

This Opinion is Not a  
Precedent of the TTAB

Mailed: November 1, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

*In re YASA Marketing, Inc.*

Serial No. 88751408

John S. Egbert, Michael F. Swartz and Kevin S. Wilson of  
Egbert, McDaniel & Swartz, PLLC for YASA Marketing, Inc.

Komal M. Vo, Trademark Examining Attorney, Law Office 128,  
Travis Wheatley, Managing Attorney.

Before Cataldo, Adlin and Lynch, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant YASA Marketing, Inc. seeks registration of the mark DEL MOLCAJETE, in standard characters, for “salsa, hot sauce,” in International Class 30.<sup>1</sup> The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark shown below

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<sup>1</sup> Application Serial No. 88751408, filed January 8, 2020 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce. The application includes this translation statement: “The English translation of ‘DEL MOLCAJETE’ in the mark is ‘of the mortar.’”



for “dried chilies for food consumption, and dried [sic]” in International Class 30,<sup>2</sup> that it is likely to cause confusion. After the refusal became final, Applicant appealed and filed a request for reconsideration that was denied. The appeal is fully briefed.

### **I. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated

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<sup>2</sup> Registration No. 5460735, issued May 1, 2018. The registration also includes goods in International Class 24 that are not a basis for the refusal. The registration includes this description of the mark: “The mark consists of the red wording ‘EL MOLCAJETE’ above the design of a mortar and pestle that is black and gray in color. On each side of the mortar and pestle is a mirrored design of two red chilies above green leaves, all outlined and highlighted in black.” It also includes this translation statement: “The English translation of the word ‘EL MOLCAJETE’ in the mark is ‘THE MORTAR.’”

by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

### **A. The Marks**

The marks are quite similar “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). In fact, the shared term MOLCAJETE, which Applicant and Registrant both translate as “mortar,” is the dominant component of both marks, with the design element of Registrant’s mark merely emphasizing this term with a picture of a mortar and pestle, and also pictorially depicting Registrant’s dried chilies.

The Examining Attorney introduced a Spanish-English dictionary’s translation of Applicant’s mark DEL MOLCAJETE that is consistent with Applicant’s translation of its mark to “of the mortar.” April 6, 2020 Office Action TSDR 20;<sup>3</sup> *see also* November 10, 2020 Office Action TSDR 49 (Wikipedia entry). The literal element of Registrant’s mark, EL MOLCAJETE, is essentially similar, translating to “the mortar.”

Because the only literal element of Registrant’s mark is almost identical to Applicant’s mark, the marks sound almost identical (and rhyme). Indeed, the only difference between them is that Applicant’s mark adds a “d” to the beginning of

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<sup>3</sup> Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, by page number, in the downloadable .pdf format.

Registrant's mark. For the same reason, the literal element of Registrant's mark and Applicant's mark appear almost identical. The exceedingly minor difference between DEL MOLCAJETE and EL MOLCAJETE in appearance and sound may not be noticed by ordinary consumers of chilies and salsa. And, even if the minor difference is noticed, we must consider whether it is "likely to be recalled by purchasers seeing the marks at spaced intervals," i.e. consumers who encounter Registrant's mark first, but do not encounter Applicant's until later, or vice versa. *Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). Here, the difference between the marks' literal elements is so minor that we find consumers would likely forget it, especially when we keep in mind: (1) "the fallibility of memory over a period of time;" and (2) that the "average" consumer "normally retains a general rather than a specific impression of trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). *See also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) ("marks must be considered in light of the fallibility of memory") (citation, internal quotation marks, and ellipsis omitted).

We have not ignored the design element of Registrant's mark, but here, as is typical, it is not as significant as the mark's literal element, because consumers are likely to call for the goods by the term EL MOLCAJETE. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) ("the verbal portion of a word and design mark likely will be the dominant portion"); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that "if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it

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would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”). This is especially true in this case, where, as explained in more detail below, the design element of Registrant’s mark merely depicts, and thus emphasizes, the term MOLCAJETE (“mortar”) that both marks share (as well as the dried chilies that Registrant offers under the mark and identifies in the cited registration).

