

**This Opinion is Not a  
Precedent of the TTAB**

Hearing: February 23, 2023

Mailed: May 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*El Burro, Inc.*

*v.*

*Knuckle Sandwich LLC*

Cancellation No. 92075933

Eric Goodman of Goodman Mooney, LLP,  
for El Burro, Inc.

Ronald P. Wargo of Friedemann Goldberg Wargo Hess LLP,  
for Knuckle Sandwich LLC.<sup>1</sup>

Before Cataldo, Wolfson, and English,  
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Respondent, Knuckle Sandwich LLC, has registered on the Principal Register the standard character mark EL BURRO BORRACHO for “restaurants” in International Class 43.<sup>2</sup>

<sup>1</sup> Gregory Goonan of The Affinity Law Group argued the case for Petitioner at the oral hearing and Stephen R. Baird of Greenberg Traurig, LLP argued the case for Respondent.

<sup>2</sup> Reg. No. 4868002, issued on the Principal Register on December 8, 2015; affidavit under Section 8 accepted on April 22, 2022. The registration includes the following statement: The English translation of “EL BURRO BORRACHO” in the mark is “the drunk donkey.”

Petitioner, El Burro, Inc. petitioned to cancel Respondent's registration, alleging prior use and registration of the standard character mark EL BURRO for "mobile cafe services for providing food and drink; providing of food and drink via a mobile truck; restaurant services" in International Class 43<sup>3</sup> and of the composite mark, depicted below, for "restaurant services" in International Class 43 (TACOS & BEER disclaimed):<sup>4</sup>



Petitioner claims priority and likelihood of confusion. 1 TTABVUE 1, 5. In its Answer, Respondent denies the salient allegations in the petition for cancellation, except that Respondent admits that its first use of its mark was on December 31, 2014, 13 TTABVUE 3, and that "the Subject Mark and Petitioner's Marks both contain the words EL BURRO." 13 TTABVUE 3.<sup>5</sup>

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<sup>3</sup> Reg. No. 4151153; renewed. The registration includes the following statement: The English translation of "EL BURRO" in the mark is the donkey.

<sup>4</sup> Reg. No. 4140047; renewed. The registration includes the following description of the mark: "The mark consists of a circle outlined in black with red inside it. The words 'EL BURRO' appear in white at the top of the circle and 'TACOS & BEER' at the bottom. There is a white star on the left and a white star on the right. There is a smaller circle inside the larger circle outlined in black and yellow inside with a caricature of a donkey in the yellow circle." The colors black, white, red and yellow are claimed as features of the mark. The English translation of "EL BURRO" in the mark is the "donkey."

<sup>5</sup> Respondent pleaded affirmative defenses of laches, unclean hands and estoppel, 13 TTABVUE 3-4. Respondent argued laches and estoppel under the "market interface factor" (identified by Respondent as the tenth *DuPont* factor, 18 TTABVUE 29) in its brief. Respondent did not pursue its affirmative defense of unclean hands, which is deemed waived.

The case has been fully briefed.<sup>6</sup> In addition, counsel for the parties presented oral arguments at a hearing before this panel of the TTAB. Because we find the term “el burro” to be widely used in connection with Mexican-style restaurants, and that the marks can coexist in this crowded field, we deny the petition to cancel.

## **I. Evidence of Record**

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Respondent’s registration file. In addition, Petitioner submitted the testimony declaration of its principal, Gabriel Garcia, 15 TTABVue 15-19, and a Notice of Reliance on:

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*Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (affirmative defense not argued in brief deemed waived), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014); *Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012) (same). Respondent also pleaded that the petition fails to state a claim upon which relief may be granted. This is not a true affirmative defense, and inasmuch as Respondent did not file a motion to dismiss under Fed. R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, the “defense” is deemed waived. *See Alcatraz Media, Inc. v. Watermark Cruises*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013); *John W. Carson Found. v. Toilets.com, Inc.*, 97 USPQ2d 1942, 1949 (TTAB 2010) (“The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer’s claim rather than a statement of a defense to a properly pleaded claim.”) (citing *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001)).

