

**This Opinion is Not a
Precedent of the TTAB**

Mailed: September 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Casa Bonita Foods Inc.

Serial No. 90658257
—

Tuvia Rotberg of Tarter Krinsky & Drogin LLP,
for Casa Bonita Foods Inc.

Andrea Cornwell, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Zervas, Greenbaum and Myles,
Administrative Trademark Judges.


Opinion by Greenbaum, Administrative Trademark Judge:

Casa Bonita Foods Inc. (“Applicant”) seeks registration on the Principal Register
of the standard character mark CASA BONITA for

Tortillas; Corn-based snack foods; Tortilla chips; Tortilla
shells, in International Class 30.¹

The Trademark Examining Attorney finally refused registration of the mark
under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that

¹ Application Serial No. 90658257 was filed on April 20, 2021, based on Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), and includes the following translation statement: “The English translation of CASA BONITA in the mark is beautiful home.”

Applicant's mark, when used on or in connection with the identified goods, so resembles the mark CASA BONITA, in standard characters and in stylized format, displayed as , both owned by a single Registrant and registered on the Principal Register for "restaurant services" in International Class 42, as to be likely to cause confusion, mistake or deception.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed, and Applicant and the Examining Attorney filed briefs. We affirm the refusal.

I. Likelihood of Confusion

"The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive." *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (cleaned up).

Our determination under Trademark Act Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We

² Reg. No. 1747587 (standard characters) issued on January 19, 1993. Reg. No. 1000819 (stylized) issued on December 31, 1974. Both registrations have been renewed, and both include the following translation statement: "The Spanish words 'CASA BONITA' may be translated into English as 'pretty house.'"


consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Charger Ventures*, 2023 USPQ2d 451, at *4 (“In any given case, different *DuPont* factors may play a dominant role and some factors may not relevant to the analysis.”). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)). However, in any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent consumer confusion as to source and to protect registrants from damage caused by registration of similar marks likely to cause such confusion. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *see also Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

A. Similarity or dissimilarity of the marks

Under this *DuPont* factor, we compare the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). *See also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Applicant did not address this factor in its brief.

Applicant’s standard character mark CASA BONITA is identical to the cited standard character mark in Reg. No. 1747587. The cited mark  in Reg. No. 1000819 consists of the same wording in stylized format. Because Applicant may display its standard character mark in any font style, including the same font style as the cited mark in Reg. No. 1000819, the marks are legally identical. *i.am.symbolic*, 123 USPQ2d at 1748 (“Symbolic does not, and cannot, dispute that the mark, I AM in standard character form, and the registrants’ marks, I AM in standard character, typed, or stylized form, are pronounced the same way and, at a minimum, legally identical.”); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB

2018) (literal elements of standard character mark may be presented in any font style, size or color).

B. Similarity or dissimilarity of the goods and services

Under this *DuPont* factor, we compare the goods and services as they are identified in the application (“tortillas, corn-based snack foods, tortilla chips and tortilla shells”) and cited registration (“restaurant services”). See *Detroit Ath. Co.*, 128 USPQ2d at 1052; *Dixie Rests.*, 41 USPQ2d at 1534. Although likelihood of confusion often has been found where similar marks are used in connection with both food products and restaurant services, there is no per se rule to this effect. See *Lloyd’s Food Prods., Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993). Instead, the evidence “must show **something more** than that similar or even identical marks are used for food products and for restaurant services.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1234, 212 USPQ 641, 642 (Fed. Cir. 2003) (emphasis in original) (quoting *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982)).

In *Coors Brewing*, the Court of Appeals for the Federal Circuit explained the reason for the “something more” requirement when assessing the relatedness of restaurants and food or beverage products:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered

trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The *Jacobs* case [*Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982)] stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.

Coors Brewing, 68 USPQ2d at 1063.

