

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Don't burn your brand: Intellectual property considerations for restaurants

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UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Discussion topics

- Definitions
- Trademarks
- Trade dress
- Copyrights
- Patents
- Trade secrets
- How to find help

Discussion topics

# Definitions



# What is intellectual property?

- **Real property**
  - Land and buildings
- **Personal property**
  - Furniture, fixtures, and equipment
- **Intellectual property (IP)**
  - Products of the human mind



# What restaurant IP is valuable?

- Restaurant name?
- Restaurant logo?
- Slogan?
- Hashtag?
- Specific menu item name?
- Restaurant design?
- Signature food dish?
- Recipe?
- Plating?



# What restaurant IP is valuable?

- Collateral product?
- Overall menu design?
- Marketing materials?
- Website?
- Customer list?
- Vendor list?
- Music played in restaurant?



# How do you protect valuable IP?

- Secure legal rights.
  - Trademarks
  - Trade dress
  - Copyrights
  - Patents
  - Trade secrets





# Definitions

- Trademark

- Protects any word, slogan, symbol, design, or combination of those that:

- Identifies the source of goods or services

and

- Distinguishes them from the goods or services of another party.



# Definitions

- Trade dress
  - Protects the commercial look and feel of a product or service.
- Copyright
  - Protects an original artistic or literary creation.



# Definitions

- Patent
  - Protects an invention.
- Trade secret
  - Protects information that has value because it is not generally known.

Discussion topics

# **Trademarks: Basics**



# Traditional types of marks

- Standard character marks
  - Word or words
  - Slogan

**MCDONALD'S**

**HAPPY MEAL**

**I'M LOVIN' IT**



# Traditional types of marks

- Standard character marks
  - Word or words
  - Slogan

**#FASTFOODIE**

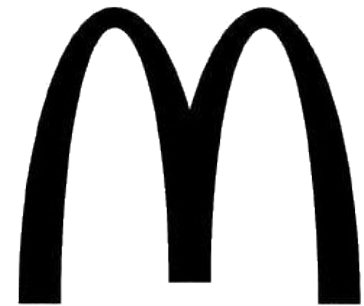
**#STEAKWORTHY**

**#VIVALARITA**

# Traditional types of marks

- Special form marks
  - Stylized
  - Composite
  - Design

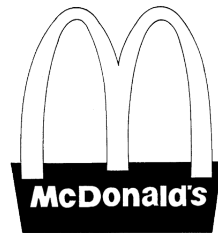
*Ronald McDonald*



# Traditional types of marks

- Use as a restaurant name or logo

**MCDONALD'S**






# Traditional types of marks





- Use as a menu item

**BIG MAC**

**QUARTER  
POUNDER**

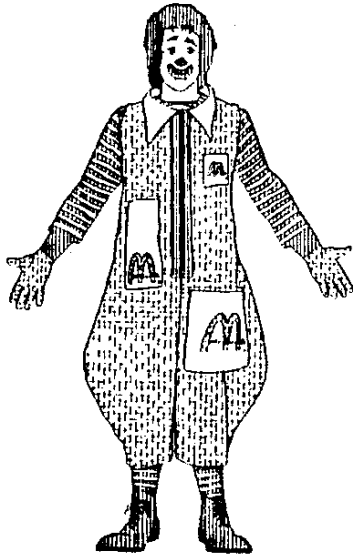
**DOUBLE  
QUARTER  
POUNDER**

**Combo Meals**  Meals include medium fries or side salad and medium soft drink. Pick a different drink or side for an additional charge. Promotion pricing may be lower than meal pricing.

 <b>1</b> Big Mac® meal 7.30   500-1140 Cal. 4.35   540 Cal.	 <b>2</b> Quarter Pounder®† with Cheese Quarter Pounder®†† with Cheese Bacon Quarter Pounder®†† Deluxe meal 7.00   530-1110 Cal. 4.40   510 Cal.	 <b>3</b> Double Quarter Pounder®†† with Cheese meal 7.40   630-1210 Cal. 5.39   610 Cal. meal 6.75   640-1220 Cal. 5.00   620 Cal.	 meal 7.95   740-1320 Cal. 5.49   720 Cal.
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# Non-traditional types of marks