<sup>6</sup> We have not considered any matter that has been identified as being located at a hyperlink, *see, e.g.*, Petitioner’s brief 17 TTABVue 13; the Board does not open hyperlinks embedded in a party’s brief. *See, e.g., In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at \*2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided). Even if links were sufficient to put evidence into the record, it is too late to introduce new evidence at the briefing stage. *See, e.g., Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at \*2 (TTAB 2020) (exhibits attached to brief not considered); *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at \*2 (TTAB 2019) (inserted screenshots and hypertext link within the text of reply brief, if not previously and properly introduced into the record, not considered).

- Respondent's responses to select interrogatories propounded by Petitioner, 15 TTABVUE 22-63.
- Respondent's responses to Petitioner's requests for production of documents, 15 TTABVUE 54-107. Respondent's responses are admissible solely to show the extent to which Respondent stated that there are no responsive documents. See Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii); *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance). Any produced documents would generally not be admissible by notice of reliance alone, but no documents were attached to Petitioner's Notice of Reliance.
- Examples of Petitioner's use of its trademark on building signage, menu boards, window films, caps, coupons, a catering menu, and food packaging, 15 TTABVUE 111-139.<sup>7</sup>
- Internet webpages purporting to show Respondent's use of the EL BURRO BORRACHO mark, 15 TTABVUE 207-212.<sup>8</sup>
- Respondent's "restaurant license agreement[s]" between:
  - KS Las Vegas LLC (identified as the licensor having the right to use and exploit Respondent's mark EL BURRO BORRACHO) and Rio

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<sup>7</sup> These materials have not been shown to be publicly available nor do they qualify as official records. See Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e); *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1038 n.8 (TTAB 2012) (private letters, invoices, delivery notes and credit card statements not proper subject matter for introduction by notice of reliance); *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009) (financial reports may not be introduced by notice of reliance). However, because Respondent has not objected, and has introduced similar material under notice of reliance, we accept the materials for what they show on their face, but not for the truth of any matter stated therein. Cf. *Harry Winston, Inc. v. Winston Gem Corp.*, 111 USPQ2d 1419, 1427-28 (TTAB 2014) (printed publications "are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false. Accordingly, they will not be excluded outright, but considered for what they show on their face").

<sup>8</sup> *Spiritline Cruises LLC v. Tour Mgmt. Servs.*, 2020 USPQ2d 48324, at \*2 (TTAB 2020) ("[W]e consider Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony only for what they show on their face rather than for the truth of the matters asserted therein." See also Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

Properties, LLC (identified in the license agreement as the operator of the “Rio All Suite Hotel and Casino”), 15 TTABVUE 141-172, dated October 8, 2015; and

- KS Las Vegas LLC (identified as the licensor having the right to use and exploit Respondent’s mark EL BURRO BORRACHO) and Laughlin CERP Manager, LLC on behalf of Harrah’s Laughlin, LLC d/b/a Harrah’s Laughlin (identified as the operator of a “first-class casino resort” located in Laughlin Nevada), 15 TTABVUE 174-202, dated May 15, 2014.<sup>9</sup>
- Profit and loss statement of GRF Enterprises, LLC. 15 TTABVUE 204-05.<sup>10</sup>

Respondent submitted the following evidence under its Notice of Reliance:

- Respondent’s registration certificate and TSDR printout reflecting ownership and status of Respondent’s mark, 16 TTABVUE 13-20.<sup>11</sup>
- Petitioner’s responses to Respondent’s requests for admission, 16 TTABVUE 23-25. Petitioner denied all requests except No. 4, wherein Petitioner admitted that Respondent’s marks “are registered as service marks only.” 16 TTABVUE 23. This admission is of record; the denials are not. *See Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1395 n.9 (TTAB 2016) (“admissions are properly of record, the denials are not”); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008).

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<sup>9</sup> These internal documents are not probative evidence of consumer exposure to or awareness of the mark. Thus, “while these materials are accepted as true and accurate copies of [Respondent’s] authentic business documents they are of record only for what they show on their face, at least to the extent that there is no testimony concerning the truth or accuracy of the information contained in those documents.” *Nike, Inc. v. WNBA Enters., LLC*, 85 USPQ2d 1187, 1197-1198 (TTAB 2007) (finding “sponsorship and promotional agreement” admissible only for what it showed on its face).

