

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: July 24, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Riviana Foods Inc.

v.

Romero-Nunez, Susana

\_\_\_\_\_  
Opposition No. 91167098  
to application Serial No. 78497674  
filed on October 11, 2004

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Paul C. Van Slyke of Locke Liddell & Sapp LLP for Riviana  
Foods Inc.

John S. Egbert of Harrison & Egbert for Susana Romero-Nunez.

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Before Rogers, Drost and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Susana Romero-Nunez, has applied to register on the Principal Register the mark EL MAGO in standard character form based upon her allegation of a bona fide intent to use the mark in commerce for "restaurant services" in International Class 43.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78497674 was filed on October 11, 2004. Applicant submits the following translation of the foreign wording in the mark: The English translation of EL MAGO is THE MAGICIAN.

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Registration has been opposed by opposer, Riviana Foods, Inc. As grounds for opposition, opposer asserts that it is the owner of the mark EL MAGO, previously used and registered on the Principal Register in typed or standard character form, for "rice and rice mixes" in International Class 30.<sup>2</sup>

Opposer argues that it has used its registered mark in connection with the above listed goods since prior to any date upon which applicant may rely for purposes of priority of use of its involved mark; that applicant's mark, when used in connection with applicant's services, so resembles opposer's mark for its recited goods as to be likely to cause confusion, to cause mistake, and to deceive; and that opposer will be damaged thereby.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.<sup>3</sup>

The record in this case consists of the pleadings and the file of the involved application. During its assigned

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<sup>2</sup> Registration No. 2329953 issued on March 14, 2000 with the following translation of the foreign wording in the mark: The English translation of the word "EL MAGO" in the mark is "the magician." Section 8 affidavit accepted; Section 15 affidavit acknowledged.

<sup>3</sup> In addition, applicant asserted as an "affirmative defense" that the notice of opposition fails to state a claim upon which relief can be granted. However, applicant did not file a motion to dismiss under Fed. R. Civ. P. 12(b)(6) by means of which any asserted insufficiency in opposer's pleading might be addressed. Accordingly, applicant's "affirmative defense" will be given no further consideration.

testimony period, opposer filed a notice of reliance upon the following: a status and title copy of its pleaded registration; copies of third party registrations obtained from the United States Patent and Trademark Office (USPTO) Trademark Electronic Search System (TESS) reciting both restaurant services and food products under the same marks; and copies of articles from printed publications. In addition, opposer filed the testimony deposition of Mr. Charles Gibson, the Director of Information Services at the office of opposer's counsel, and accompanying exhibits.

Applicant did not take testimony or offer any other evidence during its assigned testimony period.<sup>4</sup> Only opposer filed a brief on the case.

#### **Opposer's Standing**

Because opposer has properly made its pleaded registration of record, we find that opposer has established its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

#### **Priority of Use**

Moreover, because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case

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<sup>4</sup> It is noted in addition that applicant's counsel did not attend the testimony deposition of Mr. Gibson.

as to its EL MAGO mark as well as the goods covered thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

### Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, even those not specifically discussed in this decision. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

#### The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot*, *supra*. In this case, applicant's EL MAGO mark in standard character form is identical to opposer's EL MAGO mark in typed or standard character form in appearance and sound. Further, there is nothing in the record to suggest that EL MAGO

conveys a different connotation or commercial impression when used in connection with opposer's goods versus applicant's services. As a result, we find that the marks are identical in every respect. This *du Pont* factor heavily favors opposer.

The Goods and Services

Next, we turn to our consideration of the similarities or dissimilarities between the parties' goods and services. We note, at the outset of considering this *du Pont* factor, that the greater the degree of similarity between the parties' marks, the lesser the degree of similarity between their respective goods and services that is required to support a finding of likelihood of confusion. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are identical, as in this case, it is only necessary that there be a viable relationship between the goods and services in order to support a finding of likelihood of confusion. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). The issue remains, of course, not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In this case, applicant recites "restaurant services," without limitation as to type or ethnicity of cuisine, in

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its involved application. The goods in opposer's pleaded registration are identified as "rice and rice mixes," also without limitation as to any particular cuisine. Because, as identified, neither applicant's services nor opposer's goods are unrestricted as to type, we must assume that applicant's restaurant services may include all types of restaurants and opposer's rice and rice mixes may include all types of rice. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Thus, opposer's goods and applicant's services must be presumed to include rice and rice mixes on the one hand and restaurants on the other with the same theme or flavoring. See *Id.* As a result, patrons of applicant's restaurant, upon encountering registrant's rice and rice mixes identified by the identical EL MAGO mark, would be likely to experience confusion as to the source of those goods and services.

