

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No.: 3621366	§	
Mark: TACO TUESDAY	§	
Issued: May 19, 2009	§	
	§	
TACO BELL IP HOLDER, LLC,	§	
	§	Cancellation No. _____
Petitioner,	§	
	§	
v.	§	
	§	
GREGORY HOTEL, INC.,	§	
	§	
Registrant.	§	

PETITION FOR CANCELLATION

Petitioner Taco Bell IP Holder, LLC, a Delaware limited liability company, believes “Taco Tuesday” should be freely available to all who make, sell, eat, and celebrate tacos, and therefore petitions to cancel Registration No. 3621366 (the “Registration”) for the “mark” TACO TUESDAY.

PREFACE

A. People like tacos on Tuesdays. They just do. It’s even fun to say: “Taco Tuesday.” Tacos have the unique ability to bring people together and bring joy to their lives on an otherwise mediocre day of the week. But since 1995, Registrant has owned a federal trademark registration for “Taco Tuesday.” Not cool.

B. Because of the Registration, Registrant is the only restaurant in New Jersey that has the presumptive right to use “Taco Tuesday.” That’s not right.

C. The Registration potentially subjects Taco Bell and anyone else who wants to share tacos with the world to the possibility of legal action or angry letters if they say “Taco Tuesday”

without express permission from Registrant—simply for pursuing happiness on a Tuesday. This violates an American ideal: “the pursuit of happiness.”

D. “Taco Tuesday” is a common phrase. Nobody should have exclusive rights in a common phrase. Can you imagine if we weren’t allowed to say “what’s up” or “brunch”? Chaos.

E. This Petition is brought because Taco Bell believes that tacos, just like the joy they bring, belong to everyone on any day. Ergo, “Taco Tuesday” should belong to everyone.

F. Taco Bell believes “Taco Tuesday” is critical to everyone’s Tuesday. To deprive anyone of saying “Taco Tuesday”—be it Taco Bell or anyone who provides tacos to the world—is like depriving the world of sunshine itself.

G. Taco Bell supports everyone’s right to celebrate, and say, “Taco Tuesday,” no matter who they are. How can we tell our fans to Live Más if their favorite taco joints aren’t even allowed to freely say “Taco Tuesday”? Anything else is *menos*.

H. Taco Bell seeks no damages; it simply seeks reason and common sense.

I. If one of us is not free to celebrate “Taco Tuesday,” then none of us are free to celebrate “Taco Tuesday.” A win for Taco Bell here is a win for all. When tacos win, we all win.

ALLEGATIONS

As grounds for cancellation, Petitioner asserts the following:

1. Petitioner, itself and through its licensees, affiliates, and predecessors in interest and title, has offered and provided restaurant services and food products for more than 60 years in the United States, becoming one of the largest and most recognized U.S. restaurant brands.

2. Petitioner is the owner and licensor of trademark rights associated with the world-famous TACO BELL chain of Mexican-inspired quick service restaurants. Petitioner's affiliate Taco Bell Corp., through its franchisees, licensees, and other affiliated entities, operates TACO BELL restaurants in the United States, including over 450 U.S. company-owned restaurants and over 6,600 U.S. franchised restaurants.

3. Petitioner, through its franchisees, licensees, and affiliated entities, offers a variety of Mexican-inspired foods, including several varieties of tacos, in TACO BELL restaurants, and has done so for nearly 60 years.

4. On May 19, 2009, Registrant was granted the Registration for the term TACO TUESDAY, disclaiming "TACO" and covering "restaurant services" in Class 43. The Registration is "limited to the area comprising the State of New Jersey," pursuant to Concurrent Use Proceeding No. 94000972. Today, the Registration exists concurrently with Registration No. 1572589, which is owned by Spicy Seasonings, LLC and is restricted to the "area comprising the entire United States, except for the state of New Jersey."¹

¹ Petitioner has also filed a petition to cancel the concurrent registration owned by Spicy Seasonings, LLC on the same grounds as those stated in this Petition.

5. The term “Taco Tuesday” is generic for the services identified in the Registration—“restaurant services”—including for promotions, deals, coupons, and other incentives for purchasing tacos and related products on Tuesdays.

6. The term “Taco Tuesday” is used ubiquitously by restaurants throughout the United States in a generic and informational manner to promote the sale and/or consumption of tacos and related products on Tuesdays.

7. The term “Taco Tuesday” is an informational message conveying the ordinary and familiar concept or custom of consuming tacos and related products on Tuesdays, and it is used widely by the public and by merchants to convey that concept or custom.

8. As this Board has found, “Taco Tuesday” is a “very commonplace term that refers to having tacos and drinks on that particular day of the week.” *In re Monday Night Ventures LLC*, Ser. No. 88817107 (TTAB, Nov. 28, 2022), at 21. The marketplace is awash with use of the term “Taco Tuesday” for “Taco Tuesday” events and specials. *Id.* Thus, the term “Taco Tuesday” fails to function as a mark for restaurant services and related events, specials, and products.

9. Because of the widespread use of “Taco Tuesday” and the informational nature of the term, the public does not use or understand the term as a source identifier.

10. A recent survey commissioned by Petitioner reveals that 86% of consumers nationwide and 77% of consumers in New Jersey believe that “Taco Tuesday” is a common name not associated with any particular company.

11. The “mark” that is the subject of the Registration does not meet the statutory definition of a trademark under 15 U.S.C. § 1127 because it does not “identify and distinguish” Registrant’s services and does not “indicate the source” of such services.

12. Registrant's failure or inability to adequately police the "mark" that is the subject of the Registration has caused the "mark" "to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a trademark," and as such, the "mark" has been abandoned pursuant to 15 U.S.C. § 1127.

13. Petitioner and others in the food industry have a right to use the commonplace term "Taco Tuesday."

14. Petitioner and its affiliated entities must be able to promote their goods and services using the generic, informational term "Taco Tuesday" to compete effectively in the marketplace.

15. The Registration inappropriately provides Registrant *prima facie* exclusive rights to use the term "Taco Tuesday." Therefore, the Registration is a source of damage and injury to Petitioner and others in the food industry because it ostensibly precludes Petitioner and others from using the generic, informational term "Taco Tuesday" to promote their goods and services.

16. The Registration should be cancelled because Petitioner and the public must be able to use the generic, informational term "Taco Tuesday" to advertise and properly identify their own goods and services.

CLAIM 1

17. Petitioner fully incorporates by reference the preceding paragraphs as if fully set forth herein.

18. The "mark" that is the subject of the Registration is or has become generic for the services described therein. The Registration should therefore be cancelled pursuant to 15 U.S.C. § 1064(3).

CLAIM 2

19. Petitioner fully incorporates by reference the preceding paragraphs as if fully set forth herein.

20. The “mark” that is the subject of the Registration has been abandoned through Registrant’s conduct, including acts of omission and/or commission, which has caused the “mark” to become the generic name for the services in connection with which it is used or otherwise to lose its significance as a trademark. The Registration should therefore be cancelled pursuant to 15 U.S.C. § 1064(3).

WHEREFORE, for the reasons set forth above, Petitioner requests that Registration No. 3621366 be cancelled.

This Petition for Cancellation is being filed electronically, along with the filing fee required by 37 C.F.R. § 26(a)(16). The Commissioner is authorized draw on the Deposit Account of Pirkey Barber PLLC, Account No. 50-3924/YUMB148/SPM, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: May 16, 2023

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