

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cantina Imperfecto, LLC

Serial No. 97625773

Rhett V. Barney and Robert A. Madayag III of Lee & Hayes, PC
for Cantina Imperfecto, LLC

Matthew Digan, Trademark Examining Attorney, Law Office 124,
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Before Heasley, Lynch, and Brock,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background¹

Cantina Imperfecto, LLC (“Applicant”) seeks registration on the Principal Register of the mark CANTINA IMPERFECTO in standard characters (CANTINA

¹ Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, *4 n.1 (TTAB 2020). The number preceding TTABVUE

disclaimed; IMPERFECTO translated as “imperfect”) for the following services in International Class 43:

Restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurant, bar and catering services; Cafe and restaurant services.²

During prosecution of the application, the Examining Attorney required Applicant to submit the translation and the disclaimer. The Examining Attorney explained that “Applicant’s mark is in Spanish,” but that “[w]hile CANTINA is technically a Spanish word, it has been widely adopted into the English language.”³ The Office Action pointed to an English-language dictionary entry and a Wikipedia entry indicating that CANTINA refers to “a small barroom: saloon” or “a tavern with a Southwestern or Mexican motif that serves traditional alcoholic Mexican drinks.”⁴ Thus, the

corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation, this opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion cites to the LEXIS legal database and cites only precedential decisions. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024). Proceeding and serial numbers also are included for decisions of the Board. Those Board decisions that issued on or after January 1, 2008 may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/ reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available through USPTO.gov in the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

² Application Serial No. 97625773 was filed October 10, 2022 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce.

³ July 25, 2023 Office Action at TSDR 6.

⁴ *Id.* at 8, 17 (Merriam-Webster.com), 23-24 (en.Wikipedia.org).

Examining Attorney proposed, and Applicant provided, a translation of IMPERFECTO as “imperfect,” and a disclaimer of CANTINA as at least descriptive of Applicant’s services.⁵ Notably, the translation Applicant submitted in response to the Office action translated the entire mark, including CANTINA as “canteen.”⁶ However, the Examining Attorney deemed that portion of the translation “unnecessary because this term appears in an English dictionary,” and did not include it in the record for registration.⁷ See TMEP §809.01(b)(i) (2024) (“It is generally unnecessary to provide a translation of a foreign term if the term appears in an English dictionary.”).

As explained in more detail below, the Examining Attorney applied the doctrine of foreign equivalents to Applicant’s mark and refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with

two commonly-owned registered marks, **imperfect**⁸ and



,⁹ both for goods and services that include “food and drink catering; bar services; restaurant services,” in International Class 43.

⁵ *Id.* at 8-9; October 24, 2023 Response to Office Action at TSDR 1.

⁶ October 24, 2023 Response to Office Action at TSDR 1.

⁷ November 30, 2023 Office Action at TSDR 7.

⁸ Registration No. 6181930 issued October 27, 2020.

⁹ Registration No. 6197411 issued November 17, 2020. The registration contains the following mark description: “The mark consists of the stylized term ‘IMPERFECT’ inside of single line

After the Examining Attorney made the refusal final, Applicant appealed and filed a request for reconsideration, which was denied. For the reasons set forth below, we affirm the refusal to register.

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). The analysis often particularly focuses on the similarities between the marks and the similarities between the goods or services. *See 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.”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

A. The Services, Trade Channels and Consumers

In analyzing the relatedness of the services under the second *DuPont* factor, we look to the identifications in the application and cited registrations. *Octocom Sys., Inc. v. Houston Comp. Servs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990). In this case, the subject application includes services identical to some of the services in the cited

rectangle with the lower right corner cut into an arc shape.” Color is not claimed as a feature of the mark.

registrations, such as restaurant services, bar services, and catering. It is sufficient for a determination of likelihood of confusion for a single-class application such as this one if relatedness is established for any one of the identified services within the class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981); *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, Opp. No. 91270181, 2024 TTAB LEXIS 139 at *19 n.41 (TTAB 2024). Thus, the partial overlap between Applicant's and Registrant's recited services alone suffices to show relatedness under this *DuPont* factor.

