

This Opinion is not a  
Precedent of the TTAB

Hearing: February 11, 2025

Mailed: March 7, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Texas Department of Transportation*

*v.*

*El T. Mexican Restaurants, Inc.*

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Opposition No. 91264923  
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Dwayne K. Goetzel, of Kowert, Hood, Munyon, Rankin & Goetzel, P.C.,  
for Texas Department of Transportation.

John C. Rawls, Sarah Silbert, of Baker Williams Matthiesen LLP,  
for El T. Mexican Restaurants, Inc.

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Before Lynch, English, and Casagrande,  
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:

El T. Mexican Restaurants, Inc. (“Applicant”) applied to register the mark DON’T  
MESS WITH TEX-MEX (in standard characters) on the Principal Register for  
“Restaurant services” in International Class 43.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88830928 was filed on March 11, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of February 1, 2020.

Texas Department of Transportation (“Opposer”) opposes registration.<sup>2</sup> Opposer alleges ownership of many U.S. Trademark Registrations for the standard-character mark DON’T MESS WITH TEXAS, including the following two registrations:

- Reg. No. 2616831 for services identified as “promoting the beautification of Texas highways and the public awareness of the need for litter prevention and litter cleanup through the development and dissemination of educational materials and public service,” in International Class 42;<sup>3</sup>
- Reg. No. 2627196 for goods including “paper food containers, paper bags” in International Class 16;<sup>4</sup> and
- Reg. No. 3149283 for “Beverage containers, namely mugs and cups,” in International Class 21.<sup>5</sup>

Opposer claims that registration should be refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because Applicant’s mark is likely to cause consumer confusion in view of Opposer’s mark.<sup>6</sup> Opposer also claims that use of Applicant’s mark will dilute the distinctiveness of Opposer’s mark, which Opposer alleges is famous.<sup>7</sup> *See* 15 U.S.C. §§ 1063(a) & 1125(c).

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<sup>2</sup> *See* Notice of Opposition, 1 TTABVUE. References to the pleadings, briefs, and other filings, including evidentiary filings, in the case cite the Board’s TTABVUE docket system. The number preceding “TTABVUE” is the docket number assigned to the cited filing in TTABVUE and any number immediately following “TTABVUE” identifies the specific page(s) to which we refer.

<sup>3</sup> Reg. No. 2616831 (the “’831 Registration”) issued September 10, 2002, and is renewed.

<sup>4</sup> Reg. No. 2627196 (the “’196 Registration”) issued October 1, 2002, and is renewed.

<sup>5</sup> Reg. No. 3149283 (the “’283 Registration”) issued September 26, 2006, and is renewed.

<sup>6</sup> *See* 1 TTABVUE 5-7.

<sup>7</sup> *See* 1 TTABVUE 6-7.

Applicant filed an Answer admitting that USPTO records reflect that Opposer owns the pleaded registrations but denying the other salient allegations in the Notice.<sup>8</sup>

The parties filed trial briefs<sup>9</sup> and Opposer filed a rebuttal brief.<sup>10</sup> For the reasons explained below, we sustain the opposition.

## I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the challenged application. In its Notice of Opposition, Opposer attached printouts of information from the USPTO's public electronic database records showing the current status and title of its pleaded registrations, including the '196 and '283 Registrations,<sup>11</sup> thereby making them of record. *See*

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<sup>8</sup> *See* 6 TTABVUE 3-4. Applicant did not interpose any counterclaims seeking cancellation of any of Opposer's pleaded registrations. As an "affirmative defense," Applicant's Answer asserted that Opposer "fails to state a claim upon which relief may be granted." *See id.* at 4. This is merely a generalized assertion that Opposer insufficiently pleaded its claims, not "a statement of a defense to a properly pleaded claim." *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, No. 91263919, 2022 WL 16646840, at \*1 n.5 (TTAB 2022). Applicant also pleaded "unclean hands" as an affirmative defense, but it did not pursue this defense in its trial brief. Consequently, Applicant impliedly waived, or forfeited, this defense. *See, e.g., Keystone Consol. Indus., Inc. v. Franklin Invest. Corp.*, No. 92066927, 2024 WL 3771168, at \*2 (TTAB 2024).

This opinion is issued under an internal Board pilot citation program on broadening acceptable forms of case citations in Board cases. It cites decisions of the U.S. Court of Appeals for the Federal Circuit (and the CCPA) only to the Federal Reporter (e.g., F.2d, F.3d, or F.4th). Westlaw (WL) citations are used for Board decisions. Serial or proceeding numbers are provided where available to assist finding cited Board opinions in USPTO and other databases. This opinion thus conforms to the practice set forth in Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 101.03 (2024).

