

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Productos Verdes Valle, S.A. de C.V.

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Serial No. 87110668
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Alan S. Nemes of Husch Blackwell LLP,
for Productos Veres Valle, S.A. de C.V.

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Before Bergsman, Ritchie and Heasley,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Productos Verdes Valle, S.A. de C.V. (“Applicant”) seeks registration on the Principal Register of the mark TAMAL TAMAYO and design, shown below, for “tamales,” in Class 30.¹

¹ Application Serial No. 87110668 was filed on July 20, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce.



The description of the mark in the application reads as follows:

The mark consists of a design of a chef standing behind a stock pot and holding the stock pot lid in his right hand. The chef is wearing a chef's bandana on his head and a t-shirt and apron. In front of the stock pot and the chef are the terms "TAMAL TAMAYO" in stylized font.

The application also provides that "[t]he English translation of TAMAL in the mark is tamale," and that "[t]he name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual."

The Trademark Examining Attorney refused to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the mark TAMAYO (typed drawing format) for "restaurant services," in Class 42, registered on the Supplemental Register, as to be likely to cause confusion.² The Trademark Examining Attorney has also required Applicant to disclaim the exclusive right to use the word "Tamal," which is the Mexican word for "Tamale," because it is merely descriptive of tamales.

² Registration No. 2447221, registered April 24, 2001; renewed.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. See *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 goods or 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.”); see also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and

relatedness of the goods”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The strength of the mark in the cited registration

Applicant argues that the mark in the cited registration (TAMAYO) is weak and entitled to a narrow scope of protection because it is primarily merely a surname registered on the Supplemental Register.³ Quoting the Board's opinion in *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975), Applicant asserts that the scope of protection for a mark registered on the Supplemental Register is “limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.” 185 USPQ at 189.⁴

There is no categorical rule that citation of registrations on the Supplemental Register is limited to registrations of “substantially identical’ marks for ‘substantially similar goods,’” or that a different test for likelihood of confusion should be applied in such cases. *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d

³ Applicant’s Brief, p. 3 (7 TTABVUE 8). The only evidence referring to the meaning of the word “Tamayo” is a statement by a “translator” that “TAMAYO is the name of a town in the Dominican Republic and in Mexico.” November 2, 2016 Office Action (TSDR 11). However, this statement has no probative value because there is no evidence that lays the foundation for the statement of the translator and because the purported translation is not supported by any evidence (*e.g.*, corroboration by a gazetteer or encyclopedia). Even though there is no basis for concluding that “TAMAYO” is a surname, including the above-noted translator’s statement as an exhibit in the November 2, 2016 Office Action, the Trademark Examining Attorney, in his brief, states that the cited mark was registered on the Supplemental Register because it is primarily merely a surname. 9 TTABVUE 11. Because both Applicant and the Trademark Examining Attorney treat “TAMAYO” as being primarily merely a surname, we find that Applicant and the Trademark Examining Attorney have stipulated that “TAMAYO” is primarily merely a surname. Accordingly, we shall treat it as such.

⁴ Applicant’s Brief, p. 5 (7 TTABVUE 10).

1039, 1042 (Fed. Cir. 1990); *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir. 1986) (“It is not material whether or not registration on the Supplemental Register implies that there is a degree of descriptiveness to that mark, as appellant argues. Such registration may be cited under section 2(d) in a determination of likelihood of confusion, an inquiry separate from that of descriptiveness.”) (citing *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978) (there is no basis for applying a different standard for determining likelihood of confusion for marks on the Supplemental Register)).

We do not read *Hunke & Jochheim* as limiting the citation of Supplemental Registrations or applying a different Section 2(d) analysis when one is cited. First, *Hunke & Jochheim* predated the appellate court’s decisions in *Research and Trading* and *Clorox*, which settled the propriety of citing marks on the Supplemental Register as a bar to registration. But in case there was any doubt, the Board later expressly disavowed Applicant’s theory.

[W]e have kept in mind that the cited mark is registered on the Supplemental Register. Applicant argues that the scope of protection to which the registrant’s mark is entitled is narrower than a mark registered on the Principal Register, and that under this standard applicant’s mark is sufficiently dissimilar from the cited registration to avoid confusion.

