

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

Kevin T. McCarney, dba
POQUITO MAS,
Opposer,

v.

UNA MAS RESTAURANTS, INC.,
Applicant

Opposition No. 107,026
Opposition No. 107,048

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**APPLICANT UNA MAS RESTAURANTS, INC.'S
RESPONSE TO OPPOSER'S BRIEF**

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INTRODUCTION

Opposer, Kevin T. McCarney, dba POQUITO MAS, argues that there is likelihood of confusion between Opposer's service mark, POQUITO MAS, and Applicant's service marks, UNA MAS and ONE IS GOOD BUT UNA MAS IS BETTER. Opposer, however, has not met its burden of proof. First, POQUITO MAS and UNA MAS are significantly dissimilar in sound, appearance and connotation. Second, POQUITO MAS should be accorded a narrow scope of protection because "MAS" has a laudatory connotation and therefore the mark is weak for restaurant services. Finally, Applicant has conducted an extensive survey which establishes there is no likelihood of confusion in the marketplace between POQUITO MAS and UNA MAS. Opposer has submitted no credible evidence to the contrary. Accordingly, there is no likelihood of confusion between the marks.

DESCRIPTION OF THE RECORD

Applicant UNA MAS RESTAURANTS, INC.'s evidence of record consists of the following:

1. Trial testimony deposition transcript of Richard Hamner and exhibits thereto, taken by Applicant on August 13, 2002 (hereinafter "Hamner Tr."). Richard Hamner is the founder of Una Mas Restaurants. Until January 2000, Mr. Hamner was also the president and CEO of Una Mas Restaurants, and he currently holds the position of chairman.
2. Trial testimony deposition transcript of Lynne Mobilio, Ph.D., and exhibits thereto, taken by Applicant on August 14, 2002 (hereinafter "Mobilio Tr."). Dr. Mobilio, a partner in the firm of Lewis Mobilio & Associates, conducted a survey regarding the likelihood of confusion between the marks POQUITO MAS and UNA MAS (hereinafter "Una Mas

Survey,” attached as Exhibit 2 to Mobilio Tr.). A copy of the survey is also attached to this brief for the Board’s convenience.

3. Trial testimony deposition transcript of Christine P. Peters and exhibits thereto, taken by Applicant on August 12, 2002 (hereinafter “Peters Tr.”). Ms. Peters was a paralegal with Applicant’s counsel, Dorsey & Whitney.

4. Excerpts from Cassell’s Spanish Dictionary are identified in and attached to Applicant’s First Notice of Reliance as Exhibits 1 through 3, filed on August 29, 2002 (hereinafter “App.’s 1st NOR”).

5. A copy of Opposer’s file history for the mark MUCHO MAS is identified in and attached to Applicant’s Second Notice of Reliance as Exhibit 1, filed on August 29, 2002 (hereinafter “App.’s 2d NOR”). The file history shows that the mark was initially refused registration over the registration for MUCHO’S, and not the application for UNA MAS.

6. Applicant served its First Set of Interrogatories on Opposer on March 24, 1998, and Opposer served its Responses on June 18, 1998. Applicant served its Second Set of Interrogatories on Opposer on April 12, 2001, and Opposer served its Responses on May 10, 2001. Applicant served its Third Set of Interrogatories on Opposer on December 26, 2001, and Opposer served its Responses on January 25, 2002. Excerpts from Opposer’s Response to Interrogatory Requests are identified in and attached to Applicant’s Third Notice of Reliance as Exhibits 1 through 3, filed on August 29, 2002 (hereinafter “App.’s 3rd NOR”).

7. Publications regarding Applicant’s restaurants, identified in and attached to Applicant’s Fourth Notice of Reliance as Exhibits 1 through 5, filed on August 29, 2002 (hereinafter “App.’s 4th NOR”).

8. Opposer took the discovery deposition of Opposer, Kevin T. McCarney, on May 25, 2001. Excerpts from the deposition are identified in and attached to Applicant's Fifth Notice of Reliance as Exhibit 1, filed on August 29, 2002 (hereinafter "App.'s 5th NOR").

9. Trial testimony deposition of Kevin T. McCarney and exhibits attached thereto, taken by Opposer on June 24, 2002 (hereinafter "McCarney Tr.").

10. Opposer's Notices of Reliance (hereinafter "Opp's NOR").

STATEMENT OF THE ISSUES

1. Whether POQUITO MAS and UNA MAS are similar in sound or appearance.
2. Whether POQUITO MAS and UNA MAS have similar connotations.
3. Whether POQUITO MAS is a weak mark for restaurant services.
4. Whether actual confusion exists between the use of the marks POQUITO MAS and UNA MAS for restaurant services.
5. Whether there is a likelihood of confusion between POQUITO MAS and UNA MAS for restaurant services.

FACTS

Applicant owns a chain of restaurants that serve Mexican food. Hamner Tr. pp. 15:1-14; 17:16-20; Hamner Tr., Ex. 3-4. Currently, the restaurants are located in Northern California, Portland, Oregon, and Chicago, Illinois. Hamner Tr., p. 15:1-14; Ex. 3.

Richard Hamner, the founder of Una Mas restaurants, thought of the trade name "Una Mas" for his restaurants because it is a fun phrase that is used in bars to request another beer. Hamner Tr. p. 14:3-7; p. 14:21-25. Hamner was not aware of the existence of the restaurant Poquito Mas when he chose the service mark. Hamner Tr., p. 27:5-14; 28:6-8.

Applicant first used the service name UNA MAS in September 1991. Hamner Tr., p 10:25-11:1. This was two years before Opposer filed its application for the service mark POQUITO MAS, Reg. No. 1,892,451, on December 13, 1993. Applicant first used the slogan "ONE IS GOOD BUT UNA MAS IS BETTER" as a service mark in 1996. Hamner Tr. 18:8-12.

Applicant filed its U.S. Trademark Application Serial No. 75154590 for ONE IS GOOD BUT UNA MAS IS BETTER, for restaurant services in class 42, on August 22, 1996. Applicant filed its U.S. Trademark Application Serial No. 75214266 for UNA MAS, for restaurant services in class 42, on December 17, 1996.

Since the founding of the Una Mas restaurants, the service mark UNA MAS has been extensively and continuously promoted. The mark is promoted through newspaper advertisements, direct distribution of promotional material, television and radio ads, and on billboards and signs. Additionally, the mark is promoted through the sponsorship of community festivals and events, charity events, professional sporting events, and the sales and distribution of clothing items bearing the mark UNA MAS. Hamner Tr., pp. 18:19-19:15; pp. 20:22-24:14; Ex. 5-8. Applicant typically spends two to three percent of its annual sales for advertising and promotions. Hamner Tr., p. 20:13-21.

Applicant is unaware of any actual confusion between its mark UNA MAS and Opposer's mark POQUITO MAS. Mr. Hamner is not aware of any mail, telephone calls or facsimiles that were meant for Poquito Mas but misdirected to Una Mas, nor is he aware of any misdirected communications from vendors, banks, or potential investors. Hamner Tr., p. 25:10-25. Furthermore, Mr. Hamner is not aware of any customers, vendors, or potential investors who have inquired whether POQUITO MAS and UNA MAS are related. Hamner Tr., p. 26:1-4. In

fact, when surveyed, none of Una Mas' restaurant managers reported receiving any inquiries regarding POQUITO MAS. Hamner Tr., p. 26:5-27:4.

