

# PUBLICATION

---

## Taco Bell Seeks Cancellation of the "Taco Tuesday" Trademark

Authors: Benjamin West Janke

May 23, 2023

**On May 16, 2023 (a Tuesday), fast food franchise Taco Bell launched its campaign to "liberate" the TACO TUESDAY trademark by filing legal petitions with the United States Patent and Trademark Office (USPTO) to cancel the trademark registration owned by rival food chain, Taco John's.**

Taco John's was granted a trademark registration for the phrase "Taco Tuesday" in 1989 and has since enforced its rights against others who have sought to use the mark in connection with their own endeavors.<sup>1</sup> Taco Bell asserts that the phrase "Taco Tuesday" is a common term that should not be owned by any one person or company, but should, instead, be "free for all restaurants and taco vendors to use without fear of a cease-and-desist letter or lawsuit."<sup>2</sup> According to its Petition, Taco Bell seeks no damages but rather seeks to cancel the trademark because it "believes 'Taco Tuesday' should be freely available to all who make, sell, eat, and celebrate tacos."<sup>3</sup>

### "Failure-to-Function" Refusals

Taco Bell's challenges to the registration of the phrase "Taco Tuesday" are based on the USPTO's longstanding rule that a common phrase or message that is widely used to convey an ordinary, familiar, or generally recognized concept fails to function as a trademark and is, therefore, not registrable.<sup>4</sup> Pursuant to this rule, an examining attorney with the USPTO will generally refuse to register a proposed mark that is found to merely convey a widely used message or expression. Indeed, "failure-to-function" refusals have become increasingly common in recent years. For instance, in *In re Team Jesus LLC*, the Trademark Trial and Appeal Board (TTAB) held that the phrase "Team Jesus" failed to function as a mark where evidence showed that consumers would perceive the wording merely as a commonplace message of Christian affiliation, rather than as a source identifier.<sup>5</sup> Accordingly, the Board affirmed the refusal to register TEAM JESUS as a trademark.<sup>6</sup>

Similarly, in *In re Lee Greenwood*, the TTAB found that the proposed mark GOD BLESS THE USA was devoid of any source-identifying significance and thus failed to function as a trademark.<sup>7</sup> There, the Board noted, in particular, that "[c]onsumers ordinarily take widely-used, commonplace messages at their ordinary meaning, and not as source indicators, absent evidence to the contrary."<sup>8</sup> Accordingly, the Board found that the common use of the phrase "God Bless the USA" by third parties rendered it less likely that consumers would perceive the phrase as a source identifier.<sup>9</sup>

More recently, in *In re D2k IP*, the TTAB affirmed an examining attorney's refusal to register the proposed mark HAVE A GREAT DAY in connection with cups, coffee cups, and insulating sleeves.<sup>10</sup> The Board reasoned that "[t]he more commonly a term or phrase is used in everyday speech by various sources, the less likely consumers will perceive the matter as a trademark for any goods."<sup>11</sup> Based on the evidence presented, the Board concluded that the phrase "Have A Great Day" is a widely used message that fails to function as a trademark.<sup>12</sup>

### Takeaways To "Taco Bout"

As indicated above, Taco Bell's challenges to the TACO TUESDAY trademark are particularly relevant given the recent increase in failure-to-function refusals issued by the USPTO. Determinations as to whether a phrase or slogan is capable of functioning as a trademark depend, not upon the intent of the applicant seeking

registration, but on how the proposed phrase is perceived by the public. Thus, when selecting a trademark, it is important to consider whether the proposed mark would likely be viewed by consumers as merely conveying a commonplace message or expression, and if so, to consider adopting a different mark that would better serve as a source identifier in the relevant market. Furthermore, those seeking to develop or reinvent their brand should strongly consider consulting a trademark attorney early on to assist in evaluating the availability and registerability of a proposed mark, which can save business owners significant time and expenses on the back-end by addressing issues that could have otherwise been avoided.

For more information regarding trademarks or other intellectual property matters, please contact [Benjamin W. Janke](#), [Addie Guida](#), or any member of Baker Donelson's [Intellectual Property](#) team.

<sup>1</sup> Jordan Valinsky, *Taco Bell is Fighting to Cancel the 'Taco Tuesday' Trademark*, CNNBUSINESS, (May 16, 2023, 7:59 AM), <https://www.cnn.com/2023/05/16/business/taco-tuesday-trademark-taco-bell/index.html>.

<sup>2</sup> Taco Bell, *Taco Bell Taco Tuesday Trademark FAQ*, [www.tacobell.com](http://www.tacobell.com), <https://www.tacobell.com/freeing-taco-tuesday> (last visited May 19, 2023).

<sup>3</sup> Petition for Cancellation at 1-2, *Taco Bell IP Holder, LLC v. Spicy Seasonings, LLC*, No. 92082333 (TTAB No. 92082333) available at <https://ttabvue.uspto.gov/ttabvue/v?pno=92082333&pty=CAN>.

<sup>4</sup> See Trademark Manual of Examining Procedure §1202.04(b) (July 2022).

<sup>5</sup> *In re Team Jesus LLC*, 2020 USPQ2d 11489, at \*6 -\*7 (TTAB 2020).

<sup>6</sup> *Id.* at \*7.

<sup>7</sup> *In re Greenwood*, 2020 USPQ2d 11439, at \*4 (TTAB 2020).

<sup>8</sup> *Id.* at \*2.

<sup>9</sup> *Id.* at \*3.

<sup>10</sup> *In re D2k IP*, Serial No. 90471186 (TTAB Mar. 2, 2023) (not precedential).

<sup>11</sup> *Id.* at \*10 (citing to the Examining Attorney's Brief).

<sup>12</sup> *Id.* at \*12.