<sup>9</sup> *See* 70 TTABVUE (Opposer's brief); 71 TTABVUE (Applicant's public (redacted) brief); 72 TTABVUE (Applicant's confidential (unredacted) brief).

<sup>10</sup> *See* 73 TTABVUE.

<sup>11</sup> *See* 1 TTABVUE 17-19 ('196 Registration); *id.* at 26-28 ('283 Registration).

Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). During its trial period, Opposer submitted additional evidence:

- A Notice of Reliance attaching many different types of documents, including excerpts of discovery depositions and discovery responses, as well as numerous examples of ads and promotional materials concerning Opposer's anti-littering program under its mark, as well as third-party articles about the success of its anti-littering program;<sup>12</sup> and
- The Declaration of Becky Ozuna, who for many years was the coordinator for Opposer's anti-littering campaign, attaching documents including many of the same advertisements, promotional materials, and third-party articles already attached to Opposer's Notice of Reliance, as well as various agreements concerning Opposer's mark as to which Opposer is a signatory;<sup>13</sup> and
- The Affidavit of Jerry Thomas, the president and CEO of a market research company, opining on the results of a consumer survey his company designed and conducted that purports to address the fame of Opposer's mark and likelihood of confusion.<sup>14</sup>

During its trial period, Applicant submitted the following:

- The transcript of Applicant's cross-examination deposition of Becky Ozuna;<sup>15</sup>
- The transcript of Applicant's cross-examination deposition of Jerry Thomas;<sup>16</sup>

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<sup>12</sup> See 37 & 38 TTABVUE. Opposer later submitted amended versions of these Notices of Reliance. See 50 & 51 TTABVUE.

<sup>13</sup> See 39 TTABVUE (public, redacted version); 40 TTABVUE (confidential, unredacted version).

<sup>14</sup> See 54 TTABVUE (public version); 55 TTABVUE (confidential version). The public and confidential versions of the affidavit itself are identical. The confidential version includes the survey and supporting data as an exhibit; the public version does not.

<sup>15</sup> See 57 TTABVUE.

<sup>16</sup> See 63 TTABVUE (public versions without Thomas survey attached); 64 TTABVUE (confidential filing with Thomas survey attached).

- A first Notice of Reliance attaching Opposer's responses to Applicant's discovery requests;<sup>17</sup>
- A second Notice of Reliance attaching articles discussing Opposer's anti-littering campaign;<sup>18</sup> and
- The Declaration of John Mayes, the Vice-President of Applicant.<sup>19</sup>

Opposer timely filed a rebuttal declaration, with exhibits, from Becky Ozuna.<sup>20</sup>

## II. Opposer is statutorily entitled to pursue this opposition proceeding

In every inter partes case, the plaintiff must establish that it is entitled to invoke the statute authorizing the proceeding it filed. Opposer filed an opposition proceeding under Section 13 of the Trademark Act, 15 U.S.C. § 1063, and therefore must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 120-37 (2014)); *id.* at 1305 (applying *Lexmark* to inter partes TTAB cases). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark establishes proximate causation. *Id.* at 1305-06.

Opposer's Notice of Opposition invokes Section 2(d) and alleges that Applicant's mark creates a likelihood of consumer confusion as to source in view of several

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<sup>17</sup> See 65 TTABVUE (public version with redactions); 66 TTABVUE (confidential, unredacted version).

<sup>18</sup> See 67 TTABVUE.

<sup>19</sup> See 68 TTABVUE.

<sup>20</sup> See 69 TTABVUE.

registered marks Opposer owns, and Opposer supported this plausible claim by attaching to the Notice printouts of information from the USPTO's public electronic database records showing the current status and title of its pleaded registrations.<sup>21</sup> Accordingly, Opposer has established that it is entitled to have filed this statutory opposition proceeding. *See, e.g., Made in Nature, LLC v. Pharmavite LLC*, No. 91223352, 2022 WL 2188890, at \*9 (TTAB 2022); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, No. 91217095, 2016 WL 7655551, at \*2 (TTAB 2016). Entitlement to oppose based on one statutory bar to registration entitles Opposer to raise any other applicable statutory bar(s). *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377 (Fed. Cir. 2012). Thus, Opposer is also statutorily entitled to pursue its claim that Applicant's mark dilutes the distinctiveness of Opposer's marks.

### III. Analysis of Opposer's claims

We turn to the substance of Opposer's two claims. We begin with Opposer's likelihood-of-confusion claim.

