

Week of 5-2-2012

Q. I am a local restaurant owner and caterer. I have been in the business for over 10 years. I have been selling signature dishes, drinks and deserts for nearly all of those 10 years. I generally come up with really zany ways to decorate and name my dishes.

I recently walked in to a restaurant nearby to find out that the owner was selling a dish nearly identical to mine, with a special sauce and a name that was purely a knock-off. I was so upset by this. I really wanted to say something that minute but decided to hold my tongue until I could get a little extra advice. So, here I am wondering what can I do? The restaurant across the street has to be doing something illegal. No one makes this dish in this way. Everything about it is says me and my restaurant from the colors to the smell. They are stealing my brand. No one else makes this dish this way.

Aggravated Chef – Cleveland, OH

A. Aggravated Chef, I understand your pain. My father was also a chef and caterer. He makes

a Creole tea that taste so good and is so unique you wouldn't dare die for it due to fear that the angels wouldn't be able to reproduce the flavor appropriately. What you are dealing with is another classic case of potential intellectual property infringement. This is another reminder of the need to recognize the inherent value in the things we create and the importance of taking prudent steps to protect that value and guard against those who may be in the position to dilute it.

It is important in this case to distinguish between what seems to be infringement and what actually constitutes infringement. The best way to make this evaluation is to identify your rights, if any, and from where they arise.

A trademark includes any word, name, symbol, device, or any combination, used, or intended to be used, in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others, and to indicate the source of the goods.[1] Likewise, a service mark is any word, name, symbol, device, or any combination, used, or intended to be used, in commerce, to identify and distinguish the services of one provider from services provided by others, and to indicate the source of the services.

Federal law applies a broad definition of "trademark" which stretches the scope of federal trademark protections beyond traditional names and logos to include other less traditional categories of marks, such as shapes, sound, touch, colors, motions, and more.

Your dish would seem to fall in the non-traditional trademark category. The appearance of your dishes, the flair associated with the plate decorations and accourrements, the clever naming, etc. all seem to connect what you create and serve to you as the chef and owner of the creation. Your food is your art and it may very well deserve the same level of protection given to one of Picasso's canvases. Simply because your art is food-based and not oil-based does not mean it should be deprived of the protection of the federal trademark laws.

Non-traditional marks are protected under the United States trademark law. Thus, an owner of a nontraditional trademark may register that mark if it (1) distinguishes one source from another and (2) is neither functional nor descriptive. While common law rights exists immediately, once registered, the owner can more readily exercise the rights associated with such ownership to include demanding that others who infringe those rights cease and desist from continuing all unauthorized and infringing activity. Should the offender continue to infringe the mark, the federal courts will provide recourse.

Before asserting rights, however, we must still make sure that you have rights to assert. In your case, you will have to show that the colors of your dish are purposeful (but not functional or descriptive) and act to distinguish your dish from all others. Your challenge, and that of all potential registrants, is to prove that your mark, whether its confetti cake, black pretzels, or green Bloody Marys, is in fact an indicator of the source of the item or mark. You will have to convince the courts that the average consumer associates the appearance of the dish with you and your restaurant. Thus, it may not be that the dish itself brings you to mind but rather the way in which you garnish the plate.

Nontraditional marks have the potential to serve as powerful tools in conveying the emotions and ideas underlying the most compelling brand. In order to bring action against the restaurateur around the corner you will need to be able to offer some proof of consumer recognition. Color marks are not inherently distinctive but over time, customers can come to treat a particular color on a product or its packaging as signifying a brand. Just think about the Big Brown that is UPS or the vibrant red that signifies Coca-Cola. Other common color marks include (i) Tiffany & Co.'s "robin's-egg" blue used in gift boxes and bags; (ii) Heinz's green ketchup; (iii) John Deere's green and yellow used on its equipment and machinery.

Should you have additional questions, please follow-up with the Counselor at counselorsdesk @call-post.com

Be well and Godspeed.

Aaron A. O'Brien, Esq.

Business attorney and community advocate.

Counselor's Desk Week of 5-2-2012 Friday, 04 May 2012 12:16