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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91256413
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No.:
88/646,951

For the Mark: OLÉ CHAMOYLE

Filing Date: October 8, 2019

OLÉ MEXICAN FOODS, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91256413
)	
CERVEZA CITRUS L.L.C.,)	
)	
Applicant.)	

APPLICANT'S TRIAL BRIEF

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I. INTRODUCTION

Applicant CERVEZA CITRUS L.L.C. (the “Applicant”) filed Application Serial No. 88/646,951 for the word mark OLÉ CHAMOYLE¹ on October 8, 2019 (hereinafter, the “Mark”) for “Packaged combinations consisting of chamoy and chile lime seasoning in separate compartments”² in Class 30 (the “Applicant’s Goods”). Applicant’s application for the Mark was filed as an intent-to-use trademark application.³ The Mark was published for opposition on February 18, 2020. OLÉ MEXICAN FOODS, INC. (the “Opposer”) commenced the present Opposition against the Mark on June 16, 2020.

As the basis of the present opposition, Opposer relies on certain of its registered trademarks that are or consist of the word OLÉ and alleged common law rights in the word OLÉ. The Opposer is the owner of registered trademarks for OLÉ in Classes 29 and 30 (the “Opposer’s Mark”), for use with various Mexican style food products set forth in its motion for summary judgment (the “Opposer’s Goods”). Applicant does not challenge the type and sales of the Opposer’s Goods, nor does it challenge the sales of those goods by or on behalf of Opposer. The only issue involved in this Opposition is the likelihood of confusion between the parties’ marks, which should clearly be resolved in Applicant’s favor.

¹ Applicant’s mark was originally filed as OLE’ (with an apostrophe after the E). On October 21, 2021 (16 TTABVUE), the Applicant filed a motion to amend its mark to OLÉ (with an acute accent over the E). On February 10, 2022, the Board issued an Order deferring the decision on the motion until final decision. 20 TTABVUE. On June 9, 2022, Opposer, after further discovery, withdrew its Objection to Applicant’s Motion to Amend. 24 TTABVUE. Given the agreement between the parties and to correspond to Opposer’s Trial Brief, Applicant has treated the first word of Applicant’s mark as OLÉ (with an acute accent over the E) throughout this Trial Brief.

² The packaging for the goods were the subject of a patent application filed with the U.S. Patent and Trademark Office, namely, U.S. Patent Application Serial No. 16/396,593 filed April 26, 2019.

³ During the approximately 29 months since the filing date of the trademark application for the Mark, the Applicant has and is using the Mark in interstate commerce with the goods described in the application and is ready to file proof of use.

II. DESCRIPTION OF THE RECORD

A. Applicant's Evidence

1. The Trial Declaration of Kyle Bell ("Bell Trial Decl.") filed on September 26, 2022. 37 TTABVUE 4-5.

2. The Trial Declaration of Ryan Milan ("Milan Trial Decl.") filed on September 26, 2022. 37 TTABVUE 8-9.

3. Applicant's Third Notice of Reliance (USPTO Records - Trademark Registrations in Class 030) filed on September 26, 2022. 38 TTABVUE 10-89.

4. Applicant's Sixth Notice of Reliance (USPTO Records - Trademark Registrations in Class 029) filed on September 26, 2022. 38 TTABVUE 141-183.

5. Applicant's Seventh Notice of Reliance (Internet Materials) filed on September 26, 2022 consisting of definitions for the words Olé and Ole. 38 TTABVUE 184-210.

6. Applicant's Ninth Notice of Reliance (USPTO Records - Trademark Registrations in Class 043) filed on September 26, 2022. 38 TTABVUE 214-253.

B. Opposer's Claimed Evidence

1. The Trial Declaration of Samuel Rodriguez ("Rodriguez Trial Decl.") and Exhibits 1-18 thereto (25 TTABVUE), and the corresponding Confidential Version (26 TTABVUE) filed on July 25, 2022.

2. The Trial Declaration of Enrique Botello ("Botello Trial Decl.") and Exhibits 1-21 thereto (27 TTABVUE) and the corresponding Confidential Version (28 TTABVUE) filed on July 25, 2022.

3. Opposer's First Notice of Reliance (USPTO Records) filed on July 25, 2022 consisting of Opposer's Registration Nos. 3,223,608; 2,740,014; 4,899,762; and, 4,292,655. 29 TTABVUE.

4. Opposer's Second Notice of Reliance (Printed Publications) filed on July 25, 2022, consisting of definitions for the words Olé, Ole, Salsa, Seasoning, Condiment, and Chamoy. 31 TTABVUE.