In re Smith & Mehaffey, 31 USPQ2d 1531, 1533 (TTAB 1994). The Board went on to explain that the strength of the cited mark is—as always—relevant to assessing the likelihood of confusion under the *du Pont* framework. Most marks are on the Supplemental Register because they are descriptive, and the weaker the mark on the fanciful to generic continuum, the less its ability to preclude registration of a similar

mark under Section 2(d). *Id.* (citing *Clorox*, 198 USPQ at 341). But there is no categorical rule that citation of registrations on the Supplemental Register is limited to registrations of “substantially identical’ marks for ‘substantially similar goods,’” or that a different test for likelihood of confusion should be applied in such cases. *See In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1743-44 (TTAB 2016).

Nevertheless, because the cited mark is registered on the Supplemental Register, we find that it is not inherently distinctive. *Cf. Clorox*, 198 USPQ at 340 (application for Supplemental Registration is an admission of descriptiveness); *In re Future Ads LLC*, 103 USPQ2d 1571, 1574 (TTAB 2012) (“Registration on the Supplemental Register is prima facie evidence that, at least at the time of registration, the registered mark was merely descriptive.”); *In re Rosemount Inc.*, 86 USPQ2d 1436, 1439 (TTAB 2008) (“because applicant seeks registration on the Supplemental Register, applicant has conceded that the marks are merely descriptive.”). As noted above in footnote 9, Applicant and the Trademark Examining Attorney have stipulated that “TAMAYO” is primarily merely a surname.

Although the Trademark Examining Attorney asserts that “there are only two marks featuring the wording ‘TAMAYO’ on the register for food-related goods or services, namely, applicant’s and registrant’s,”⁵ there is no corroborating evidence (*e.g.*, the results of a search inquiry from the USPTO TESS search engine). By the same token, Applicant did not introduce any evidence of third-party use or registration of TAMAYO in connection with restaurant services or food products.

⁵ Trademark Examining Attorney’s Brief (9 TTABVUE 11).

Accordingly, there is no evidence regarding the number and nature of similar marks in use on similar goods or services or third-party registrations consisting in whole, or in part, of the name “TAMAYO” or variations thereof. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (the extent of third-party use or registrations may indicate that a term carries a suggestive or descriptive connotation and is weak for that reason).

Also, there is no evidence regarding the extent to which TAMAYO is perceived as a surname. *See In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017) (“we first consider the frequency of, and public exposure to, the term OLIN’s surname use.”) (citing *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985) (considering the extent to which the term was used by others as a surname)).

In sum, because Registrant’s mark TAMAYO is on the Supplemental Register, we find that it is not inherently distinctive and there is no countervailing evidence regarding the commercial strength of Registrant’s mark. Thus, this weighs against finding a likelihood of confusion.

B. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling*

Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also* *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods and services at issue are tamales and restaurant services, without any restrictions or limitations in the respective descriptions of goods and services, the average customer is an ordinary consumer.

As indicated above, Applicant is seeking to register the mark TAMAL TAMAYO and design, reproduced below, and the registered mark is TAMAYO.



Applicant's mark TAMAL TAMAYO and design is similar to Registrant's mark because they share the name TAMAYO and, to that extent, they are similar in appearance, sound, connotation and commercial impression. In other words, because TAMAYO is a surname, the source of the goods and services is a person with the surname TAMAYO.

In analyzing Applicant's mark, the name TAMAYO is the most prominent feature by virtue of its size and location in the middle in the mark. There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). "[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985). As discussed below, the differences between the marks fail to distinguish them.

Although we assess each mark in its entirety, the wording often is considered the dominant feature of a mark comprising both literal and design elements because it is the words that are most likely to indicate the source of the services. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). That is, it is the words that are likely to make an impression upon purchasers, be remembered by them, and be used by them to request the goods and services. *See Viterra*, 101 USPQ2d at 1908 (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987).

With respect to the words, as noted above, the English translation of the word “Tamal” is “Tamale.” A “tamale” is defined as “a Mexican dish made of minced and seasoned meat packed in cornmeal dough, wrapped in corn husks, and steamed.”⁶ Accordingly, the word “Tamal” is a generic term for “tamales.” It is well-settled that descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“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.’”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752);

⁶ *Dictionary.com* based on the RANDOM HOUSE DICTIONARY (2017) attached to Applicant’s May 2, 2017 Response to an Office Action (TSDR 18).

In re Dixie Rests. Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

Thus, the name TAMAYO is the most prominent element in Applicant's mark.