- Configuration/shape/3D mascot



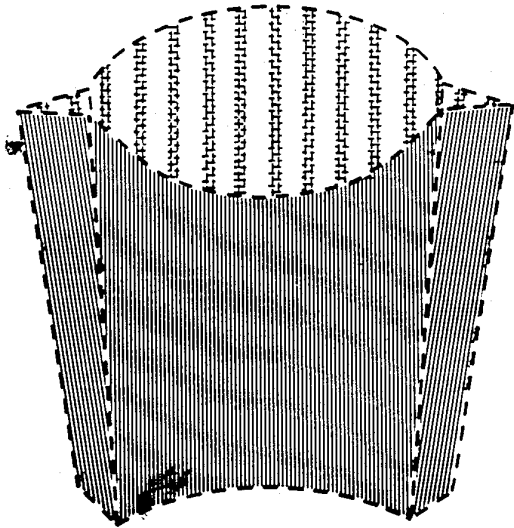
# Non-traditional types of marks

- Configuration/shape/3D mascot



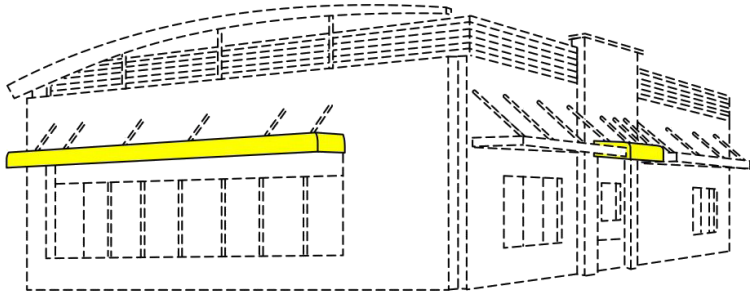
# Non-traditional types of marks

- Color



# Non-traditional types of marks

- Color



Discussion topics

# Trademarks: Rights

# Trademark rights

- Rights can be created two ways
  - Common law
  - Federal registration



# Common law trademark rights

- Rights
  - Created when trademark is used in commerce
  - Limited to geographic area where trademark is used
- Symbols
  - Optional: TM SM
  - Never: ®







# Federal registration rights

- Rights

- Created when trademark registers with the USPTO
- Legal presumption you own the trademark
- Legal presumption you have the right to use the trademark in all 50 states and U.S. territories (but not other countries)





# Federal registration rights

- Rights

- Can claim notice to the public of your rights in the trademark.
- Can bring legal action concerning trademark in federal court.
- Enables recordation of registration with U.S. Customs and Border Protection.





# Federal registration rights

- Rights
  - Can be used as a basis for filing in another country.
- Symbols
  - Permitted: ®

Discussion topics

# Trademarks: Registration



# Trademark selection challenges

- Remember:
  - The mission of the USPTO is to register any trademark that is eligible for registration.
  - Not every trademark is registrable.
  - Not every trademark is enforceable.
  - Select a trademark that is both federally registrable and legally protectable.



# Registrable and protectable

- Two main concepts:
  - Likelihood of confusion
  - Strength of the trademark



# Likelihood of confusion

- Confusion as to source:
  - Are the trademarks confusingly similar?  
and
  - Are the goods and/or services related?



# Suggestions for searching

On your own:

- USPTO database
  - TESS (Trademark Electronic Search System)
  - [www.uspto.gov/search/trademarks](http://www.uspto.gov/search/trademarks)
- The internet
  - Only option for searching for common law use







