



BOX RESPONSES NO FEE  
Attorney Docket No. 40911.840004.000  
Express Mail No. EL216145034US

Grill, Inc. ("Registrant"). The Registrant is the surviving entity of a corporate merger between the Applicant and the Registrant as evidenced in the attached Notice of Recordation of Assignment Document issued by the Patent and Trademark Office ("PTO"), dated May 20, 1998. See Exhibit A attached hereto. The Notice confirms the assignment of the application mark from the Applicant, World Foods, Inc. to the Registrant, Chipotle Mexican Grill, Inc. Consequently, refusal under section 2(d) is unwarranted and the application should be approved for publication.

**II. The Mark Sought to be Registered is Not Descriptive of Applicant's Restaurant Services**

The Examiner has also initially refused registration of the application mark under section 2(e), 15 U.S.C. §1052(e). Applicant respectfully asserts that the Examiner erred in concluding that CHIPOTLE, as applied to restaurant services, is merely descriptive. Under general trademark principles, for a mark to be unregistrable as merely descriptive pursuant to section 2(e), it must "immediately convey to one seeing or hearing it the thought of [applicant's] services." *In re American Society of Clinical Pathologists, Inc.*, 442 F.2d 1404, 1407, 169 U.S.P.Q. 800 (CCPA 1971). Conversely, a suggestive mark requires imagination, thought and perception to reach a conclusion concerning the nature of the goods or services designated. *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968). Applicant submits that the Examiner failed to properly apply these principles in the context of restaurant

services. Consequently, under the applicable standard, the mark CHIPOTLE is, at most, suggestive of Applicant's restaurant services.

**A. Standard Applicable to Restaurant Services**

For purposes of determining whether a mark is suggestive or merely descriptive in the unique context of restaurant services, both the Trademark Trial and Appeal Board (TTAB) and the courts have clearly established that the line between a suggestive mark and a merely descriptive mark is drawn when it is readily apparent that there is a direct relationship between a mark that is used to identify both the name of the establishment and the primary entrees served by the establishment to its patrons. Consequently, for a mark to be found merely descriptive of restaurant services, the proper inquiry is whether the mark is simply a generic name for the central food product ordered by customers of the restaurant, i.e., "the specialty of the house." *In re France Croissant, Ltd.*

1 U.S.P.Q.2d 1238 (TTAB 1986) (where a mark for restaurant services that comprises the generic name of a good which is the specialty of the house, it is merely descriptive); *In re Taylor*, 133 U.S.P.Q. 490, 491 (TTAB 1962) (because there was no common name other than CHUCK-A-BURGER by which the burger-type product could be ordered by customers, the name functioned as a product name rather than as a trademark for the restaurant); *beef & brew, inc. v. Beef & Brew, Inc.*, 389 F. Supp. 179, 185 U.S.P.Q. 531 (D. Or. 1974) (a name that expressly tells the diner what his dinner will be is descriptive).

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Conversely, a mark is suggestive for purposes of restaurant services if it infers or suggests the type or general nature of the cuisine served by the restaurant, rather than to describe the principal food item offered to consumers. *In re Sweet Victory, Inc.*, 228 U.S.P.Q. 959, 961 (TTAB 1986) (GLACE LITE held registrable for sherbet, frozen yogurts and the like); *see also In re General Franchising Corporation*, 169 U.S.P.Q. 55, (TTAB 1971) (LE CREPE held registrable for restaurant services).

Under strikingly analogous facts to those presented here, the TTAB, in *In re Registry Hotel Corporation*, 216 U.S.P.Q. 1104 (TTAB 1983), further defined the demarcation between suggestive and merely descriptive marks in the context of restaurant services. Concluding that the mark LA CHAMPAGNE was not descriptive of restaurant services, the Board reasoned that the mark “served a function different from that of merely informing customers that champagne is served in the applicant’s restaurant.” *Id.* At 1105. Instead, the mark was “suggestive of French cuisine in general and not descriptive of a particular wine or beverage served by the applicant.” *Id.*

**B. Applicant’s Mark is Suggestive of its Restaurant Services**

Turning to the instant application, like the *Registry* case, Applicant’s use of the word, CHIPOTLE, does not describe, with any degree of specificity, Applicant’s restaurant services. Rather, the mark serves, at most, to communicate to customers the general type or nature of the cuisine served at Applicant’s restaurant, i.e., spicy foods originating from Mexico. As further evidenced from the attached menu displaying

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Applicant's entree selections, CHIPOTLE, is clearly not the "specialty of the house." Moreover, CHIPOTLE, while an ingredient for one of Applicant's many sauces, is certainly not an item that customers could independently order. See Applicant's menu, attached as Exhibit B hereto. Consequently, both imagination and thought is required for customers of Applicant's restaurant to reach a conclusion as to the nature of the services offered.

