

Taco Bell Wins “Taco Tuesday” Trademark Battle

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Fast food chains Taco Bell and Taco John’s have been embroiled in a legal battle over rights to the phrase “Taco Tuesday.” What started as a simple promotion by Taco Bell turned into a conflict at the United States Patent and Trademark Office (“USPTO”). After years of disputes, Taco Bell filed a petition in May 2023 to cancel the “Taco Tuesday” trademark registration owned by Taco John’s, calling the phrase common and stating that “nobody should have exclusive rights [for] a common phrase.”^[i] On Tuesday, July 18th, Taco Bell emerged victorious and Taco John’s relinquished its trademark registration.

Taco John’s claimed rights to “Taco Tuesday” based on a USPTO trademark registration it obtained in 1989. Since the registration, Taco John’s sent cease and desist letters to many restaurants and food trucks using the slogan, and required those who wished to use the phrase to first obtain permission from Taco John’s.

Taco Bell argued that the term was too generic to warrant trademark protection and sought to cancel the mark. According to U.S. Code 15 U.S.C 1064(3), a petition to cancel a registration of a mark may be filed “[a]t any time if the registered mark becomes the generic name for the goods or services... [t]he primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services or in connection with which it has been used.”^[ii] Further, courts, when determining whether trademarks have become generic, consider what the public associates with “Taco Tuesday”. As the federal circuit court stated, “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”^[iii]

Taco Bell relied heavily on evidence that “Taco Tuesday” had become a generic term widely used in popular culture beyond any connection to Taco John’s. Taco Bell even recruited LeBron James in its battle to free the “Taco Tuesday” mark. Rather than risk the poor publicity of a lengthy litigation and potentially adverse decision, Taco John’s agreed to abandon its registration and make the mark available for anyone to use.

The “Taco Tuesday” dispute demonstrates the need to enforce trademark registrations against third party infringers in order to avoid the mark becoming generic. However, regardless of the level of enforcement, abandonment is sometimes unavoidable if a term becomes too widely used by the public.

Cullen and Dykman’s Intellectual Property team continues to monitor important developments in trademark and copyright law. Should you have any questions about this legal alert, please feel free to contact Karen Levin (klevin@cullenllp.com) at (516) 296-9110 or Ariel Ronneburger (aronneburger@cullenllp.com) at (516) 296-9182.

This advisory provides a brief overview of the most significant changes in the law and does not constitute legal advice. Nothing herein creates an attorney-client relationship between the sender and recipient.

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Footnotes

[i] Complaint in *Taco Bell IP Holder, LLC v. Spicy Seasonings, LLC* (TTAB Proceeding No. 92082333), at ¶ D.

[ii] 15 U.S.C.A. § 1064 (2021)

[iii] *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90 (Fed. Cir. 1986)

Practices

- Intellectual Property

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