

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

Hearing: February 4, 2009

Mailed: May 6, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ARTURO SANTANA GALLEGO
v.
SANTANA'S GRILL, INC.

Cancellation Nos. 92043152; 92043160; and 92043175¹

M. Cris Armenta of The Armenta Law Firm for Arturo Santana Gallego.

Nicole Whyte and Michael A. Sandstrum of Bremer Whyte Brown & O'Meara for Santana's Grill, Inc.

Before Quinn, Cataldo and Taylor,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Arutro Santana Gallego has petitioned to cancel the below registrations owned by Santana's Grill, Inc. for the following marks, all registered on the Principal Register for "restaurant services" in International Class 42:

¹ These cancellation proceedings were consolidated in a Board order issued on August 13, 2004.



SANTANA'S MEXICAN GRILL

in typed or standard characters;³ and

SANTANA'S MEXICAN FOOD...ES MUY BUENO

in typed or standard characters.⁴

As grounds for cancellation, petitioner alleges in his amended petitions to cancel that prior to both the filing dates of the underlying applications for registration of such marks and respondent's claimed dates of first use thereof, petitioner adopted and used the mark SANTANA'S MEXICAN FOOD, by itself and also with ES MUY BUENO, for

² Registration No. 2682978 issued on February 4, 2003 from a use-based application filed on December 5, 2001, which sets forth dates of first use of 1993. "MEXICAN FOOD" and "CALIFORNIA BURRITO" are disclaimed and the English translation of "ES MUY BUENO" is "it's very good." Section 8 affidavit accepted.

³ Registration No. 2634976 issued on October 15, 2002 from a use-based application filed on December 5, 2001, which sets forth dates of first use of July 1998. "MEXICAN GRILL" is disclaimed. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

⁴ Registration No. 2631458 issued on October 8, 2002, from a use-based application filed on December 5, 2001, which sets forth dates of first use of 1988. "MEXICAN FOOD" and "CALIFORNIA BURRITO" are disclaimed and the English translation of "ES MUY BUENO" is "it's very good." Section 8 affidavit accepted; Section 15 affidavit acknowledged.

restaurant services; that respondent's earliest claimed date of first use actually reflects use by petitioner; and that the contemporaneous use of the parties' marks in connection with their services is likely to cause confusion, to cause mistake, or to deceive.⁵ In addition, petitioner alleges that respondent committed fraud upon the United States Patent and Trademark Office (USPTO) when it made knowingly false statements in the declarations in support of the applications underlying its involved registrations.

Respondent, in its amended answers, has denied the salient allegations of the amended petitions to cancel. In addition, respondent asserts as affirmative defenses that petitioner has abandoned his rights in the SANTANA'S MEXICAN FOOD mark due to uncontrolled licensing.⁶

⁵ The petitions for cancellation were filed on March 30, 2004 in Cancellation Nos. 92043152 and 92043175, and April 5, 2004 in Cancellation No. 92043160. Accordingly, petitioner brought his claims of priority and likelihood of confusion within 5 years from the dates of registration of the involved marks. See 15 U.S.C. §1064.

⁶ Respondent also asserts petitioner's lack of standing as an affirmative defense. However, inasmuch as petitioner must prove his standing as a threshold matter in order for its claims to be heard, respondent's assertion that petitioner lacks standing is not considered an affirmative defense, but rather will be construed as an amplification of its denials of the salient allegations of the amended petitions for cancellation.

In addition, respondent pleads laches, acquiescence and estoppel in its amended answers. However, in its brief, respondent does not raise these defenses and, accordingly, they are deemed waived except to the extent that they serve to amplify respondent's affirmative defense of abandonment.

EVIDENTIARY OBJECTION

An evidentiary matter requires consideration prior to our discussion of the merits of this case. Petitioner's thirty-day testimony period closed on January 31, 2008 and his fifteen-day rebuttal testimony period closed on May 15, 2008. Petitioner filed his notice of reliance in these consolidated cases on February 4, 2008. Petitioner's notice of reliance includes a certificate of service by first class mail upon counsel for respondent dated January 31, 2008. However, the notice of reliance does not include a certificate of mailing.