On the other hand, Applicant contends that "Tamal" is a given name and that "consumers are likely to perceive the term TAMAL as the first name of the chef character in the drawing."⁷ In that case, the marks share similar meanings and commercial impressions because consumers will perceive TAMAYO as being a surname and that Registrant's TAMAYO is a shortened version of Applicant's TAMAL TAMAYO and, thus, refer to the same person. *See In re C. H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (HANSON is similar to C.H. HANSON); *Somerset Distilling, Inc. v. Speymalt Whisky Distrib., Ltd.*, 14 USPQ2d 1539, 1542 (TTAB 1989) (GORDON'S is similar to JAS. GORDON and design); *In re Leslie Hennessy, Jr.*, 226 USPQ 274, 276 (TTAB 1985) (HENNESSY is similar to LESLIE HENNESSY); *In re Sawyer of Napa, Inc.* 222 USPQ 923, 924 (TTAB 1983) (SAWYER is similar to TOM SAWYER).

Finally, while there is no explicit rule that marks must be found similar where one contains in part the whole of another, the fact that Registrant's mark is entirely subsumed by Applicant's mark increases the similarity between the two. *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant's mark VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus

⁷ Applicant's Brief, p. 13 (7 TTABVUE 18) *citing BabyCenter.com* attached to Applicant's May 2, 2017 Response to an Office Action (TSDR 23).

Tamal
Boy's name meaning, origin, and popularity

confusingly similar to TITAN for medical ultrasound diagnostic apparatus); *Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1568 (TTAB 2007) (respondent's mark ABS-CBN is similar to petitioner's mark CBN both for television broadcasting services); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (applicant's mark MACHO COMBOS for food items confusingly similar to MACHO for restaurant entrees); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers confusingly similar to ACCU-TUNE for automotive testing equipment).

In view of the foregoing, we find that the marks are similar in their entireties in terms of their appearance, sound, connotation and commercial impression. This favors finding a likelihood of confusion.

C. The similarity or dissimilarity and nature of the goods and services.

Applicant is seeking to register its mark for tamales and the cited mark is registered for restaurant services. The fact that restaurants may serve tamales is not enough to render those goods and services related. Instead, “[t]o establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used for food products and for restaurant services.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (quoting *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982)).

In *Coors*, the Court of Appeals for the Federal Circuit explained why more evidence than just showing restaurants sell beer is required to prove that those goods and services are related:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The *Jacobs* case [*Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982)] stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.

Coors, 68 USPQ2d at 1063. In other words, there is no *per se* rule that certain goods and services are related. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (no *per se* rule about confusion, where similar marks are used in connection with restaurant services and food products).

The diversity and expansion of businesses in a modern economy is not, in and of itself, sufficient to support an inference that purchasers are apt to believe that disparate products or services emanate from the same source. See *In re American Olean Tile Co.*, 1 USPQ2d 1823, 1826 (TTAB 1986). Taking the Examining Attorney's position to its logical extreme, not only would a senior user of a mark for restaurant services have prior rights for that mark for tamales, but the senior user of a mark for restaurant services could have prior rights for that mark for other foods, beverages and condiments (e.g., wine or spirits, salsa, mustard, chips, desserts, *etc.*) and a

variety of broadly described promotional items (*e.g.*, clothing, glassware, toys, jewelry, sunglasses, paper products, *etc.*).

The Board has found the “something more” requirement to be met under the following circumstances:

- Applicant’s mark made clear that its restaurant specialized in registrant’s type of goods. *See In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services confusingly similar to GOLDEN GRIDDLE for table syrup); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services confusingly similar to AZTECA for Mexican food items);

- The record showed that registrant’s wines were actually sold in applicant’s restaurant. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) (“the record in this case reveals that registrant’s OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant.”); and

- Registrant’s mark was found to be “a very unique, strong mark.” *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988) (“the Examining Attorney has indicated that he has been unable to find, in the records of the Patent and Trademark Office, any registration, other than the cited registration, for a mark containing the expression ‘Mucky Duck,’” nor has applicant offered any evidence of third-party use of marks containing the expression.).

We now analyze whether the record includes evidence sufficient to meet the “something more” requirement. The Trademark Examining Attorney submitted

excerpts from third-party websites listed below showing the third parties using the same marks to identify their restaurant services and packaged tamales:

- *Swamplot.com* (June 1, 2011)⁸

“Remember the Alamo Spinach and Cheese: New Tamale Central Coming to the Northside,” a news article announcing the development of the Alamo Table Company “tamale-themed entertainment: a full-service restaurant, a cantina opened late, a panaderia that will open early, a banquet and reception hall, and a raspa and dessert bar open primarily on weekends.” This will be “next door to the company’s existing handmade tamale HQ.”