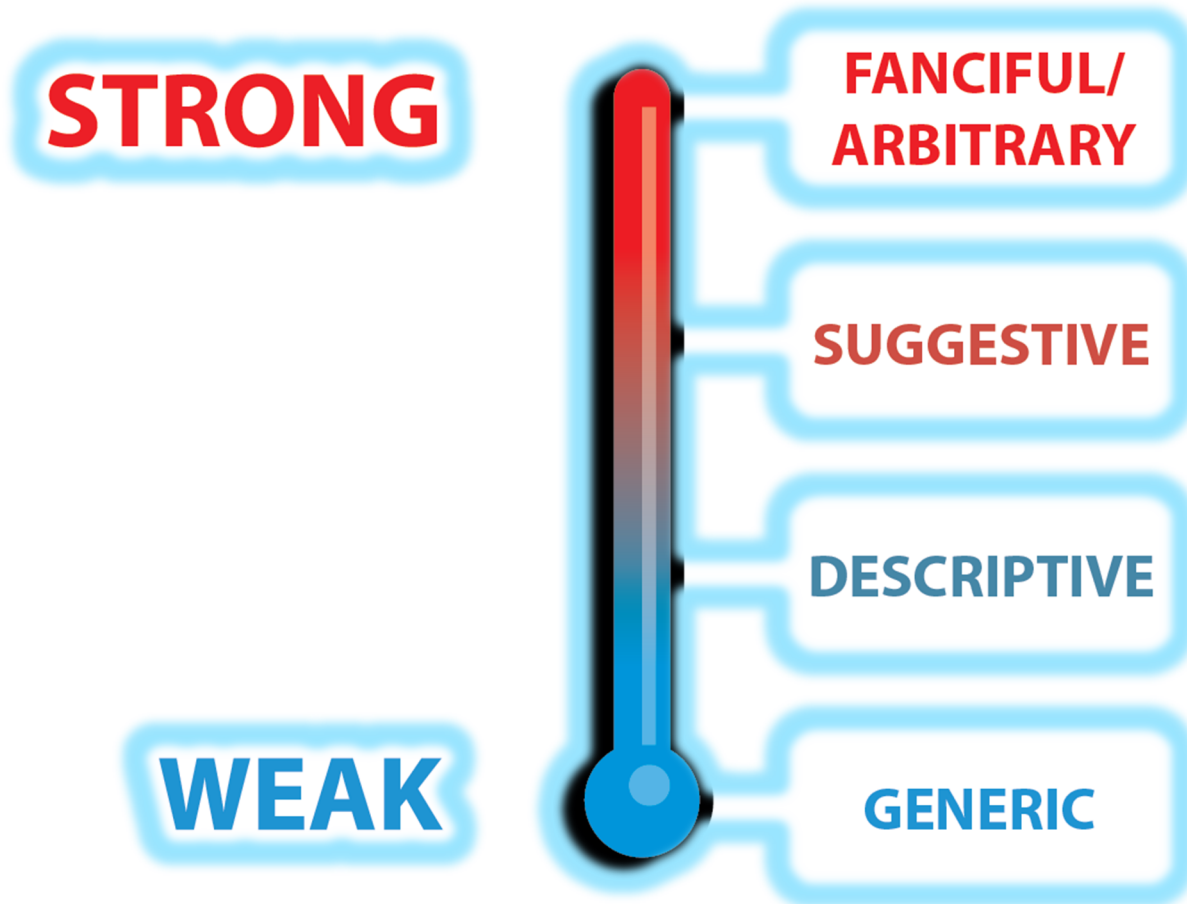
# Trademark clearance search

Hire a private trademark attorney:

- Full clearance search
  - USPTO database of registrations and applications
  - State trademark databases
  - Business name registries
  - Foreign trademark databases
  - The internet



# Strength of trademark





# Strength of trademark examples

- Fanciful
  - STARBUCKS for “coffee café services”
- Arbitrary
  - SONIC for “restaurant services”



# Strength of trademark examples

- Suggestive
  - THE DOUGH ROLLER for “restaurant services”
- Descriptive
  - CALIFORNIA PIZZA KITCHEN for “restaurant services”
- Generic
  - CAFÉ for “restaurant services”



# Trademarks as advertising

- Would the trademark be interpreted as making some sort of advertising claim?
- Is that claim legally substantiated?