Of note in this appeal, the Board has found the “something more” requirement to be met where the registrant’s mark was found to be “a very unique, strong mark.” See *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988) (MUCKY DUCK for mustard confusingly similar to MUCKY DUCK for restaurant services, no evidence of third-party use or registration of MUCKY DUCK-inclusive marks). The Board also has found the requirement to be met where the applicant’s mark made clear that its restaurant serves the registrant’s type of food or beverage. See *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2050-51 (TTAB 2012) (COLOMBIANO COFFEE HOUSE for providing food and drink similar to COLOMBIAN for coffee); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services confusingly similar to AZTECA for Mexican food items); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services confusingly similar to GOLDEN GRIDDLE for table syrup). And the Board has found the requirement to be met where the record showed the registrant’s wines were actually sold in the applicant’s restaurant. See *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001) (“the

record in this case reveals that registrant's OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant").

In support of the refusal, the Examining Attorney submitted Internet printouts showing that some third-party restaurants featuring Mexican cuisine, such as burritos, tacos and enchiladas (all of which are wrapped in tortillas), also offer packaged tortilla chips for sale under the restaurant's name. The most relevant examples are: Taco Bell;³ Frontera Grill;⁴ Sabor Mexicano;⁵ On the Border;⁶ Qdoba;⁷ and Inca Authentic Mexican Restaurant.⁸ Evidence showing that the involved goods and services are offered by various companies under the same mark supports a finding of relatedness. *See, e.g., Detroit Ath. Co.*, 128 USPQ2d at 1051 (crediting relatedness evidence showing third parties use the same mark for the goods and services); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *46 (TTAB 2022) (third-party websites promoting sale of both parties' goods showed relatedness).

Additional Internet printouts show that some other third-party restaurants featuring Mexican cuisine, including various tortilla-wrapped dishes, also tout their homemade tortillas and tortilla chips. The most relevant examples are: Amelia's Exquisite Mexican Dining (featuring "refillable house-made tortilla chips ... or a

³ December 15, 2021 Office Action, TSDR 11-21. Citations to the prosecution history are to the downloaded .pdf versions contained in the Trademark Status & Document Retrieval (TSDR) database.

⁴ July 12, 2022 Final Office Action, TSDR 41-47.

⁵ *Id.* at TSDR 61-77 (restaurant services offered under the name Cancun Sabor Mexicano).

⁶ January 31, 2023 Suspension Letter, TSDR 4-12.

⁷ *Id.* at 13-19.

⁸ *Id.* at TSDR 20-23.

bucket of our hand-made corn tortillas”);⁹ Chuy’s Taqueria (featuring “tortillas freshly made at our restaurant”);¹⁰ Rockin Tacos (featuring “house-made tortillas” and “fresh made tortilla chips”);¹¹ Las Tortillas Mexican Restaurant (featuring “famous flour tortillas” made “from scratch”);¹² Mex on Main (featuring “homemade tortilla chips”);¹³ Pepino’s (featuring “A favorite for more than 40 years! Homemade tortilla chips”);¹⁴ and Taco Caliente (featuring fresh “homemade tortillas”).¹⁵

The Examining Attorney also made of record 21 third-party use-based registrations, owned by different registrants, covering restaurant services of the type identified in the cited registrations, and one or more food products of the types identified in the application (e.g., Reg. No. 1826505 for ROBERTO’S; Reg. No. 2608591 for MAUI TACOS; Reg. No. 4023263 for CHIDO BURRITO; Reg. No. 3020149 for the mark THINK OUTSIDE THE BUN; and Reg. No. 5726259 for the mark TACOS MARIACHI).¹⁶ The third-party registrations are probative of the relatedness of the goods and services because they suggest the listed goods and services are of a type that may emanate from the same source. *See, e.g., In re*

⁹ December 15, 2021 Office Action, TSDR 32-35.

¹⁰ *Id.* at TSDR 36-40.

¹¹ *Id.* at TSDR 41-50.

¹² July 12, 2022 Final Office Action, TSDR 48-52.

¹³ *Id.* at TSDR 53-57.

¹⁴ *Id.* at TSDR 58-60.

¹⁵ *Id.* at TSDR 78-84.

¹⁶ December 15, 2021 Office Action, TSDR 51-96 (listed examples located at TSDR 51-52, 55-63, 82-84); July 12, 2022 Final Office Action, TSDR 85-94.

Aquamar, Inc., 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *Mucky Duck*, 6 USPQ2d at 1470 n.6.