The marks also convey essentially identical meanings and create highly similar commercial impressions. There is a negligible difference between DEL MOLCAJETE, which means “of the mortar” and EL MOLCAJETE, which means “the mortar.” In the context of the goods, both marks convey food products made in a mortar. Furthermore, the design element of Registrant’s mark depicts “a mortar and pestle” as well as “two red chilies above green leaves,” highlighting both the marks’ shared term MOLCAJETE (mortar), and Registrant’s identified goods. *See In re Rolf Nilsson AB*, 230 USPQ 141, 142 (TTAB 1986) (“it is well settled that a picture and the word that describes that picture are given the same significance in determining likelihood of confusion”). *See also In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018) (“in this case, the house design in Applicant’s mark may be interpreted as a large estate home or ‘chateau’ that would correspond to, or at least call to mind, the word CHATEAU in Registrant’s mark”). Thus, the design does not distinguish Registrant’s mark from Applicant’s.

Considered in their entirety, the marks are much more similar than dissimilar. This factor weighs in favor of finding a likelihood of confusion.

**B. Strength of the Cited Mark**

There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength ....”). Without specifying the type of strength to which it refers, Applicant argues that Registrant’s mark is entitled to “an extremely narrow scope of protection.” 6 TTABVUE 13-14.<sup>4</sup> The evidence Applicant relies upon does not support the argument, however, with respect to either type of strength.

Applicant’s argument that MOLCAJETE is “weak” is based entirely on third-party applications and registrations containing the term. July 8, 2021 Office Action response TSDR 18-49. But generally, “third-party registrations, with no evidence of the extent of the use of the marks in commerce, do not diminish the commercial strength of” a cited mark. This is because “third-party registrations are not evidence of third-party use of the registered marks in the marketplace, for purposes of the sixth *du Pont* factor.” *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542,

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<sup>4</sup> Citations to the appeal record are to TTABVUE, the Board’s online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

1545 (Fed. Cir. 1992)). Here, Applicant has not introduced evidence that any of the third-party marks on which it relies are in use.

Third-party registrations may “bear on conceptual weakness if a term is commonly registered **for similar goods or services.**” *In re Embiid*, 2021 USPQ2d 577, at \*34 (TTAB 2021) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)) (emphasis added). *See also Juice Generation, Inc. v. GS Enter., LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015). But here, most of the third-party registrations upon which Applicant relies are for unrelated goods and services, July 8, 2021 Office Action response TSDR 25-27 and 40-48, and thus do not establish that MOLCAJETE is conceptually weak for dried peppers. *Tao Licensing*, 125 USPQ2d at 1057. In fact, the only third-party registration Applicant



relies upon that is for related goods is Registration No. 5098764 (  for “preserved hot peppers”). A single third-party registration for a mark less similar to the cited mark than Applicant’s mark is simply not enough to establish that the term MOLCAJETE is conceptually weak.<sup>5</sup>

Nonetheless, we recognize that the term MOLCAJETE is suggestive and thus conceptually somewhat weak because the record reveals that mortars are used “for

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<sup>5</sup> Applicant’s reliance on pending third-party applications, as opposed to registrations, July 8, 2021 Office Action response TSDR 18-24 and 28-31, is misplaced. Pending applications have “no probative value other than as evidence that the application was filed.” *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

grinding various food products,” and “to prepare salsas.” March 4, 2022 Denial of Request for Reconsideration TSDR 4-5. We therefore assume that mortars may be used to grind dried chilies. Nonetheless, we must keep in mind that “likelihood of confusion, mistake or deception is to be avoided as much between weak marks as between strong marks.” *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (citing *King Candy*, 182 USPQ at 109). Here, we find that the inherently distinctive cited mark is not so weak that Applicant should be entitled to register its highly similar mark for related goods. We thus turn to the relationship, if any, between Applicant’s and Registrant’s goods.