Respondent objects in its brief to petitioner's notice of reliance on the ground that it is untimely. In response, petitioner argues in his reply brief that "either the Notice of Reliance was one day late and caused no prejudice, or it was filed more than three months before the last day, May 15, 2008, on which Petitioner could have filed its Notice of Reliance as a rebuttal to Registrant's testimony and evidence" (reply brief, p. 13).

Petitioner's contention notwithstanding, we find that his notice of reliance was filed four days after the close of his testimony period and approximately three months prior to the close of his rebuttal testimony period and, as such, is untimely. See, for example, *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1071, 1075 (TTAB 1990); and *Questor Corp. v.*

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Dan Robbins & Associates, Inc., 199 USPQ 358, 361 n.3 (TTAB 1978), aff'd, 599 F.2d 1009, 202 USPQ 100 (CIPA 1979).

Moreover, petitioner has not provided any explanation as to why his notice of reliance is untimely filed.

Accordingly, respondent's objection to petitioner's notice of reliance is sustained, and the evidence submitted thereunder will not be considered in reaching our decision herein.⁷

THE RECORD

The record consists of the pleadings and the files of the involved registrations. See Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, during his assigned testimony period, petitioner took the testimony depositions, with exhibits, of petitioner Arturo Santana Gallego (Gallego), Arturo Santana Lee (Arturo), Arturo Castaneda (Castaneda), Claudia Vallarta (Vallarta), and Abelardo Santana Lee (Abelardo). During its assigned testimony period, respondent took the testimony depositions, with exhibits, of Abelardo Santana (Abelardo 2), Maite Agahnia (Agahnia), Claudia Vallarta (Vallarta 2), and Benito Santana Lee (Benito).⁸ In addition, respondent submitted a notice of reliance.

⁷ We add, however, that had we considered this evidence, it would not change our decision in this proceeding.

⁸ All of the testimony depositions were conducted in Spanish with a court-certified translator. The parties stipulated to dispense

Both parties have filed briefs, and petitioner filed a reply brief. In addition, counsels for both parties presented arguments at an oral hearing held before this panel on February 4, 2009.

FACTS

At least as early as 1986, petitioner purchased two Mexican restaurants called "ALBERTO'S MEXICAN FOOD."⁹ One was located at 1480 Rosencrans, San Diego, California.¹⁰ The second, which opened shortly thereafter, was located five hours away at 56547 Twenty-Nine Palms Highway, Yucca Valley, California.¹¹ Petitioner changed the names of these two restaurants to "CORONA'S MEXICAN FOOD" but received a request from Corona Beer Company to cease using the term "Corona's."¹² As a result, in December 1987, petitioner changed the name of his Rosencrans restaurant to SANTANA'S

with the notarization and signature requirements unless counsel noticed discrepancies in the testimony or interpretation.

We note that each of the testimony depositions was attended by at least one, and as many as five, of the other deponents herein. We further note that the deposition transcripts contain numerous objections by counsels, interruptions and comments by both counsels, and suggestions of disruptive behavior on the part of one or more of those in attendance. We would be remiss not to observe that such activities have achieved little to advance the parties' respective cases.

⁹ Respondent's Notice of Reliance, Document 1. It is noted that in his testimony deposition, petitioner states that he began using "Alberto's Mexican Food" in connection with restaurant services as early as 1979.

¹⁰ Abelardo Testimony, p. 6.

¹¹ Benito Testimony, p. 5-7.

¹² Gallego Testimony, p. 7; Benito Testimony, p. 7-8.

MEXICAN FOOD.¹³ At an undetermined time in 1988, but apparently within a month or two of the name change of the Rosencrans location, petitioner also changed the name of the Yucca Valley restaurant to SANTANA'S MEXICAN FOOD.¹⁴ In 1989, petitioner purchased radio advertisements for his restaurants, including a musical jingle that featured the words ES MUY BUENO.¹⁵ Petitioner's son Benito copied the wording ES MUY BUENO from the radio advertisement to use as part of the signage and menus for petitioner's restaurants.¹⁶ In addition, Benito designed signage for petitioner's restaurants that included triangular designs.¹⁷

Petitioner's son Arturo began working at the Rosencrans location in 1986, and after working at that location for one year, transferred to the Yucca Valley location and worked there for another year and a half.¹⁸ Petitioner's son Abelardo began working at the Rosencrans location in 1987.¹⁹ Petitioner's son Benito remodeled, painted, made signage and menus for the Rosencrans and Yucca Valley restaurants from 1988 through the early 1990s.²⁰ Arturo Castaneda, who is not related to petitioner, began working at petitioner's

¹³ Id., Exhibit R. 7; Id. at 8-10; Vallarta 2 Testimony, Exhibit R 30.