#### A. Section 2(d) claim

Section 2(d) prohibits registration of a mark that "so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in

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<sup>21</sup> *See* 1 TTABVUE.

connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

1. Priority is not an issue because Opposer owns unchallenged registrations

Under Section 2(d), an opposer must prove ownership of a prior-filed application or registration, or else prove priority of use. Where, as here, an opposition is based on ownership of registered marks, those registrations are of record, and the applicant has not counterclaimed to cancel them, the opposer need not prove priority of use as to the marks and goods or services covered by the registrations. *See, e.g., Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1403 n.6 (CCPA 1974); *Top Tobacco LP v. N. Atl. Op. Co.*, No. 91157248, 2011 WL 6099691, at \*6 (TTAB 2011); *Itel Corp. v. Ainslie*, No. 91072956, 1988 WL 252407, at \*2 (TTAB 1988).

2. Likelihood of confusion

The remaining element of Opposer’s Section 2(d) claim is likelihood of confusion. “[T]he opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (citation omitted). To determine whether Opposer has proved confusion is likely, we evaluate evidence bearing on the several factors listed in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). *See, e.g., Stratus Networks*, 955 F.3d at 998. The first two listed factors are the similarities and/or dissimilarities between the parties’ marks and goods/services. *du Pont*, 476 F.2d at 1361. These are key factors in any case under Section 2(d). *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental

inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *In re Max Cap. Grp. Ltd.*, No. 77186166, 2010 WL 22358, at \*1 (TTAB 2010) (“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.”) (citations omitted); *see also Stratus Networks*, 955 F.3d at 999 (the Board “may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods”) (citations omitted).

After assessing all relevant factors, our last step is to “weigh the ... factors used in [our] analysis and explain the results of that weighing” and “the weight [we] assigned to the relevant factors.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1383-84 (Fed. Cir. 2023) (citation omitted). “The weight given to each factor depends on the circumstances of each case.” *Id.* at 1381 (citation omitted); *see also Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022) (“Not all of the ... factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case.”) (cleaned up; citation omitted).

a. Comparison of the marks

We start with the first factor listed in *du Pont*: the “similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” 476 F.2d at 1361. “The similarity or dissimilarity of the marks in their entirety is a predominant inquiry.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165 (Fed. Cir. 2002) (cleaned up; citation omitted); *accord Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265-66 (Fed. Cir. 2002). “Marks are



compared along the axes of their ‘appearance, sound, connotation and commercial impression.’” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015) (citation omitted); *accord In re i.am.symbolic, llc*, 866 F.3d 1315, 1323 (Fed. Cir. 2017).

Opposer’s mark, for all the asserted registrations, is DON’T MESS WITH TEXAS. Applicant’s mark is DON’T MESS WITH TEX-MEX. The marks look highly similar. They’re both four words, the first three of which are identical. Consumers tend to notice and remember first words. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1303 (Fed. Cir. 2018) (“The identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.”) (citations omitted); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, No. 91074797, 1988 WL 252340, at \*3 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). Here, the first three identical words are followed by their last words, which both begin with “Tex-.” The marks sound highly similar as well, for similar reasons. And though the marks’ final words are different, they’re both two syllables and begin with “TEX.” Overall, the aural difference in the companies’ phrases is so small that it might even be indiscernible in speech, depending on how clearly each is articulated.

The marks have both similarities and differences in meanings and connotations, however. The admonition “DON’T MESS WITH” is the same, but the object of the admonitions is different: Texas is a state and Tex-Mex is a cuisine. But even the

difference in the last word isn't stark, for the "Tex" in "Tex-Mex" refers to Texas.<sup>22</sup> Thus, the admonition of Opposer's mark is not to mess with Texas, and the admonition of Applicant's mark is not to mess with a Texas-influenced cuisine. Keeping in mind the well-settled principle that not all of the so-called "axes" of comparison, *see Juice Generation*, 794 F.3d at 1340, have to align for confusion to be likely, *see, e.g., Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted); *Holiday Casuals v. M. Beckerman & Sons, Inc.*, 228 F.2d 224, 225 (CCPA 1955) ("sound alone or appearance alone may be sufficient to create likelihood of confusion") (citations omitted), we find that, while the marks aren't identical, they are highly similar overall.

b. Comparison of the goods, trade channels, and classes of customers.

The second, third, and fourth likelihood-of-confusion factors assess the types of goods and services the parties offer under their respective marks, their trade channels, and their classes of customers. *See du Pont*, 476 F.2d at 1361. The fourth factor also assesses the degree of care with which the typical customer approaches purchasing decisions as to the types of goods in question. *See id.* ("impulse' vs. careful, sophisticated purchasing"). Our analysis of "the second, third, and fourth *du Pont* factors ... is based ... on the identifications as set forth in the application and

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<sup>22</sup> *See* 37 TTABVUE 173 (Applicant's Rule 36 admission that "that 'Tex-Mex,' as used by El T. in the DON'T MESS WITH TEX-MEX trademark, is intended to refer to a type of cuisine influenced by the cuisines and cultures of both Texas and Mexico").

the cited registration.” *Advance Mag. Publishers, Inc. v. Fashion Elecs., Inc.*, No. 91247034, 2023 WL 4261426, at \*16 (TTAB 2023) (citation omitted).