<sup>10</sup> Although the relationship between Respondent and GRF Enterprises, LLC has not been explained, Petitioner identifies this exhibit as “Respondent financials.” 15 TTABVUE 13. Accordingly, we accept the document as true and accurate for what it shows on its face.

<sup>11</sup> This was unnecessary because the file of the registration that is sought to be cancelled is automatically of record. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1); *McGowen Precision Barrels, LLC v. Proof Research, Inc.*, 2021 USPQ2d 559 (TTAB 2021); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (respondent’s registration file is automatically part of the record of the proceeding and need not be introduced under a notice of reliance).

- Petitioner's responses to Respondent's propounded interrogatories, 16 TTABVUE 27-45.
- Petitioner's responses to requests for production of documents, 16 TTABVUE 47-54. As noted, responses to document production requests are generally not admissible by notice of reliance alone, but no such documents were attached to Respondent's Notice of Reliance in any event. Petitioner's responses are admissible to the extent Petitioner stated that there are no responsive documents.
- Menu from Respondent's restaurant, 16 TTABVUE 56-62.
- Webpages from [www.caesar's.com](http://www.caesar's.com), 16 TTABVUE 63-67;
- Copies of webpages from eleven third-party vendors purporting to show widespread use of "EL BURRO" in association with restaurant services, 16 TTABVUE 69-379.

## **II. Entitlement to a Statutory Cause of Action**

Respondent does not dispute Petitioner's entitlement to bring the instant cancellation proceeding. Nonetheless, entitlement to a statutory cause of action, formerly referred to as "standing" by the Federal Circuit and the Board, is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration

of the mark. *Corcamore*, 2020 USPQ2d 11277, at \*4 (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014); *see also Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022); *Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at \*1 (TTAB 2020).

Petitioner has established its status as a direct competitor of Respondent, a fact Respondent does not dispute. Respondent’s Brief, 18 TTABVUE 11-12. (“The evidence reflects that Petitioner’s Marks are used in conjunction with a taqueria-style restaurant in a suburban strip-mall located in a high-traffic area.”) Accordingly, Petitioner may seek to cancel Respondent’s registration, as its claim is within the zone of interests protected by statute and Petitioner has a reasonable belief in damage proximately caused by the continued registration of Respondent’s mark. *See Books on Tape, Inc. v. The Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (competitor entitled to petition to cancel registration of BOOKTAPES issued on the Supplemental Register); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014) (finding standing based on petitioner being a competitor and using a similar term); *Plyboo Am., Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999) (petitioner’s entitlement based on its status as competitor).

### **III. Likelihood of Confusion**

To prevail on its Section 2(d) claim, Petitioner must prove priority and likelihood of confusion by a preponderance of the evidence *Cunningham v. Laser Golf Corp.*, 222

F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Hydro-Dynamics Inc. v. George Putnam & Co.*, 811 F.2d 147, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

### **A. Priority**

Respondent filed the application for registration of its EL BURRO BURRACHO mark on September 9, 2014. Respondent first used its mark “in connection with restaurant services [on] December 31, 2014.” 13 TTABVUE 3, ¶ 11 (“Answering paragraph 11 of the Petition, Registrant admits that its first use of the Subject Mark was on December 31, 2014”).

The filing date of the applications that matured into Petitioner’s pleaded registrations (February 11, 2011) precede the September 9, 2014 filing date of the application that matured into Respondent’s involved registration as well as Respondent’s first use date. Although Petitioner failed to submit copies of its pleaded registrations or official printouts showing their status and title, Respondent admitted Petitioner’s ownership of its registrations and that “Petitioner’s Marks were first used in commerce in February of 2011.” Respondent’s Brief, 18 TTABVUE 10-11 (citing Petitioner’s response to Respondent’s Interrogatory No. 2, 16 TTABVUE 28 (“[Petitioner] owns incontestable registrations containing the words BURRO in connection with restaurant services [including Reg. No. 4140047 and 4151153].”). *See Floralife, Inc. v. Floraline Int’l Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (“[A]pplicant has not contested opposer’s ownership of the relied upon registrations, nor questioned that they are still in force. In fact, applicant’s counsel assumes that they are properly of record as part of opposer’s case in his recitation of the record....