¹⁴ Benito Testimony. P. 9.

¹⁵ Gallego Testimony, p. 9-10; Arturo Testimony, p. 18, 108-9.

¹⁶ Benito Testimony, p. 26-7.

¹⁷ Benito Testimony, p. 22-24.

¹⁸ Arturo Testimony, p. 5-8.

¹⁹ Abelardo Testimony, p. 9.

²⁰ Benito Testimony, p. 10-19.

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Rosencrans location in 1990. Claudia Vallarta, who at the time was married to Abelardo, began working at the Rosencrans location in 1991.²¹

Abelardo and Claudia acquired the Rosencrans location from petitioner in January 1992.²² Abelardo and Claudia formed respondent in 1998.²³ In 1997, Arturo Santana Lee opened a SANTANA'S MEXICAN GRILL in El Cajon, California.²⁴ Petitioner assisted Arturo in selecting the location, and Abelardo and Claudia assisted Arturo with obtaining a lease, insurance and personnel.²⁵ The El Cajon location featured the same color scheme as the Yucca location and a similar menu.²⁶ Petitioner continued to own and operate the Yucca Valley location until selling that restaurant to Arturo Castaneda in 1998 or 1999. At the time of trial, Castaneda had not yet completed the installment payments for purchase of the Yucca Valley location to petitioner.²⁷ Presently, respondent owns 6 restaurants; Arturo owns 2 restaurants;

²¹ Vallarta Testimony, p. 5.

²² Abelardo Testimony, p. 9-10, Exhibit R 10; Vallarta Testimony, p. 6-7; Gallego Testimony, p. 12-13, 39. There is conflicting testimony regarding whether the transfer of interest in the Rosencrans location was a gift or a sale, and there is no documentary evidence of record to indicate whether the transaction was accompanied by monetary or other consideration. In any event, the parties are in agreement that the transfer of interest in the Rosencrans restaurant occurred, and whether such transfer was a gift or a sale is not relevant to our determination herein.

²³ Vallarta Testimony, p. 18-19.

²⁴ Arturo Testimony, p. 10, 47.

²⁵ Id. at 10-12.

²⁶ Id. at 19, 26, 29; Exhibits P 5-8.

²⁷ Gallego Testimony, p. 16-17.

and Castaneda owns 8 restaurants, all utilizing variations of the marks at issue herein.

STANDING

First, we consider whether petitioner has standing. A plaintiff must have a 'real interest' in the outcome of a proceeding in order to have standing. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit." *Lipton Industries v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Petitioner's testimony and evidence of use of, inter alia, SANTANA'S MEXICAN FOOD in connection with restaurant services establishes his standing to petition to cancel respondent's involved marks for restaurant services.

PRIORITY

To establish priority on a likelihood of confusion claim brought under Trademark Act §2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned..." Trademark Act Section 2, 15 U.S.C. §1052. A party may establish its own prior proprietary rights in a mark through ownership of a prior registration, actual use or through use analogous to trademark use which creates a

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public awareness of the designation as a trademark identifying the party as a source. See Trademark Act §§2(d) and 45, 15 U.S.C. §§1052(d) and 1127. See also T.A.B. Systems v. PacTel Teletrac, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating Pactel Teletrac v. T.A.B. Systems, 32 USPQ2d 1668 (TTAB 1994).

In this case, petitioner has established by oral testimony, and the parties agree, that petitioner's first use of SANTANA'S MEXICAN FOOD in connection with restaurant services occurred in December 1987 at his Rosencrans restaurant, followed either immediately or up to two months later at his Yucca Valley restaurant. "Oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding." Powermatics, Inc. v. Globe Roofing Products Co., 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). See also National Bank Book Co. v. Leather Crafted Products, Inc., 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted); Liqwacon Corp. v. Browning-Ferris Industries, Inc., 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing,

consistent, and sufficiently circumstantial to convince the Board of its probative value); GAF Corp. v. Anatox Analytical Services, Inc., 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted). Petitioner's testimony, which was corroborated, inter alia, by respondent's president, Abelardo Santana Lee, is clear, convincing, consistent and sufficiently circumstantial to persuade us of its probative value.