But we first must address a preliminary logistical issue. As mentioned, Opposer’s Section 2(d) claim asserts that Applicant’s mark likely will cause consumer confusion in view of several prior registered marks owned by Opposer. We don’t assess likelihood of confusion in the abstract, but in the context of the parties’ goods and/or services. Opposer’s several asserted registrations all concern the same mark (DON’T MESS WITH TEXAS, in standard characters) but differ in the goods or services each covers. We have to do the comparisons one-by-one and therefore need to pick from among the multiple registrations to begin our analysis. Because the similarities or dissimilarities in the parties’ goods and/or services is a key factor in any Section 2(d) case, *see Federated Foods*, 544 F.2d at 1103, confusion may be more or less likely as to each asserted registration depending on how closely related its identified goods or services are to Applicant’s restaurant services. Opposer’s ’196 Registration covers “paper food containers, paper bags,”<sup>23</sup> and its ’283 Registration lists “cups.” Those two registrations seems like good choices to compare to restaurant services. If we find a likelihood of confusion as to either or both of these registrations, that alone would require refusal of Applicant’s application.

We take judicial notice of the generally known facts that restaurants frequently provide their patrons with paper food containers and paper bags for take-out orders

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<sup>23</sup> While the ’196 and ’283 Registrations list other goods, registration of Applicant’s mark must be refused if confusion is likely even as to one of the items in a cited registration. *See, e.g., SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983).

and for dine-in customers to take home leftovers, as well as cups for beverages, and that these containers, bags, and cups commonly bear the restaurant's mark and/or logo. Indeed, Applicant in discovery provided Opposer with a mock-up of what appears to be a bag, as well as mock-ups of cups (and a photo of an actual cup), all bearing both Applicant's restaurant name and the slogan DON'T MESS WITH TEX-MEX.<sup>24</sup> Here is the photo of the cup:



This is not the sort of case where the relationship between restaurant services and these specific goods is “obscure or less evident.” *In re St. Helena Hosp.*, 774 F.3d 747, 753-54 (Fed. Cir. 2014). Rather, we find that “paper food containers, paper bags” and “cups” are complementary with and related to restaurant services. That restaurants provide their patrons with these goods also shows that the parties’ trade channels and classes of customers overlap to that extent.<sup>25</sup>

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<sup>24</sup> See 69 TTABVUE 7-8, 12-16. Opposer submitted a photo of a paper bag bearing Opposer’s slogan DON’T MESS WITH TEXAS together the logo of the WHATABURGER restaurant chain. See 39 TTABVUE 130. These examples corroborate the generally known facts.

<sup>25</sup> Applicant’s cursory argument that the channels of trade overlap is minimal does not discuss the goods in the ’196 and ’283 Registrations with which we are concerned. Rather, it

As to customer sophistication and care, restaurant customers comprise most, if not all, the general population. We see nothing in the record indicating that restaurant patrons would exercise anything other than ordinary care.<sup>26</sup> *Cf. In re Midwest Gaming & Ent. LLC*, No. 85111552, 2013 WL 1442237, at \*5 (TTAB 2013) (“relevant purchasers of restaurant and bar services ... would include ordinary consumers who would exercise only a normal degree of care in purchasing the services”). And when considering classes of relevant customers, we base our decision “on the least sophisticated potential purchasers” in the broad class of restaurant patrons. *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014).

In sum, Opposer’s paper food containers, paper bags, and cups are related to restaurant services, and the trade channels and classes of customers overlap because the goods are provided to restaurant patrons. These factors all support a conclusion that confusion is likely in view of the ’196 and ’283 Registrations. Restaurant patrons generally exercise no more than ordinary care in selecting restaurant services, and some may exhibit less. We find the customer sophistication factor neutral.

c. Degree of strength of Opposer’s marks

We now come to the factor on which Opposer focuses most intently. The fifth likelihood-of-confusion factor is the “fame of the prior mark (sales, advertising, length of use).” *du Pont*, 476 F.2d at 1361. “Fame for purposes of likelihood of confusion is a

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appears to be directed to Opposer’s anti-littering campaign and co-branded beverage bottles. *See* 71 TTABVUE 32.

<sup>26</sup> Applicant does not make any argument about this factor.

matter of degree that varies along a spectrum from very strong to very weak.” *Coach Servs.*, 668 F.2d at 1367 (cleaned up; citations omitted). “A strong mark is more likely than a weak mark to be remembered ... .” *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1338 n.3 (CCPA 1981) (citation omitted). A mark’s strength partakes of two components: conceptual strength (distinctiveness) and marketplace strength. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010).

