

**THIS OPINION IS NOT A  
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Mailed:  
May 1, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re The Border Cafe of Texas, Inc.

Serial No. 85104508

Scott T. Kannady of Brown & Kannady, LLC for The Border  
Cafe of Texas, Inc.

Raul Cordova, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

Before Seeherman, Bucher and Cataldo, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Border Cafe of Texas, Inc. has applied to register  
LA CASITA MEXICAN GRILL, in standard characters, for  
"restaurant services."<sup>1</sup> In response to a requirement by the  
examining attorney, applicant subsequently offered a  
disclaimer of MEXICAN GRILL, and the translation statement

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<sup>1</sup> Application Serial No. 85104508, filed August 10, 2010  
pursuant to Section 1(a) of the Trademark Act, asserting first  
use and first use in commerce as early as February 4, 2010.

"The English translation of 'LA CASITA' in the mark is THE SMALL HOUSE."

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the following marks, registered by the same entity for "restaurant services and catering services," that as used in connection with applicant's services it is likely to cause confusion or mistake or to deceive:

LA CASITA MEXICANA, with MEXICANA disclaimed, in standard characters. "The foreign wording in the mark translates into English as the little mexican [sic] house."<sup>2</sup>

LA CASITA MEXICANA and design, with MEXICANA disclaimed. "The foreign wording in the mark translates into English as the little mexican [sic] house. The colors purple, black and orange is/are claimed as a feature of the mark. The mark consists of the color purple which appears in two bars outlined in black that come together at one end pointing north forming a roof like figure; below the bottom ends of the two bars forming the roof are two additional purple bars outlined in black that point straight down forming the sides of a house when viewed in conjunction with the roof; inside the two side bars is an orange bowl with finger holders at each end, and the bowl has a purple stylistic pattern below its top edge; above the bowl is black stylistic scribbling that looks like steam as well as like the faces of two chefs with mustaches looking in opposite directions. All of the wording is in black. The background of the

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<sup>2</sup> Registration No. 3176886, issued November 28, 2006.

mark is transparent and no other color is claimed as a feature of the mark."<sup>3</sup>



The examining attorney has also made final a requirement that applicant submit an additional fee of \$50 due to the fact that applicant did not comply with the TEAS Plus requirements and therefore is not entitled to the reduced application filing fee for a TEAS Plus application.

We affirm both the refusal and the requirement.

We turn first to the refusal under Section 2(d). Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and

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<sup>3</sup> Registration No. 3186558, issued December 10, 2006.

the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's identified "restaurant services" are legally identical to the "restaurant services" identified in the cited registrations. Although applicant has argued that the nature of its Mexican restaurant, in terms of food and atmosphere, is different from the registrant's, such differences are irrelevant to our determination.

Likelihood of confusion must be determined based on an analysis of the mark as applied to the services recited in applicant's application vis-à-vis the services recited in a registration, rather than what the evidence shows the services to be. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Further, because as identified the services are legally identical, they must be presumed to travel in the same channels of trade and be rendered or offered to the same classes of consumers. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re*

Max Capital Group Ltd., 93 USPQ2d 1243, 1245 (TTAB 2010).

These du Pont factors favor a finding of likelihood of confusion.

The next du Pont factor we consider is the similarity of the marks. Because the design element in the cited LA CASITA MEXICANA mark arguably contains an additional point of difference with applicant's mark, we confine our analysis to the issue of likelihood of confusion between applicant's mark and the cited registration for LA CASITA MEXICANA in standard characters. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the cited mark for LA CASITA MEXICANA with the design, while if there is no likelihood of confusion between applicant's mark and LA CASITA MEXICANA in standard characters, then there would be no likelihood of confusion with the LA CASITA MEXICANA and design mark. See *In re Max Capital Group Ltd.*, 93 USPQ2d at 1245.

There are certain principles that we must keep in mind. First, when marks would appear on virtually identical goods or services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700

(Fed. Cir. 1992). Second, there is nothing improper in according, for rational reasons, more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Third, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. In re Association of the United States Army, 85 USPQ2d 1264, 1268 (TTAB 2007); Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Because MEXICAN GRILL is descriptive of applicant's services, a point that has been acknowledged by applicant by its agreement to disclaim this term, the LA CASITA portion of its mark deserves greater weight in the overall comparison of the marks; it is this portion that consumers will view as the source-indicating part of the mark. Similarly, the disclaimed word MEXICANA in the cited mark

describes the type of restaurant the registrant operates, while LA CASITA is the portion of the mark that has source-indicating significance. Although there are some differences in the marks due to the final elements, these differences are not sufficient to distinguish the marks. Because consumers will pay more attention to the beginning and source-identifying parts of the marks, they are likely not to remember the relatively minor differences in the descriptive portions and, even if they note these differences, they are not likely to ascribe them to differences in the sources of the legally identical restaurant services. Overall, the marks are substantially similar in appearance and pronunciation, and convey the same connotation and commercial impression. This du Pont factor favors a finding of likelihood of confusion.