It is well-settled that in the absence of any evidence of earlier use, the earliest date upon which respondent may rely is the filing date of the applications underlying its involved registrations. See Trademark Act Section 7(c), 15 U.S.C. §1057(c). See also Larami Corp. v. Talk to Me Programs, Inc., 36 USPQ2d 1840 (TTAB 1995). In this case, and as noted above, the applications that matured into the registrations at issue herein were all accorded a filing date of December 5, 2001. Respondent has introduced testimony and evidence that it began using SANTANA'S MEXICAN FOOD as early as January 1992 when it acquired the Rosencrans restaurant from petitioner. However, petitioner began use of SANTANA'S MEXICAN FOOD in December 1987, which is prior to respondent's earliest constructive date of first use or any of respondent's alleged dates of first use.

Thus, it is undisputed that petitioner was the first to use SANTANA'S MEXICAN FOOD as a mark in connection with restaurant services. Nonetheless, respondent presents several arguments in support of its position that petitioner may not rely upon his established date of first use. We will address these arguments below.

Inherent or Acquired Distinctiveness of Petitioner's
SANTANA'S MEXICAN FOOD Mark

Inasmuch as petitioner has not pleaded ownership of any registered trademark, petitioner must rely on his common law use of SANTANA'S MEXICAN FOOD as a trademark to prove priority. In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

In this case, respondent did not plead lack of inherent or acquired distinctiveness as an affirmative defense; nor did respondent introduce evidence on this issue at trial; nor are there any other circumstances in the case which would have put petitioner on notice of this defense. Rather, respondent presents for the first time in its brief a somewhat cursory argument that petitioner has failed to establish that his SANTANA'S MEXICAN FOOD mark has acquired secondary meaning. In his reply brief, petitioner denies

respondent's arguments. Thus, the issue of distinctiveness is unpleaded and, moreover, there is no evidence that SANTANA'S MEXICAN FOOD lacks inherent distinctiveness. As such, and particularly because respondent has registered the involved SANTANA'S-formative marks without benefit of Section 2(f), we find that petitioner's mark is inherently distinctive. See *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). See also *Wetseal Inc. v. FD Management Inc.*, 82 USPQ2d 1629 (TTAB 2007).

Abandonment Due to Uncontrolled Licensing

In its brief, respondent makes the conclusory statements that "the evidence is straight forward that Petitioner has failed to exercise control over its alleged licensees" and that "Petitioner has no right nor has he ever exercised any type of control over how Registrant (and its predecessors) operated any of its [six] Mexican restaurants from January 1992 until the present."²⁸ We note, however, that there is no evidence of record that bears directly on the question of licensing of the marks at issue. First, there is no documentary evidence with regard to the transfer by petitioner of the Rosencrans restaurant to respondent's predecessors or the sale by petitioner of the Yucca Valley restaurant to Mr. Castaneda. Second, there is no documentary evidence that either transaction was accompanied

²⁸ Respondent's brief, p. 33.

by a written license or any other documents relating to use of SANTANA'S MEXICAN FOOD or other trademarks associated therewith. Indeed, none of the deponents have testified that any written licensing agreements exist. Instead, there is only conflicting testimony with regard to ownership and implied licensing of these marks. This testimony may briefly be summarized as follows:

Petitioner testified that when he transferred the Rosencrans restaurant to respondent's predecessors, he had no discussions regarding granting them exclusive use of the name SANTANA'S MEXICAN FOOD.²⁹ Due to their familial relationship, petitioner does not charge either of his sons (Abelardo who is president of respondent that owns six restaurants and Arturo who owns two restaurants) any licensing fee for use of SANTANA'S MEXICAN FOOD, but that he does charge Mr. Castaneda for such use.³⁰ After some early discussions he has been very satisfied with Abelardo's operation of respondent's restaurants, but would discuss any problems with him as they arise.³¹ Petitioner regularly checks Mr. Castaneda's operation of his restaurants.³²

Respondent's predecessors and officers testified that they believe petitioner transferred ownership of the

²⁹ Gallego Testimony, p. 14-15.

³⁰ Id. at 93.