Una Mas has not copied Poquito Mas' menu, and any similarity between the menus is because Opposer's and Applicant's restaurants serve food items typically sold in casual Mexican restaurants. Hamner Tr., p. 28:17-22.

Una Mas conducted an extensive and rigorous telephone survey regarding the likelihood of confusion between POQUITO MAS and UNA MAS. Participants in the survey were specifically asked whether they thought a named restaurant was commonly owned or operated or otherwise related to any other restaurant. Una Mas Survey, p. 9; Mobilio Tr. p. 28:3-29:10. Only one percent thought UNA MAS was commonly owned or operated with POQUITO MAS. Una Mas Survey, p. 11-12. Significantly, none of the participants who were previously aware of either the UNA MAS or POQUITO MAS restaurants held an opinion that the two restaurants are commonly owned, operated or otherwise related. Una Mas Survey, p. 13-15; Mobilio Tr., p. 13:24. Even when the survey participants were presented with a list of eight restaurant names, less than three percent believed that UNA MAS or POQUITO MAS are commonly owned, operated or otherwise related. Una Mas Survey, p. 17.

Other Mexican restaurants in the United States use the formative "MAS" as part of their service mark. Peters Tr., pp. 8:2-12:19; Ex. 1, ¶¶2-14. Excluding Opposer's and Applicant's restaurants, there are twenty-seven other restaurants listed in the American Business Directory that contain the formative "MAS." Peters Tr. Ex. 1, ¶15.

ARGUMENT

Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 767, 25 USPQ2d 2027

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(Fed. Cir. 1993). Likelihood of confusion is determined on a case-specific basis, applying the factors set out in *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), when relevant evidence is of record. “[N]ot all the of the Dupont factors are relevant or of similar weight in every case.” *Opryland USA Inc. v. Great Am. Music Show*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992).

In this matter, Applicant concedes that Opposer’s mark has priority of use. Furthermore, the marks in questions will be used in connection with the same services, namely restaurant services in class 42, and will be marketed and used in the same channels of trade and to the same consumers. Accordingly, Applicant will only analyze the following *DuPont* factors which demonstrate that there is no likelihood of confusion between the marks POQUITO MAS and UNA MAS: 1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, and connotation; 2) the fame of the prior mark; 3) the number and nature of similar marks in use on similar goods; 4) the nature and extent of any actual confusion; 5) the length of time during and conditions under which there have been concurrent use without evidence of actual confusion; 6) the extent to which applicant has a right to exclude others from use of its mark on its goods; and 7) the extent of potential confusion, i.e., whether de minimis or substantial. *In re E. I. DuPont DeNemours & Co.*, 177 USPQ at 567.

Opposer has attempted to confuse the issues in this matter by discussing the trade dress of Opposer’s and Applicant’s restaurants and by discussing his other marks. The issues of trade dress, any niche Opposer’s restaurants occupy, the specific menus of the restaurants, and the conditions under which sales are made to consumers are not relevant issues in this opposition proceeding. Instead, the focus should be solely on the particular services described in the relevant registration and applications.

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Furthermore, in this matter, the only basis for the opposition before this Board is whether there is a likelihood of confusion between Applicant's marks, UNA MAS and ONE IS GOOD BUT UNA MAS IS BETTER, and Opposer's Registration No. 1,892,451 for POQUITO MAS for restaurant services in class 42. *See*, Notice of Opposition 107,026, filed June 9, 1997; Notice of Opposition No. 107,748, filed June 9, 1997; and App.'s 3rd NOR, Ex. 1, Opposer's Response to Applicant's First set of Interrogatories to Opposer, No. 20 ("POQUITO MAS is the only mark used by Opposer for restaurant services which includes the term "MAS.>"). Opposer therefore cannot rely on any other marks in this opposition proceeding. *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1455 (TTAB 1998) (opposer cannot rely on registrations not pled in opposition or disclosed in discovery).

A. The Marks Are Dissimilar In Appearance, Sound, And Connotation.

The similarity or dissimilarity of the marks in their entirety is to be considered with respect to appearance, sound and connotation. *In re E. I. DuPont de Nemours & Co.*, 177 USPQ at 567. "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 services offered under the respective marks is likely to result." *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1375 (TTAB 1999).

Opposer argues that the doctrine of foreign equivalents should be applied to the marks in question to determine whether the marks are confusingly similar. Any conclusion regarding the likelihood of confusion between the marks, however, is reached only after weighing the dissimilarity in appearance and sound of the untranslated marks, as well as any similarity in meaning of the translated foreign marks. 3 J. Thomas McCarthy, McCarthy on Trademarks and

Unfair Competition, 23-118 (4th. ed. 2002) (citing *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983)).

Here, no likelihood of confusion exists between the marks POQUITO MAS and UNA MAS, because the marks are significantly different in sound and appearance, as well as in their literal translated meaning and connotation.

1. POQUITO MAS And UNA MAS Are Substantially Different In Appearance And Sound.

While marks must be compared in their entireties, one feature of a mark may have more significance than another, and in such a case there is nothing improper in giving greater weight to the dominant feature. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (it is not improper to give more or less weight to a particular feature of a mark). The first word in a mark is usually given greater weight as the dominant feature. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of the mark which is most likely to be impressed upon the mind of the purchaser and remembered."). Here the first words of the marks in question, POQUITO and UNA, bear no resemblance to each other whatsoever in sound or appearance.

The only similarity between the marks is the second word "MAS." "Mas" is a Spanish word meaning "more" and is therefore a laudatory term as applied to restaurant services. App.'s 1st NOR, Ex. 1, entry for "mas." Normally, less weight is given to laudatory terms. *Nestle Foods Corp. v. Kellogg Co.*, 6 USPQ2d 1145 (TTAB 1988) (No likelihood of confusion between TASTER'S CHOICE and DINER'S CHOICE, where principal similarity between marks is laudatory word "choice.").

In *In re Lar Mor Int'l*, 221 USPQ 180, 183 (TTAB 1983), the Board found that both TRES JOLIE and BIEN JOLIE translate to “very pretty” or “quite pretty.” However, the “highly laudatory” meaning of the registered mark was found to be a significant factor, because purchasers are less likely to view such terms as an indication of source. *Id.* at 181. As the only common element in the two marks was laudatory, the scope of protection afforded the registered mark was narrow, and no likelihood of confusion between TRES JOLIE and BIEN JOLIE was found. *Id.* at 183. Similarly, the scope of protection granted to POQUITO MAS should also be narrow. Therefore, as “POQUITO” and “UNA” are totally dissimilar in sound and appearance, a determination of no likelihood of confusion between POQUITO MAS and UNA MAS should be found.

