

This Opinion is Not a
Precedent of the TTAB

Mailed: May 12, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Guidos Burritos LLC
—

Serial No. 87931059
—

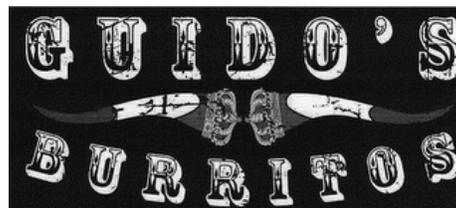
Jay E. Eckhaus of Business Law Center of the Palm Beaches
for Applicant, Guidos Burritos LLC.

Susan Leslie DuBois, Trademark Examining Attorney, Law Office 111,
Christopher Doninger, Managing Attorney.
—

Before Mermelstein, Kuczma and Dunn,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Guidos Burritos LLC (“Applicant”) seeks registration on the Principal Register of
the mark:



for:

Clothing, namely, t-shirts and hoodies in International Class 25; and

Mexican Restaurant and Tequila Cantina in International Class 43.¹

The Trademark Examining Attorney refused registration of Applicant's mark under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), citing Registration No. 2405367, owned by Guido's Premium Pizza, Inc. ("Registrant"), for the mark GUIDO'S for "Restaurant services" in International Class 42², as a bar to registration.

After the Examining Attorney made the refusal final, Applicant appealed to this Board and requested reconsideration of the refusal which was denied. Applicant and the Examining Attorney submitted briefs. For the reasons set forth below, the refusal to register is affirmed.

¹ Application Serial No. 87931059 was filed on May 22, 2018, based upon Applicant's claim of first use and first use in commerce of the mark for the goods in Class 25 and the services in Class 43 on May 1, 2011, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The mark is described as follows: The mark consists of two stylized horns and two crowns. The horns and crowns are mirrored to each other. Above the horns and crowns is the stylized word "Guido's." Below the horns and crowns is the stylized word "Burritos." The background in the color black is only a placard and not a part of the mark. Additionally, BURRITOS is disclaimed and color is not claimed as a feature of the mark.

² Registration No. 2405367 issued November 21, 2000; renewed. The mark shown in Registration No. 2405367 is depicted as a typed drawing. Before November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. Trademark Rule 2.52, 37 C.F.R. 2.52; TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 807.03(i) (Oct. 2018). Additionally, restaurant services were classified in International Class 42 at the time the Registration issued, but are now classified in International Class 43. TMEP § 1401.09 and § 1401.11.

Page references to the application record refer to the downloadable .pdf version of the United States Patent and Trademark Office (USPTO) Trademark Status & Document Retrieval (TSDR) system. References to the briefs refer to the Board's TTABVue docket system.

Likelihood of Confusion

Our determination under § 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion enunciated in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Ft. 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.”). Additionally, we consider the similarity of the trade channels and customers; the conditions under which and buyers to whom sales are made i.e., impulse versus careful sophisticated purchasing; and the number and nature of similar marks in use on similar services and goods.

We have considered all of the evidence as it pertains to the relevant *DuPont* factors, as well as Applicant’s arguments (including any evidence and arguments not specifically discussed in this opinion). *DuPont*, 177 USPQ at 567-68; see also *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (not all

of the *DuPont* factors are relevant to every case, only factors of significance to the particular mark need be considered). The other factors we treat as neutral.

A. Similarity of the Services and Goods

We turn first to the *DuPont* factor involving the similarity of Applicant's services and goods, i.e., Mexican restaurant and tequila cantina services, and t-shirts and hoodies, to Registrant's restaurant services. The issue is whether Applicant's services and goods are identical or related to Registrant's services. They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Inasmuch as Registrant's registered services are "restaurant services," without limitation as to the nature or type of cuisine offered, they necessarily encompass Applicant's more narrowly identified "Mexican restaurant and tequila cantina" services. Therefore, Applicant's services are encompassed by Registrant's services, making them legally identical. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (1997) ("restaurant services specializing in Southern-style cuisine" are legally identical to "restaurant services"). *See also, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Stone Lion Capital Partners, L.P. v. Lion*

Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Denisi*, 225 USPQ 624, 625-26 (TTAB 1985).

The USPTO classification of Applicant's Mexican restaurant and tequila cantina services in International Class 43 and Registrant's earlier-registered restaurant services in International Class 42 does not establish that these services are unrelated under § 2(d). *See* TMEP §1207.01(d)(v). The determination concerning the proper classification of goods or services is a purely administrative determination unrelated to the determination of likelihood of confusion. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1543 (Fed. Cir. 2007); *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993). Moreover, effective January 1, 2002, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks was amended to add three new service classes (Classes 43 through 45) arising from the extensive restructuring of Class 42. In the course of that restructuring, many activities were removed from Class 42 and placed in one of the three new classes. TMEP § 1401.11. Restaurant services have been reclassified in International Class 43 (Hotels and restaurants) which covers among other services "services for providing food and drink." TMEP § 1401.02(a). Nonetheless, the restructuring of Class 42 and creation of Class 43 have no substantive effect. *Jean Patou*, 29 USPQ2d at 1774.

Notwithstanding Applicant's argument and evidence regarding the differences in the actual scope of its own and the cited Registrant's commercial uses of their marks, the nature, scope and similarity of the services and goods must be determined based

on the identification of services and goods listed in the application and cited registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic*, 123 USPQ2d at 1749); *In re Dixie Rests.*, 41 USPQ2d at 1534; *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”). Therefore, Applicant’s evidence and arguments that it has not broadly identified its services and that “Mexican restaurants are not competitive with Registrant’s services which include pizza and other Italian fare,”³ are not relevant. Based on the services as identified in the application and cited registration, Applicant’s Mexican Restaurant and Tequila Cantina services are legally identical to Registrant’s restaurant services.