Opposer does not address conceptual strength. We note, however, that the ’196 and ’283 Registrations issued without claims of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). As to these registrations, therefore, we presume the mark to be inherently distinctive. *See, e.g., Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 146 (Fed. Cir. 2021). And the mark does not, at least to us, seem to suggest anything that bears on the nature or characteristics of paper food containers, paper bags, or cups. In other words, the mark is arbitrary as to these goods. It therefore is conceptually strong. *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1372 (Fed. Cir. 2005)

As to marketplace strength, “a mark’s renown within a specific product market is the proper standard.” *Id.* at 1375 (citation omitted). Our review of the record discloses that none of Opposer’s evidence of strength pertains to its sales or distribution of paper food containers, paper bags and cups. As to these goods, there is no evidence concerning the number of units sold, revenue generated, advertising or promotion, or third-party publicity. *See, e.g., Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (evidence of fame/strength “may be measured indirectly, among

other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident”). Rather, Opposer’s evidence concerns the fame of, and notoriety generated by, its anti-littering campaign services (i.e., the services listed in its ’781 Registration).

Opposer offers a survey whose results, according to Opposer, prove that its mark is famous. We see several problems with the survey design that sap the survey of the evidentiary impact Opposer urges. First, it’s an “aided awareness” survey. An “aided awareness” survey prompts respondents by mentioning the brand. *See Chanel, Inc. v. Makarczyk*, No. 91208352, 2014 WL 2531211, at \*10 n.10 (TTAB 2014) (“Unaided’ awareness indicates that the survey participant spontaneously mentions the CHANEL brand name without prompting; ‘aided’ awareness means that the survey participant responds ‘yes’ when asked whether he or she is aware of the CHANEL brand name.”). The survey asked: “Have you ever seen, read, or heard of ‘Don’t Mess with Texas?’”<sup>27</sup> That’s a classic aided-awareness question.

“In general, the Board has discouraged heavy reliance on aided awareness to prove fame.” *ProMark Brands Inc. v. GFA Brands, Inc.*, No. 91194974, 2015 WL 1646447, at \*13 (TTAB 2015) (citing *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, No. 91116355, 2005 WL 2451671, at \*17 (TTAB 2005) (“One should not be permitted to so heavily rely on aided awareness, that is, awareness after the brand has been

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<sup>27</sup> See 55 TTABVUE 34. Though the survey was filed as a “confidential” document, the parties’ public briefs argue about the “aided awareness” issue as well as the percentages the survey generated, and we see no reason why we can’t mention this question.

prompted, to show fame (e.g., ‘Have you ever heard of CAREFIRST?’.)” (citation omitted), *aff’d*, 479 F.3d 825 (Fed. Cir. 2007).

Second, even if we were to overlook that it was an aided awareness survey, the responses are not directed to the strength of Opposer’s mark as to the “paper food containers” and “paper bag” products in the ’196 Registration or the “cups” in the ’283 Registration. Respondents who responded affirmatively to the aided awareness question were then asked some follow-up questions, none of which tied the phrase to Opposer’s paper food containers, paper bags, or cups. The survey only question that tied the respondents’ awareness of the phrase to anything at all stated:

What message does "Don't Mess with Texas" communicate?  
(Select One Or More Of The Following)

- 1 To prevent littering
- 2 To promote pride in the state
- 3 To encourage maintenance of your vehicle
- 4 To encourage the purchase of official state-sponsored merchandise
- 5 None of the above

*See* 55 TTABVUE 34-35.<sup>28</sup> Selection 1 mentions only prevention of littering; selection 2 is tied to no good or service; selection 3 mentions a service not covered by any of Opposer’s pleaded registrations; and selection 4 applies to merchandise in general, not any particular type or types of goods in any of Opposer’s pleaded registrations. Thus, even if we were to ignore the aided awareness shortcoming, there is nothing in

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<sup>28</sup> This clip is lifted from the confidentially-filed version of the Jerry Thomas Affidavit, but is reproduced in this opinion because Opposer quoted from it in its publicly-filed rebuttal brief. *See* 73 TTABVUE 9.



the survey that bears on the strength of Opposer's mark as to the paper food containers and paper bags in the '196 Registration and cups in the '283 Registration.<sup>29</sup>

In sum, Opposer has not proved that its mark has any degree of commercial strength as a source identifier for the relevant goods in the '196 Registration (paper food containers and paper bag products) or the '283 Registration (cups).

Applicant wants us to go further. It argues that Opposer's survey not only doesn't prove fame or strength, it actually shows the commercial weakness Opposer's mark. Specifically, Applicant argues that more people view the phrase DON'T MESS WITH TEXAS as simply an expression of Texas pride or bravado than as an indicator of source.<sup>30</sup> We agree that both Opposer's survey and several articles in the record support the assertion that many people view the phrase as a commonplace expression of Texas pride or bravado. In response to the survey question quoted above asking what message the phrase communicates, 67% of respondents indicated that the phrase was simply an expression of Texas pride and only 21% associated it with litter

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<sup>29</sup> Further, the question "What message does 'Don't Mess with Texas' communicate?" does not measure awareness of the mark as a source identifier for goods, which is what the fifth likelihood-of-confusion factor targets.