2. POQUITO MAS and UNA MAS Have Substantially Different Connotations.

Despite Opposer’s contention otherwise, the literal translated meanings of “POQUITO MAS” and “UNA MAS” are quite different. While the phrase “un poquito mas” has the definition of “a little more,” Opposer’s mark is “POQUITO MAS,” a Spanish phrase that literally translates to “very little more.” *See*, App.’s 1st NOR, Ex. 2, entry for “poquito;” Brief of Opposer, p. 12 (“literal translation of POQUITO MAS is “little more.”). The difference in meaning between “un poquito mas” and “poquito mas” is even acknowledged by the restaurant reviews cited by Opposer. *See*, Opposer’s Notice of Reliance 5, Attachment 3 (“it’s also a little more, or rather un poquito mas”).

In contrast, “una mas” means “one more.” Brief of Opposer, p. 12; Hamner Tr., 14:1-2. “Little more” and “one more” have completely different connotations. “Little more” has a negative connotation, as in “his nachos are little more than chips with processed cheese.” “One more,” however, has the positive connotation of a customer asking for “one more” helping. This

connotation of quantity is reinforced by Applicant's slogan - ONE IS GOOD BUT UNA MAS IS BETTER. Accordingly, as Opposer's mark is "POQUITO MAS" and not "UN POQUITO MAS," Applicant strongly disputes that Opposer's mark has the connotation of "giving more to the consumer." See, Opposer's Brief, p. 14 (Opposer's use of the "more" concept relates generally to giving more to the consumer.)

Furthermore, assuming Opposer's mode of promotion is relevant, Opposer has not established that he has promoted the "giving more to the customer" concept in conjunction with his mark. Opposer's first menu in 1984 had the slogan "Mexican food with a little more," and a 1985 ad carried in a monthly local paper contained the slogan "and a little bit more." McCarney Tr., p. 66; Ex. 5; Opp's 5th NOR, Attachment 12. Subsequent menus, however, lack any reference to "a little more" and instead promote the slogan "WE DON'T SERVE FAST FOOD - WE SERVE FRESH FOOD AS FAST AS WE CAN" McCarney Tr., Ex. 6, 8, 9. In fact, Opposer apparently did not promote the "little more" meaning of his mark until 1998, a year after this opposition proceeding started. McCarney Tr., p. 70:12-17; Ex. 11 (Poquito Mas' web site from 1998.).

Opposer's failure to promote the "little more" connotation is reflected in the fact that only two restaurant reviewers acknowledge that "poquito mas" means "little more." Opp.'s 3rd NOR, attachment 15 (Lipson review titled "A little more senior"); Opp.'s 5th NOR, attachment 3 (Huneven review stating "it's also a little more, or rather, un poquito mas, than that."). However, even the Huneven review acknowledged that "un poquito mas" and not "poquito mas" translates to "a little more." Moreover, Opposer has not introduced any evidence that his customers use the phrase "poquito mas" to order food, or even understand what it means. Accordingly, Opposer

has not established that the public understands that “poquito mas” has the connotation of requesting a little more and/or giving more to the customer.

Even if this Board, however, were to accept Opposer’s erroneous argument that POQUITO MAS and UNA MAS have similar connotations, this would still not be enough to find that a likelihood of confusion exists between the marks. While similarity in meaning “may be sufficient where marks are coined or arbitrary terms,” such similarity alone is insufficient when the marks are descriptive or laudatory. *In re Lar Mor Int’l*, 221 USPQ at 181-182 (highly laudatory terms accorded a narrow scope of protection, therefore no likelihood of confusion between TRES JOLIE and BIEN JOLIE, both for women’s clothing);, *Sunbeam Corp. v. Green Bay Tissue Mills, Inc.*, 199 USPQ 695 (TTAB 1978) (no likelihood of confusion for marks CLEAR BREW and PURE BREW, as applied to coffee makers and coffee filters.). If POQUITO MAS does translate to “a little more” and therefore has the connotation of “giving more to the customer” as argued by Opposer, then POQUITO MAS is a laudatory mark as applied to restaurant services. Therefore, any similarity in translated meaning with UNA MAS would be insufficient by itself to find a likelihood of confusion.

For the foregoing reasons, POQUITO MAS is significantly different in appearance, sound and connotation from UNA MAS and ONE IS GOOD BUT UNA MAS IS BETTER. Thus, there is no likelihood of confusion between the marks.

B. Survey Evidence Demonstrates There Is No Likelihood Of Confusion Between POQUITO MAS and UNA MAS.

Surveys can provide “useful data from which to make informed inferences about the likelihood that actual confusion will take place.” 5 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, 32-305 (4th. ed. 2002). In July 2001, a telephone survey was conducted on behalf of Applicant, to assess whether there is a likelihood of actual confusion

in the marketplace between the marks POQUITO MAS and UNA MAS. Mobilio Tr., p. 15:9-17; Mobilio Tr., Ex. 2, ¶6. As discussed below, the survey was conducted pursuant to accepted scientific methods and is therefore evidence that there is no likelihood of actual confusion in the marketplace between the marks POQUITO MAS and UNA MAS.

1. The Survey Was Conducted By An Appropriately Skilled And Experienced Expert.

Experts who design and conduct the survey should generally have the following qualifications:

“graduate training in psychology (especially social, cognitive, or consumer psychology), sociology, marketing, communication sciences, statistics, or a related discipline; that training should include courses in survey research methods, sampling, measurement, interviewing, and statistics. In some cases, professional experience in conducting and publishing survey research may provide the requisite background. In all cases, the expert must demonstrate an understanding of survey methodology, including sampling, instrument design (questionnaire and interview construction), and statistical analysis.”

Federal Judicial Center, Reference Manual on Scientific Evidence, p. 238 (2d Ed. 2000).

The survey was designed and conducted by Dr. Lynne Mobilio of Lewis Mobilio & Associates. Dr. Mobilio has a graduate degree in social psychology with a minor in statistics, has taught courses in social psychology, and has been invited to speak at conferences on the topic of survey research. Mobilio Tr., p. 4:5-24; p. 7:15-8:11; *see*, Mobilio resume, attached as Exhibit 1 to Mobilio Tr. Furthermore, Dr. Mobilio has extensive experience in designing surveys, as demonstrated by the approximately 165 surveys she has designed. Mobilio Tr. pp. 4:25-5:7; 6:1-7:14; 9:19-10:16; 11:7-18; Mobilio Tr., Ex. 2, ¶1-4. The majority of surveys designed by Dr. Mobilio had as an objective the awareness of consumers regarding a certain

company or brand. Mobilio Tr., p. 9:19-10:16. As a result of her educational and work background, Dr. Mobilio is an appropriately trained expert to write survey questions in an unbiased manner and to analyze the resulting data. Mobilio Tr., pp. 33:8-34:10; p. 91:1-10. Accordingly, Dr. Mobilio is eminently qualified pursuant to the guidelines set forth in the Reference Manual on Scientific Evidence to conduct surveys.