Because some of the services in the cited registrations are identical to some of Applicant's services, we presume that such overlapping services travel through the same channels of trade to the same classes of purchasers, considerations under the third *DuPont* factor. *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, Opp. No. 91190361, 2011 TTAB LEXIS 260, *14 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also In re Viterra, Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (where goods were identical, Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 754 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

B. Similarity of the Marks and the Doctrine of Foreign Equivalents

Under the first *DuPont* factor, we compare the marks "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. v.*

Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 1371 (Fed. Cir. 2005) (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, Serial No. 87075988, 2018 TTAB LEXIS 170, *13 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012). When the services are identical, as they are here, “the degree of similarity [of marks] necessary to support a conclusion of likely confusion declines.” *Century 21 Real Est. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir.1992).

Before considering the elements of potential similarity of the marks, we address the doctrine of foreign equivalents. Under the doctrine, “foreign words from common [modern] languages are translated into English to determine ... similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay Imps.*, 396 F.3d at 1377. Although “the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline,” applied “only when it is likely that the ordinary American purchaser would ‘stop and translate [the word] into its English equivalent,’” *In re Spirits Int’l N.V.*, 563 F.3d 1347, 1351-52 (Fed. Cir.

2009) (citations omitted), both Applicant and the Examining Attorney agree that the doctrine applies in this case.¹⁰

Applicant has not disputed that Spanish is a common, modern language for purposes of the doctrine of foreign equivalents.¹¹ The record includes evidence supporting this proposition, including that Spanish is the second most common language in the U.S.¹² We therefore find that Spanish qualifies as a common, modern language. *See In re Highlights for Children, Inc.*, Serial No. 85838981, 2016 TTAB LEXIS 104, at *8 (TTAB 2016) (“Spanish is a modern language that is widely spoken in the United States”). As to consumers stopping to translate CANTINA IMPERFECTO, although CANTINA has been adopted from Spanish as an English-language “loanword,”¹³ in the context of the mark as a whole, where CANTINA precedes a Spanish-language adjective, IMPERFECTO, we agree with the Examining Attorney that “consumers would ... interpret the mark, CANTINA IMPERFECTO, as a Spanish-language mark,” and translate it.¹⁴

¹⁰ 6 TTABVUE 10 (“Here ... the Examiner has provided sufficient evidence to conclude that the doctrine of foreign equivalents applies to the term IMPERFECTO because consumers would likely stop and translate the mark.”); 9 TTABVUE 6 (Applicant’s Reply Brief) (noting Applicant has “simultaneously agree[d] that the doctrine of foreign equivalents applies here yet is unimportant in the analysis”); 8 TTABVUE 6 (Examining Attorney’s Brief, asserting applicability of the doctrine). Because Applicant acknowledges the applicability of the doctrine, we need not address and distinguish caselaw regarding exceptions to the doctrine where consumers would not “stop and translate.” *See* 6 TTABVUE 10-11 (Applicant’s Brief).


¹¹ 6 TTABVUE (Applicant’s Brief); 9 TTABVUE (Applicant’s Reply Brief).

¹² July 25, 2023 Office Action at TSDR 6; Nov. 30, 2023 Office Action at TSDR 21-44.

¹³ November 30, 2023 Office Action at TSDR 45, 51, 59, 62.

¹⁴ 8 TTABVUE 6 (Examining Attorney’s Brief). Applicant apparently concurs that consumers would view CANTINA as a Spanish, rather than English, word in this mark. Applicant’s October 24, 2023 Response to Office Action at TSDR 1 states: “The word IMPERFECTO is not the English version of the mark [sic], and combined with another Spanish word,

With that background, we turn to the comparison of Applicant's mark to the cited

marks **imperfect** and . Despite the different languages of Applicant's marks and the cited marks, they nonetheless share some similarity in appearance and sound because the Spanish word IMPERFECTO in Applicant's mark is nearly the same as the only word in the cited marks, IMPERFECT. The words differ by only one additional letter, O, at the end of IMPERFECTO. *See In re Bayer AG*, 488 F.3d 960, 965 (Fed. Cir. 2007) (affirming Board's finding that consumers would perceive the proposed mark ASPIRINA as just a slight variation of "aspirin" because "[t]he mere addition of the letter 'A' at the end" is insufficient to transform the common word). And because Applicant seeks a standard-character registration, its mark may be displayed in any lettering style, including that in which the cited registrations display IMPERFECT. *See Viterra*, 671 F.3d at 1363-64.

