Milk Street Café v. Milk Street Kitchen dispute. Celebrity chef Christopher Kimball plans to use the mark “Milk Street Kitchen” for cooking classes, a television show and a magazine. Milk Street Café, in business since 1981, worried about consumer confusion, filed a complaint.

The second case involves local chain Tasty Burger and Chipotle. Chipotle is launching a burger restaurant they plan to call “Tasty Made.” The proposed Tasty Made logo and other elements of the Tasty Made branding also have a similar look and feel to those of Tasty Burger, as can be seen here:

TASTY BURGER (SINCE 2010)	CHIPOTLE'S 'TASTY MADE' (FILED JULY 29, 2016)
	
	

Both complaints, in my opinion, are valid. Both challenged marks are similar enough to the senior mark to create a likelihood of confusion amongst consumers, which is the legal standard (not actual confusion, which can be a persuasive factor, but is not necessary).

Now, the lesson:

Choose distinctive marks. Milk Street Café is a descriptive mark – a café on Milk Street (geographically descriptive). Milk Street Café has trademark rights only because of its long use – the mark has acquired distinctiveness. A more fanciful, arbitrary or suggestive mark, such as RIW clients, Douzo, Papagayo,

Blue Ox, Piattini, or b.good, provides more protection without the long and arduous task of acquiring distinctiveness over time. I am sure you can see how much easier it would be to enforce against, say, Dozo, Green Ox, Papagato, or UGood, using the examples above. In other words, because the marks are inherently more distinctive, they are easier to enforce. In addition, people are less likely to even choose similar marks when the mark is distinct, so the uniqueness of the mark does some of the enforcement for you. In this case, Milk Street Kitchen may argue that they should be able to name their proposed kitchen on Milk Street, “Milk Street Kitchen,” and but for the long use by Milk Street Café, they would be correct. This is why trademark law does not favor descriptive marks, and the USPTO will not register such marks absent a showing of long and exclusive use resulting in the requisite acquired distinctiveness. Otherwise, the result is like having a monopoly on words that others may need to legitimately describe their own goods or services.

Tasty Burger has the same issue. “Burger” is obviously descriptive. “Tasty” is arguably also descriptive, but the chain has been around for six (6) years and has acquired distinctiveness in this mark. Without the acquired distinctiveness claim, Tasty Burger would have to tolerate all kinds of similar marks, because absent that, one cannot claim exclusive rights to words which describe their goods or services. Compare this situation to that of another RIW client, Wahlburgers. Although the “burgers” portion of the mark is descriptive, it is an inseparable part of the mark, coupled with the distinctive, “Wahl.” With this inherent distinctiveness, another company would be hard-pressed to say it should be allowed to use, for example, Wallyburgers, or Waburgers, or anything similar, because the Wahlburgers mark is strong from the start. It doesn’t even need acquired distinctiveness.

So, I know it is tempting to name your new establishment something that tells consumers instantly what it is. Trust me though – this is a short cut that is not worth it. The headache (and cost) of trying to register and enforce a descriptive mark greatly outweighs the immediate gratification. Focus on fanciful, made up marks (i.e. TreyLa), arbitrary marks (Book Store) or suggestive marks (Cozy). The more distinctive mark requires a bit more marketing to build up brand recognition with customers, but in the end, you will have a strong, distinctive, recognizable, registerable and enforceable mark. So listen to your trademark attorney – get your creative juices flowing and choose your marks wisely.

Stacey C. Friends is an attorney in RIW’s **Trademark**, and **Hospitality & Retail Services** Groups. She can be reached at scf@riw.com.

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