2. The Survey Is Trustworthy

The following criteria are evaluated in determining the trustworthiness of a survey:

1) whether the universe was properly defined; 2) whether a representative sample of the universe was selected; 3) whether the questions asked were framed in a clear, precise and non-leading manner; 4) whether sound interview procedures were followed by competent interviewers; 5) whether the data gathered was accurately reported; 6) whether the data was analyzed in accordance with accepted statistical principals; and 7) whether the entire process was objective. 5 McCarthy, *supra* 32-300 (citing the Federal Judicial Center, Manual For Complex Litigation §21.493 (3d Ed. 1995)).

a. The Proper Universe Was Identified And A Representative Sample Of The Universe Was Chosen

A survey “universe” is defined as “that segment of the population whose perceptions and state of mind are relevant to the issues.” 5 McCarthy, *supra* 32-250.2. In a traditional case claiming forward confusion, the proper universe to survey is the potential buyers of the junior user’s services. *Id.* at 32-250.3. When the marks in questions are used for restaurant services, the appropriate universe would be persons who have eaten at or intend to eat at restaurants. *McDonald's Corp. v. McBagel's Inc.*, 649, F.Supp. 1268, 1 USPQ2d 1761, 1768 (S.D. N.Y. 1986) (In a survey to determine likelihood of confusion between trade names of two restaurants,

breadth of the survey was adequately controlled by the question whether the respondent had eaten at a restaurant in the past six months.).

Here, the survey universe was defined as persons who had eaten food from a Mexican restaurant in the past six months, and intended to eat food from a Mexican restaurant within the next six months. Mobilio Tr., pp. 16:16-18:1. The universe was further limited to persons who lived within a five mile radius of Opposer's restaurant and Applicant's restaurant. Mobilio Tr., p. 15:18-23; Mobilio Tr., Ex. 2, ¶9; Una Mas Survey, pp. 1-2, and Appendix 2. This was done so that the survey would be more likely to find consumers who were aware of either restaurant if they lived near one of the restaurant locations. Mobilio Tr., pp. 15:24-16:9. Accordingly, consumers were screened and qualified to participate in the survey if 1) they were at least eighteen years of age; 2) had eaten food from a Mexican restaurant, either in the restaurant or take-out, in the last six months; and 3) intended to eat food from a Mexican restaurant within the next six months. Una Mas Survey, p. 1.

A sampling method called random digital dial was employed to contact potential interviewees. Random digital dial consists of randomly dialing all available telephone exchanges in a predefined geographic area. Mobilio Tr., pp. 18:19-19:7; Mobilio Tr., Ex. 2, ¶9-10; Ex. 4, ¶4. Random digital dialing results in a probability sample. *See*, 5 McCarthy, *supra*, 32-263. In a probability sample, the individual selected does a "good job of reflecting the make-up of the universe." *Id.*; *see*, Mobilio Tr., pp. 30:17-31:3.

Two hundred and fifty individuals who live within five miles of a Poquito Mas restaurant were interviewed, and two hundred and fifty individuals who live within five miles of an Una Mas restaurant were interviewed, for a total of five hundred participants in the survey. Una Mas Survey, p. 1. Of the five hundred consumers surveyed, four hundred and forty nine, or ninety

percent of those responding to the survey, had eaten food purchased from a Mexican restaurant in the past six months. Una Mas Survey, p. 6; Mobilio Tr., Ex. 4, ¶9.

b. Questions Asked Were Framed In A Clear, Precise And Non-Leading Manner

To insure that the questions asked in a survey are clear and unambiguous, it is generally recommended that a pretest be conducted. Reference Manual on Scientific Evidence, *supra*, p. 248. Furthermore, providing “don’t know” or “no opinion” as acceptable response options can reduce guessing. *Id.* at 252. Finally, providing explicit instructions regarding the use of probes “minimizes any sense of passing judgment on the context of the answers offered.” *Id.* at 254.

A complete set of the questions asked of the consumers, as well as the instructions given to the interviewers is contained in the Appendix of the Una Mas Survey. The questions were designed to be non-leading and open-ended, so that respondents were not led to name one restaurant over another. Mobilio Tr., pp. 26:23-25, 31:4-12; Mobilio Tr., Ex. 2, ¶8. To ensure that the wording of the questions was not confusing, a pretest was conducted. Mobilio Tr., pp. 23:13-24:2. Furthermore, interviewers were instructed 1) on the correct pronunciation of the restaurant names; 2) not to lead respondents to a “yes” or “no” response; and 3) that “don’t know” and “not sure” were acceptable responses. *See*, Una Mas Survey, Appendix 1, p. iv.; Mobilio Tr., 59:3-10. Interviewers were also given specific instructions on using probes. *See*, Una Mas Survey, Appendix 1, p. iv-v; Mobilio Tr., pp. 28: 17-29:10. Finally, the order of restaurants read to the respondents in certain questions were rotated so that there were not any order effects. Mobilio Tr. p. 26:16-19; 28:7-10; 30:11-14; Mobilio Tr., Ex. 2, ¶8-9; Appendix 1, pp. iii-iv.

c. Sound Interview Procedures Were Followed By Competent Interviewers

Dr. Mobilio's firm subcontracted with Interviewing Services America to conduct the actual interviews. Interviewing Services America has been in business since 1982. Mobilio Tr., p. 22:8-16. Interviewing Services America contracted with another firm that specializes in drawing samples to generate the geographic sample areas where respondents were called. Mobilio Tr., p. 11-52:8. Mobilio was provided with follow-up paperwork which made her confident that the instructions regarding geographic samples were correctly followed. Mobilio Tr., p. 52:23-53:13.

Dr. Mobilio has reviewed Interview Services America's methodologies in conducting telephone interviews and is of the opinion that they are a high quality data collection firm. Mobilio Tr., pp. 22:17-23:12. Interviewing Services America's interviewers were trained and given precise questions to read with instructions for performing the survey. Mobilio Tr., p. 24:3-8; Una Mas Survey, Appendix 1. Furthermore, Interviewing Services America uses computer assisted telephone interviewing, so that interviewers will ask questions in the appropriate order. Mobilio Tr., pp. 21:2-22:3; 24:3-25:2.

Furthermore, safeguards were in place to ensure that the survey was conducted in a fair and unbiased manner. For example, the survey takers were not informed of the purpose of the survey, nor were they informed of who was paying for the survey. Mobilio Tr., Ex. 2, ¶7. Moreover, using computer assisted telephone interviewing reduces the amount of interviewer discretion involved, as the program dictates the questions to be asked. Finally, there is less of a chance for interviewer bias in surveys conducted by telephone in comparison to surveys conducted face-to-face because of the absence of non-verbal cues. Mobilio Tr., Ex. 4, ¶6.

Finally, the survey occurred over a period of several days, and calls were made throughout the morning, afternoon and evening to catch people at different times during the day.