Applicant’s application also covers t-shirts and hoodies in Class 25, and we find those goods to be related to Registrant’s restaurant services. To support a likelihood of confusion it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive in order to find that they

³ Applicant’s Appeal Brief p. 12 (9 TTABVUE 17). Applicant’s argument at pp. 12-13 (9 TTABVUE 17-18) regarding cancelled Registration No. 2862884 for the mark SENOR GUIDO CHANGS for “restaurants featuring a combination of Mexican cuisine, Italian cuisine and Chinese cuisine for takeout, delivery and sit-down service” that issued subsequent to Registrant’s GUIDO’S registration, *see* Request for Reconsideration at TSDR 466, is not considered. It is well-established that an expired or cancelled registration has no probative value. *Action Temp. Servs., Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything”); *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987) (expired registration has no probative value other than for what it shows on its face, i.e., that the registration issued). However, even if that Registration was considered, it is for a mark that is different in nature and readily distinguishable from Applicant’s mark.

are related for purposes of our likelihood of confusion analysis. It is enough if there is a relationship between them or they are marketed under the same or similar conditions and surroundings to the same general class of purchasers such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources. That is, the issue is not whether customers would confuse the goods and services themselves, but rather whether they would be confused as to the source of the goods and services or find an association between their sources. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 144 USPQ 435, 438 (CCPA 1965); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB 1986) (holding 21 CLUB for various items of clothing and THE "21" CLUB (stylized) for restaurant services likely to cause confusion); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

The Examining Attorney argues that clothing is related to restaurant services because many restaurants sell clothing items with their logos prominently displayed, submitting webpages from a couple of restaurants offering clothing items for purchase.⁴ Additionally, she submits an article from *Gourmet Marketing* acknowledging that "[t]he sale of T-shirts, mugs, hats and other merchandise provides a supplemental revenue source for some restaurants. . . . So your customers

⁴ See Examining Attorney's Brief (11 TTABVUE 5) citing September 13, 2018 Office Action, TSDR 2-3, 16-19, 20-22.

may want to buy merchandise and bring home something from your restaurant;”⁵ and an article from *LA Weekly* titled “7 Restaurant T-Shirts Cool Enough to Actually Wear” which notes that “industry swag has reached a whole new level,” discussing the impact that creative and fun clothing items can have on a restaurant’s bottom line.⁶

In further support of the refusal, the Examining Attorney submits evidence from the USPTO’s X-Search database consisting of a sample of third-party marks registered for use in connection with the same or similar services and goods as those of both Applicant and Registrant, i.e., restaurant services (Classes 42/43) and clothing items including t-shirts and/or hats (Class 25), under the same mark⁷:

Registration Number	Mark	Goods and Services
Reg. No. 2153260 ⁸	MAUI TACO	T-shirts Class 25 and restaurant services Class 42
Reg. No. 2521553 ⁹	THUNDER CANYON BREWERY RESTAURANT & PUB	T-shirts etc. Class 25, beer, soft drinks Class 32 and restaurant services Class 42

⁵ See September 13, 2018 Office Action, “Selling Restaurant Merchandise” January 17, 2020 <https://www.gourmetmarketing.net/selling-restaurant-merchandise/> 09/13/2018 at TSDR 8-12.

⁶ *Id.* “7 Restaurant T-Shirts Cool Enough to Actually Wear” September 19, 2016 <https://www.laweekly.com/restaurants/la-loves-alexs-lemonade-raises-14-million-to-fight-childhood-cancer-9846155> 09/13/2018 at TSDR 13-15.

⁷ See August 1, 2019 Request for Reconsideration Denied (5 TTABVUE 4); Registration No. 4395771 (5 TTABVUE 41-43) has been cancelled and has not been considered.

⁸ August 1, 2019 Request for Reconsideration Denied (5 TTABVUE 5-6); Registration renewed second time.

⁹ *Id.* (5 TTABVUE 7-9); Registration renewed.

Registration Number	Mark	Goods and Services
Reg. No. 2561494 ¹⁰	TAQUERIA ARANDAS SABROSOSABROSITO!!! & Design	Shirts and baseball caps Class 25, Mexican food restaurant and bar services Class 42 (and Classes 16 & 35)
Reg. No. 3278565 ¹¹	SANITARY FISH MARKET AND RESTAURANT	T-shirts, hats etc. Class 25, Food products in Class 30, restaurant services Class 43
Reg. No. 4246177 ¹²	CAFÉ CREPE	t-shirts, baseball caps Class 25 and restaurant services Class 43
Reg. No. 3461717 ¹³	THE QUIET WOMAN RESTAURANT & BAR & Design	Shirts, sweatshirts, etc. Class 25 and restaurant services Class 43
Reg. No. 3758277 ¹⁴	HAPPY AS A CLAM LINDSEY'S RESTAURANT BUZZARDS BAY, MASS & Design	Tee-shirts, sweatshirts and hats Class 25, and restaurant services Class 43, and mugs Class 21
Reg. No. 4427026 ¹⁵	O'LEARY'S EST 1988 BAR & RESTAURANT & Design	Shirts, hats etc., Class 25 and restaurant services Class 43, and tableware in Class 21, food items in Classes 29 & 30, beers, fruit drinks in Class 32
Reg. No. 4595072 ¹⁶	DEATH CAFE	t-shirts, baseball hats etc. Class 25; restaurant services Class 43; greeting cards etc. in Class 16; and organizing and arranging

¹⁰ *Id.* (5 TTABVUE 10-12); Registration renewed.

¹¹ *Id.* (5 TTABVUE 13-15); Registration renewed.

¹² *Id.* (5 TTABVUE 16-18); §§ 8 & 15 declaration accepted and acknowledged.

¹³ *Id.* (5 TTABVUE 19-21); Registration renewed.

¹⁴ *Id.* (5 TTABVUE 22-24); partial §§ 8 & 15 declaration accepted and acknowledged.

¹⁵ *Id.* (5 TTABVUE 25-27); this Registration issued on November 5, 2013 and to date, no § 8 declaration of use has been filed.

¹⁶ *Id.* (5 TTABVUE 28-30).