The Examiner's finding that Applicant's mark is descriptive because it is the name of a "spice" and, as such, "conveys to purchasers dining at the restaurant that they will be served food seasoned with chipotle" is a misapplication of the legal standard relevant to determining whether a mark is suggestive or merely descriptive with respect to restaurant services. Indeed, the Examiner's position directly conflicts with the numerous existing trademark registrations and/or marks authorized for registration by the PTO on the Principal Register for restaurant services. Some examples include:

<u>Mark</u>	<u>Reg. No./ Serial No.</u>	<u>Class</u>	<u>Goods/Services</u>
CILANTRO'S	1,528,945	042	Restaurant Services
EPAZOTE	2,028,993	042	Restaurant Services
ANCHO'S	1,877,080	042	Restaurant Services
THE BLACK EYED PEA	1,486,543	042	Restaurant Services
CHILI'S	1,104,978	042	Restaurant Services

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<u>Mark</u>	<u>Reg. No./ Serial No.</u>	<u>Class</u>	<u>Goods/Services</u>
THE GARLIC CLOVE	1,731,926	042	Restaurant Services
MACARONI GRILL	1,973,724	042	Restaurant Services
RED TOMATO	1,917,478	042	Restaurant Services
LETTUCE	1,672,175	042	Restaurant Services
SWEET BASIL	1,963,810	042	Restaurant Services
BASILICO (basil)	1,788,671	042	Restaurant Services
THYME	published	042	Restaurant Services

Notably, all of the above references are word-only marks, free from any graphic design or other stylized features.

The burden of proof to establish that a mark is merely descriptive is on the Examining Attorney, and any doubts surrounding the registrability of the mark are to be resolved in Applicant's favor. *In re Shutts*, 217 U.S.P.Q. 363, 365 (TTAB 1983). Here, the Examiner has not established that Applicant's mark is merely descriptive. To the contrary, several of the above-cited registrations for restaurant services were also specifically referenced in the excerpted articles upon which the Examiner exclusively relied for determining Applicant's mark was descriptive, e.g., cilantro, epazote, ancho, chili, garlic clove, basil, and thyme. In short, when analyzed under the applicable legal

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standard, Applicant's mark is not merely descriptive, but rather, suggestive of Applicant's restaurant services.

REVOCATION AND SUBSTITUTED POWER OF ATTORNEY

Pursuant to 37 C.F.R. §2.18, registrant hereby substitutes in place of its previous attorneys and hereby appoints Scott S. Havlick, Donald A. Degnan, Robert G. Crouch, Timothy Getzoff, Elizabeth S. Cohen, Wendy J. Pifher, and Carol W. Burton, members of the Bar of the State of Colorado, whose postal address is 555 17<sup>th</sup> Street, Suite 3200, Denver, Colorado 80202, telephone (303) 473-2710, as its attorneys for application number 75/416,235, with full power of substitution and revocation, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the Certificates of Registration.

All communications, verbal or written, are to be addressed to:

AT  
CD  
[ Scott S. Havlick ]  
[ Holland & Hart LLP ]  
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**CONCLUSION**

For the foregoing reasons, Applicant respectfully requests that this trademark application be approved for publication and ultimately registration.

Dated: February 24 1999.

Respectfully submitted,



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ATTORNEYS FOR APPLICANT  
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DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares: that he is properly authorized to execute this Declaration confirming the factual accuracy of this Amendment on behalf of the applicant; that he believes the applicant to be the owner of the trade mark sought to be registered; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Chipotle Mexican Grill, Inc.

Date: 2-23, 1999

By John Miller  
Mr. John Miller  
Title: Chief Financial Officer

A



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
 ASSISTANT SECRETARY AND COMMISSIONER  
 OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20231

MAY 20, 1998

PTAS



\*100672328A\*

HELLER EHRMAN WHITE ET AL.  
 BETH M. GOLDMAN  
 525 UNIVERSITY AVENUE  
 PALO ALTO, CA 94301

UNITED STATES PATENT AND TRADEMARK OFFICE  
 NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

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BRIEF: MERGER

ASSIGNOR:  
 WORLD FOODS, INC.

DOC DATE: 03/02/1998  
 CITIZENSHIP: COLORADO  
 ENTITY: CORPORATION

ASSIGNEE:  
 CHIPOTLE MEXICAN GRILL, INC.  
 2546 15TH STREET  
 DENVER, COLORADO 80211

CITIZENSHIP: DELAWARE  
 ENTITY: CORPORATION

APPLICATION NUMBER: 75360961  
 REGISTRATION NUMBER:

FILING DATE: 09/22/1997  
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MARK:  
 DRAWING TYPE: MISCELLANEOUS DESIGN

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 78573

1705/0552 PAGE 2

APPLICATION NUMBER: 75380099  
REGISTRATION NUMBER:

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MARK: UNBURRITABLE  
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MARK: CHIPOTLE MEXICAN GRILL  
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.STEVEN POST, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