Mobilio Tr., p. 21:16-22:3. The total number of telephone numbers called by Interviewing Services Americas was 16, 704. Of that number, 3,848 residential contacts were made, and 500 of those contacts were willing to participate in the survey and were qualified to participate in the survey. Mobilio Tr., Ex. 2, 10. To validate the survey results, twenty percent of all respondents were contacted by a Interviewing Services America supervisor to ensure that the respondent had been called and did answer the questions. Mobilio Tr., Ex. 2, ¶11. Based on her knowledge of and prior experience with Interview Services America, Dr. Mobilio was entitled to reasonably rely on the raw data generated by Interview Services America. Fed.R. Evid. 703.

d. The Data Gathered Was Accurately Reported And Analyzed In Accordance With Accepted Statistical Principals

Respondent's answers to the interview questions were directly entered into a computer program. Mobilio Tr. 24:10-19; 60:7-23. Since a probability sample was used, the survey results could be projected to the entire universe by the use of mathematical and statistical probability models. Mobilio Tr., Ex. 4, ¶5; *see, Cairns v. Franklin Mint Co.*, 24 F.Supp.2d 1013, 49 USPQ2d 1396 (C.D. Calif. 1998) (The fact that defendants' survey is based on a random sample makes it more reliable.). A Chi-square analysis was performed on the survey results. Mobilio Tr., p. 62:9-24. The margin of error for any particular question is at most 4.38 percent. Una Mas Survey, p. 2; Mobilio Tr., Ex. 4, ¶11.

3. The Survey Results Demonstrate There Is No Confusion Between POQUITO MAS And UNA MAS In The Marketplace

To test for unaided awareness of the Opposer's and Applicant's restaurants, the participants of the survey were asked to name all the Mexican restaurants they had eaten food from in the past. Una Mas Survey, question 8, Appendix 1 p. -ii. To test for aided awareness, a respondent would be directly asked if he had ever heard of the restaurants Una Mas or Poquito

Mas. Una Mas Survey, questions 12-13, Appendix 1 p. v-vi. In Opposer's territory, POQUITO MAS had an unaided awareness of 2%, and an aided awareness of 28%. In Applicant's territory, UNA MAS had an unaided awareness of 4%, and an aided awareness of 41%. Una Mas Survey, p. 4; Mobilio Tr., p. 30:3-10.

Participants in the survey were then asked questions about individual restaurants. Question 10 in the survey specifically asked whether the participants thought a named restaurant was commonly owned or operated or otherwise related to any other restaurant. Una Mas Survey, p. 9; Mobilio Tr. p. 28:3-29:10. Only three respondents out of the five hundred participants stated they thought UNA MAS was commonly owned or operated with POQUITO MAS. Una Mas Survey, p. 11. Furthermore, only two respondents thought POQUITO MAS was commonly owned or operated with UNA MAS. Una Mas Survey, p. 12. Significantly, 1) only one percent of those surveyed thought POQUITO MAS and UNA MAS are commonly owned or operated or otherwise related; and 2) none of the participants who were previously aware of either UNA MAS or POQUITO MAS held an opinion that the two restaurants are commonly owned, operated or otherwise related. Una Mas Survey, p. 13-15; Mobilio Tr., p. 13:24.

In a follow-up assessment series of questions, participants in the survey were read a limited list of eight restaurants, which included POQUITO MAS and UNA MAS, and asked whether they had an opinion whether any of the restaurants were commonly owned, operated or otherwise related. The follow-up assessment questions, question 11 in the survey, were asked in order to provide respondents with sufficient opportunity to voice an opinion regarding a relationship between POQUITO MAS and UNA MAS. By asking question 11, Applicant was bending over backwards to find out if any confusion existed in the marketplace between POQUITO MAS and UNA MAS. Mobilio Tr., p. 29:11-30:2.

The fact that questions 10 and 11 are so similar presents what is known in survey research as a “demand characteristic.” Based on Gricean conversational norms, respondents may have believed that the survey taker expected a different response than the answer given to Question 10. *Mobilio Tr*, Ex. 2, ¶13. It is therefore significantly more likely that participants would find a relationship between the listed restaurants in response to the follow-up assessment questions, than in the initial assessment questions of consumer confusion.

In the follow-up assessment questions, eighty-one percent of the respondents had no opinion regarding the common ownership and/or operation of the listed restaurants, while twelve percent held an opinion. *Una Mas Survey*, p. 16-17. Only fourteen out of five hundred respondents, or three percent overall, thought that POQUITO MAS and UNA MAS are commonly owned or operated or otherwise related. *Una Mas Survey*, p. 17. Of the fourteen, only seven (less than 1.5% overall) stated they thought the restaurants were related because the names are similar. *See, Una Mas Survey*, Appendix 3. Others gave immaterial reasons for their responses, such as:

they “heard of them before and they are all over the place” (*Una Mas Survey*, Appendix 3, Case ID 153.);

“because they probably want to have different names but the same owner” (*Una Mas Survey*, Appendix 3, Case ID 219.);

“because they sound like good Mexican restaurants” (*Una Mas Survey*, Appendix 3, Case ID 274.);

“mainly because there is more than one of them; they have a lot of them in Southern California” (*Una Mas Survey*, Appendix 3, Case ID 140.); and

“the names sound the same; all have the word ‘Uno’” (*Una Mas Survey*, Appendix 3, Case ID 10175.).

The intentional presence of a demand characteristic built into question 11 is probably the reason why slightly more respondents expressed an opinion regarding a relationship between POQUITO MAS and UNA MAS in question 11 than in question 10. Mobilio Tr., Ex. 2, ¶13. However, even if all the responses based on questions with a demand characteristic are tallied, at most 3% of the consumers may be confused about the marks POQUITO MAS and UNA MAS. In *Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989), this Board noted that a 7.6 percent level of confusion is not significant, while surveys disclosing a likelihood of confusion in the range of 11 percent to 25 percent have been found to be significant. 13 USPQ2d at 1626 (citing McCarthy, Trademarks and Unfair Competition, §32:54 (2d ed. 1984)). Accordingly, the results of this survey show a de minimus level of confusion between POQUITO MAS and UNA MAS. *See*, Mobilio Tr., p. 31:13-24.

4. Opposer's Objections To The Survey Have No Merit

a. The Survey is Admissible Evidence

During the deposition of Dr. Mobilio, Opposer objected to the admissibility of the Una Mas Survey on the basis that the survey's raw data was not previously produced to Opposer. Mobilio Tr., p. 12:16-23; p. 34:11-36:23. Opposer's position appears to be that certain discovery requests asked for documents related to any surveys, and/or to provide a complete statement of all opinions to be expressed by Applicant's expert witnesses at trial. For the reasons below, Opposer's objection has no merit.

Una Mas' survey report was first produced to Opposer as an exhibit in Una Mas' Response to Opposer's Motion for Summary Judgment. Furthermore, during the discovery period Una Mas identified Lynne Mobilio and the survey report in response to an interrogatory asking Una Mas to identify all experts it intended to call as an expert witness at trial. *See*,

Applicant's Response to Opposer's First Set of Interrogatories, No. 13, attached to Opposer's Fourth Notice Of Reliance. In response to an interrogatory asking what the expert witness would be testifying about, Una Mas again referred to the survey report. *See*, Applicant's Response to Opposer's First Set of Interrogatories, No. 14, attached to Opposer's Fourth Notice Of Reliance. Likewise, in response to a request for all documents relating to a survey, Una Mas objected that the request was vague, ambiguous and overbroad, and identified the survey report that was previously produced to Opposer. *See*, Applicant's Response to Opposer's First Request for Production of Documents, No. 15, attached to Opposer's Fourth Notice Of Reliance.