Registration Number	Mark	Goods and Services
		conferences and events etc. in Class 41
Reg. No. 5816144 ¹⁷	CAFÉ KITSUNÉ	Tee-shirts, caps etc. Class 25, restaurant services Class 43, Household utensils in Class 21, food items in Class 30
Reg. No. 4491834 ¹⁸	RISTORANTE AL MARE	t-shirts, hats etc. Class 25, restaurant services Class 43, key chains in Class 6 and cups and mugs in Class 21
Reg. No. 4492063 ¹⁹	RISTORANTE AL MARE & Design	t-shirts, hats etc. Class 25, restaurant services Class 43, key chains in Class 6 and cups and mugs in Class 21
Reg. No. 4435330 ²⁰	DON JUAN BAJA BEACH TACOS & Design	Shirts and headwear Class 25, restaurant services Class 43
Reg. No. 4732188 ²¹	MUSETTE CAFFE	T-shirts, hats etc. Class 25, restaurant and coffee bar services Class 43, and shoulder and sport bags in Class 18
Reg. No. 4825871 ²²	DONNA'S CARIBBEAN RESTAURANT & Design	Shirts, caps and visors Class 25, restaurant services Class 43
Reg. No. 5337895 ²³	KWALITY SWEETS & RESTAURANT & Design	t-shirts, caps etc. Class 25, restaurant and food preparation services Class

¹⁷ *Id.* (5 TTABVUE 31-34).

¹⁸ *Id.* (5 TTABVUE 35-37).

¹⁹ *Id.* (5 TTABVUE 38-40); this Registration is owned by the same owner as Registration No. 4491834.

²⁰ *Id.* (5 TTABVUE 44-46); §§ 8 & 15 declaration accepted and acknowledged.

²¹ *Id.* (5 TTABVUE 47-49).

²² *Id.* (5 TTABVUE 50-52).

²³ *Id.* (5 TTABVUE 53-57).

Registration Number	Mark	Goods and Services
		43; food products Classes 29 & 30, beverages Class 32, ice cream store services Class 35, event planning Class 41
Reg. No. 5362406 ²⁴	FATTYS SEAFOOD RESTAURANT & Design	Hats and shirts Class 25, Restaurant services Class 43; glasses, cups and mugs in Class 21
Reg. No. 5628386 ²⁵	PIZZA SQUAD	t-shirts and hats etc. Class 25, restaurant services Class 43, pizza Class 30, and customer loyalty programs in Class 35
Reg. No. 5682971 ²⁶	LIVE LUCKY	Retail and online store services featuring headwear, shirts etc. Class 35, and restaurant services in Class 43
Reg. No. 5644279 ²⁷	ANDYTOWN COFFEE ROASTERS	Shirts, beanies, infant and toddler clothing Class 25, and restaurant services Class 43; and food items Class 30, Totebags Class 18 and drinking glasses, mugs Class 21
Reg. No. 5644316 ²⁸	ZIG ZAG SMOKIN BURGER & Design	T-shirts, caps etc. Class 25, Restaurant services Class 43, and on-line restaurant take-out and delivery ordering services Class 35

²⁴ *Id.* (5 TTABVUE 58-60).

²⁵ *Id.* (5 TTABVUE 61-63).

²⁶ *Id.* (5 TTABVUE 64-66).

²⁷ *Id.* (5 TTABVUE 67-69).

²⁸ *Id.* (5 TTABVUE 70-72).

Registration Number	Mark	Goods and Services
Reg. No. 5644317 ²⁹	MILE HIGH MEATBALL EATERY AND LIBATIONS & Design	T-shirts, hats etc. Class 25; Restaurant services Class 43, on-line restaurant take-out and delivery ordering services in Class 35
Reg. No. 5566746 ³⁰	SMOKY ROSE & Design	T-shirts, caps, etc. Class 25, restaurant services Class 43; and household and kitchen use items in Class 21
Reg. No. 5681407 ³¹	BIRD CREEK TRD MRK ESTB XX17 BURGER CO. & Design	Shirts Class 25, and restaurant and bar services Class 43
Reg. No. 5671099 ³²	BIRD CREEK – BURGER CO. – & Design	Shirts Class 25, and restaurant and bar services Class 43
Reg. No. 5604298 ³³	FISH SHACK & Design	Shirts, hats Class 25 and restaurant services Class 43
Reg. No. 5651740 ³⁴	ADVENTURES ON THE GORGE	Retail store services featuring clothing souvenirs etc. Class 35, restaurant services Class 43, and rental of mountain biking and boat equipment etc. Class 39, providing facilities for

²⁹ *Id.* (5 TTABVUE 73-75).

³⁰ *Id.* (5 TTABVUE 76-78).

³¹ *Id.* (5 TTABVUE 79-81).

³² *Id.* (5 TTABVUE 82-84); this Registration is owned by the same owner as Registration No. 5681407.

³³ *Id.* (5 TTABVUE 85-87).

³⁴ *Id.* (5 TTABVUE 88-90).

Registration Number	Mark	Goods and Services
		recreational activities Class 41
Reg. No. 5613003 ³⁵	WINGHOUSE BAR + GRILL & Design	T-shirts, hats etc. Class 25; restaurant and bar services Class 43 (and Classes 18 and 21)
Reg. No. 5572092 ³⁶	THE ASPEN WAY UNITY – LOVE – RESPECT – COMMIT & Design	T-shirts, hats etc. Class 25, restaurant services Class 43; and providing adventure park facilities, providing recreational facilities Class 41
Reg. No. 5535432 ³⁷	OTHER HALF	Retail apparel and clothing stores Class 35; Restaurant and bar services Class 43; Beers Class 32
Reg. No. 5549745 ³⁸	O H & Design	Retail apparel and clothing stores in Class 35; Restaurant and bar services Class 43; Beers in Class 32
Reg. No. 5616766 ³⁹	E.A.T. ITALIAN & Design	Hooded sweatshirts, hats etc. Class 25, restaurant services Class 43
Reg. No. 5654165 ⁴⁰	TRIUMPH BREWING COMPANY & Design	Shirts, hats Class 25; brew pub and restaurant services Class 43
Reg. No. 5647936 ⁴¹	FITTINGLY DELICIOUS	Tee-shirts etc. Class 25, restaurant services Class 43

³⁵ *Id.* (5 TTABVUE 91-93).