Accordingly, we treat the registrations' currency and their ownership by opposer as having been stipulated.”).

Because Petitioner's registrations are deemed of record, Petitioner has established its priority.

### **B. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (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.”). We discuss these and the other relevant *DuPont* factors below.

### **1. Similarity or Dissimilarity of the Services**

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” *In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Here, the services are identical; both parties offer “restaurant services” under their respective marks. This factor favors a finding of likelihood of confusion.

### **2. Trade Channels, Classes of Purchasers, and Conditions of Sale**

The third *DuPont* factor “considers ‘[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Ath. Co.*, 128 USPQ2d at 1052 (quoting *DuPont*, 177 USPQ at 567). Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Respondent argues that the trade channels are different because each party would only offer its services within its own establishment, and never “side-by-side.” 18 TTABVUE 20-21. Whether services would be offered “side-by-side” is not the test, but even if it were, there is no evidence to support this contention. Because Petitioner and Respondent offer identical services, we must presume that the services move through the same channels of trade and are sold to the same classes of purchasers. *Monster Energy Co. v. Chun Hua Lo*, 2023 USPQ2d 87, at \*17 (TTAB 2023); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods or services are presumed to travel in same channels of trade to same class of

purchasers) (*cited in Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (for legally identical services, marketing channels of trade and targeted classes of consumers are the same).

Regarding classes of consumers, the record evidence shows that each party’s restaurant is intended to appeal to the same classes of purchasers, namely members of the general public who enjoy Mexican-style cuisine. 18 TTABVUE 22. (“the parties each sell the food prepared at their respective restaurants directly to members of the general public”). Respondent further acknowledges that the impulse purchasing concern “that arises in conjunction with inexpensive goods offered for sale in the same location simply does not apply to the parties’ restaurant services.” 18 TTABVUE 23.

The *DuPont* factors of channels of trade, classes of consumers, and conditions of sale weigh in favor of likelihood of confusion.

### **3. Similarity or Dissimilarity of the Marks**

We compare the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567. Because the involved restaurant services are

identical, “the degree of similarity between the marks necessary to support a determination that confusion is likely declines.” *Monster Energy Co. v. Chun Hua Lo*, 2023 USPQ2d 87, at \*31 (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citing *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d. 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012)).

We focus our comparison on Petitioner’s EL BURRO mark because if we find a likelihood of confusion as to this registration, we need not find it as to Petitioner’s composite mark. On the other hand, if we do not find a likelihood of confusion with the EL BURRO word mark, we would not find it as to the EL BURRO and design mark either, due to its additional visual differences. *See, e.g., Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015).

The marks EL BURRO and EL BURRO BURRACHO are similar in appearance and pronunciation due to the words “el burro” that form the entirety of Petitioner’s mark and the lead element of Respondent’s mark. The Court of Appeals for the Federal Circuit has often held that the lead element in a mark has a position of prominence. *See Detroit Ath. Co.*, 128 USPQ2d at 1049 (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay Imps. Inc.*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

However, although EL BURRO is the lead element of Respondent's mark, we do not find it to be the dominant portion of the mark. Consumers are as likely to recall the alliteration of BURRO BORRACHO and may equally remember these two words as they would the term EL BURRO.

As to connotation, the word "burracho" means "drunken" in Spanish. Thus, Petitioner's mark connotes an ordinary donkey, while Respondent's mark connotes a whimsical, that is, a drunken donkey. Nonetheless, both marks bring to mind the idea of this specific pack animal. The marks are thus similar in meaning. And because BORRACHO simply serves to modify the type of BURRO involved, the marks create a similar overall commercial impression. The first *DuPont* factor favors a finding of likelihood of confusion.

#### **4. Strength of Petitioner's Mark**

Despite the similarity of the marks, Respondent argues that Petitioner's mark is "intrinsically weak" because it identifies a Mexican-style restaurant, 18 TTABVUE 25, and commercially weak because of the existence of eleven third-party vendors who use EL BURRO, alone or with other words, for Mexican-style restaurants. "[T]he evidence of third-party use of the term 'El Burro' in the name of Mexican restaurants demonstrates that consumers are unlikely to be confused between the parties' respective marks containing that term." Respondent's Brief, 18 TTABVUE 27.