The predecessor of our primary reviewing Court has held that the mere fact that restaurants serve food and beverages is not enough to render food and beverages related to restaurant services for purposes of determining likelihood of confusion. See *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (CCPA 1982). In affirming the Board's finding that BOSTON SEA PARTY A DINING REVOLUTION and design for restaurants was not confusingly

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similar to BOSTON TEA PARTY for tea, the Court noted that "[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services." *Id.* See also *In re Coors Brewing Co.*, 68 USPQ2d 1059 (Fed. Cir. 2003). The Court further found that the Board correctly considered the "disparity in degree of inherent distinctiveness of the *marks*, the readily perceived differences between the *terms*" [BOSTON SEA PARTY versus the historical Boston Tea Party] and "the differences in the activities of the parties involving the uses of the *marks*," (*Id.* at 643, emphasis in original) in the Board's finding of no likelihood of confusion.

In this case, because the marks are identical there is no disparity in the degree of inherent distinctiveness of EL MAGO as applied to opposer's goods and applicant's services. Further, there is no evidence that EL MAGO is identified with an individual, place or historical event, unlike the mark BOSTON TEA PARTY in *Jacobs* which identifies a well-known historical event from Colonial American history. See *Jacobs v. International Multifoods Corp.*, 211 USPQ 165, 172 (TTAB 1981). Thus, there is no readily perceived difference between the mark EL MAGO and the term EL MAGO.

In addition, opposer has introduced by notice of reliance copies of articles from printed publications such

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as The Wall Street Journal, St. Petersburg Times, San Diego Business Journal, USA Today, Los Angeles Times, and Chicago Tribune, all discussing the growing trend among restaurants to license the use of their marks on food items or to otherwise market food items under the restaurants' names. This evidence suggests that consumers are becoming more accustomed to associating certain food items sold at retail with the restaurants in which such foods are served, and purchasing food products based upon their association with such restaurants. Opposer also has introduced evidence in the form of copies of third-party registrations in which the same marks are used to identify restaurant services and a variety of food products, including rice. This evidence further tends to suggest that consumers are likely to believe that opposer's goods and applicant's services may emanate from a common source. Thus, opposer's uncontroverted evidence supports a finding that applicant's restaurant services are related to opposer's rice and rice mixes, especially when offered under an identical mark. In view of the foregoing evidence, we find that opposer has satisfied the requirement articulated in *Jacobs* that it demonstrate, in addition to the use of similar marks on restaurants on the one hand and food products on the other, that there is an additional association between applicant's

restaurant services and its rice and rice mixes. This *du Pont* factor also favors opposer.

Channels of Trade

Because applicant's services are related to opposer's goods, and because there are no recited restrictions as to the channels of trade or classes of purchasers, the goods and services are presumed to be marketed to the same class of consumers, i.e., the general public, through the same media outlets such as television, radio, internet, and printed advertisements. It is settled that in making our determination regarding the relatedness of the parties' goods and/or services, we must look to the goods and services as identified in the involved application and pleaded registration. See *Octocom Systems, supra*. ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the

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respective descriptions of goods.") Thus, this *du Pont* factor also favors opposer.

**Summary**

In view of the foregoing, we find that opposer has established its standing to bring this proceeding; its priority of use; and that patrons of applicant's restaurant, upon encountering opposer's rice and rice mixes under the identical EL MAGO mark, are likely to experience confusion as to the source of the parties' goods and services.

DECISION: The opposition is sustained on the ground of priority and likelihood of confusion, and registration to applicant is refused.