³⁶ *Id.* (5 TTABVUE 94-96).

³⁷ *Id.* (5 TTABVUE 97-99).

³⁸ *Id.* (5 TTABVUE 100-102); this Registration is owned by the same owner as Registration No. 5535432.

³⁹ *Id.* (5 TTABVUE 103-105).

⁴⁰ *Id.* (5 TTABVUE 106-108).

⁴¹ *Id.* (5 TTABVUE 109-111).

Registration Number	Mark	Goods and Services
Reg. No. 5586398 ⁴²	RED HOT & BLUE	t-shirts, golf hats etc. Class 25, restaurant services Class 43

This evidence shows that the services and goods listed in these registrations, namely restaurant services and clothing items, are of a kind that may emanate from a single source under a single mark, and thus are related for the purpose of determining likelihood of confusion. *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Phillips-Van Heusen*, 228 USPQ at 951 (likelihood of confusion found between the mark 21 CLUB for shirts and the mark THE “21” CLUB for restaurant services finding that clothing, especially shirts, is a natural area for the “collateral product” use of commercial trademarks); *see also L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (“It is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on ‘collateral products’ has become a part of everyday life.”).

Therefore, inasmuch as Applicant’s Mexican restaurant services are legally identical to Registrant’s restaurant services, and Applicant’s t-shirts and hoodies are related to Registrant’s restaurant services, the similarity of the services and goods favors finding a likelihood of confusion.

⁴² *Id.* (5 TTABVUE 112-114).

B. Channels of Trade and Classes of Customers

With respect to the channels of trade and classes of customers, our determinations under these factors are also based on the services identified in the cited Registration and the services and goods identified in Applicant's application. *See Stone Lion v. Lion Capital*, 110 USPQ2d at 1162 ("It was proper, however, for the Board to focus on the application and registrations rather than on real world conditions, because 'the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application . . .'" (quoting *Octocom Sys., Inc. v. Hous. Comptr. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990))); *Coach Servs. v. Triumph Learning*, 101 USPQ2d at 1722-23; *In re Dixie Rests.*, 41 USPQ2d at 1534.

Given the legal identity of the restaurant services, and the lack of restrictions on trade channels and classes of customers in the recitations of services, we presume that these services travel through the same channels of trade to the same classes of customers. *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (citing *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

The evidence Applicant submits in support of its argument that Registrant's and Applicant's services are found in differing trade channels is not pertinent.⁴³ Given

⁴³ *See* Applicant's Appeal Brief pp. 16-18 (9 TTABVUE 21-23).

the overlapping relationship between the registered restaurant services, which are presumed to encompass Mexican restaurant services, and Applicant's Mexican restaurant and tequila cantina services, at least some of Registrant's customers are part of the general consuming public for Applicant's services. Therefore, because Applicant's services and Registrant's services are offered to the general consuming public, the channels of trade and classes of customers overlap. This overlap weighs in favor of a finding of likelihood of confusion, under the third *DuPont* factor. *In re Wilson*, 57 USPQ2d 1863, 1866 (TTAB 2001).

Additionally, as set forth above, Applicant's t-shirts and hoodies in Class 25 are related to the services of Applicant and Registrant. The evidence shows a commercial practice of offering apparel with the restaurant name for sale to restaurant customers. Therefore, while they may travel in separate trades of channel for apparel, we find Applicant's t-shirts and hoodies also travel in the same trade channels to the same classes of customers as the registered restaurant services.

Accordingly, the *DuPont* factor relating to channels of trade and classes of customers favors a finding of likelihood of confusion.

C. Conditions Under Which and Buyers to Whom Sales are Made, i.e.,
"Impulse" vs. Careful, Sophisticated Purchasing

Applicant argues that the relevant purchasers, i.e., customers of restaurant services, are sophisticated and careful purchasers. Sophistication under the fourth *DuPont* factor is important because sophisticated purchasers may be expected to exercise greater care avoiding a likelihood of confusion. *See Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

Applicant contends that “consumers choose where to dine based largely on Internet search results, and consideration of the type of food the consumer wants to consume (e.g. Mexican Food, Pizza-Italian or Chinese cuisine) and not by brand.”⁴⁴ Based on the evidence it submits, Applicant concludes that “a consumer looking for pizza or other Italian themed cuisine is unlikely to consider dining at Guido’s Burritos, which clearly evokes Mexican themed cuisine.”⁴⁵ Even assuming that consumers rely on Internet search results and consideration of the type of food served in selecting a restaurant, this misses the point. The ultimate issue that must be decided is not whether customers can differentiate Registrant’s restaurant services from Applicant’s Mexican restaurant services, but rather whether consumers are likely to be confused as to the source of the services, or as to an affiliation, connection or sponsorship of them when the services are offered in connection with Applicant’s mark and the registered mark. *See Hilson Rsch. Inc. v. Soc. for Human Resource Mgmt.*, 27 USPQ2d 1423, 1429 (TTAB 1993). Thus, it is not necessary that the services and goods be similar or even competitive to support a finding of likelihood of confusion.

The confusion which the Trademark Act is concerned with is not only that a customer would mistakenly choose Applicant’s or Registrant’s restaurant but also whether such a customer, familiar with Registrant’s restaurant would believe that Applicant’s Mexican restaurant was yet another restaurant emanating from

⁴⁴ Applicant’s Appeal Brief pp. 14-15 (9 TTABVUE 19-20).

⁴⁵ Applicant’ Appeal Brief p. 16 (9 TTABVUE 21).

Registrant (or vice versa), or that the two restaurants were somehow associated with the same source. *In re Uncle Sam Chem. Co.*, 229 USPQ 233, 235 (TTAB 1986). *See also Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1407 (TTAB 1998) (“While ordinary consumers can be said to choose their restaurants with a certain degree of care based on their own experience and the recommendations of others, we do not find this fact to warrant the conclusion, with respect to likelihood of confusion, that consumers exercise a high degree of discrimination or sophistication with regard to their decision to patronize certain eating establishments.”).