There are some differences among the marks. Applicant's mark includes as its first word, CANTINA, adding a visual and phonetic difference, and the cited composite mark includes a notched rectangle surrounding IMPERFECT, another visual difference. Even though this additional matter creates some variation between Applicant's mark and the cited marks, overall we find that they look and sound

CANTINA, the commercial impression is different than if the words, either separately or together, were used in their English form rather than their Spanish form."

somewhat similar because of the IMPERFECT and IMPERFECTO elements of the marks.

More significantly in this case, the connotation and commercial impression of the marks are quite similar. IMPERFECTO and IMPERFECT mean the same thing, and the CANTINA portion of Applicant's mark is a generic or highly descriptive term for the services. Under the doctrine of foreign equivalents, Applicant's CANTINA IMPERFECTO directly translates from Spanish to English as "imperfect cantina" or "imperfect tavern."¹⁵ A cantina is defined as a small barroom or saloon,¹⁶ and as Applicant acknowledges, CANTINA often refers to a Mexican-style restaurant or bar.¹⁷ Thus, CANTINA names a subcategory of restaurants or bars, and therefore is a highly descriptive or generic term for the services at issue here. Consumers are unlikely to rely on such terms to distinguish source.¹⁸ *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (in comparing THE DELTA CAFÉ to DELTA, the generic term CAFÉ lacks sufficient distinctiveness to create a different

¹⁵ October 24, 2023 Response to Office Action at 1 (Applicant's discussion of the significance of CANTINA).

¹⁶ July 25, 2023 Office Action at TSDR 4.

¹⁷ 9 TTABVUE 6 (Applicant's Reply Brief, referring to its "assertion that consumers are accustomed to associating 'cantinas' with Mexican food."); July 25, 2023 Office Action at TSDR 4-13; *see also* July 1, 2024 Request for Reconsideration at 6-74 (third-party uses that include CANTINA in connection with Mexican-themed restaurants and bars).

¹⁸ There is also a "penchant of consumers to shorten marks" that might lead consumers to drop the highly descriptive or generic term and refer to Applicant's establishments only as IMPERFECTO, increasing the visual and phonetic similarity to the cited marks. *See, e.g., Sabhnani, v. Mirage Brands, LLC*, Canc. No. 92068086, 2021 TTAB LEXIS 464, at *45 (TTAB 2021) (quoting *In re Bay State Brewing Co.*, Serial No. 85826258, 2016 TTAB LEXIS 46, at *9 (TTAB 2016)); *In re Abcor Dev. Corp.*, 588 F.2d 811, 815 (CCPA 1978) (Rich, J., concurring) (acknowledging that generally, "users of language have a universal habit of shortening full names from haste or laziness or just economy of words").

commercial impression). Thus, even though CANTINA comes first in CANTINA IMPERFECTO, it does not dominate the mark. One of the cited marks consists only of the word IMPERFECT and the other includes a notched rectangle around the word IMPERFECT. In the composite mark, this design element makes a minimal contribution to the commercial impression of the mark, at most reinforcing the literal element by showing an “imperfect” rectangle with a piece missing.

The connotation and commercial impression of both cited marks rest on the word IMPERFECT, which is identical to the translation of IMPERFECTO in Applicant’s mark, or could be perceived as a mere word or spelling variant. *See Bayer AG*, 488 F.3d at 965. The addition of the generic or highly descriptive term CANTINA does not alter or change the meaning or commercial impression of IMPERFECTO. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 947 (Fed. Cir. 2000) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”)).

Applicant contends that the CANTINA portion of its mark creates a different commercial impression by conveying that the services are Mexican-themed.¹⁹ Applicant points to the third-party use and registration evidence in the record as consistent with this connotation of CANTINA.²⁰ As to the cited marks, Applicant insists that they “would never be viewed by consumers to be associated with Mexican

¹⁹ 6 TTABVUE 13 (Applicant’s Brief).