# Filing for federal registration

- Create a USPTO.gov account in MyUSPTO.
  - Two-step login process for authentication
  - <https://my.uspto.gov/>
- File using the Trademark Electronic Application System (TEAS).
  - Two filing options: TEAS Plus and TEAS Standard
  - [www.uspto.gov/teas](http://www.uspto.gov/teas)





# Filing for federal registration

- Filing fees per TEAS filing option
  - TEAS Plus: \$250 per international class
  - TEAS Standard: \$350 per international class
- **Formula for calculating filing fee**
  - Your filing option fee multiplied by the number of international classes in the application

# Filing for federal registration

- Mark drawing type
  - Standard character drawing
  - Special form drawing

**COCA-COLA**

*Coca-Cola*







# Filing for federal registration

- Identification of goods and services
  - Generally understood terminology
  - Specific terminology
  - Cannot expand “scope” after filing
  - Trademark ID Manual
    - [www.uspto.gov/trademarkid](http://www.uspto.gov/trademarkid)



# Filing for federal registration

- Filing basis
  - Required for each listed good or service in your application
  - Most common bases
    - Use in commerce
    - Intent to use



# Filing for federal registration

- Common bases for refusal
  - Likelihood of confusion
  - Merely descriptive
  - Geographically descriptive of the origin of the goods/services
  - Specimen does not support use for listed items
  - Mark used in an ornamental manner





# Caution: misleading notices

- All application data becomes public information.
- Beware of misleading notices and offers.
  - Usually for fees not required by the USPTO
  - [www.uspto.gov/trademarksolicitations](http://www.uspto.gov/trademarksolicitations)

Discussion topics

# Trade dress



# Trade dress

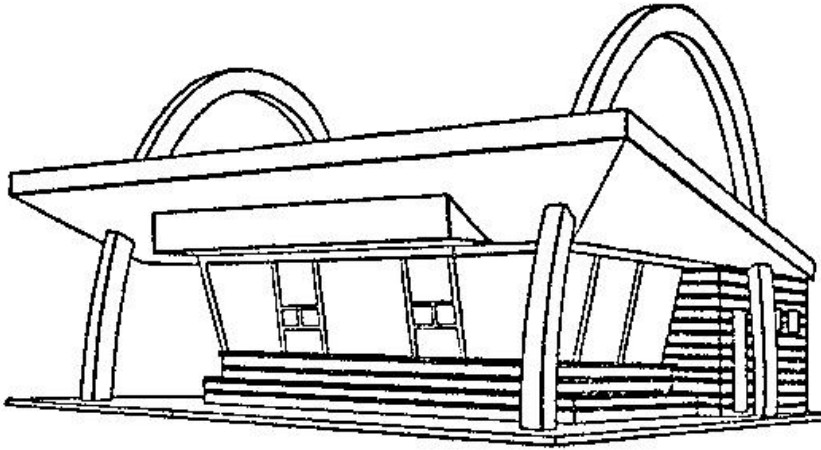
- Common types of trade dress
  - Exterior and interior architecture of the restaurant
  - Signs
  - Interior floor plan
  - Décor