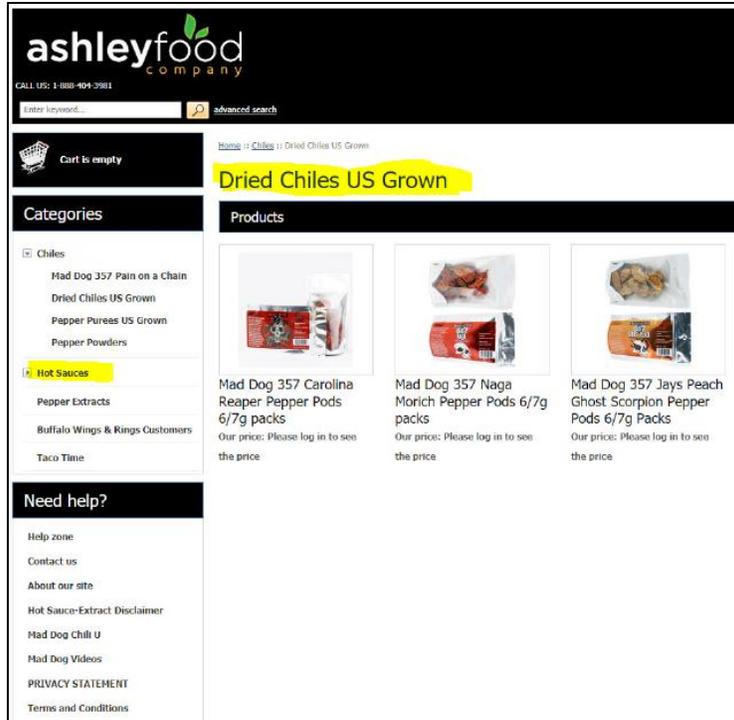
### **C. The Goods, Their Channels of Trade and Classes of Consumers**

The goods need not be identical or even competitive in order to find a likelihood of confusion. Rather, the question is whether the goods are marketed in a manner that “could give rise to the mistaken belief that they 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)). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.”); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods”); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1109 (2007).

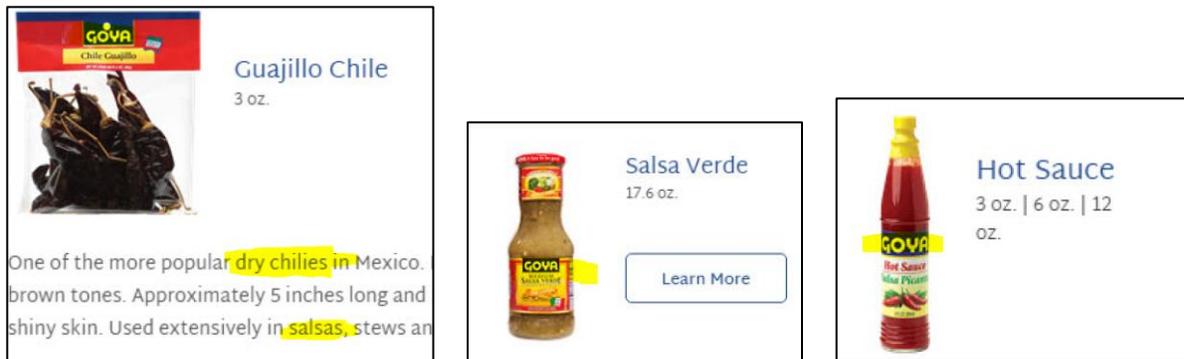
Here, the Examining Attorney has introduced evidence showing that third parties offer both dried chilies and salsa or hot sauce under the same mark or trade name. For example, TIERRA VEGETABLES offers “dried chiles” as well as “chile products,” including salsa and hot sauce, as shown below:



April 6, 2020 Office Action TSDR 12-13 (highlighting added). Similarly, Ashley Food Company offers dried chilies and hot sauces under the mark/trade name ASHLEY FOOD, as shown below:



*Id.* at 15 (highlighting added). Goya offers dried chilies, hot sauces and salsas under its GOYA mark:



*Id.* at 17-19 (highlighting added). Uncle Steve's Hot Stuff offers dried chilies and hot sauce under its UNCLE STEVE'S mark:



November 10, 2020 Office Action TSDR 8 (highlighting added).

In addition: Electric Pepper Co. offers hot sauces and dried chilies under its WICKED TICKLE mark; Rancho Gordo offers dried chilies and hot sauce under its RANCHO GORDO mark; PuckerButt Pepper Company offers dried chilies, hot sauces and salsa under its PUCKERBUTT mark; Possum Sauce uses its POSSUM SAUCE mark for dried poblano peppers and hot sauce; and Pepper Joe's uses its PEPPER JOE'S mark for dried chili peppers, salsa and hot sauce. *Id.* at 9-19; March 4, 2022 Denial of Request for Reconsideration TSDR 6-10.