Finally, the Examining Attorney submitted an entry for the “Casa Bonita” Mexican restaurant from Wikipedia describing its many unique, eye-catching features:¹⁷

Casa Bonita (Spanish for “pretty house”) is a Mexican restaurant in Lakewood, Colorado. ... Per THE DENVER POST, the restaurant’s “pink exterior conceals a vast network of nooks and crannies inside. While the main, multilevel dining room is decorated with plastic palm trees and strings of lights, different facades and themed rooms invoke regional Mexican architectural styles, including the resort of Puerto Vallarta.” The centerpiece is a 30-foot indoor waterfall with cliff divers, an imitation of the cliffs of Acapulco. The building is crowned with a gold dome and a status of Cuauhtémoc, the last Aztec emperor of Mexico. It was designated a historic landmark of the city in March 2015. It has billed itself as “The World’s Most Exciting Restaurant.”

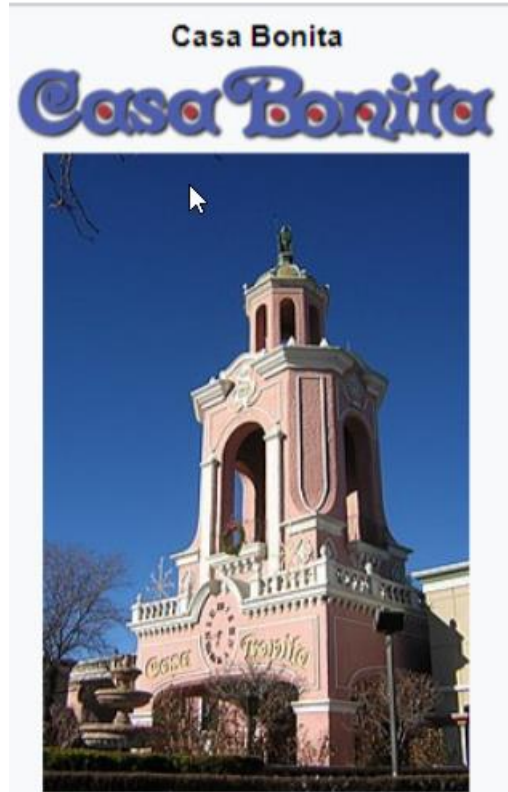
...

The website Roadside America mentions that the restaurant has “Wild West shootouts, brawling pirates, [and] a dancing gorilla” that “can be viewed while you eat.” It also has a small puppet theater, a “haunted tunnel” called Black Bart’s Cave, an arcade with a large skee-ball room, and a magic theater. The restaurant is 52,000 square feet and can seat up to 1,100 patrons.

The Wikipedia entry includes a photograph of the restaurant’s front façade, which

displays the cited mark  in Reg. No. 1000819:

¹⁷ January 31, 2023 Suspension Letter, TSDR 24-28.



The restaurant was featured in the popular animated show “South Park.” Indeed, “Casa Bonita” is the name of one “South Park” episode, as the “In popular culture” portion of the Wikipedia entry reflects:

The “South Park” episode “Casa Bonita” prominently features the Colorado branch of the restaurant. Other episodes that mention it briefly are “Quest for Ratings” (where a clock is labeled as showing the time at Casa Bonita), “You Have 0 Friends,” “201” (where the restaurant is reportedly destroyed), and “Let Go, Let Gov.” Additionally, the building that houses South Park Studios was named after the restaurant.

Applicant did not address the Wikipedia evidence or submit any evidence to counter the Examining Attorney’s arguments and evidence of relatedness and the requisite “something more.” Rather, Applicant contends the Examining Attorney’s evidence is insufficient to meet the “something more” requirement because “[t]he

degree of overlap between the sources of restaurant services and the sources of tortilla products is, at best, d[e] minimis[.]”¹⁸ Citing *Coors Brewing*, 68 USPQ2d at 1063,