²⁰ *Id.* (citing July 25, 2023 Office Action and July 1, 2024 Request for Reconsideration).

cuisine,” even when used for restaurant and bar services.²¹ In addition, Applicant insists that although CANTINA may be descriptive, IMPERFECTO should be considered highly suggestive and weak. Thus, according to Applicant, in its mark, CANTINA should be considered dominant or entitled to equal weight with IMPERFECTO.²²

We do not agree that IMPERFECTO/IMPERFECT is a highly suggestive term for the services at issue. Applicant provides no supporting evidence for this proposition. Even if the term were suggestive, Applicant’s argument that this would place it on equal footing with a descriptive or generic term like CANTINA is flawed, because a suggestive term is stronger on the spectrum of distinctiveness than a descriptive or generic term. As noted above, CANTINA is not dominant in Applicant’s mark.

As to Applicant’s argument about the distinct impression of its mark, we agree that because CANTINA IMPERFECTO is in Spanish, consumers likely may derive the impression that Applicant’s bar, restaurant and catering services involve food or drinks in the style of Mexico or some other Spanish-speaking country. However, we are not persuaded that merely because Applicant’s mark is in Spanish and contains a generic or high descriptive word for a type of bar or restaurant, CANTINA IMPERFECTO must be distinguishable from the cited IMPERFECT marks.

We cannot rely on a mark merely being in a common, modern foreign language as a reason, in and of itself, to avoid likely confusion with an English-language mark to

²¹ *Id.*

²² 9 TTABVUE 4 (Applicant’s Reply Brief).

which wording in the foreign mark directly translates. That would render the doctrine of foreign equivalents a nullity. The doctrine “extends the protection of the [Trademark] Act to those consumers in this country who speak other languages in addition to English,” recognizing their propensity to stop and translate. *In re Spirits Int’l N.V.*, Serial No. 74382759, 2008 TTAB LEXIS 6, at *16 (TTAB 2008), *rev’d on other grounds*, 563 F.3d 1347 (Fed. Cir. 2009).

We also reject Applicant’s contention that just because the cited marks include the English-language word IMPERFECT as their only literal element, their commercial impressions differ significantly from Applicant’s mark. Applicant implies that the cited marks could not be used in connection with a cantina or Mexican restaurant, and argues they could never be perceived as such. However, the cited registrations’ unrestricted identifications of bar, restaurant and catering services encompass all types of those services, including cantinas. *See, e.g., In re Hughes Furniture Indus., Inc.*, Serial No. 85627379, 2015 TTAB LEXIS 65, at *12 (TTAB 2015) (unrestricted identifications encompass all goods or services of the type identified). Applicant’s own evidence shows generic use of CANTINA in the industry, such as in Registration No. 2115063, which generically identifies “restaurant and cantina services,”²³ or the blog post “What is a Cantina,” defining it as “a bar with a Mexican or Southwestern theme.”²⁴ Thus, the cited marks could be used in connection with cantinas, and Applicant’s inclusion of CANTINA in its mark does not create such

²³ July 1, 2024 Request for Reconsideration at TSDR 75.

²⁴ *Id.* at 84.

a different connotation and commercial impression that it distinguishes Applicant's mark from the cited marks. "[I]f a junior user takes the entire mark of another and adds a generic, descriptive or highly suggestive term, it is generally not sufficient to avoid confusion," as consumers may perceive such uses as extensions of the senior mark. *Double Coin Holdings Ltd. v. Tru Dev.*, Canc. No. 92063808, 2019 TTAB LEXIS 347, at *22-23 (TTAB 2019) (in the context of tires, ROAD WARRIOR gives the impression of a line extension of the senior mark WARRIOR).

Having taken account of the marks in their entirety, we find them somewhat similar in look and sound, and, considering the doctrine of foreign equivalents, quite similar in connotation and commercial impression.

C. Balancing the Factors

The similarity of these marks in their entirety, including under the doctrine of foreign equivalents, for in-part identical services that move in the same channels of trade to the same classes of customers renders confusion likely. No *DuPont* factors weigh against likely confusion.

Decision: The refusal to register Applicant's mark is affirmed. 15 U.S.C. § 1052(d).