

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 75/416235		APPLICANT CHIPOTLE MEXICAN GRILL, INC.		PAPER NO.	
MARK CHIPOTLE				ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513	
ADDRESS SCOTT S HAVLICK HOLLAND & HART LLP 555 17TH ST STE 3200 DENVER CO 80202		ACTION NO. 02		If no fees are enclosed, the address should include the words "Box Responses - No Fee."	
		MAILING DATE 04/14/99		Please provide in all correspondence:	
FORM PTO-1525 (5-90)		U.S. DEPT. OF COMM. PAT. & TM OFFICE		1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.	
		REF. NO. 23565-0001			

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/416235

This letter responds to the applicant's communication filed on February 24, 1999.

The Office has reassigned this application to the undersigned examining attorney.

In view of applicant's submission the refusal to register under Trademark Act Section 2(d) is withdrawn.

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified services.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and made FINAL.

Whether or not the designation sought for registration is merely descriptive in a service mark sense must be considered in relation to the services for which registration is sought, the context in which

it is used, the possible significance of the designation in relation to the services and the likely reaction thereto by the average purchaser. *In re International Spike, Inc.*, 190 USPQ 505 (TTAB 1976).

Applicant is attempting to register CHIPOTLE for "restaurant services" in International Class 42.

The dictionary defines the term as:

Chipotle: *Mexican Cookery.* A pungent red pepper, often pickled and eaten as an appetizer or added to meat stews, sauces, etc.

The specimens of record contained the following statements (emphasis added):

Barbacoa

Shredded beef braised with **chipotle** peppers, cumin, cloves and garlic, served in a giant flour tortilla with pinto beans, cilantro-lime rice, sour cream, and hot tomatillo-green chili salsa

The question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one who sees the mark alone can guess what the applicant's services are, but rather in relation to the services for which registration is sought, that is, by asking whether, when the mark is seen used in connection with applicant's services, it immediately conveys information about their nature. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

In the present case the designation sought for registration is merely descriptive of the identified services. It immediately tells customers information about applicant's restaurant that they used Chipotle as part of food items sold.

It is not necessary that a term describe all of the purposes, functions, characteristics or features of the services to be merely descriptive. It is enough if the term describes one attribute of the services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

A term is suggestive if some imagination, thought or perception is required to determine the nature of the services from the term. A suggestive term differs from a descriptive term, which immediately tells something about the services. *In re Aid Laboratories, Inc.*, 223 USPQ 357 (TTAB 1984). A suggestive mark is registrable on the Principal Register. TMEP section 1209.01(a).

Third-party registrations are not conclusive on the question of descriptiveness. The examining attorney must consider each case on its own merits. A mark, which is merely descriptive, is not registrable merely because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

The application indicates use of the mark for a significant time. Therefore, the applicant may amend to seek registration under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), based on acquired distinctiveness. If the applicant chooses to do so by using the statutory suggestion of five years of use as proof of distinctiveness, the applicant should submit a claim of distinctiveness that reads as follows, if accurate.

The mark has become distinctive of the services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

The applicant must provide this statement supported by an affidavit or a declaration under 37 C.F.R. Section 2.20. 37 C.F.R. Section 2.41(b); TMEP section 1212.05(d).

Amos T. Matthews
Examining Attorney
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)	
)	
)	Chipotle Mexican Grill, Inc.
)	a Delaware Corporation
)	
Serial No. :)	75/416,235
)	
Filed :)	January 9, 1998
)	
Mark :)	CHIPOTLE
)	
Class :)	042
)	

Law Office 108
Caryn Hines

CERTIFICATE OF MAILING BY EXPRESS MAIL

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

The undersigned hereby certifies that the attached Amendment and Exhibits A and B, relating to the above application, was deposited as "Express Mail", Mailing Label No. EL216145034US, with the United States Postal Service, addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on February 24, 1999.

February 24, 1999
Date
Feb. 24, 1999
Date

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