- Central Market (*centralmarket.com*)⁹

Excerpts from this website show advertisements for that company’s café and its packaged tamales.

- Dean & DeLuca (*deandeluca.com*)¹⁰

⁸ November 2, 2016 Office Action (TSDR 12-13). The Trademark Examining Attorney also included an excerpt from the H•E•B website (*heb.com*) advertising the sale of Alamo Mild Pork Tamales. November 2, 2016 Office Action (TSDR 18). However, there is no way to tell whether the Alamo Mild Pork Tamales are an H•E•B product or an Alamo Table Company product sold by H•E•B.

Likewise, there is no way to tell whether the Pedro’s Tamales in Lubbock, Texas discussed in the *Lubbock Avalanche Journal* (November 2, 2016 Office Action (TSDR 54)) is the same entity as Pedro’s Tamales Inc. advertised by Nieman Marcus (November 2, 2016 Office Action (TSDR 59)).

Amy’s Drive Thru (*amysdrivethru.com*) (November 2, 2016 Office Action (TSDR 21)) is a different entity than Amy’s (*amy’s.com*) (November 2, 2016 Office Action (TSDR 28)) because Amy’s Drive Thru copyright notice identifies Amy’s Drive Thru (TSDR 27) while Amy’s copyright notice identifies Amy’s Kitchen’s Inc. (TSDR 29).

⁹ November 2, 2016 Office Action (TSDR 30).

¹⁰ November 2, 2016 Office Action (TSDR 34).

Excerpts from this website show advertisements for that company's café and its packaged tamales.

- Fat Mama's Tamales (*fatmamastamales.com*)¹¹

This website advertises both Fat Mama's Tamale restaurant and packaged tamales.

- Hot Damn Tamales! (*hotdamntamales.com*)¹²

This website advertises the sale of packaged Hot Damn Tamales tamales, as well as the Hot Damn Tamales restaurant, carryout and catering services.

- Rolando's (*rolandosrestaurant.com*)¹³

This website advertises the company's restaurant and carryout services. The website does not advertise packaged tamales.

- Texas Tamale Company (*texastamale.com*)¹⁴

The Texas Tamale Company website advertises the company's packaged tamales and its Mexican delicatessen and restaurant services.

- Tony's Tamales (*tonystamales.com*)¹⁵

The website advertises Tony's Tamales restaurant services and packaged tamales.

- *Tucson Citizen* (*tucsoncitizen.com*) (December 25, 1996)¹⁶

¹¹ November 2, 2016 Office Action (TSDR 39).

¹² November 2, 2016 Office Action (TSDR 46).

¹³ November 2, 2016 Office Action (TSDR 61).

¹⁴ November 2, 2016 Office Action (TSDR 63).

¹⁵ November 2, 2016 Office Action (TSDR 69).

¹⁶ November 2, 2016 Office Action (TSDR 75).

A news article entitled “Mail-Order Mexican Food” reports on restaurants in Tucson that render mail order food services, including tamales, to remote customers.

- Tucson Tamale (*tucsontamale.com*)¹⁷

This website advertises the company’s restaurant services and packaged tamales.

The above-noted evidence shows that companies that render restaurant services may also sell packaged tamales. However, in light of the requirement that “something more” be shown to establish the relatedness of tamales and restaurant services for purposes of demonstrating likelihood of confusion, the evidentiary record does not support a finding that consumers are likely to conclude that tamales and restaurant services with similar marks emanate from the same source. On a more comprehensive record, the Federal Circuit found that the degree of overlap between the sources of restaurant services and sources of beer *de minimis*. See *Coors*, 68 USPQ2d at 1063.¹⁸

The Examining Attorney contends that he has met the something more standard because the record shows that the same entities may render restaurant services and sell tamales under the same mark. However, as noted above, “[t]o establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used for food products and for restaurant services.” *Coors Brewing*, 68 USPQ2d at 1063. That the same entity renders restaurant services and sells tamales under the same mark is that for which something more must be shown.

¹⁷ November 2, 2016 Office Action (TSDR 77).

¹⁸ In addition to evidence of restaurants serving food and beverages, the Board considered articles showing the brewpubs, which brew their own beer, often feature restaurant services and third-party registrations showing a single mark has been registered for beer and restaurant services. *Coors*, 68 USPQ2d at 1063.