5. Opposer's Third Notice of Reliance (Printed Publications) filed on July 25, 2022 consisting of third-party articles about Opposer. 30 TTABVUE.

6. Opposer's Fourth Notice of Reliance (USPTO Records) filed on July 25, 2022 consisting of TESS pages and the corresponding TTAB docket pages for trademark applications and registrations that Opposer has opposed or canceled. 32 TTABVUE.

7. Opposer's Fifth Notice of Reliance (USPTO Records) filed on July 25, 2022 consisting of TESS printouts of third-party registrations for marks registered for both Opposer's and Applicant's goods. 33 TTABVUE.

8. Opposer's Sixth Notice of Reliance (Discovery Deposition) filed on July 25, 2022 consisting of excerpts from the deposition of Applicant's 30(b)(6) witness, Ryan Milan ("Milan Dep. Tr."), and accompanying exhibits. 34 TTABVUE.

9. Opposer's Seventh Notice of Reliance (Discovery Deposition) filed on July 25, 2022 consisting of excerpts from the deposition of Applicant's 30(b)(6) witness, Kyle Bell ("Bell Dep. Tr."), and accompanying exhibits. 35 TTABVUE.

10. Opposer's Eighth Notice of Reliance (USPTO Records) filed on November 8, 2022 consisting of USPTO records submitted in rebuttal to Applicant's First Notice of Reliance, Exhibits 3, 6, and 9. 43 TTABVUE.

III. STATEMENT OF THE FACTS

A. Applicant

Applicant-Cerveza Citrus L.L.C. has two members, namely, Kyle Bell and Ryan Milan, who both appeared for deposition as Applicant's 30(b)(6) witnesses and both are personally involved in the sales and marketing of Applicant's OLÉ CHAMOYLE product, and personally meeting with buyers of the products. 37 TTABVUE 4-5 (Bell Trial Decl. ¶¶ 2-3) and 8-9 (Milan Trial Decl. ¶¶ 2-3).

B. Nature of Applicant's Product

As stated in its application for registration, Applicant filed its intent-to-use application on October 8, 2019 for the Mark for use with Applicant's Goods, namely, a single-serving package that contains a chamoy-based sauce and a chile lime seasoning in separate segmented compartments, with a top compartment containing "a blend of seasoning," including chile peppers and lime and a bottom compartment containing "chamoy sauce." 34 TTABVUE 19, 39-42 (Milan Dep. Tr. 39:9-20 and Exhs. 6 and 8); 35 TTABVUE 16-19 (Bell Dep. Tr. 34:9-35:7 and Exh. 6). The segmented package allows customers to choose to use one or both of the sauce and seasoning. 34 TTABVUE 19-20, 39-42 (Milan Dep. Tr. 39:9-40:14 and Exhs. 6 and 8); 35 TTABVUE 16-17 (Bell Dep. Tr. 34:9-37:21 and Exh. 6). The container for Applicant's product is a single-serving size package, the front and back of which are shown below:



34 TTABVUE 8-9, 39-42 (Milan Dep. Tr. 18:2-13, 19:16-19, 36:9-14 and Exhs. 6 and 8); 35 TTABVUE 10-11, 45-46 (Bell Dep. Tr. 20:4-21:9 and Exh. 6). See also 34 TTABVUE 41-42 and 35 TTABVUE 48-49, giving a fuller view of the front of the package at Exhibit 8.

Applicant describes its OLÉ CHAMOYLE product as an “authentic Mexican sweet and spicy Chamoy condiment [sic] COMBINATION.” 34 TTABVUE 17-19, 41-42 (Milan Dep. Tr. 38:17-39:4 and Exh. 8). The product is intended to be used both as a spice, sauce, or condiment used in the preparation of authentic Mexican dishes or as a condiment added to Mexican dishes after preparation to impart or enhance the flavors. 35 TTABVUE 18-21, 45-48 (Bell Dep. Tr. 35:20-36:17, 36:25-37:5, and 38:23-39:8 and Exhs. 6 and 8).

C. Selection, Pronunciation and Meaning of Applicant’s Mark

The second word of Applicant’s OLÉ CHAMOYLE Mark, Chamoye, is a made-up word that the principals of Applicant, Ryan Milan and Kyle Bell, put together. 34 TTABVUE 19 (Milan Dep. Tr. 31:4-15); 37 TTABVUE 4-5 (Bell Trial Decl). The OLÉ portion of the Mark is pronounced “Olay (phonetic).” 35 TTABVUE 9 (Bell Dep. Tr. 21:14-21); 34 TTABVUE 11 (Milan Dep. Tr. 25:17-24). Further, as to its meaning, Applicant maintains that OLÉ is “a chant at a soccer stadium or at a bullfighting arena” and “[s]omething, I guess, you would describe as celebratory” 35 TTABVUE 10 (Bell Dep. Tr. 22:1-5). The CHAMOYLE portion of the Mark is pronounced, phonetically, as Chamoylay. 35 TTABVUE 10 (Bell Dep. Tr. 23:15-17); 34 TTABVUE 11 (Milan Dep. Tr. 26:7-13).

