

This Opinion is not a
Precedent of the TTAB

Mailed: April 30, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pueblos, Inc.

Serial No. 90469285

S. Bradley Shipe of Shipe Dosik Law LLC
for Pueblos, Inc.

Andrew Janson, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

Before Greenbaum, Heasley, and Cohen,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:¹

Applicant, Pueblos, Inc., seeks registration on the Principal Register of the mark

PUEBLOS MEXICAN CUISINE (in standard characters, with “MEXICAN

¹ As part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases, this decision varies from the citation form recommended in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2023). This decision cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board and the Director, this decision may cite to the WESTLAW (WL) or LEXIS legal database. As of the date of this decision, the pilot is ongoing, using various citation forms. Until further notice, practitioners should continue to adhere to the citation form recommended in TBMP § 101.03.

CUISINE” disclaimed) for “restaurant services; restaurant and bar services, including restaurant carryout services” in International Class 43.² According to the Application’s translation statement, the English translation of “PUEBLOS” in the mark is “VILLAGES.”

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as used in connection with these services, so resembles the following registered marks, all owned by the same Registrant, all for “restaurant services” in International Class 43, as to be likely to cause confusion, to cause mistake, or to deceive:

MI PUEBLO (in standard characters);³

MI PUEBLO MEXICAN GRILL (stylized, with “MEXICAN GRILL” disclaimed);⁴ and



(composite mark, with “MEXICAN GRILL” disclaimed).⁵

² Application Serial No. 90469285 was filed on January 15, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere as of March 14, 2001, and use in commerce since at least as early as April 22, 2001.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system and identify the documents by title, date, and page in the downloadable .pdf version. Citations to the briefs and other materials in the appeal record refer to the Board’s TTABVue online docket system.

³ Registration No. 3241055, issued on May 15, 2007; renewed.

⁴ Registration No. 4384104, issued on the Principal Register on August 13, 2013; renewed.

⁵ Registration No. 4384103, issued on the Principal Register on August 13, 2013; renewed. The description of the mark reads: “[t]he mark consists of the wording ‘MI PUEBLO’

The three Registrations' translation statements state that the English translation of "MI PUEBLO" is "MY VILLAGE."

When the refusal was made final, Applicant appealed. We affirm the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a mark may be refused registration if it:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive....

15 U.S.C. §§ 1052(d), 1053.

The fundamental purposes underlying Section 2(d) are to prevent consumer confusion as to source and to protect trademark owners from damage caused by registration of confusingly similar marks. *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 146 (2023); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995).

To determine whether there is a likelihood of confusion between marks under Section 2(d), we analyze the evidence and arguments under the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (the "*DuPont*

underlined and under the wording 'MEXICAN GRILL' overlaying a design of a façade of a building."

factors”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 144 (2015). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1319 (Fed. Cir. 2018). “Not all of the *DuPont* factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case.’ *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022) (internal quotation marks omitted). ‘Only the *DuPont* factors of significance to the particular mark need be considered in the likelihood of confusion analysis.’ *Id.* (internal quotation marks omitted).” *Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 1116-17 (Fed. Cir. 2024). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976).

A. Similarity of the Services, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 476 F.2d at 1361.

The subject services' similarities can be determined from their descriptions in the Application and Registrations. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307 (Fed. Cir. 2018) Here, as the Examining Attorney correctly observes, Registrant's "restaurant services" and Applicant's "restaurant services; restaurant and bar services, including restaurant carryout services" are identical in part and otherwise highly related.⁶ Both recite "restaurant services," which often entail bar and carryout services, as the evidence shows.⁷ Where the identification of services is broad, the Board "presume[s] that the services encompass all services of the type identified." *In re Country Oven, Inc.*, 2019 WL 6170483, *2 (TTAB 2019) (internal punctuation omitted).

Because the respective services are identical in part and otherwise highly related, we may presume that they flow through the same channels of trade to the same classes of customers: members of the general consuming public. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012)); *Genesco Inc. v. Martz*, 2003 WL 1154482, *10 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods,

⁶ Examining Attorney's brief, 6 TTABVUE 7-8.