Opposer was fully aware of Una Mas' survey report during the discovery period. If Opposer wanted to obtain the raw data or any other documents related to the survey report, Opposer could have specifically requested such documents during the discovery period. Opposer, however, made no effort to obtain any other information related to the survey report during the discovery period or to meet and confer regarding Una Mas' objections to the discovery requests. Opposer should therefore not be allowed to use its failure to follow-up on its discovery requests to prevent the admission of Una Mas' survey report.

b. Opposer's Other Objections Have No Merit

Opposer did not introduce any evidence and/or opinions from a survey expert during its testimony and rebuttal periods to attack Una Mas' survey report. Therefore, any arguments from Opposer regarding the weight to be accorded to Una Mas' survey should be given little regard.

Opposer has previously attacked the credibility of Una Mas' survey by alleging that the survey did not encompass the commercial impression surrounding the use of POQUITO MAS and UNA MAS. Replicating the trademark as used in the marketplace would be relevant in a Federal court determining trademark infringement. This opposition proceeding, however, is

based on the marks of the registration and applications which are unstylized; therefore, trade dress or commercial impression is not relevant. Instead, a survey designed to determine the likelihood of confusion between a registered mark and a pending application should replicate the registration as closely as possible. Applicant's survey did this by reciting the marks in question and linking the marks to restaurant services.

Moreover, the Una Mas survey avoided a direct side by side comparison of POQUITO MAS and UNA MAS by randomly separating the marks in the list of restaurants presented to the respondents, and because the respondents were not shown side by side depictions of the marks. Mobilio Tr., Ex 4, ¶ 7. The short time frame between the presentation of the names POQUITO MAS and UNA MAS did not skew the accuracy of the survey results. Mobilio Tr., Ex. 4 ¶ 8. Moreover, even if the timing of the presentation of the names did affect the survey results, it would tend to increase the finding of an association between the names in the minds of the respondents, in comparison to the presentation of the names separated by a large time gap. Mobilio Tr., Ex. 4 ¶ 8. Therefore a more stringent test of consumer confusion was conducted by presenting POQUITO MAS and UNA MAS within the same survey episode. Mobilio Tr., Ex. 4 ¶ 8.

C. Opposer Has Not Introduced Any Credible Evidence Of Actual Confusion.

As proof of actual confusion between Opposer's mark and Applicant's mark, McCarney testified that he had a conversation with an unknown person on an airplane and with a cashier at a store in Northern California. Applicant moves to strike McCarney's testimony regarding these conversations as hearsay. Fed.R.Evid. 802.

Even if this Board finds that McCarney's testimony is admissible evidence, McCarney's testimony consists of uncorroborated, self-serving statements from a biased witness that is

obviously not credible. McCarney testified in his deposition that he has stopped other companies from using similar trademarks. App.'s 5th NOR, p. 17:21-19:9. Having retained attorneys in the past to protect his trademark interests, McCarney must have realized the importance of this alleged airplane conversation. Yet McCarney did not even get the name of this passenger, or take notes of the conversation. App.'s 5th NOR, p. 22:22-23:13.

In fact, during his discovery deposition, McCarney also related two or three other purported conversations he had on airplanes, wherein he was allegedly asked whether Poquito Mas is the same as Una Mas. App.'s 5th NOR, p. 24:18- 28:6. These conversations allegedly occurred after he prepared his Declaration filed in Support of Opposer's Motion for Summary Judgment in this matter. App.'s 5th NOR, p. 13:16 – 14:4. Although McCarney was aware of this ongoing opposition, McCarney did not even get the names of the people he alleges were confused, and barely recalls the conversations. App.'s 5th NOR, p. 27:18 – 28:6. This casts great doubt on the credibility of these statements. Moreover, Applicant was denied the opportunity of cross examining these mystery witnesses to find out if they were actually confused and/or believed that there is some relationship between POQUITO MAS and UNA MAS.

McCarney's testimony about a purported conversation he had with a cashier at a retail store in Northern California was also during the pendency of this opposition proceeding. Yet McCarney did not present testimony from this supposed witness, but instead chose to rely on his hearsay conversation with this allegedly confused person. McCarney's alleged recollections are not credible evidence of actual confusion, and, even if admissible, should be granted little weight, if any, by this Board. 4 McCarthy, *Trademarks and Unfair Competition* 23-55 (4th Ed. 2002) (evidence of actual confusion of a very limited scope may be dismissed as *deminimis*);

Electronic Water Conditioners, Inc. v. Turbomag Corp., 221 USPQ 162 (TTAB 1984) (“That questions have been raised as to the relationship between firms is not evidence of actual confusion of their trademarks.”); *Atlantic Richfield Co. v. Arco Globus Int’l. Co.*, 43 USPQ2d 1574 (S.D.N.Y. 1997) (“isolated incidents of confusion, especially by unidentified individuals after the commencement of litigation, is insufficient to establish a likelihood of confusion.”).

Even if this Board were to accept that the conversations occurred, these conversations are not evidence of actual confusion in the marketplace. First, McCarney has not shown that these persons were actually confused, instead of just wondering about a possible relationship. *See, Lloyd’s Food Products, Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993). For example, McCarney states that he told a fellow airplane passenger that he ran a restaurant called POQUITO MAS. In response, the unknown person allegedly asked either “Oh, the Una Mas chain up here?” (McCarney Tr., p. 96:4-14) or “Oh, are you part of that UNA MAS chain up here?” App.’s 5th NOR, p. 22:8-23. Such a statement by the alleged witness is not evidence that these unnamed person was actually confused, but instead should be interpreted as mere wondering about a possible relationship. *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1327 (TTAB 1992) (fact that three individuals asked whether MRS. FIELDS is part of MARSHALL FIELDS does not indicate confusion, but instead indicates that individuals recognized these were two separate entities.).

Furthermore, despite ten years of co-existence, Applicant is unaware of any actual confusion between its mark UNA MAS and Opposer’s mark POQUITO MAS. Mr. Hamner is not aware of any mail that was meant for Poquito Mas but misdirected to Una Mas, nor aware of any misdirected telephone calls or facsimiles, or any misdirected communications from vendors, banks, or potential investors. Hamner Tr., p. 25:10-25. Furthermore, Mr. Hamner is not aware

of any inquiries from customers, vendors, or potential investors asking if POQUITO MAS and UNA MAS are related. Hamner Tr., p. 26:1-4. In fact, none of Una Mas' restaurant managers have reported any inquiries regarding POQUITO MAS. Hamner Tr., p. 26:5-27:4.