³¹ Id. at 94-97.

³² Id. at 90-14.

SANTANA'S MEXICAN FOOD mark with the Rosencrans restaurant, and that at no time have they been licensees of petitioner.³³ Respondent believes that it licenses use of the SANTANA'S MEXICAN GRILL mark to Arturo Santana Lee and that Arturo's restaurants would be part of respondent's chain of restaurants.³⁴

Arturo Santana Lee testified that although he received assistance from his brother Abelardo and his brother's then-wife Claudia in establishing his first restaurant, he believed that such assistance was due to their family relationship and Arturo's lack of familiarity with the English language.³⁵ Petitioner assisted Arturo in selecting the location of his first restaurant.³⁶ Arturo used the same menu and food preparation as those used in petitioner's original restaurants.³⁷ Abelardo and Claudio visited Arturo's restaurant and offered advice, but did not indicate that they had a right to control operation thereof or his use of the SANTANA'S MEXICAN GRILL mark.³⁸

Mr. Castaneda testifies that he did not purchase the name SANTANA'S MEXICAN FOOD mark from petitioner when he purchased the Yucca Valley restaurant, but rather that he

³³ Abelardo Testimony 2, p. 13; Vallarta Testimony 2, p. 19-20.

³⁴ Id. at 29-30, 43, 45; Id. at 25-33.

³⁵ Arturo Testimony, p. 12-13, 62-63.

³⁶ Id. at 9-10, 47.

³⁷ Id. at 47, 66-67.

³⁸ Id. at 30-33.

has entered into an oral license with petitioner regarding his use thereof.³⁹ Mr. Castaneda consults with petitioner regarding where to open new restaurants, and avoids opening new locations near those owned and operated by Abelardo and Arturo.⁴⁰ Petitioner regularly visits Mr. Castaneda's restaurants to inspect their operation.⁴¹

In view of the testimony of record, and in the absence of any documentary evidence on the matter, we find no support for respondent's claim that petitioner transferred ownership of the SANTANA'S MEXICAN FOOD mark to respondent's predecessors with the Rosencrans restaurant.⁴² Furthermore, respondent's claim that petitioner transferred ownership of such mark to its predecessors is directly contradicted by petitioner's continued use thereof at the Yucca Valley restaurant; petitioner's subsequent sale of the Yucca Valley location to Mr. Castaneda; and petitioner's licensing of use of the SANTANA'S MEXICAN FOOD mark to Mr. Castaneda at the Yucca Valley location and succeeding restaurants.

In addition, based upon the testimony of petitioner and Mr. Castaneda, we find that Mr. Castaneda has entered into

³⁹ Castaneda Testimony, p. 32-35.

⁴⁰ Id. at 15-17, 54.

⁴¹ Id. at 18-19.

⁴² The documentary evidence of record consists largely of documents filed with the State of California relating to the filing and abandonment of fictitious business names as well as tax records. These documents evidence the transfer and purchase of the various restaurants noted above. However, these documents cast no light on the ownership or licensing of the trademarks at issue herein.

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an oral license with petitioner allowing Mr. Castaneda to use the SANTANA'S MEXICAN FOOD mark. As a result of petitioner's grant of this oral license to Mr. Castaneda, and also because at the time of trial Mr. Castaneda continued to make payments to petitioner for the Yucca Valley restaurant, we further find that Mr. Castaneda's use of SANTANA'S MEXICAN FOOD inures to the benefit of petitioner. In view thereof, we find that petitioner has made continuous use of the SANTANA'S MEXICAN FOOD mark from 1987 to the present. Such use includes petitioner's own use of the mark at his Rosencrans and Yucca Valley restaurants and subsequent use by petitioner's licensee, Mr. Castaneda.

Finally, we find no support for respondent's claim that because its predecessors purchased the Rosencrans restaurant from petitioner, it became the senior user of the SANTANA'S MEXICAN FOOD mark. As noted above, there is no evidence that petitioner sold or otherwise conveyed the SANTANA'S MEXICAN FOOD mark to respondent or its predecessors; petitioner continued to use the SANTANA'S MEXICAN FOOD mark at the Yucca Valley location until its sale to petitioner's licensee, Mr. Castaneda, in 1998 or 1999; and Mr. Castaneda's subsequent use inures to the benefit of petitioner. As a result, respondent's claim that it is the senior user of the SANTANA'S MEXICAN FOOD mark is not supported either by the testimony of record or the law.