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*,

622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. North Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. 2019) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). For purposes of analysis of likelihood of confusion, a mark’s renown may “var[y] along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted).

The term “el burro” used in connection with restaurant services is arbitrary because it does not describe, or suggest, any quality or characteristic of those services. *See Alberto-Culver Co. v. Helene Curtis Indus., Inc.*, 167 USPQ 365, 370 (TTAB 1970).

The fact that a word or term may be found in a dictionary does not indicate that the word is lacking in trademark significance unless the dictionary meaning of the word is descriptive of the goods in connection with which it is used. That is, the capability of a dictionary word to function as a trademark must be determined by the simple expedient of exploring what meaning, if any, does it possess as applied to a particular product. In this regard, it must be recognized that while a word may have a meaning or descriptive significance as applied to one product, it may

not have such a significance as applied to a different product. Insofar as “COMMAND” is concerned, although it may in a round about manner possess some suggestive characteristics of hair care products, it is, in essence, an arbitrary mark as applied to such goods.

*Id.* Respondent argues that the mark is suggestive of a Mexican-style restaurant, because “el burro” is Spanish for “donkey.” 18 TTABVUE 10. But even though “el burro” is a Spanish term, the record does not indicate that consumers would necessarily perceive Petitioner’s restaurant to serve cuisine from a Spanish-speaking country, let alone Mexico specifically. There is no evidence of record that [EL] BURRO identifies any type of cuisine or, unlike “burrito,” any type of Mexican food dish. Because the EL BURRO mark is registered on the Principal Register without a showing of acquired distinctiveness, Petitioner is “entitled to a strong prima facie presumption that its registered mark is either not ‘merely descriptive’ or if descriptive, that secondary meaning is presumed, which amounts to the same thing.” *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). Petitioner’s mark EL BURRO, when used in connection with restaurant services, is inherently strong.

With respect to the commercial strength of Petitioner’s EL BURRO mark, Petitioner has introduced the declaration of its principal, Gabriel Garcia, who testifies that Petitioner has operated three restaurants in California since 2011 and that all of its restaurants are located on “major surface streets in heavily-populated areas close to major freeways.” Garcia Decl., 15 TTABVUE 16. Petitioner’s marks are prominently featured on the exterior of the buildings housing the restaurants and within the interior, *id.* at 18, as well as on packaging, menu boards, windows, and

cups used inside the restaurants. *Id.* Petitioner also claims that it “extensively uses the El Burro Marks in its promotional and marketing materials,” 15 TTABVUE 17, and copies of a coupon, promotional brochure and pages from Petitioner’s website were included as Exhibits 10-13 to Garcia’s declaration. Petitioner did not provide sales figures or advertising expenses, direct evidence of consumer perception, or media or news reports.

On the other hand, “*DuPont* factor six requires us to consider the number and nature of similar marks in use on similar goods and services.” *Sock It to Me v. Aiping Fan*, 2020 USPQ2d 10611, at \*8-9 (TTAB 2020) (citing *DuPont*, 177 USPQ at 567; *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016)). We find the term “El Burro” to be commonly used for Mexican restaurants and therefore the market strength of Petitioner’s mark has been considerably lessened. Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. To support its argument that Petitioner’s mark is commercially weak, Respondent submitted the following evidence of third-party use of EL BURRO in association with Mexican restaurants:<sup>12</sup>

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<sup>12</sup> 16 TTABVUE 68-279, Exhibits 9-19.



- “El Burro Taco Shop,” Exhibit 9



- El Burro Picante,” Exhibit 10



- “El Burro,” Exhibit 11



- “El Burro Veloz,” Exhibit 12



- “El Burro Loco,” Exhibit 13

**El Burro Loco**  
**Feliz Cinco de Mayo! We are open tonight 3-8p!!**

[Home](#) [Online](#) [Info](#)



**Mountain Mexican**

OPEN FOR PATIO AND INDOOR DINING  
Making plenty of good food to satisfy your belly.  
Take care, be kind and see you soon.