The class of restaurant patrons and t-shirt (and hoodie) purchasers is unquestionably large, including the vast majority of adults. Despite the fact that some of these customers may be “sophisticated,” many undoubtedly are not. Our decision must be based on the least sophisticated customers in that relevant group. *Stone Lion v. Lion Capital*, 110 USPQ2d at 1163 (“Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”). Inasmuch as there is no evidence to suggest that customers of the relevant restaurant services and t-shirts (and hoodies) are any more sophisticated than customers of any other retail services and goods, the customers are ordinary average consumers who are likely to be confused by similar marks used in connection with services that are, in part, legally identical. *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (“That the relevant class of buyers may exercise care does not

necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods.”).

Even if some of the relevant customers of the compared restaurant and Mexican restaurant services are sophisticated and discriminating about restaurants does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. Being knowledgeable or sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (indicating that “even sophisticated purchasers can be confused by very similar marks”); *Top Tobacco, LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011) (even consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988).

In view of the overlapping identification of services and the presumption that the services are offered to the same customers, which are not necessarily sophisticated, this factor supports a likelihood of confusion.

D. Similarity of the Marks

It is well settled that marks are compared in their entireties for similarities in appearance, sound, connotation and commercial impression. *Stone Lion v. Lion Capital*, 110 USPQ2d at 1160 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir.

2005)); *In re Viterra*, 101 USPQ2d at 1908. When the goods or services are identical or virtually identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

The term “GUIDO’S” forms the dominant impression of both marks. It is presented as the first term in Applicant’s mark GUIDO’S BURRITOS and the only term in Registrant’s mark GUIDO’S, resulting in marks that are similar in sound and sight. It is significant that Applicant’s mark begins with the same word as the registered mark. In such cases, similarity has often been found because consumers are generally more inclined to focus on the first word in any trademark or service mark, which in this case is identical. *See also In re Detroit Athletic*, 128 USPQ2d at 1049 (finding “[t]he identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1340 (Fed. Cir. 2007) (the shared word in CHI and CHI PLUS is likely to cause confusion despite differences in the marks’ designs); *Palm Bay Imps. v. Veuve Clicquot*, 73 USPQ2d at 1692 (the presence of the strong distinctive term VEUVE as the first word in both parties’ marks renders the marks similar); *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER for non-alcoholic club soda, quinine water and ginger ale similar to BENGAL for gin); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016)

(finding BARR GROUP and BARR confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBO likely to cause confusion with registered MACHO mark); *In re Denisi*, 225 USPQ at 626 (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *Johnson Pub'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re South Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUG for toy doll carriages and LITTLE LADY for doll clothing).

Applicant contends that word "BURRITOS" in its mark is not descriptive of its goods and services but rather is suggestive of the type of food a consumer might purchase and distinguishes its mark from the Registrant's mark. While we agree with Applicant that suggestive marks imply or suggest, but do not explicitly describe, qualities or functions of a particular product or service, the term "BURRITOS" in Applicant's mark is not suggestive; it describes the type of food served at its restaurant, i.e., burritos and related products.⁴⁶ See *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1638 (Fed. Cir. 2016) (finding CHURRASCOS generic for a class of restaurants that serve churrascos (grilled meat)). Thus, the word "BURRITOS" in Applicant's mark is at least descriptive of Applicant's identified

⁴⁶ See Applicant's menu offering "BURRITOS" as well as "GUIDO'S BURRITO" and other related Mexican menu items. January 10, 2019, Response to Office Action, p. 3 and Exhibit 3, TSDR 12, 48-49; also a news article titled History and Origins of Burritos identifying them as "the lauded Mexican fast food item." July 24, 2019 Request for Reconsideration, <https://www.portablepress.com/blog/2018/04/history-origin-burritos>, TSDR 634.

services, and has been appropriately disclaimed by Applicant.⁴⁷ It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (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”)); *In re Dixie Rests.*, 41 USPQ2d at 1533-34 (“DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Inasmuch as the word “BURRITOS” in Applicant’s mark is at least merely descriptive of menu items offered for sale and served in its restaurant, the dominant first element in Applicant’s mark is identical to the distinctive term “GUIDO’S” in Registrant’s mark. *See In re Viterra*, 101 USPQ2d at 1908 (the court may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, however, the ultimate conclusion nonetheless must rest on consideration of the marks in total). 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

⁴⁷ *See* September 13, 2018 Office Action, TSDR 3; and January 10, 2019 Response to Office Action, TSDR 9.

rests on a consideration of the marks in their entireties. *In re Nat'l Data*, 224 USPQ at 751. The difference in the marks due to the inclusion of the descriptive word “BURRITOS” following “GUIDO’S” in Applicant’s mark, is not sufficient to distinguish them. Because Applicant’s mark begins with identical wording to that found in the registered mark and does not contain additional wording that distinguishes it from Registrant’s mark, the marks look and sound alike, and the commercial impression of the marks is very similar.⁴⁸

Applicant contends that its mark “is strikingly dissimilar combining GUIDO’S with BURRITOS *and with* prominent design elements consisting of two horns and crowns mirrored to each other.” Applicant maintains that the “overall commercial impression of [its] mark is dominated by its design features (bull horns and crowns), and weigh[s] heavily against a conclusion that confusion is likely based solely on the overlap of the term ‘GUIDO’S,’” citing *In re Covalinski*, 113 USPQ2d 1166 (TTAB

2014). *In re Covalinski* involved the mark  which is very different from Applicant’s mark because the letters RR rather than the wording in the mark was found to be the dominant portion of the mark.⁴⁹

⁴⁸ In its Request for Reconsideration, Applicant argues that the term “GUIDO’S” in its mark is juxtaposed with the term “BURRITOS” lending a sing-song or rhyming quality to the literal portion of its mark which is absent from Registrant’s single word mark. Request for Reconsideration at TSDR, 324 of 7268. Even if the term “BURRITOS” does lend a sing-song or rhyming quality to the literal portion of Applicant’s mark, that alone does diminish the identical similarity in sound between Registrant’s mark and Applicant’s mark particularly in light of the descriptiveness of BURRITO.