The length of time during and conditions under which there has been concurrent use without evidence of actual confusion is relevant evidence of the lack of a likelihood of confusion. *Old Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 204-205, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992). Opposer's restaurants have co-existed with Applicant's restaurants for ten years. Yet, despite receiving inquiries from all over the United States about franchising the Poquito Mas restaurants (McCarney Tr., p. 33:11-21); despite receiving emails from persons around the country, including Chicago and Northern California where Una Mas has restaurants (McCarney Tr., p. 43:13-15, 45:12-20); despite the fact that some of his restaurant customers have lived in Northern California (McCarney Tr., p. 46:21-24) and Opposer believes that POQUITO MAS' reputation has reached Northern California (App.'s 5th NOR, p. 11:11-22); the only "evidence" of actual confusion that Opposer can muster is his own uncorroborated hearsay testimony. If Opposer's testimony of the extensive reputation of POQUITO MAS is believed, then Opposer's inability to provide any credible evidence of actual instances of confusion during the past ten years also weighs against a finding of a likelihood of confusion. *G.H. Mumm & Cie v. Denoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990) (no likelihood of confusion when Opposer cannot offer any evidence of actual confusion despite the marketing of Applicant's mark for over a decade.); *Fruit of the Loom, Inc. v. Fruit of the Earth, Inc.*, 3 USPQ2d 1531, 1533 (absence of instances of actual confusion despite concurrent advertising, sales of millions of dollars by both parties in the same channels of trade for over five years is some evidence that confusion is not likely).

D. POQUITO MAS Is Not A Famous or Even a Remotely Well-Known Mark

Fame of a mark is shown by evidence of advertising figures, sales, market share, and survey evidence regarding recognition of a mark. *See, DuPont*, 476 F.2d at 1361, 177 USPQ at 567; *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451 (TTAB 1998) (party seeking to show that mark is famous should put sales and advertising figures into context, and better practice is to also submit consumer and trade testimony). Here, Opposer has not submitted any evidence regarding its sales and advertising figures. In fact, Opposer has testified that he does very little advertising. *McCarney Tr.*, p. 60:12-61:16.

Furthermore, Opposer's restaurant reviews and other articles regarding his restaurant are not evidence that POQUITO MAS is famous or well known for restaurant services. First, such articles are hearsay as to whether the mark is famous. *See, Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1406 (TTAB 1998). Moreover, Opposer has not introduced any evidence regarding the circulation of the various publications from which he has taken excerpts, therefore there is no evidence regarding the market penetration and exposure that his mark is receiving.

Additionally, Opposer has not introduced any marketing research or surveys regarding the fame of his mark or consumer recognition of his mark. In contrast, the Una Mas Survey is reliable evidence that Opposer's mark is not famous or even well-known in Opposer's own backyard. In an unaided awareness question, only two percent of the two-hundred and fifty respondents within a five mile radius of Opposer's restaurants identified Poquito Mas as a Mexican restaurant. Una Mas Survey, pp. 4, 7-8. This is underscored by the fact that while industry articles regarding the growth of Mexican food-style restaurants have mentioned UNA MAS as a leader, POQUITO MAS is not mentioned. *See, Opp.'s 3rd NOR, Attachment 2*

(leading fast-casual Mexican restaurants are “Chipotle, Rubio’s, Baja Fresh, Qdoba and Una Mas.”); App.’s 4th NOR, Ex. 2. Accordingly, in contrast to Opposer’s self-serving testimony, the unbiased evidence shows that Opposer’s mark is not, under any standard, a well-known mark for restaurant services, let alone a famous one.

E. Similar Marks Are In Use By Third Parties

Under DuPont, “[t]he number and nature of similar marks in use on similar goods” is a factor that must be considered in determining likelihood of confusion. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361. Evidence of actual use of similar marks for similar goods can support an inference that opposer’s mark is weak. *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 22 USPQ2d 1542 (Fed. Cir. 1992).

Applicant performed a search for restaurants in the United States that contain the term “Mas” as part of their trade name. Peters Tr., p. 6:10-17; Ex. 1. A sampling of these restaurants were then contacted to verify that they are operating restaurants. Peters Tr., p. 8:2-12:19; Ex. 1. In fact, several of the restaurants contacted sent a copy of their menus. *Id.* Such evidence is a survey and thus is admissible as an exception to the rule against hearsay. Furthermore, whether the third party marks are used for expensive sit down restaurants or inexpensive take out restaurants is not relevant as both Opposer’s and Applicant’s marks are for “restaurant services” in general.

The survey of restaurants found that there are at least thirteen operating restaurants in the United States that serve Mexican or Latin-American style food that contain the formative “MAS.” Peters Tr., Ex. 1, ¶2-14. For example, DOS MAS in Texas serves Mexican food; MAS TORTILLA GRILL in Texas serves Mexican food; MAS AMIGOS MEXICAN RESTAURANT

in Texas serves Mexican food; EL MAS CAFÉ in California serves Mexican food; MAS RESTAURANT and OTRO MAS in Illinois serve Latin American cuisine; MAS FAJITAS in Texas serves Mexican food; BURGERS Y MAS serves hamburgers and burritos; MUCHO MAS in California serves Mexican food; ENCHILDAS Y MAS in Texas serves Mexican food; and LATINO Y MAS SPANISH CUISINE in Florida serves Spanish, Mexican and Puerto Rican Food. *Id.*

Furthermore, use of a mark in sales or advertising materials is important in establishing rights to a service mark. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993). Therefore use of a mark in telephone directories, and advertisements in yellow pages carries a presumption that the services mark is being used by third-parties in connection with the offering of advertised services. *Id.* Such evidence is “at least sufficient to raise a potentially dispositive issue of fact about the extent and character of the third-party use of the mark . . . and to preclude summary judgment on the likelihood of confusion.” *Id.*

Here, Applicant has introduced listings from the American Business Listings. The American Business Listings is comprised of information gathered from several sources, including the yellow pages and annual reports from public companies. Peters Tr., Ex. 1 ¶15. Excluding Opposer’s and Applicant’s restaurants, there are twenty-seven restaurants listed in the American Business Directory that contain the formative “MAS.” Peters Tr., Ex. 1¶15. This demonstrates that “MAS” is frequently used for restaurant services and that the public has been exposed to restaurants with similar service marks. Accordingly, the public would be able to differentiate between POQUITO MAS and UNA MAS. *See, Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 393 (TTAB 1976).

1. Applicant has circumscribed rights to exclude others from use of its mark.

Where the common element in two marks is descriptive, suggestive or laudatory, the scope of protection afforded the registered mark may be circumscribed. *In re Lar Mor Int'l*, 221 USPQ 180, 183 (TTAB 1983). *See, General Mills, Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992) (“One” in FIBER ONE is laudatory, no likelihood of confusion between FIBER ONE and FIBER 7.) As explained above, MAS has a laudatory connotation of giving more to the customer in the context of restaurant services. Therefore, the scope of protection accorded to restaurant names containing the formative “MAS” should be less than the scope of protection accorded to restaurant names that are arbitrary marks.

Opposer’s evidence regarding how both parties promote the concept of “giving more to the customer” underscores that “MAS” has a laudatory connotation when applied to restaurant services. *See, McCarney Tr., Ex. 11, 13, 28, 29*. The laudatory connotation of the term “MAS,” combined with the fact that other third parties are using the term “MAS” in service marks for restaurants, leads to the conclusion that the use of “MAS” as a service mark for restaurants is less than arbitrary. Therefore, Opposer cannot prevent the use of all marks that include the term “MAS” for restaurant services. *Nestle Foods Corp. v. Kellogg Co.*, 6 USPQ2d at 1149 (Opposer, who was first to use mark, cannot preclude others from using marks with similar suggestiveness if marks distinguishable in sound and appearance; no likelihood of confusion between TASTERS CHOICE and DINERS CHOICE.).