# Trade dress

- Registrable if:
  - Non-functional
  - Distinctive

# Exterior



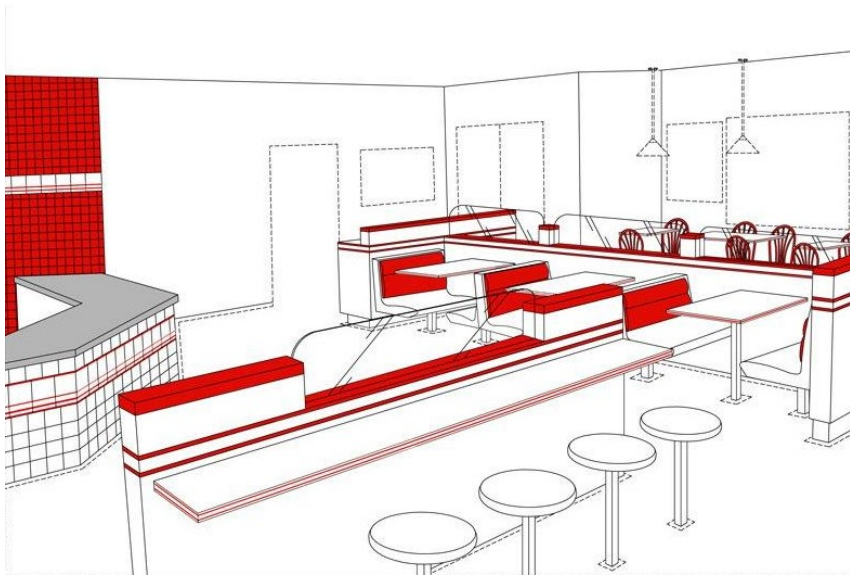


# Exterior

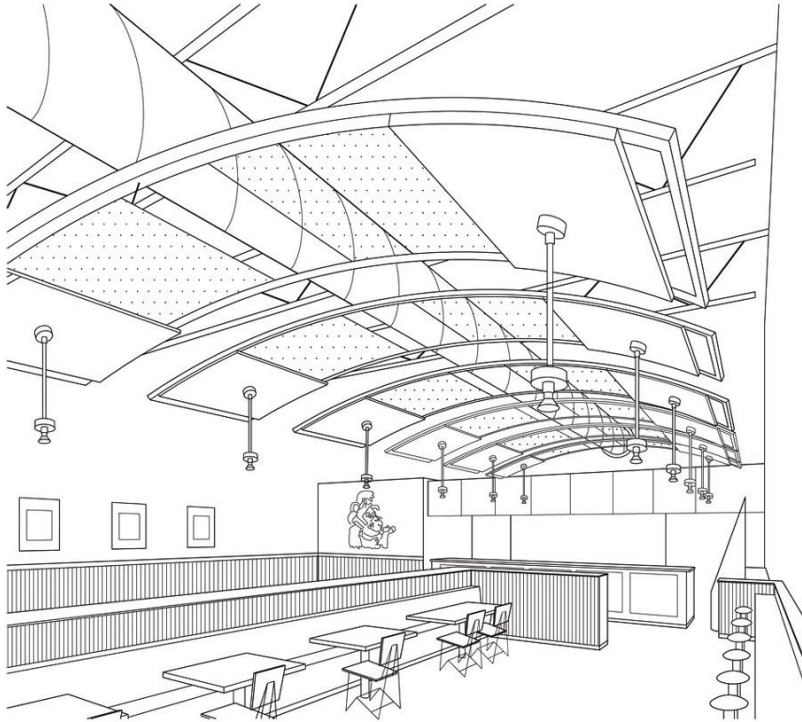


uspto

# Interior



# Interior



uspto



# Plating

- Possibly protectable as trade dress
  - Must have earned a sufficient reputation to indicate the source of the dish.

# Plating



# Plating



# Plating





Discussion topics

# Copyrights





# Recipes

- Not entitled to copyright protection since:
  - Listing of ingredients is mere statement of facts
  - Functional
  - Directions are a procedure, process, or system
  - Does not reflect required amount of creative expression

# Menu design



# Restaurant website



The image shows a screenshot of the Ali Baba Restaurant website. The header is dark red with a scalloped bottom edge. It features a central logo for "Ali Baba RESTAURANT" in a gold oval, with Arabic text "مطعم البابا" below it. Navigation links include "HOME", "ABOUT", "MENU", "ALIBABA CLUB", "CATERING", "NEWS", and "Contact Us". The main content area has a light beige background. A large photo of a plate of food with fried onions, tomatoes, and cucumbers is centered. Below the photo, the text reads: "Ali Baba Restaurant offers the finest Mediterranean & American cuisine in town. Come in and enjoy!". To the right is a dark red button with white text that says "CHECK OUT OUR MENU". At the bottom, there is a line of small text: "For nearly three decades we have been serving the finest authentic Mediterranean and American cuisine" on the left, and "Appetizers & Side Orders" on the right.

HOME ABOUT MENU **Ali Baba RESTAURANT** ALIBABA CLUB CATERING NEWS Contact Us

مطعم البابا

**Ali Baba Restaurant offers the finest Mediterranean & American cuisine in town. Come in and enjoy!**

**CHECK OUT OUR MENU**

For nearly three decades we have been serving the finest authentic Mediterranean and American cuisine

Appetizers & Side Orders

# Plating

- Possibly protectable under copyright
  - Need clarification from courts whether plating creates a sufficiently “fixed” form.





# Architectural design

- **Protectable by copyright**
  - Rights belong to original designer or architect.
  - If you want the rights, you must have them assigned to you in your contract with the architect.

# Music in restaurants

- Protectable by copyright.
  - Copyright prohibits public performance of music without authorization.
  - Playing a song in a restaurant is considered a type of public performance.



# Music in restaurants

- Avoiding infringement
  - Pay for annual licenses from the music performing rights organizations.
  - Pay for a direct license from the copyright owner.
  - Only play live music in public domain.