⁴⁹ Applicant’s Appeal Brief p. 3 (9 TTABVUE 8).



Here, the wording in Applicant's mark and particularly the first word "GUIDO'S," is the dominant portion of the mark appearing in the largest font, with the decorative bull horns and crown design located underneath "GUIDO'S" and above the second descriptive word "BURRITOS." Contrary to Applicant's contention, the bull horns and crowns are not the dominant portion of its mark as customers seeing Applicant's mark would readily recognize the wording GUIDO'S BURRITOS and use it to identify Applicant's restaurant services and other goods. The addition of a design element in Applicant's mark does not obviate the fact that Applicant's mark incorporates Registrant's mark as its first and most significant element. The horn-and-crown design element is visually subordinate to the larger and more prominent wording. Thus, the term "GUIDO'S" dominates the commercial impression of Applicant's mark and renders it similar to Registrant's mark. *See In re Max Capital*, 93 USPQ2d at 1248 (holding applicant's MAX with pillar design mark, and registrant's MAX mark likely to cause confusion, noting that the "addition of a column design to the cited mark ... is not sufficient to convey that [the] marks ... identify different sources for legally identical insurance services").

Applicant's reliance on *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009) is misplaced.⁵⁰ In *White Rock*, the applicant's mark VOLTA and the cited

⁵⁰ Applicant's Appeal Brief pp. 4-5 (9 TTABVUE 9-10).



TERZA
VOLTA

registrant's mark were used on unrelated alcoholic beverages and were not found to be similar in appearance. Additionally, *White Rock's* citation of *Fossil Inc. v. Fossil Grp.*, 49 USPQ2d 1451, 1454 (TTAB 1998), quoted by Applicant at p. 5 of its Brief, simply reiterates that an opposer's rights in its registered mark affords opposer a scope of protection which encompasses "all reasonable" manners in which the opposer's mark could be depicted, but it does not afford opposer rights in the mark combined with other wording or with designs.⁵¹ *In re White Rock*, 92 USPQ2d at 1284. However, the Federal Circuit subsequently noted that the "reasonable manners" in which a mark could be depicted "is ambiguous and unduly narrow" and "limits the range of marks considered in the *DuPont* analysis." *Citigroup v. Capital City Bank*, 98 USPQ2d at 1259. While rights in a term are not automatically extended to include protection for that term combined with other matter such as a design element or additional wording, *White Rock* and *Fossil* did not say that such marks could not be found similar when considered in their entirety.

In evaluating similarities of marks, if one of the marks comprises both a word portion and a design, the word portion is normally accorded greater weight in determining whether the marks are similar because it would be more likely to be impressed upon a purchaser's memory and used by purchasers to request the

⁵¹ Applicant's Appeal Brief pp. 4-5 (9 TTABVUE 9-10).

services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). Moreover, because restaurants are often recommended by word of mouth and referred to orally the word portion of a composite word and design mark is generally accorded greater weight. *See In re Dixie Rests.*, 41 USPQ2d at 1534; *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Thus, customers will likely use the wording of Applicant's GUIDO'S BURRITOS mark in describing and requesting its services. *In re Viterra*, 101 USPQ2d at 1908 ("In the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed" (internal quotation marks omitted)).

We do not agree with Applicant's contention that the Examining Attorney "considered the 'GUIDO' overlap, and disregarded all other elements of the Applicant's mark that make it dissimilar to the Cited Registration," and more importantly, we do not ignore any element of the marks in reaching our decision. Nor do we agree that the refusal is contrary to the inter partes decisions in *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KDAA v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015), and *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1978), which Applicant argues that "in [those] cases, as here, more weight may be accorded to a more distinctive element in the mark."⁵²

⁵² Applicant's Appeal Brief pp. 5-6 (9 TTABVUE 10-11).

In *Jack Wolfskin*, the Federal Circuit noted that “the Board essentially disregarded the verbal portion of [opposer’s] mark [**KELME** ] and found that the two paw print designs [in applicant’s mark  versus opposer’s **KELME** ] were substantially similar. This analysis did not consider the marks as a whole.” 116 USPQ2d at 1135. Here, we address both marks as a whole in finding them similar.

In *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, the Board found that the

applicant’s mark  , and opposer’s mark STEVE’S, when considered in their entirety, were readily distinguishable as applicant’s mark is extremely suggestive of the fact that applicant’s restaurants feature hot dogs, and opposer’s ice cream sold under its mark differed from applicant’s restaurant services rendered under its mark, such that prospective purchasers would not be confused. A significant difference in this case is that here, unlike in *Steve’s Ice Cream*, Applicant’s and Registrant’s services are identical.

Lastly, Applicant argues that its composite mark will have a greater visual impact and therefore, a greater commercial impression on consumers than Registrant’s standard character mark.⁵³ In support, Applicant cites articles from Forbes Magazine, Digital Marketing and the treatise Brain Rules, noting the migration away from text toward the use of images in electronic media, marketing and

⁵³ Applicant’s Appeal Brief pp. 8-10 (9 TTABVue 13-15).

presentations.⁵⁴ While the importance or significance of the use of images may be changing, Applicant offers no evidence or explanation of how the “greater visual impact and greater commercial impression” of images will result in avoiding a likelihood of confusion between its mark and the cited mark which include partially identical textual portions.

Thus, viewing Applicant’s and Registrant’s marks as a whole, they are similar in appearance, sound, meaning and commercial impression.