The Trademark Examining Attorney also contends that the marks in this case are analogous to the marks in *Azteca Rest*, 50 USPQ2d 1209. because Applicant's mark "indicates not only that restaurant services might be involved given there is a cook with an apron holding a pot lid above a pot, but applicant's mark also indicates that tamales are specifically involved since the mark itself features the wording 'TAMAL' which translates to 'tamale' just below the cook."¹⁹ We disagree. The marks at issue in *Azteca Rest*. were applicant's mark AZTECA MEXICAN RESTAURANT for restaurant services and the registered mark AZTECA for "partially prepared Mexican foods, namely, tortillas." The Board found that the something more requirement was met because Applicant's mark for restaurant services indicated that it served Mexican food. In this case, Registrant's mark TAMAYO for restaurant services does not make clear or in any way indicate that Registrant serves tamales.

Moreover, there is no evidence that Registrant's restaurant services serves Applicant's tamales in its restaurant upon which we may find that the "something more" requirement has been met. Also, as discussed above, because Registrant's mark is primarily merely a surname registered on the Supplemental Register, it is not inherently distinctive and there is no evidence regarding its commercial strength. Accordingly, Registrant's mark is not a "very unique, strong mark" upon which we may support a finding of "something more."

On this record, we find that the goods and services are not similar or related. This weighs against finding a likelihood of confusion.

¹⁹ Trademark Examining Attorney's Brief (9 TTABVUE 10).

- D. Established, likely-to-continue channels of trade and purchasers to whom sales are made.

The above-noted evidence establishes that tamales and restaurant services mark be encountered by the same consumers in the same marketing milieu and, therefore, supports finding that tamales and restaurant services are offered in some of the same channels to trade to some of the same consumers.

- E. Analyzing the factors.

Even though the marks are similar in some respects and the goods and services are sometimes offered in some of the same channels of trade to some of the same consumers, because the registered mark is not inherently distinctive and because the goods and services have not been shown to be sufficiently related, we find that Applicant's mark TAMAL TAMAYO and design for tamales is not likely to cause confusion with the registered mark TAMAYO for restaurant services.

- II. Whether Applicant's exclusive right to use the word "TAMAL" must be disclaimed?

A requirement under Section 6 of the Trademark Act, 15 U.S.C. § 1056, for a disclaimer of unregistrable matter in a mark is appropriate when that matter is merely descriptive of the goods. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). Merely descriptive or generic terms are unregistrable under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and therefore are subject to a disclaimer requirement if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In*

re La. Fish Fry Prods., Ltd., 797 F.3d 1332, 116 USPQ2d 1262, 1266 (Fed. Cir. 2015); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

A term is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act if it immediately conveys knowledge of an ingredient, quality, characteristic, function, feature, purpose, or use of the goods or services with which it is used. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the possible significance that the mark is likely to have to the average purchaser encountering the goods or services in the marketplace. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1818, 1831 (Fed. Cir. 2007); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1473 (TTAB 2014); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods or services are will understand the mark to convey information about them. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1512 (TTAB 2016).

The Trademark Examining Attorney argues that Applicant must disclaim the exclusive right to use the term “Tamal” because the English translation of “Tamal” is “Tamale” and “Tamale” is generic for tamales.²⁰ Applicant, on the other hand, does not argue that “Tamal” is not descriptive or generic, rather Applicant contends that

²⁰ Trademark Examining Attorney’s Brief (9 TTABVUE 15).

consumers will not translate the word “Tamal” and that they are likely to perceive that term as being the first name of the chef appearing in the drawing.²¹ Accordingly, Applicant concludes that “Tamal Tamayo” is a unitary term obviating the need for a disclaimer.²²

A unitary mark is a mark with multiple elements that create a single and distinct commercial impression separate and apart from the meaning of its constituent elements. *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). The Board explained that a unitary mark could be created “where the words which have been put together function as a unit, with each relating to the other rather than directly to the goods.” *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) (LIGHT N’ LIVELY perceived as a unitary term, in part, because of its alliterative nature: when a composite mark is unitary in nature, no disclaimer is required);²³ see also *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (“disclaimers are often required of portions of composite marks in order that it might be understood that a significant element of a composite mark is not being exclusively appropriated by itself apart from the composite.”).

²¹ Applicant’s Brief, p. 13 (7 TTABVUE 18).

²² Applicant’s Brief, pp. 13-14 (7 TTABVUE 18-19).

²³ *In re Kraft*, the Board found that the mark LIGHT N’ LIVELY was unitary because it had a suggestive significance apart from the merely descriptive significance of the individual term LIGHT for reduced calorie mayonnaise. Based upon that reasoning, the Board held that a disclaimer of the term LIGHT was unnecessary.