As discussed above, POQUITO MAS is a weak mark that is not entitled to a broad scope of protection. The weakness of a mark is “a significant factor and serves, in this case, to tip the scales in favor of a finding of no likelihood of confusion.” *In re Dayco Prodcuts-Eaglemotive, Inc.*, 9 USPQ2d 1910, 1912 (Third party registrations demonstrate that IMPERIAL is laudatory

as adopted by vehicular field; therefore IMPERIAL is weak mark.). Accordingly, since “MAS” is a weak term while “UNA” is distinguishable from “POQUITO” in sound, appearance and connotation, there is no likelihood of confusion between POQUITO MAS and UNA MAS.

G. Trade Dress Is Not An Issue In This Proceeding

After correctly stating that trade dress is not an issue before the Board (Opposer’s Brief, p. 11), Opposer then attempts to muddle the record by making repeated references to his restaurants’ trade dress and image. This appears to be a desperate attempt by Opposer to distract this Board with a side show. Even if this Board were to consider the parties’ trade dress, a close look at the record reveals that Opposer has not established that his restaurants possess a trade dress other than that of a typical taqueria or taco stand.

McCarney has repeatedly testified that his restaurants are “upscale.” McCarney Tr., pp. 74:7-8; 75:20-21; 77:4; 82:17-18; 95:15. McCarney has also testified that he would not use the term “taqueria” or taco stand to describe his restaurants. Many of the reviews of his restaurants, however, describe his restaurant as less than “upscale.” See, McCarney Tr., Ex. 12 (“POQUITO MAS looks like an ordinary fast-food joint.”); McCarney Tr., Ex. 35 (“these no frills spots don’t look like much.”); McCarney Tr., Ex. 36 (“low-rent facilities”); Opp. 5th NOR, Attachment 3 (“its just a taco shack . . . nothing fancy”), Attachment 5 (“Poquito Mas looks, on the surface, like any number of small taquerias”), and Attachment 11 (“pint-sized taqueria”).

Similarly, while Opposer insinuates that Una Mas Restaurants is copying his restaurants’ “upscale” look, the evidence indicates that individual Poquito Mas restaurants do not even have the same trade dress, let alone share an “upscale” look. See, McCarney Tr., p. 15:22-24 (older units have Saltio tiles), p. 16:20-22 (used brick in some of the units), p. 18:23-25 (not all

restaurants have the same color walls); Opp. 5th NOR, Attachment 2 (“order at a counter under red galvanized tin roofing”), Opp. 5th NOR, Attachment 11 (“bright, modestly upscale café featuring a salsa counter . . . a few plastic tables”). Accordingly, the unbiased evidence shows that Opposer’s restaurants do not have a unified trade dress. Moreover, Opposer’s restaurant that Applicant is allegedly copying was not even built until 1999, two years after the start of this opposition proceeding. McCarney Tr., p. 17:18-19.

H. Unbiased Evidence Shows There Is No Likelihood Of Confusion

Opposer has attempted to rely on uncorroborated, biased, and hearsay testimony regarding 1) actual confusion between the marks at issue; 2) the strength and fame of his mark; and 3) the trade dress of his restaurants to show that a likelihood of confusion exists between POQUITO MAS and UNA MAS for restaurant services in class 42. However, the one credible piece of evidence regarding actual confusion between the marks, the Una Mas Survey, establishes that there is no confusion between POQUITO MAS and UNA MAS in the marketplace.

The survey was taken within five miles of Opposer’s restaurants, where it would be expected that more people would have knowledge of Opposers restaurants and therefore be more likely to be confused by Applicant’s mark. The survey was also very conservative in that it asked follow-up assessment series of questions to provide respondents with sufficient opportunity to voice an opinion regarding a relationship between POQUITO MAS and UNA MAS. Una Masa Survey, question 11. By asking the follow-up assessment questions, Applicant was bending over backwards to determine whether any confusion existed in the marketplace between POQUITO MAS and UNA MAS. Mobilio Tr., p. 29:11-30:2.

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Applicant structured its survey to favor Opposer in every respect. Yet the survey found only a de minimus level of confusion. See, *Mobilio Tr.*, p. 31:13-24. This is credible, unbiased evidence that this Board can rely on to find that there is no likelihood of confusion between POQUITO MAS and UNA MAS.

SUMMARY

POQUITO MAS and UNA MAS are significantly dissimilar in appearance, sound and connotation. Likewise, the service marks POQUITO MAS and ONE IS GOOD BUT UNA MAS IS BETTER are significantly dissimilar in appearance, sound and connotation. Accordingly, there is no likelihood of confusion between Opposer's mark and Applicant's marks. This is further evidenced by Applicant's survey, which shows that there is no actual confusion in the marketplace between the marks POQUITO MAS and UNA MAS. Applicant therefore respectfully requests the dismissal of this opposition proceedings, and that U.S. Trademark Application Serial No. 75154590 for ONE IS GOOD BUT UNA MAS IS BETTER, and U.S. Trademark Application Serial No. 75214266 for UNA MAS be allowed to register.

Respectfully submitted,

DORSEY & WHITNEY LLP

Date: 2/11/03



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CERTIFICATE OF SERVICE

I hereby certify that on this 11th day of February, 2003, a true and correct copy of the foregoing APPLICANT'S RESPONSE TO THE BRIEF OF OPPOSER was served on Opposer's Attorney by mail to:

Robert V. Vickers
Fay Sharpe Fagan Minnich & McKee LLP
1100 Superior Avenue, Seventh Floor
Cleveland, Ohio 44114

I declare under penalty of perjury that the foregoing is true and correct.

Executed on February 11, 2003 at San Francisco, California.



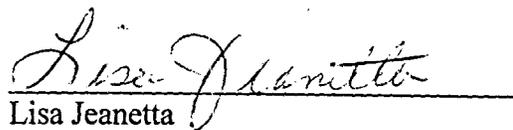
Lisa Jeanetta

CERTIFICATE OF MAILING

I hereby certify that an original and two (2) true and correct copies of the foregoing APPLICANT'S RESPONSE TO THE BRIEF OF OPPOSER is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: BOX TTAB – NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on February 11, 2003.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on February 11, 2003 at San Francisco, California.



Lisa Jeanetta

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VIA FEDERAL EXPRESS

Tammy Logan
BOX TTAB
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Re: Kevin T. McCarney, dba Poquito Mas v. Una Mas Restaurants, Inc.
Opposition No. 107,026
Opposition No. 107,048
Our File: TL-53425-2/DJB/DJM (468097-10)

06 JUN -5 AM 9:30
COMMUNICATIONS SECTION
U.S. PATENT & TRADEMARK OFFICE

Dear Ms. Logan:

Pursuant to your request, enclosed is a copy of the Response to Opposer's Brief in regard to the above matter.

Very truly yours,

DORSEY & WHITNEY LLP

David J. Brezner

DJB:lj
1111731

Enclosure