E. Strength of Cited Mark

Under the sixth *DuPont* factor, “extensive evidence of third-party use and registrations is ‘powerful on its face, even where the specific extent and impact of the usage has not been established.’” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Use evidence may reflect commercial weakness, while third-party registration evidence, which does not equate to proof of third-party use, may bear on conceptual weakness if a term is commonly registered for similar goods or services. Applicant

⁵⁴ See July 24, 2019 Request for Reconsideration, Exhibit 7, The Shift From Words To Pictures And Implications For Digital Marketers, by Apu Gupta, July 2, 2013, <https://www.forbes.com/sites/onmarketing/2013/07/02/the-shift-from-words-to-pictures-and-implications-for-digital-marketers/#76c54ac5405a>, TSDR 661-664; Exhibit 8 (Digital Marketing, Visual Marketing: A Picture’s Worth 60,000 Words, Cresset Wealth Advisors, Ritu Pant, January 16, 2015, <https://www.business2community.com/digital-marketing/visual-marketingpictures-worth-60000-words-01126256>), TSDR 665-669; Exhibit 9 (Brain Rules, 9. Vision, John Medina, Pear Press, 2014, pp. 191-197), TSDR 670-677.

argues that “GUIDO” is a weak term, noting third-party registrations as well as its evidence offered in support of third-party uses.

Three registrations for marks containing the term “GUIDO” for restaurant services and clothing items are in the record⁵⁵:

Registration No.	Mark	Goods or Services
3954823	GUIDO LOMBARDI	Belts; Coats; Dresses; Hats; Hosiery; Jackets; Lingerie; Pants; Scarves; Socks; Ties; Tops; Wearable garments and clothing, namely, shirts; Wraps in Int'l Class 25
4762316		Bandanas; berets; short-sleeve shirts; hats; knitted caps; pullovers; etc. (and other goods in Int'l Class 25, and in Classes 9 and 16)
5075721		Cafes; restaurants; fast-food restaurants and snackbars; self-service restaurants; food

⁵⁵ Applicant’s Appeal Brief p. 8 (9 TTABVUE 13) and July 24, 2019 Request for Reconsideration, TSDR 326-27, reciting Registrations cited by the Examining Attorney including Registration Nos. 3954823 and 4762316 both registered for clothing items. *See* January 30, 2019 Final Office Action at TSDR 2, 12-16, 20-22; *see also* Exhibit 1 to July 24, 2019 Request for Reconsideration at TSDR 344, 354-358, 362-364. Registration No. 5075721 was also cited in the January 30, 2019 Final Office Action at TSDR 2, 17-19; *see also* Exhibit 1 to Applicant’s Request for Reconsideration at TSDR 344, 359-361.

Also cited were Registration Nos. 2262534 for the mark GA GUIDO ANGELONI & Design, and 4200550 for the mark SG GUIDO SGARIGLIA & Design (cited by the Examining Attorney in the January 30, 2019 Final Office Action at TSDR 2, 5-7, 9-11; *see also* Exhibit 1 to Request for Reconsideration 347-349, 351-353) which have been cancelled. It is well-established that an expired or cancelled registration is evidence of nothing but the fact that it once issued. *Action Temp. Servs. v. Labor Force*, 10 USPQ2d at 1309 (“[A] cancelled registration does not provide constructive notice of anything”); *Sunnen Prods. v. Sunex Int’l*, 1 USPQ2d at 1747 (expired registration has no probative value other than for what it shows on its face, i.e., that the registration issued). Accordingly, we give those registrations no consideration.

		preparation services; providing temporary accommodation in Int'l Class 43 (and other food and beverage items in Classes 29, 30 and 33)
--	--	---

All that these third-party registrations demonstrate is that their owners believe the marks including the terms “Guido” or “Guido-” are appropriate for a trademark for restaurant services, food items and clothing. “The question still remains whether [Applicant’s and Registrant’s] marks viewed as a whole are confusingly similar. The existence of third-party registrations of similar marks has very little weight on this question.” *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967). These Registrations are entitled to little, if any, weight given the differences in the manner of use of “GUIDO” in the marks which contain additional, non-descriptive surnames rendering a different commercial impression from Registrant’s mark that does not support the weakness of Registrant’s mark “GUIDO’S.” More importantly, the existence of these Registrations is not evidence of what happens in the marketplace or that customers are familiar with the use of those marks. 153 USPQ 407.

Applicant submits evidence of third-party uses consisting of internet search results conducted on the Bing and Google search engines for “guido restaurant,” and a Dun & Bradstreet search of business names that contain the term “Guido” in the restaurant services industry. Applicant contends this evidence shows the extensive

use of the term “Guido” in the restaurant services industry, frequently associated with Italian foods, i.e., pizza, pasta, etc.⁵⁶

Looking more closely at the listings, some of them identify restaurants located outside of the United States which are not relevant. Other listings do not appear to be for restaurants, for example, Guidos Italian Deli, Guido’s Fresh Marketplace selling organic fresh food, Guido’s Chicago Meat & Deli, Guido Fenu obituary, and are also not relevant.⁵⁷ Although some of the listings do not identify relevant “Guido” restaurants, and some of the listings are duplicate listings for the same restaurants, the search results identify at least a few dozen restaurants featuring Italian food with GUIDO in the name, a sufficient number to warrant consideration.⁵⁸

⁵⁶ See Applicant’s Appeal Brief p. 6, 19-20 (9 TTABVUE 11, 24-25) regarding the Bing, Google and Dun & Bradstreet internet searches, citing to Affidavit of Edmundo Bulacio, an “Administrative Assistant at The Business Law Center of the Palm Beaches, for Attorney Jay Eckhaus, Applicant’s attorney of record,” with supporting Exhibits A-D (TSDR 719-828) submitted with the July 24, 2019 Request for Reconsideration (see TSDR 325-326).

Applicant contends that its Bing search for “Guido Restaurant” (Exhibit A, TSDR 726-745) listed more than 140 search results related to restaurant businesses that use the term “Guido” on the first 10 pages of search results including Registrant’s GUIDO’S restaurant; the Google search results for “Guido Restaurant” (Exhibit B, TSDR 746-765) resulted in more than 100 listings for restaurant related businesses using “Guido” on the first 10 pages of search results including Registrant’s GUIDO’S restaurant; the Dun & Bradstreet search results (Exhibits C-D, TSDR 766-828) identified 85 companies using “Guido” in the restaurant services industry in the United States, with “13 restaurants are related to the Registrant and of these 13, 2 are closed and 5 are listed more than once as having common addresses.” See Request for Reconsideration at fn.2 (at TSDR 325) and Affidavit of Edmundo Bulacio ¶¶ 4-6, TSDR 719-720.