As discussed above, Applicant argues, in essence, that “Tamal” is a double entendre because it can be perceived as the given name Tamal, as well as the generic term tamale.

A “double entendre” is a word or expression capable of more than one interpretation. For trademark purposes, a “double entendre” is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the “double entendre” will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.

A true “double entendre” is unitary by definition. An expression that is a “double entendre” should not be broken up for purposes of requiring a disclaimer. *See In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), where the Board found inappropriate a requirement for a disclaimer of “LIGHT” apart from the mark “LIGHT N’ LIVELY” for reduced calorie mayonnaise, stating as follows:

The mark “LIGHT N’ LIVELY” as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term “LIGHT” per se. That is, the merely descriptive significance of the term “LIGHT” is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole.

See also In re Symbra’ette, Inc., 189 USPQ 448 (TTAB 1975) (holding SHEER ELEGANCE for panty hose to be a registrable unitary expression; thus, no disclaimer of “SHEER” considered necessary).

TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1213.05(c) (October 2017).

Nevertheless, because “[t]he English translation of TAMAL in the mark is tamale,” the Trademark Examining Attorney required Applicant to disclaim the exclusive right to use the Spanish word “Tamal” which is a generic term for the goods in the application.²⁴ Spanish is a modern language widely spoken in the United States. *See also In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 (TTAB 2016); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1648 (TTAB 2008) (“there is no question that Spanish is a common, modern language”). The 2011 American Community Survey, the primary source for language data, reports that 37.6 million U.S. residents age five and over spoke Spanish at home.²⁵ Thus, the term “Tamal” has a definite English translation that ordinary consumers familiar with Spanish will stop and translate.

²⁴ Trademark Examining Attorney’s Brief (9 TTABVUE 3) (“applicant is required to disclaim exclusive right to use the wording ‘TAMAL’ because, since it translates to ‘tamale’ in Spanish, it is merely descriptive of and generic for applicant’s tamales.”).

²⁵ *See* “Language Use in the United States: 2012,” accessed at <http://www.census.gov/prod/2013pubs/acs-22.pdf>. Because the U.S. census is a standard reference, we may take judicial notice of the information. *See Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1098 n.114 (TTAB 2014), *aff’d*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded*, *Pro Football, Inc. v. Blackhorse*, 709 F. App’x 183 (per curiam) (4th Cir. 2018) (mem.); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001).

The Trademark Examining Attorney cited an Internet link to the census presumably for us to take judicial notice of the information. This is improper. Because the information displayed at a link's Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record. *See, e.g., In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017); *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013); *In re HSB Solomon Assocs. LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012). The better practice is to include a copy of the information from which we should take judicial notice.

Moreover, the only evidence regarding “Tamal” as a given name is from *BabyCenter.com*.²⁶ That excerpt states that as of 2009, the last year provided, “Tamal” was the 12,258th most popular name. According to the U.S. Social Security Administration, “Tamal is not in the top 1000 name for any year of birth beginning with 1900.”²⁷ Accordingly, “Tamal” is a rare name in the United States and, therefore, it is unlikely that the ordinary consumer will perceive “Tamal” as being the given name of the character featured in the drawing of the mark.

Because ordinary consumers are unlikely to perceive “Tamal” as a given name and, in fact, are more likely to perceive “Tamal” as the Spanish word for “tamale,” the word “Tamal” in the mark TAMAL TAMAYO and design sought to be registered does not create a double entendre. In view of the foregoing, the requirement for Applicant to disclaim the exclusive right to use the word “Tamal” is affirmed.

Decision: The refusal to register Applicant’s mark TAMAL TAMAYO and design under Section 2(d) is reversed.

The requirement for Applicant to disclaim the exclusive right to use the word “Tamal” is affirmed and registration to Applicant is refused. However, in the event that Applicant submits the required disclaimer within thirty days from the mailing

²⁶ Applicant’s May 2, 2017 Response to an Office Action (TSDR 23).

²⁷ *SSA.gov/cgi-bin/babyname*. We may take judicial notice of data in the Social Security Administration. *Cf. Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d at 1098 n.114.

date of this decision, the refusal to register will be set aside and the application will proceed to publication.²⁸ *See* Trademark Rule 2.142(g).

²⁸ A proper disclaimer would read: "No claim is made to the exclusive right to use TAMAL apart from the mark as shown."