This is exactly the type of evidence that has been found to establish that goods are related. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (crediting relatedness evidence showing that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co.*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness

analysis”). Here, there is more than enough evidence that third-parties use the same marks and trade names for dried chilies on the one hand and salsa or hot sauce on the other to establish a relationship between these goods.

Furthermore, the Examining Attorney introduced the following use-based third-party registrations showing that the same marks are registered for dried chilies, as well as salsa or hot sauce, including:

**CAJUN POWER** (Reg. No. 3605386) is registered for “dried chili peppers” and “hot sauce.”

BENITO’S (Reg. No. 4138731) is registered for “dried chili peppers,” “hot chili pepper sauce” and “hot sauce.”



(Reg. No. 4237535) is registered for “dried chili peppers” and “salsa.”



BURNING BUSH (Reg. No. 4609670) is registered for “dried chili peppers,” “chili sauce” and “hot sauce.”

UNIQUE HEAT (Reg. No. 4979507) is registered for “dried chili peppers,” “chili sauce,” “hot sauce” and “salsa.”

PEPPERHEAD (Reg. No. 4870667) is registered for “dried chili peppers,” “condiment, namely, pepper sauce” and “hot sauce.”



(Reg. No. 4963298) is registered for “dried chili peppers,” “hot sauce” and “salsa.”

CONTIGO (Reg. No. 5125487) is registered for “dried chili peppers,” “hot sauce” and “salsa.”



HABANERITA (Reg. No. 5233392) is registered for “dried chili peppers,” “salsa” and “hot chili pepper sauce.”



(Reg. No. 5974926) is registered for “dried chili peppers,” “chili sauce,” “hot sauce” and “salsa sauces.”

WICKED REAPER (Reg. No. 6068764) is registered for “dried chili peppers” and “hot sauce.”

November 10, 2020 Office Action TSDR 20-48. “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998). Thus, this evidence corroborates the third-party use evidence, and the record as a whole demonstrates that Applicant’s and Registrant’s goods are related.

The third-party use evidence also establishes that the channels of trade and classes of consumers for dried chilies and salsa/hot sauce overlap. In fact, the screenshots in the record show that these products are often sold right next to each

other on the same third-party food seller webpages. Thus, these factors also weigh in favor of finding a likelihood of confusion.<sup>6</sup>

#### **D. Consumer Sophistication and Care**

Finally, Applicant's unsupported argument that "the purchase of Applicant's goods and the cited registrant's goods are made by sophisticated purchasers who exercise extra care when deciding whether to purchase such goods," 6 TTABVUE 19, is not persuasive. Attorney argument is no substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *see also In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (finding that there was no proof to support the statements in the record by counsel). Moreover, the record reveals that dried peppers and hot sauces may cost less than \$10. March 4, 2022 Denial of Request for Reconsideration TSDR 6-7; November 10, 2020 Office Action TSDR 9-14, 18-19. This factor is neutral.

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<sup>6</sup> To the extent Applicant argues that confusion is unlikely because it is based in Chicago and Registrant is based in California, 6 TTABVUE 14, this is irrelevant because Applicant seeks a geographically unrestricted registration (and the cited registration is also geographically unrestricted). *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 n.4 (TTAB 1987) (territorial separation of the use of the cited registered mark from the applicant is irrelevant to determining likelihood of confusion in a geographically unrestricted application); *Peopleware Sys., Inc. v. Peopleware, Inc.*, 226 USPQ 320, 321 (TTAB 1985) (while opposer and applicant may currently be geographically separated in their uses, this is irrelevant where applicant seeks a nationwide unrestricted registration).

## **II. Conclusion**

Even considering that the cited mark is conceptually somewhat weak, because the marks are quite similar, the goods are related and the channels of trade and classes of consumers overlap, confusion is likely.

**Decision:** The refusal to register Applicant's mark for the identified goods under Section 2(d) of the Trademark Act is affirmed.