⁵⁷ *Id.* TSDR at 469, 470, 482, 484, 485.

⁵⁸ For example, the first page of the Bing search results contains two listings for restaurants located outside of the U.S.; another listing for Gaido’s Seafood Restaurant; three listings that do not identify the city where the Guido’s restaurant is located; and two others that do not identify any restaurants. Request for Reconsideration, TSDR 726. However, the Bing and Google search results identified “Guido’s” restaurants located in: Anchorage, AK; Daphne and Mobile, AL; Prescott and Scottsdale, AZ; Boise, ID; Middlefield, CT; Champaign, IL; Annapolis and Ocean City, MD; Norfolk and Walpole, MA; St. Louis, MO; Camden, NJ;

Evidence in the form of listings and advertisements, such as in yellow and white page phone book listings, triggers a presumption that a third-party service mark is in fact in use by third-parties, possibly making a registrant's mark weak. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993) (showing that the mark appears in advertising, in the form of current listings in the yellow and white pages, carries the presumption that the service mark is being used by third-parties in connection with the offering of the advertised services). *See also In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996) (Under the *Lloyd's* rule, evidence of hundreds of yellow and white pages listings of a restaurant name containing the word BROADWAY, almost 600 similar entries from the American Business Directory, and more than 500 similar entries from the Dun & Bradstreet database are together sufficient to establish that a significant number of persons are using names and marks containing the word "Broadway" for restaurant services and related goods. This makes the cited registration of BROADWAY PIZZA weak and no obstacle to the registration of BROADWAY CHICKEN for restaurant services.); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d at 1479 (numerous third-party uses [of STEVE'S] demonstrate that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store fields use the term ... and that this purchasing public is able to distinguish between these businesses based on small distinctions among the marks). While the evidence

Houston, TX; Byron, WI; as well as several locations in California, Florida, Michigan and Ohio; some of which identify Applicant's and Registrant's restaurants.

Applicant submits is not the same as telephone phone book listings, it is somewhat similar in nature.

Citing to *Anthony's Pizza & Pasta Int'l, Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271 (TTAB 2009) (testimony, third-party registrations, and telephone listings are sufficient to show “Anthony’s” has been extensively adopted, registered and used as a trademark for restaurant services; thus, mark comprising, in whole or in part, the name ‘Anthony’s’ for restaurant services given a restricted scope of protection), *aff'd*, 415 F. App’x 222 (Fed. Cir. 2010), Applicant argues that the evidence submitted calls for the cited Registration to be given a restricted scope of protection.⁵⁹ As Applicant explains in its Brief:

The purpose of introducing evidence of third-party use is “to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374 (Fed. Cir. 2005) (cite omitted). Third-party use is “relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Id.* at 1373. *Omaha Steaks Int'l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018).⁶⁰

“The weaker [Registrant’s] mark, the closer [Applicant’s] mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674. Evidence of third-party use of similar marks on similar goods “can

⁵⁹ Applicant’s Appeal Brief p. 8 (9 TTABVUE 13).

⁶⁰ Applicant’s Appeal Brief p. 19 (9 TTABVUE 24) (citation revised).

show that customers have been educated to distinguish between different marks on the basis of minute distinctions.” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (citing *Palm Bay Imps. v. Veuve Clicquot*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”)).

Although Applicant’s evidence does not show the actual use of “GUIDO” by the restaurants, it reveals numerous listings for restaurants containing the name “Guido” as the first word in the restaurant name without any other distinctive wording.⁶¹ Overall, the evidence submitted supports that a mark comprising, in whole or in part, the word “GUIDO” in connection with Italian restaurant services should be given a limited scope of protection. Registrant’s mark GUIDO is not entitled a broad scope of protection that would bar the registration of every mark comprising, in whole or in part, the word “Guido;” it will only bar the registration of marks “as to which the resemblance to [Registrant’s mark] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.” *Anthony’s Pizza & Pasta v. Anthony’s Pizza*, 95 USPQ2d at 1278 (quoting *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB1983)); *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036-37 (TTAB 2016).

⁶¹ Some of the listings show names that include “Guido” but are easily distinguished, including for example, Frank Guido’s Little Italy, Café Guido & The Book Nook coffee house, Charcoal Guido’s, Little Guido’s Pizza, and Guido and Vito’s Italian restaurant, and thus are not relevant. See Request for Reconsideration, Exhibit 7 from Bing (TSDR 467-476) and Exhibit 8 from Google (TSDR 477-486).

While Registrant's mark is weak, it is well recognized that marks deemed "weak" are still entitled to protection under § 2(d) against the registration by a subsequent user of a similar mark for closely related goods or services. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *Anthony's Pizza & Pasta v. Anthony's Pizza*, 95 USPQ2d at 1283; *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1676 (TTAB 2018) (citing *China Healthways v. Wang*, 83 USPQ2d at 1125); *In re Max Capital*, 93 USPQ2d at 1246.

On this record, Registrant's mark GUIDO'S is not so weak as to permit the registration of a very similar mark, GUIDO'S BURRITOS, that shares the identical first word "GUIDO'S" for use on legally identical services and related goods that travel in the same trade channels to the same customers. Thus, the evidence of third-party use under the sixth *DuPont* factor is neutral.

F. Conclusion

Based on the record, we find the marks, which begin with the same key first word, are similar in sound, appearance, connotation and commercial impression and inasmuch as the services are legally identical and the goods set forth in Applicant's application are related, they travel through the same trade channels and are purchased by the same classes of customers. Further, although the cited registered mark is weak, such weakness does not render confusion unlikely because even weak marks are entitled to protection against registration of similar marks for identical services and related goods if confusion is likely.

Serial No. 87931059

Decision: The refusal to register Applicant's mark GUIDO'S BURRITOS under § 2(d) of the Trademark Act is affirmed.