D. Applicant’s Sales Price and Channels of Trade

Applicant’s OLÉ CHAMOYLE product is inexpensively priced, selling for \$0.79 to \$0.99 per single-serving package. 34 TTABVUE 23-24, 28, 38 (Milan Dep. Tr. 46:22-47:9, Resp. to Rog. 2(a) and verification page). Applicant’s OLÉ CHAMOYLE product is currently being sold to “retail grocery stores, supermarkets, wholesale distributors, food-service distributors, warehouse sales to large or mass retailers and internet sales.” 34 TTABVUE 23-24, 29 (Milan Dep. Tr. 46:22-47:9, Resp. to Rog. 3). Sales proposals to these buyers are made to the Hispanic buyers since store buyers see OLÉ CHAMOYLE as an Hispanic product. 35 TTABVUE 24 (Bell Dep. Tr. 46:4-18).

E. Opposer’s Use of OLÉ Mark

In its Trial Brief, the Opposer sets forth a relatively long discussion of the history of its various marks and a discussion of the evolution of the various goods and services with

which the Opposer's marks are utilized. Applicant does not have the resources to investigate and, as may be relevant, dispute the history description and characterization of the marks and goods or services. All of the goods referenced by Opposer are "standard" or "traditional" types of Mexican foods and services related to those foods. In contrast, as set forth above, the goods which are associated with Applicant's Mark are "packaged combinations consisting of chamoy and chile lime seasoning in separate compartments". As also set forth above, the product is more fully described as a single-serving package that contains a chamoy-based sauce and a chile lime seasoning in separate segmented compartments, with a top compartment containing "a blend of seasoning," including chile peppers and lime and a bottom compartment containing "chamoy sauce." 34 TTABVUE 19, 39-42 (Milan Dep. Tr. 39:9-20 and Exhs. 6 and 8); 35 TTABVUE 16-19 (Bell Dep. Tr. 34:9-35:7 and Exh. 6). Throughout its Trial Brief, Opposer makes reference to the relatedness or similarity between its "traditional" Mexican food and food-type goods and the sauce and spice inside the segmented compartments, apparently choosing to ignore the fact that Applicant's Goods comprise single serving packages with segmented compartments separately containing a chamoy-based sauce and a chile lime seasoning when arguing the registration of Applicant's Mark will result in a likelihood of confusion with Opposer's various marks. To the best of Applicant's knowledge, Opposer has no products which are even remotely configured in a manner of the Applicant's packaged combinations in a segmented container. Because Opposer does not reference the actual nature of Applicant's goods, it is unclear why (particularly in light of the very unique made-up CHAMOYLE portion of Applicant's mark. With regard to the alleged popularity of Opposer's Goods and widespread dissemination of those goods with the Opposer's marks, the Applicant notes that neither of its principals were, prior to the initiation of

the present Opposition, familiar with the Opposer's marks or any other parties using Olé in connection with the sale of food products. 34 TTABVUE 11-12 (Milan Dep. Tr. 25:25-26:6); 35 TTABVUE 10-11 (Bell Dep. Tr. 22:9-23:14).

IV. STATEMENT OF THE PROCEEDINGS

The Applicant filed Application Serial No. 88/646,951 for the word Mark for its Applicant Goods in Class 30 on October 8, 2019. Applicant's application for the Mark was filed as an intent-to-use trademark application. The Mark was published for opposition on February 18, 2020. The Opposer commenced the present Opposition against the Mark on June 16, 2020. The Applicant timely filed its Answer to the Notice of Opposition on July 24, 2020. The Opposer filed a Motion for Summary Judgement on April 5, 2021 and Applicant filed its Response on May 5, 2021. Proceedings were suspended pending the decision on the Motion for Summary Judgement. On July 14, 2021, the Board issued its decision denying the Opposer's Motion for Summary Judgment.