⁷ See evidence of eight third-party websites offering restaurant and bar services, some with carryout service: ETA Restaurant + Bar ("We will continue to offer take-out on our full menu, dessert & beverages of your choice...."), Good News Restaurant & Bar, The Porch Restaurant and Bar, O'Connell's restaurant and bar ("Click here to order online or call...."), Grange restaurant and bar, Saint Ann restaurant and bar, Trummer's restaurant and bar ("Join us for dinner or brunch in the restaurant or order online to enjoy your food at home"), and Zero restaurant and bar. July 29, 2021 Office Action at TSDR 3, 22-25; Feb. 21, 2023 Office Action at TSDR 11-36, 39-43. See *In re Charger Ventures LLC*, 64 F.4th 1375, 1382 (Fed. Cir. 2023) (evidence showing that companies offer the respective services under the same mark on the same website supports a finding of similarity of services and channels of trade).

and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these ... items could be offered and sold to the same classes of purchasers through the same channels of trade”), *quoted in In re FabFitFun, Inc.*, 2018 WL 4043156, *2 (TTAB 2018).

The second and third *DuPont* factors thus weigh heavily in favor of finding a likelihood of confusion. Applicant does not contest these factors in its brief. *See In re Morinaga Nyugyo K.K.*, 2016 WL 5219811, *2 (TTAB 2016) (applicant’s failure to address second and third *DuPont* factors in its brief deemed an apparent concession on those factors).

B. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 476 F.2d at 1361; *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1319 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005).

“In comparing the marks, we are mindful that where, as here, the services are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, [1368] (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, [877] (Fed. Cir. 1992).” *In*

re Inn at St. John's, LLC, 2018 WL 2734893, *5 (TTAB 2018), *aff'd*, 777 F. App'x 516 (Fed. Cir. 2019).

Applicant's mark, once again, is **PUEBLOS MEXICAN CUISINE**. We compare it with the mark **MI PUEBLO MEXICAN GRILL** in Registration No. 4384104 because of the three cited marks, it has the most points in common with Applicant's mark. *See Sock It To Me, Inc. v. Aiping Fan*, 2020 WL 3027605, *9 (TTAB 2020).

Applicant agrees that this cited mark is closest to Applicant's mark, as the two marks share the words "PUEBLO(S) MEXICAN."⁸ Applicant maintains, however, that "there is no rule that confusion is likely to occur simply because marks share common elements," and that "the marks must be considered in their entirety because the commercial impression of the marks on the consumer is created by the marks as a whole, not by their respective component parts."⁹

As with all of the cited registered marks, **MI PUEBLO MEXICAN GRILL** begins with "MI." Applicant maintains that "MI" is the dominant part of the mark, as it is the initial word, on which consumers are more inclined to focus.¹⁰ Applicant continues:

the word MI in the Cited Marks, meaning "my", in the Cited Marks, ... is an important distinction. The USPTO has frequently recognized this distinction approving similar marks for similar goods and services, sometimes distinguished solely by the inclusion or exclusion of the word "my", including:

⁸ Applicant's brief, 4 TTABVUE 7.

⁹ 4 TTABVUE 6.

¹⁰ 4 TTABVUE 8 (*citing Palm Bay Imps. v. Veuve Clicquot*, 396 F.3d at 1372).

<p>MYFOOTSIE (U.S. Reg. 5422941) for insulated blanket for warming feet</p>	<p>FOOTSIE (U.S. Reg. 5125501) for blankets and throws</p>
<p>MY ONECARE (U.S. Reg. 4859946) for computer software platforms related to medical records</p>	<p>ONECARE (U.S. Reg. 4048265) for computer software applications, namely software for tracking and managing health conditions and health data</p>
<p>MY NATURAL K9 (U.S. Reg. 3976470) For food and dietary supplements for dogs</p>	<p>K9 NATURAL (U.S. Reg. 6444154) For vitamins and dietary supplements for animals and pets</p>
<p>MY TERRA (U.S. Reg. 5546232) for chemical cleaners directed to commercial kitchens, among others</p>	<p>TERRA (U.S. Reg. 1055842) for chemical fertilizers</p>
<p>MY STRANDZ (U.S. Reg. 6369312) For hair condition, hair creams, hair gels, and shampoo, among others</p>	<p>STRANDZ UNLIMITED (U.S. Reg. 6238679) for hair care creams, hair gels and mousse, hair oils, shampoos and conditioners, among others</p>