Accordingly, we find that petitioner has demonstrated, by a preponderance of the evidence, his priority of use, at least, of the mark SANTANA'S MEXICAN FOOD.

LIKELIHOOD OF CONFUSION

In determining the legal question of likelihood of confusion, the Board must consider all of the probative facts in evidence which are relevant to the factors bearing on likelihood of confusion as identified in *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973).⁴³

Similarity Between the Services; Channels of Trade; Potential Consumers

The first du Pont factors we consider are whether the services of the petitioner and the respondent, the channels of trade through which the services travel, and the potential consumers for the services, are the same or related.

In this case, both petitioner and respondent provide restaurant services. The parties' services thus are identical.

Because the parties' services are identical, and because there are no restrictions as to their channels of trade or classes of purchasers, the services are presumed to be marketed in all the normal channels of trade to all the usual purchasers thereof, and that the channels of trade and

⁴³ It is noted that respondent does not address the factors bearing on likelihood of confusion in its brief on appeal.

the purchasers for petitioner's services as well as respondent's services would be the same. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). It is settled that in making our determination regarding the relatedness of the parties' services, we must look to the services as identified in the involved registration. See *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973).

Thus, these du Pont factors favors petitioner.

Similarity Between the Marks

Next we consider the du Pont factor of the similarity between petitioner's SANTANA'S MEXICAN FOOD mark and the marks in respondent's involved registrations. This factor requires an examination of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test under this factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather

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than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 743 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this where the services of the respective parties are identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

The mark in respondent's Registration No. 2631458, SANTANA'S MEXICAN FOOD...ES MUY BUENO, incorporates and includes in its entirety petitioners SANTANA'S MEXICAN FOOD mark. As a result, the marks are identical in part and, when viewed as a whole, are highly similar in appearance and sound. The mere addition of ES MUY BUENO which translates to "it's very good" does little to distinguish respondent's mark, especially inasmuch as it modifies and refers to SANTANA'S MEXICAN FOOD, which is identical to petitioner's mark. As a result, we find that the marks are highly

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similar in connotation and convey highly similar commercial impressions.

The mark in respondent's Registration No. 2682987, shown below



again incorporates and includes in its entirety petitioner's SANTANA'S MEXICAN FOOD mark. As noted above, ES MUY BUENO modifies and refers to SANTANA'S MEXICAN FOOD, as does the additional wording, HOME OF THE FAMOUS CALIFORNIA BURRITO. The relatively simple geometric design surrounding the wording SANTANA'S MEXICAN FOOD does little to distinguish the mark from that of petitioner, and in any event, would not be used by customers when referring the mark. In addition, the wording SANTANA'S MEXICAN FOOD in respondent's mark appears first, at the top of the mark and in the largest letters. For these reasons, we consider SANTANA'S MEXICAN FOOD to be the dominant portion of respondent's mark. See *In re National Data Corp.*, supra. This wording is identical to petitioner's mark. As a result, we find that the marks are highly similar in appearance, sound and

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connotation, and convey highly similar overall commercial impressions.

The mark in respondent's Registration No. 2634976, SANTANA'S MEXICAN GRILL, is nearly identical to petitioner's SANTANA'S MEXICAN FOOD mark in appearance and sound. Respondent's substitution of the descriptive wording MEXICAN GRILL in its mark for the descriptive wording MEXICAN FOOD in that of petitioner does little to distinguish the marks. Both marks convey the impression that SANTANA'S is a source for Mexican cuisine. As a result, we find that the marks are highly similar in connotation and convey highly similar commercial impressions.

Other du Pont factors

The parties have not discussed any of the remaining du Pont factors. Nor is there any evidence of record with respect thereto.

CONCLUSION

We conclude that petitioner has established his standing, priority of use, and that the contemporaneous use of his SANTANA'S MEXICAN FOOD mark and the marks in respondent's involved registrations for identical services, is likely to cause confusion, mistake or to deceive.

FRAUD

Given our determination that there is a likelihood of confusion herein, we decline to reach a determination on the question of fraud in this proceeding.

Decision: The petition to cancel is granted as to all three involved registrations on the ground of priority and likelihood of confusion.