<sup>30</sup> See 71 TTABVUE 22-27. Applicant's argument appears to suggest that Opposer's mark is primarily understood as a commonplace expression and not a source indicator. If that were true, then the expression would fail to satisfy the statutory definition of a trademark, see 15 U.S.C. § 1127—i.e., it would "fail to function" as a trademark. But registered marks are presumed valid, see 15 U.S.C. § 1057(b), and Applicant has not counterclaimed to cancel any of Opposer's asserted registrations. While we can consider this argument as one bearing on the strength or weakness of the asserted registrations, we cannot entertain any argument that any cited registration is invalid without a counterclaim directed against it. See, e.g., *Food Specialty Co. v. Standard Prods. Co.*, 406 F.2d 1397, 1397-98 (CCPA 1969) ("the validity of [an opposer's] registration of a mark may be tested only by a cancellation proceeding") (citations omitted).

prevention.<sup>31</sup> And Applicant is correct in noting that a number of articles discuss how Opposer's anti-littering campaign slogan has caught on with the public beyond Opposer's services and now is commonly used in an informational way wholly apart from Opposer or its goods or services.<sup>32</sup> We certainly agree that this evidence is not supportive of Opposer's argument that its mark is famous or strong. But we don't think it proves that the mark is a weak indicator of source as to paper food containers, paper bags, or cups, as none of the evidence relates to its strength in those markets, which are the markets implicated by Opposer's Section 2(d) claim as to the '196 and '283 Registrations.

Opposer points to a Nonfinal Office Action issued during *ex parte* prosecution of a third-party's application to register DON'T MESS WITH TEXAS for coins, in which, according to Opposer, a USPTO examining attorney found Opposer's mark to be famous.<sup>33</sup> This is unpersuasive. First, as Opposer acknowledges in its rebuttal brief,<sup>34</sup> a statement by one examining attorney in an *ex parte* examination of a third party's application is not binding on us in this case. *See, e.g., DeVivo v. Ortiz*, No. 91242863, 2020 WL 1227592, at \*10 (TTAB 2020); *Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, No. 91224343, 2019 WL 3834985, at \*17 (TTAB 2019). We decide each case on the

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<sup>31</sup> Though Opposer filed the survey data and results confidentially, *see* 55 TTABVUE, Opposer's publicly-filed rebuttal brief disclosed these numbers, *see* 73 TTABVUE 9.

<sup>32</sup> *See* Opposer's Brief, 71 TTABVUE 11-12 (citing such articles). Applicant objects that some of the articles Opposer offers to show fame are in foreign publications and thus do not bear on the perceptions of U.S. consumers. *See* 71 TTABVUE 37. Because none of these foreign articles bear on the products in the '196 and '283 Registrations with which we are concerned, we need not rule on this objection.

<sup>33</sup> *See* 70 TTABVUE 26 (citing 39 TTABVUE 140-83).

<sup>34</sup> *See* 73 TTABVUE 17.

claims and evidence before us. Second, the issue before that examining attorney was not fame of Opposer's **mark** for Section 2(d) likelihood of confusion purposes, but whether **Opposer** itself had enough fame or recognition that use of its mark by a third party would give rise to presumption of a connection for purposes of a Section 2(a) false association refusal—a different issue.

To sum up, the mark in the '196 and '283 Registrations is conceptually strong, but, on this evidentiary record, we see nothing that convinces us that the mark has any significant degree of commercial strength as to the products at issue. Because of the mark's conceptual strength by itself, however, the fifth likelihood-of-confusion factor weighs somewhat in Opposer's favor.

d. Opposer's survey and likelihood of confusion

According to Opposer, its survey also proves that confusion is likely.<sup>35</sup> We disagree. After the aided awareness question asking respondents if they'd heard DON'T MESS WITH TEXAS before, the survey showed respondents four color photos of billboards, including a billboard Applicant used that includes, among other words and design elements, the phrase DON'T MESS WITH TEX-MEX.<sup>36</sup>

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<sup>35</sup> See 70 TTABVUE 23-24, 31; 73 TTABVUE 21-23.

<sup>36</sup> See 55 TTABVUE 29. Although the entire survey was designated confidential and is therefore unavailable for viewing through TTABVUE, we reprint the photo of the billboard here because Opposer has no confidentiality interest in any billboard that was displayed to the public. In addition, Opposer reprinted the billboard in its publicly-filed trial brief. See 70 TTABVUE 19.