11

In addition to “MI,” Applicant contends, the marks also differ in other ways, such as Applicant’s inclusion of CUISINE and Registrant’s inclusion of GRILL.¹²

We agree with the Examining Attorney, however, that the marks **PUEBLOS MEXICAN CUISINE** and **MI PUEBLO MEXICAN GRILL** are more similar than dissimilar. As the first *DuPont* factor requires, we compare the marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 476 F.2d at 1361. “Similarity in any one of these elements may

¹¹ 4 TTABVUE 8-9; Registration certificates in Jan. 18, 2022 Response to Office Action at TSDR 9-19.

¹² 4 TTABVUE 9.

be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 2018 WL 2734893, at *5 (TTAB 2018) (citing *In re Davia*, 2014 WL 2531200, *2 (TTAB 2014)).

In appearance, Applicant’s **PUEBLOS MEXICAN CUISINE** word mark is in standard characters, which could be displayed in the same typeface as Registrant’s minimally-stylized **MI PUEBLO MEXICAN GRILL** mark. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party.”), *quoted in i.am.symbolic*, 866 F.3d at 1324.

In sound, the marks share the core terms “PUEBLO(S) MEXICAN,” with peripheral wording that creates a similar structure and cadence. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985) (finding similarity between CASH MANAGEMENT ACCOUNT and THE CASH MANAGEMENT EXCHANGE because they “are, in large part, identical in sound and appearance and have a general similarity in cadence”), *cited in Detroit Athl. Co.*, 903 F.3d at 1303. “[A]ny minor differences in the sound of these marks may go undetected by consumers and, therefore, would not be sufficient to distinguish the marks.” *Viterra*, 671 F.3d at 1367. This consideration “is especially important in the restaurant industry because restaurants are often recommended by word of mouth and referred to orally....” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (internal punctuation omitted). *See also In re Appetito Provisions Co.*, 1987 WL 124293, *1 (TTAB 1987) (same).

We disagree with Applicant's argument that "MI" is the dominant part of Registrant's **MI PUEBLO MEXICAN GRILL** mark by virtue of its placement at the front of the mark. Although the first word in a mark is often its dominant feature, that is not always the case. *See, e.g., Sabhnani v. Mirage Brands, LLC*, 2021 WL 6072822, *19 (TTAB 2021) ("The structure of the verbal portion of Petitioner's mark ('ROYAL MIRAGE') counsels against a reflexive application of the principle cited by Respondent that consumers are generally more inclined to focus on the first word, prefix o[r] syllable in any trademark or service mark.") (internal punctuation omitted). In *Stone Lion*, for example, the Court of Appeals for the Federal Circuit affirmed the Board decision finding that LION was dominant in applicant's STONE LION CAPITAL mark, and "accord[ing] little weight to the adjective 'STONE,' on the ground that it did not 'distinguish the marks in the context of the parties' services.'" 746 F.3d at 1322.

Here, as in *Stone Lion*, we accord little weight to "MI" in Registrant's mark, **MI PUEBLO MEXICAN GRILL**. The possessive pronoun "MI" (Spanish for "my") carries a sense of familiarity, referring to PUEBLO as "my village," but that merely draws consumers' attention to and reinforces PUEBLO, a core term in the mark. In that sense, "MI" serves the same function as the apostrophe "'S": it indicates possession, but it does not distinguish Registrant's mark from Applicant's, both of which contain the core term PUEBLO(S). *Cf. In re Binion*, 2009 WL 5194992, *3 (TTAB 2009) ("The absence of the possessive form in applicant's mark BINION has little, if any, significance for consumers in distinguishing it from the cited mark

[BINION'S ROADHOUSE].”). “MI” is thus subordinate to “PUEBLO,” the most distinctive part of Registrant’s mark, and does not significantly affect the overall similarity of the marks.