- **El Burro Loco Mexican Restaurant, Exhibit 14**



- **“El Burro Loco,” Exhibit 15**



- “Burro Loco JB Mexican Restaurant,” Exhibit 16



- “El Burro Pollo,” Exhibit 17



- “El Burro Mexican Grill,” Exhibit 18



- “Loco Burro,” Exhibit 19



After careful consideration of the evidence, we find that Petitioner has not shown its mark to be commercially strong. To the contrary, we find under *DuPont* factor six that Respondent has shown Petitioner’s EL BURRO mark to be commercially on the weaker side of the spectrum. We find the prevalence of these similar marks weighs strongly against a finding of likelihood of confusion.

#### **5. Absence of Evidence of Actual Confusion**

The eighth *DuPont* factor considers “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020) (quoting *DuPont*, 177 USPQ at 567). “[F]or the absence of actual confusion to be probative, there must have been a substantial opportunity for confusion to have occurred.” *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*9 (TTAB 2019) (citing *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (where the respective marks coexisted in the marketplace for at least nine years, absence of actual confusion



nonetheless deemed “of little probative value”)); *see also Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (Board looks to the parties’ actual activities in the marketplace to determine whether there has been a reasonable opportunity for confusion to have occurred).

Respondent argues that the absence of actual confusion is a relevant factor to be considered in this case because the parties “have both continued to used [sic] their marks in conjunction with their restaurants since [December 31, 2014].” 18 TTABVUE 28. Petitioner counters that “the lack of evidence of actual confusion carries little weight” because five years of concurrent use is a “relatively short” period. 19 TTABVUE 18. Petitioner operates three restaurants in Southern California, advertises on the Internet and via social media. Respondent operates two restaurants in Las Vegas, Nevada and also advertises on the Internet and via social media. Other than these ubiquitous forums, the record is devoid of evidence to suggest the extent of either party’s advertising, use or promotion of its mark. Although Respondent’s “profit & loss” statement indicates approximately 1.2 million dollars were generated over a period of five years in licensing fees, 15 TTABVUE 204, no profit or loss figures for Petitioner have been provided. We thus cannot discern the extent to which Petitioner’s use of its mark has been “appreciable” or “continuous” and, without a context for Respondent’s numbers, we cannot discern the extent to which Respondent’s use has entered the market.

The record before us does not indicate appreciable and continuous use by the parties of their respective marks for a significant period of time in the same markets. *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). The fact that both parties have a presence on the Internet and on social media does not constitute a sufficient level of evidence to evaluate the extent of use of their respective marks in connection with “restaurant services.” There is little to no context within which to evaluate the extent to which there has been any meaningful coexistence of the marks such that the absence of confusion would be considered relevant. We are also mindful of the fact that the test under Trademark Act Section 2(d) is likelihood of confusion, not actual confusion. *See, e.g., Herbko Int’l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

Accordingly, this factor is neutral.

### **III. Respondent’s Laches/Estoppel Defense**

Respondent argues that Petitioner unduly delayed in seeking cancellation by waiting until the day before Respondent’s mark became “incontestable” to petition for cancellation. 18 TTABVUE 29. Respondent claims prejudice “when Petitioner’s Marks became incontestable.” *Id.* “Petitioner deprived Respondent of the opportunity to challenge Petitioner’s Marks by waiting until they had become incontestable to claim that there is a likelihood of confusion.” 18 TTABVUE 29, n.4.

We agree with Petitioner, however, that Respondent has not shown economic damage because of the alleged delay nor a change of its financial position because of Petitioner’s timing of its petition to cancel. Respondent’s financial statements show a



loss of revenues during the Covid pandemic years but no loss directly attributable to any action or inaction taken by Petitioner.

Accordingly, Respondent's affirmative defense is denied.

#### **IV. Conclusion**

When viewed in their entirety, giving due weight to the components of each mark, and taking into account the weakness of the term "el burro" due to third-party uses for restaurants, we find the presence of the term "el burro" as the only common element in both parties' marks an insufficient basis for finding a likelihood of confusion in association with the parties' respective restaurant services. The sixth *DuPont* factor thus outweighs the other factors that favor likelihood of confusion. In other words, the mark EL BURRO BURRACO does not so resemble EL BURRO that when used in association with restaurant services within such a crowded field confusion, mistake, or deception is likely.

**Decision:** The petition for cancellation is denied.