Applicant has pointed to two third-party registrations, owned by a single entity, for LA CASITA CHILANGA and LA CASITA CHILANGA RESTAURANT, both for "restaurant."<sup>4</sup> The translation of the marks is "the little

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<sup>4</sup> Registration Nos. 3032011 and 3135063. Applicant had referenced these third-party registrations in its response to the first Office action, but did not submit copies of them to properly make them of record. However, the examining attorney, as he noted in his brief, mistakenly stated in the next and final Office action that printouts of such registrations had been submitted, rather than advising applicant that it would have to do so. Therefore, the examining attorney attached copies of the registrations to his brief, in order to effect applicant's intent

house of or in Mexico City," and CHILANGA and RESTAURANT were disclaimed. Applicant notes that the registrations cited here were allowed to register despite the existence of these third-party registrations, and argues that the differences in the disclaimed wording were sufficient to distinguish the marks. Whatever may have been the analysis of the examining attorney who determined that there was no likelihood of confusion in the prior situation, it is clear that the marks involved in this appeal are more similar than the third party's and the registrant's.

Applicant has asserted, in discussing the du Pont factor of purchaser care, that confusion is not likely because the registrant has only one restaurant, located in the Los Angeles area; that customers seeking the services are "individuals located in the Los Angeles area desiring authentic Mexican cuisine"; and its chefs are featured on cooking channels and "Mexican speaking television." Brief, p. 9. Applicant's restaurants are located in Colorado Springs, CO.

To the extent that applicant is suggesting that the consumers for the registrant's services would be careful and sophisticated purchasers looking for authentic Mexican

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to have these third-party registrations be considered. We therefore treat the registrations as being of record.



cuisine prepared by well-known chefs, that argument is not persuasive. The cited registrations are for "restaurant services," and that means that the registrant has the right to use its marks for all restaurant services, not only for restaurants serving authentic Mexican cuisine prepared by well-known chefs. See Section 7(b) of the Trademark Act: "A certificate of registration ... shall be prima facie evidence ... of the owner's exclusive right to use the registered mark in commerce on or in connection with the ... services specified in the certificate..." As a result, we must assess the du Pont conditions of purchase factor from the standpoint of "restaurant services," which includes inexpensive restaurants that might be visited as a result of an impulse decision. This factor favors a finding of likelihood of confusion.

Because applicant has also asserted that the applicant and registrant offer their restaurant services in different geographic locations, we must point out that even if there is a current geographic distance in the operations, we may not take this into consideration. The registrant's registration gives it the right to use its mark in commerce throughout the United States, and if applicant were to obtain a registration it would have a similar right. As a result, we must make the determination of whether confusion

is likely based on the assumption that applicant and the registrant could operate in the same geographic areas.<sup>5</sup>

Applicant has asserted that it adopted its mark without any intent of creating confusion. However, although a deliberate intent to cause confusion can be strong evidence of likelihood of confusion, the absence of such intent does not have any bearing on our decision. Even if applicant did not intend to create confusion, if applicant's use of its mark is likely to cause confusion, the refusal of registration must be affirmed.

The final du Pont factor that has been discussed is the absence of actual confusion. Uncorroborated statements of no known instances of actual confusion are of little evidentiary value. In re Majestic Distilling Co., 65 USPQ2d at 1205. In this case, the fact that applicant and the registrant appear to operate in separate geographic areas may explain the lack of any actual confusion. Certainly we cannot conclude, from the lack of such evidence, that confusion is not likely to occur. This du Pont factor is neutral.

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<sup>5</sup> The statute does provide for concurrent use registrations, and concurrent use proceedings, for registrations that are geographically restricted. See Sections 2(d), 17 and 18 of the Trademark Act.

To the extent that any other du Pont factors are relevant, we treat them as neutral.

In view of the above discussion, and our finding that the factors of the similarity of marks, the legally identical services and trade channels, and the conditions of purchase all favor a finding of likelihood of confusion, and that any other du Pont factors are neutral, we find that applicant's mark for its services is likely to cause confusion with the mark registered under Registration No. 3176886, and affirm the refusal of registration made pursuant to Section 2(d).

The examining attorney also made final a requirement that applicant submit a fee of \$50 because its application did not meet the requirements for the reduced fee of a TEAS plus filing. Specially, applicant did not include in its original application a translation for the foreign wording in its mark. TMEP Section 819.01(m) states, in part:

If the mark includes non-English wording, the application must include an English translation of that wording. ... The TEAS Plus form does not include any edits to determine when a translation and/or transliteration is required. If a translation and/or transliteration is omitted, the examining attorney will issue an Office action requiring the additional fee. 37 C.F.R. §§ 2.6(a)(1)(iv) and 2.22(b).

Trademark Rule 2.22 (b), 37 C.F.R. § 2.22(b), provides that "if an application does not meet the requirements of

paragraph (a) of this section at the time of filing, the applicant must pay the fee required by § 2.6(a)(1)(iv)," and that section requires an additional processing fee of \$50 per class.

The examining attorney made the requirement for this additional fee in the first Office action because the application did not include a translation of all non-English wording in the mark. He made this requirement final in the next Office action. Applicant did not address this requirement in either a response to an Office action or in its brief. Therefore, it appears that applicant has conceded the correctness of this requirement. In any event, we find that applicant did not include a translation statement in its original application, nor did it comply with the requirement to submit the additional fee. Accordingly, we affirm this requirement.

Decision: The refusal of registration pursuant to Section 2(d) is affirmed; the requirement to submit the additional fee under 37 C.F.R. §§ 2.22(b) and § 2.6(a)(1)(iv) is also affirmed.