Discussion topics

# Patents





# Design patent

- Possible protection for food
  - Protection for what food looks like
    - How food is displayed
    - Shape or configuration of food
  - Protection limited to 15 years

# Design patent

U.S. Patent

Jan. 26, 1999

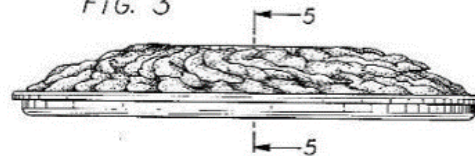
Sheet 2 of 3

Des. 404,612

FIG. 2



FIG. 3







# Utility patent

- Possible protection for food inventions and techniques
  - Protection for new and unique way of preparing a dish
  - Protection limited to 20 years



# Utility patent

- Possible protection for recipe
  - Difficult to protect because combining ingredients does not typically create a new or unexpected result
  - Protection limited to 20 years

Discussion topics

**Trade secrets**



# Trade secrets

- Protection for information, including:
  - Recipes
  - Customer lists
  - Vendor lists
  - Specific manner of food preparation



# Trade secrets

- Elements of secret
  - Is information that has either actual or potential independent economic value by virtue of not being generally known.
  - Has value to others who cannot legitimately obtain the information.
  - Is subject to reasonable efforts to maintain its secrecy.





# Trade secrets

- Some ways to protect a signature dish:
  - Show no one how to create it.
  - Refuse to write anything down.
  - Promote it as your unique creation.

# Signature dish



Discussion topics

# How to find help



# USPTO resources

- Website
  - [www.uspto.gov](http://www.uspto.gov)
- “Basic Facts About Trademarks” booklet
  - [www.uspto.gov/TrademarkBasicsPDF](http://www.uspto.gov/TrademarkBasicsPDF)
- Trademark videos
  - [www.uspto.gov/TMvideos](http://www.uspto.gov/TMvideos)





# USPTO resources

- Law School Clinic Certification Program
  - [www.uspto.gov/LawSchoolClinic](http://www.uspto.gov/LawSchoolClinic)



# USPTO resources

- Trademark Assistance Center
  - Phone: 1-800-786-9199
  - Email: [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)
  - Web: [www.uspto.gov/TrademarkAssistance](http://www.uspto.gov/TrademarkAssistance)

# USPTO resources

- The USPTO does not:
  - Provide legal advice
  - Enforce legal rights
  - Recommend specific private attorneys



# Legal resources

- Remember:
  - Best resource might be an experienced trademark attorney.
  - Best resource might not be a trademark filing company.





# Legal resources

- Free or reduced-price legal services
  - American Bar Association
    - [https://www.americanbar.org/groups/legal\\_services/flh-home/](https://www.americanbar.org/groups/legal_services/flh-home/)
  - International Trademark Association
    - <https://www.inta.org/resources/pro-bono-clearinghouse/>



# Other resources

- Advice and business consulting
  - Patent and Trademark Resource Centers (PTRCs)
    - <https://www.uspto.gov/PTRC>
  - Small Business Development Centers (SBDCs)
    - <https://americassbdc.org/>

TMFeedback@uspto.gov

**Questions?**

# Appendix

- Slide 13: Reg. 0743572, 1299742, and 2978887
- Slide 14: Reg. 5210764, 4695901, and 5035242
- Slide 15: Reg. 4365884, 1505016, and 6086135
- Slide 16: Reg. 0743572, 6086135, and 1287408
- Slide 17: Reg. 1126102, 1017498, and 1453368
- Slide 18: Reg. 1017161
- Slide 19: Reg. 1653279

# Appendix

- Slide 20: Reg. 1440070
- Slide 21: Reg. 4676898
- Slide 35: Reg. 1444549 and 6206940
- Slide 36: Reg. 1267425 and 1637904
- Slide 40: Reg. 0238145, 0238146, and 1867757
- Slide 48: Reg. 764837
- Slide 49: Reg. 4297536

# Appendix

- Slide 50: Reg. 4839216
- Slide 51: Reg. 3128649
- Slide 66: Pat. No. Design 373,452
- Slide 67: Pat. No. Design 423,184