Applicant’s table depicting five pairs of similar third-party registered marks—half with “MY” and half without—does not persuade us that “MI” distinguishes the marks in this case. The fact that some of these registrations (several of which are cancelled) once coexisted on the Register does not prove that the marks coexisted in the marketplace without confusion.¹³ *In re Thomas*, 2006 WL 1258862, *8 (TTAB 2006). None of the pairs were compared in Board proceedings; they were issued as the result of separate decisions by examining attorneys. But the Board is not bound by those decisions; it must make its own findings of fact in each case, and that duty may not be delegated by adopting conclusions reached by examining attorneys based on other marks on different records. *In re Sunmarks, Inc.*, 1994 WL 598858, *3 (TTAB 1994). “In the final analysis, when determining whether a mark is eligible for registration, each application must be considered on its own record. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, ... (Fed. Cir. 2016).” *In re Sibony*, 2021 WL 4812119, *4 (TTAB 2021). “We do not believe that our decision here is inconsistent with the registration of the third-party marks cited by Applicant, but to the extent that it is, it is the decision

¹³ Registration Nos. 5125501, 4859946, and 4048265 were cancelled for failure to file maintenance documents. A cancelled registration is only evidence that the registration issued, and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). See *In re Kysela Pere et Fils Ltd.*, 2011 WL 1399224, *2 (TTAB 2011) (“‘dead’ or cancelled registrations have no probative value at all.”), quoted in *In re Embiid*, 2021 WL 2285576, *17 n. 48 (TTAB 2021).

required under the statute on the record before us.” *In re Ala. Tourism Dept.*, 2020 WL 2301221, *14 (TTAB 2020).

The heart of both marks, **PUEBLOS MEXICAN CUISINE** and **MI PUEBLO MEXICAN GRILL**, is “PUEBLO(S) MEXICAN.” “It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word [PUEBLO] and they will therefore be regarded here as the same....” *Wilson v. Delaunay*, 245 F.2d 877, 878 (CCPA 1957), cited in *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 WL 16646840, *20 (TTAB 2022). “While each trademark must always be evaluated individually, pluralization commonly does not alter the meaning of a mark.” *Cordua Rests.*, 823 F.3d at 603 (citing *In re Belgrade Shoe, Co.*, 411 F.2d 1352, 1353 (CCPA 1969)).

As the Examining Attorney correctly notes, both “the commercial impression conveyed by each is of a Mexican restaurant invoking, for example, the feeling or characteristic of an authentic Mexican village or town.”¹⁴ See, e.g., *In re Aquitaine Wine USA*, 2018 WL 1620989, *2 (TTAB 2018) (“To the extent [the term] has a meaning in connection with [the goods or services], it would have the same connotation in Applicant’s mark as in Registrant’s mark.”).

Although “MEXICAN CUISINE” and “MEXICAN GRILL” are disclaimed in both marks as highly descriptive, if not generic, for their restaurant services, we recognize that they, too, must be considered, as the consuming public is unaware of the

¹⁴ Examining Attorney’s brief, 6 TTABVUE 4.

disclaimers. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570 (Fed. Cir. 1983). Nonetheless, the disclaimed terms do not distinguish the marks, as they are not mutually exclusive. A Mexican grill would serve Mexican cuisine. *See Detroit Athl. Co.*, 903 F.3d at 1305 (the suffixes “Co.” and “Club” are not mutually exclusive because a club could do business as a corporation).

Thus, notwithstanding their peripheral differences, Applicant’s and Registrant’s marks are likely to convey the same or similar commercial impression to ordinary consumers in the marketplace. *In re Denisi*, 1985 WL 72008, *1 (TTAB 1985) (“[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.”). “In this case, the peripheral differences fail to distinguish the marks.” *In re Dare Foods Inc.*, 2022 WL 970319, *6 (TTAB 2022).

For these reasons, the marks are more similar than dissimilar, and the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

II. Decision

Because the first through third *DuPont* factors all weigh in favor of finding a likelihood of confusion—the second and third quite heavily—and no factor weighs against that finding, the refusal to register Applicant’s mark is affirmed. 15 U.S.C. § 1052(d).