Applicant argues

Indeed, with hundreds of thousands of restaurants throughout the United States, the Examining Attorney has only identified a total of nine restaurants that, in addition to restaurant services, offer packaged tortilla products separate and independent from the menu items they serve. Moreover, with over 140,000 results for registered marks for “restaurant services,” the Examining Attorney is only able to produce 21 third-party registrations showing that the same entity registered a single mark for both restaurant services and Mexican food incorporating tortilla products. Such registrations account for well less than 1% of marks for “restaurant services.” This is precisely the type of evidence rejected by the Federal Circuit as being sufficient to satisfy the “something more” requirement.¹⁹

Although Applicant did not make of record evidence of the number of “registered marks for ‘restaurant services,’” we consider the argument because the Examining Attorney addressed (rather than objecting to) it in their appeal brief.²⁰ *Cf., e.g., In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because the examining attorney addressed the applicant’s two registrations in her brief and neither objected to the other’s discussion of the registrations, Board treated both registrations as though they were of record).

At best, adopting Applicant’s mathematical argument would create, in essence, a per se rule that restaurant services and food or beverage products are not related for

¹⁸ 6 TTABVUE 5-6. Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system.

¹⁹ *Id.* at 6.

²⁰ 8 TTABVUE 9-10.

purposes of a likelihood of confusion analysis because the number of restaurants featuring a specific food or beverage is miniscule. *Cf. Lloyds*, 25 USPQ2d at 2023 (no per se rule); *Coors Brewing*, 68 USPQ2d at 1063, and *Jacobs*, 212 USPQ at 642 (“something more” required). We decline to do so.

Also, the passages Applicant cites from *Coors Brewing* do not control because the marks in that case only shared some wording, whereas the marks in the present case are identical/legally identical. Indeed, *Coors Brewing* states: “Because there are significant differences in the design of the two marks, the finding of similarity is a less important factor in establishing a likelihood of confusion than it would be if the two marks had been identical in design or nearly indistinguishable to a casual observer.” *Coors Brewing*, 68 USPQ2d at 1062.

And, as the Examining Attorney points out:

The Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney’s action. *See In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (citing *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985)); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.4 (TTAB 2016) (quoting *In re Budge Mfg., Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260-61 (Fed. Cir. 1988)); TBMP § 1208 nn.2 & 11. Here, the evidence of record is representative of Mexican restaurants offering tortillas and tortilla chips for sale on and off the restaurant premises and touting that those goods are made in-house.²¹

²¹ 8 TTABVUE 8-9.


In this case, we find the food products identified in the application related to the restaurant services identified in the cited registrations. The third-party use and registration evidence submitted by the Examining Attorney demonstrates that restaurants featuring Mexican cuisine also offer packaged tortilla products for sale under the restaurants' names, they feature various tortilla products on their menus, and they tout the fact that the tortilla products are homemade. This evidence is qualitatively different from evidence that a restaurant merely provides a food or beverage.

Moreover, in this case, the Wikipedia evidence, and the lack of any evidence of third-party use or registration of CASA BONITA-formative marks for restaurants or food products, supports a finding that CASA BONITA is a "very unique, strong mark" for restaurant services. *Mucky Duck*, 6 USPQ2d at 1469 (no evidence of third-party use or registrations of marks containing the expression "Mucky Duck").

Based on the entire record, and because the marks are identical/legally identical, we find the requisite "something more" showing has been made, and Applicant's identified food products are related to Registrant's "restaurant services." *Id.* ("[B]ecause of the substantial similarity in the marks and the unique and memorable nature of registrant's mark, we are of the opinion that customers of registrant's restaurant who encounter applicant's "MUCKY DUCK" and design mustard in the grocery store or supermarket are likely to believe that the mustard originates with or is in some way associated with registrant, that is, that the restaurant is selling its own "special" mustard through retail outlets.").

C. Conclusion

We have considered all of the evidence and arguments bearing on the likelihood of confusion issue. The marks are identical/legally identical, and the “something more” requirement to establish the food products identified in the application are related to restaurant services identified in the registrations has been met. Accordingly, the first and second *DuPont* factors weigh in favor of a finding of likelihood of confusion, and no *DuPont* factor weighs against such a finding.

We therefore conclude confusion is likely between Applicant’s mark CASA BONITA in standard characters, and the cited registered mark CASA BONITA in both standard characters and stylized format, displayed as .

Decision: The refusal to register Applicant’s mark under Trademark Act Section 2(d) is affirmed.