The survey then asked: “Do you think any of these billboard advertisements are using part or all of ‘Don’t Mess with Texas?’”<sup>37</sup> This question simply measures whether respondents thought a sign with words on it used words from a phrase. It does not measure how many respondents believed that restaurant services under DON’T MESS WITH TEX-MEX were offered by, or affiliated with, a party using DON’T MESS WITH TEXAS for any particular good of service. Indeed, Opposer’s witness Mr. Thomas acknowledged this:

1           Q     Were there any questions in your survey that  
2           measured the percentage of respondents who believed  
3           that "Don't Mess with Tex-Mex" was in any way  
4           affiliated with "Don't Mess with Texas" or with TxDOT?

5           A     There was no direct measure of that.

9           Q     All right. And just to make sure I've asked  
10          it the other way around; there were no questions in  
11          your survey that attempted to measure whether "Don't  
12          Mess with Texas" or TxDOT was affiliated with El Toro  
13          or with the "Don't Mess with Tex-Mex" mark. Is that  
14          correct?

15          A     There was no question that attempted to

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<sup>37</sup> See 54 TTABVUE 7 (Jerry Thomas public affidavit).

16 | explicitly measure that.<sup>38</sup>

Another readily apparent problem is that use of Applicant's billboard as a stimulus (or use of any stimulus depicting the mark in any form but standard block letters without any additional design features) was inappropriate in this case. Applicant's mark is in standard character form, but the billboard also depicts Applicant's house mark in a stylized typeface, a bull logo in a diamond carrier, and uses the background colors and layout of the Texas flag. *See, e.g., Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, No. 91194148, 2015 WL 5316485, at \*16 n.20 (TTAB 2015) ("This proceeding is about whether Applicant may register as a trademark the term WINEBUD without limitation to any particular style, color, or size for use on .... Had Dr. Blair focused his survey on any particular presentation of Applicant's mark ... he would have unnecessarily restricted the survey to that presentation, although the registration Applicant seeks is not so limited."); *Miles Labs. Inc. v. Naturally Vitamin Supps. Inc.*, No. 91062820, 1986 WL 83319, at \*15 (TTAB 1986) (depiction of opposed mark in block letters "was the only appropriate stimulus" where opposed mark had no stylized lettering or design features).

We give the Thomas survey no weight on the issue of whether confusion is likely.

e. Applicant's prior knowledge of Opposer's use of DON'T  
MESS WITH TEXAS

Opposer argues that a "miscellaneous consideration[ ]" that supports a conclusion that confusion is likely is that "Applicant had actual knowledge of Opposer's DON'T

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<sup>38</sup> See 63 TTABVUE 70-71.

MESS WITH TEXAS mark prior to filing its application.”<sup>39</sup> This argument implicates the thirteenth likelihood-of-confusion factor, a catch-all category that assesses “[a]ny other established fact probative of the effect of use.” *du Pont*, 476 F.2d at 1361. Bad faith in adopting and using a mark is, when proved, one such fact. *See, e.g., QuikTrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021).

Opposer cites testimony of Applicant’s Vice-President that he had “seen ‘Don’t Mess with Texas’” before adopting DON’T MESS WITH TEX-MEX.<sup>40</sup> Opposer says this shows that Applicant had “actual awareness of Opposer’s mark.”<sup>41</sup> The question the witness was asked, however, was not about Opposer’s mark. It asked only if the witness had seen the **phrase**. As we found earlier, more people recognize the phrase as an expression of pride in the state than associate the phrase with Opposer, and the question the witness answered does not reveal the context in which the witness had seen the phrase. But even had the question asked about Applicant’s awareness of Opposer’s use of the phrase as a source identifier, “an inference of bad faith requires something more than mere knowledge of a prior similar mark. It requires an intent to confuse.” *Id.* (cleaned up; citations omitted). Opposer points to no evidence that tends to show that Applicant intended to confuse consumers about the source of its restaurant services. This factor is neutral.

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<sup>39</sup> *See* 70 TTABVUE 24.

<sup>40</sup> *See id.*

<sup>41</sup> *See id.*

- f. Weighing together all our findings on the relevant likelihood-of-confusion factors as to Opposer's '196 and '283 Registrations.

As we mentioned earlier, the last step in analyzing a claim under Section 2(d) is to “weigh the *DuPont* factors used in [our] analysis and explain the results of that weighing” and “the weight [we] assigned to the relevant factors.” *Charger Ventures*, 64 F.4th at 1383-84 (citation omitted). “The weight given to each factor depends on the circumstances of each case.” *Id.* at 1381 (citation omitted). No matter what, however, “[t]he similarity or dissimilarity of the marks in their entirety is a predominant inquiry.” *Herbko Int’l*, 308 F.3d at 1165 (cleaned up; citation omitted); *accord Hewlett-Packard*, 281 F.3d at 1265-66. And here, this important factor weighs heavily in Opposer’s favor.

Restaurant services are related to paper food containers, paper bags, and cups, are related, so the second likelihood-of-confusion factor weighs in favor of a conclusion that confusion is likely as to the marks in the '196 and '283 Registrations. That restaurants typically provide their patrons paper food containers, paper bags, and cups to allow their patrons to carry restaurant food and beverages off-premises shows that the customer classes and trade channels overlap to that extent. So these two likelihood of confusion factors further weigh in favor of a conclusion that confusion is likely as between the goods in the '196 and '283 Registrations and Applicant’s restaurant services.

Opposer’s mark is conceptually strong, but we see nothing, including Opposer’s survey, to indicate that, in the markets for paper food containers, paper bags, and

cups it has any degree of enhanced strength. The conceptual strength adds a bit, but not much, to Opposer's side of the scale.

Two factors are neutral: customer sophistication and the lack of any evidence that Applicant acted with intent to cause confusion. And, as we explained above, Opposer's survey simply misses the mark altogether as to Opposer's attempt to show that confusion is likely, particularly as to the goods in Opposers' '196 and '283 Registrations.

Viewing this altogether, all of the factor that tilt in any direction (i.e., are not neutral), all tilt in Opposer's favor as to the '196 and '283 Registrations. We therefore sustain Opposer's Section 2(d) claim on the basis of the '196 and '283 Registrations. Because registration must be refused on that basis alone, we exercise our discretion not to address whether confusion is likely as to any other of Opposer's pleaded registrations. *See Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, No. 91270181, 2024 WL 1638376, at \*2 (TTAB 2024) ("We sustain the opposition based solely on the registration for the SAGE CENTRAL mark because that registration identifies services that partially overlap with those identified in the opposed Application. We do not reach ... the question of whether a likelihood of confusion exists between Opposer's other pleaded marks and Applicant's SAGEFORTH mark.") (citing *Max Cap. Grp.*, 2010 WL 22358, at \*7).

#### B. Opposer's Section 43(c) dilution claim

Opposer's Notice of Opposition also asserted a claim of trademark dilution by blurring, and the ESTTA cover sheet also lists dilution by tarnishment, citing Section



43(c) of the Trademark Act, 15 U.S.C. § 1125(c).<sup>42</sup> A plaintiff alleging dilution must prove several elements, including that “the defendant’s use of its mark is likely to cause dilution by blurring or by tarnishment.” *Coach Servs.*, 668 F.3d at 1372. Opposer’s trial brief did not once mention the root term “dilut-,” mention the root term “blur-,” mention the root term “tarnish-,” or cite Section 43(c). Opposer impliedly waived (or forfeited) its dilution claim (or claims) by not addressing dilution in its trial brief. *See, e.g., Bell’s Brewery, Inc. v. Innovation Brewing*, No. 91215896, 2017 WL 6525233, at \*9 (TTAB 2017).

We further note that a required element of a dilution claim is that the mark is famous. *See, e.g., Coach Servs.*, 668 F.3d at 1372. Opposer’s “fame” survey, as we found earlier in the likelihood-of-confusion discussion, not only was flawed in design, but failed to prove the fame of Opposer’s slogan for Opposer’s anti-littering campaign<sup>43</sup> because the survey showed that only 21% of respondents who recognized Opposer’s slogan (even after prompting) associated the slogan with litter prevention, while 67% recognized the slogan instead as an expression of Texas pride or bravado. Professor McCarthy posits that a threshold response in the range of 75% of the general consuming public is necessary to prove fame for purposes of dilution. *See* J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:106 (5th ed.) (citing, inter alia, two Board decisions finding fame for dilution purposes

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<sup>42</sup> *See* 1 TTABVUE.

<sup>43</sup> Like Opposer’s trial brief, the Thomas Affidavit, which opined on the survey, did not mention dilution, blurring, or tarnishment. It did discuss whether Opposer’s mark is famous, but proof of fame is a factor in a Section 2(d) likelihood of confusion claim, *see du Pont*, 476 F.2d at 1361, which is the only claim the Thomas Affidavit mentions.

where surveys showed 73% and 80%, respectively, unaided awareness); *cf. Coach Servs.*, 668 F.3d at 1373 (“To establish the requisite level of fame, the marks owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner’s use of the mark.”) (cleaned up; citation omitted).

In sum, Opposer’s dilution claim is forfeited, but even if Opposer hadn’t failed to address it, Opposer failed to prove its mark is famous as required by Section 43(c)(1).

**Decision:** We sustain the opposition to registration of Applicant’s mark under Section 2(d) based on Opposer’s ’196 and ’283 Registrations.