V. ARGUMENT

A. Applicant Does Not Dispute Opposer's Standing or Priority of Trademark Rights in Connection with Opposer's Registered Goods

Applicant does not dispute Opposer's standing or Opposer's ownership in the registrations that are the basis of Opposer's Opposition proceeding. Applicant's applications for its OLÉ CHAMOYLE were filed as intent-to-use and, as such, have not claimed a date of first use of the Mark in U.S. commerce, and Applicant did not file the opposed application prior to

Opposer's use of the marks that are the basis of this proceeding in connection with Opposer's registered goods. Thus, Applicant does not contest Opposer's assertion that it has standing or that it has established priority in connection with the registered goods, which are: Mexican style food products, namely, chorizo, queso and cheese dips, and chicharrones; Mexican style food products, namely, tortillas, tostadas, tortilla chips, Mexican pastries, Mexican snack foods, namely, corn chips, and salsas.

B. Applicant Disputes Opposer's Standing and Priority of Trademark Rights in Connection with Mexican Seasonings, Spices and Candy

Opposer did not produce any evidence showing Opposer's sales of candy past the year 2017. In its Trial Brief, Opposer only identifies two products of Opposer that fall in the same very general space as Applicant's Goods, one for Chile Puya peppers and another for Whole Cumin. 25 TTABVUE 8-9, 91-94, 117-120 (Rodriguez Trial Decl. ¶ 12 and Exhs. 8, 11, and 12); and, 27 TTABVUE at ¶ 5-6 (Rodriguez Rebuttal Decl.)(Confidential). Amazon listings show that Opposer sells these products in bulk by the case, indicating that they are not targeting Applicant's relevant purchasing public, the general retail consumer. 35 TTABVUE 10 (Bell Dep. Tr. 50:13-52:13); 34 TTABVUE 11 (Milan Dep. Tr. 46:22-48:6). Opposer also states in its Trial Brief that between 1999 and 2006 Opposer sold a number (confidential) of packages of seasonings, spices and candies under the OLÉ Logo but that sales were discontinued after 2006 and then were restarted in 2016. As such, any long term sales of Opposer's products prior to 2016 are not relevant to the present proceeding. With regard to possible current sales of such products, Opposer states in its Trial Brief uses such words as "have always been part of Opposer's ongoing plans for expansion of its OLÉ Brand product line" and that "Opposer

expects both Walmart and Food Lion to expand their existing lines of OLÉ Brand products to include OLÉ Brand candies, chile peppers, seasonings, and spices by the end of the second half of 2022 citing 25 TTABVUE 17 (Rodriguez Trial Decl. ¶ 30), 13 TTABVUE at Exhs. 16, 17, and 18 (Confidential) and 25 TTABVUE 16 (Rodriguez Trial Decl. ¶ 27); 26 TTABVUE at Exhs. 16, 17, and 18 (Rodriguez Trial Decl.)(Confidential). These comments reflect the apparent fact that Opposer does not have standing or a priority trademark rights in connection with Mexican seasonings, spices and candies.

C. There Is No Likelihood of Confusion Between Applicant’s Mark and Opposer’s Marks

The Board’s determination under Section 2(d) of the Lanham Act is based on an analysis of all facts of record that are relevant to those factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). The court in *du Pont* set forth a list of thirteen factors that are pertinent to a likelihood of confusion analysis. In determining whether a likelihood of confusion exists, however, the Board need not consider every *du Pont* factor. *Shen Mfg. Co., Inc. v. The Ritz Hotel Ltd.*, 393 F.3d 1241 (Fed. Cir. 2004); *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001)(“While it must consider each factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods”). The Board may dismiss an opposition based on a determination of the first du Pont factor alone. See *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374-75 (Fed. Cir. 1998)(affirming the TTAB’s dismissal of an opposition action where it “treated the dissimilarity of the marks with respect to appearance, sound, significance, and commercial impression as the

dispositive *du Pont* factor, concluding that this dissimilarity alone precluded any reasonable likelihood of confusion”); *Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F.2d 330 (Fed. Cir. 1991)(affirming Board decision finding no likelihood of confusion based on the first *du Pont* factor alone). In fact, the *du Pont* court recognized that “each [factor] may from case to case play a dominant role.” *du Pont*, 476 F.2d at 1361-62 (citing examples of cases that held one element to determine whether confusion is likely or unlikely).

With regard to the present proceeding, the Opposer cannot demonstrate that Applicant’s Mark OLÉ CHAMOYLE creates a likelihood of confusion with Opposer’s OLÉ marks for three primary reasons: (1) the marks are significantly dissimilar in appearance, sound, connotation and commercial impression (the first *du Pont* factor); (2) the respective goods of the parties are distinct (the second *du Pont* factor); and (3) Opposer’s OLÉ-formative marks exist in a very crowded field of other marks containing the term “olé” or “ole” for related goods and services, including those for Mexican and Mexican-related foods and the like (the sixth *du Pont* factor). In addition, an examination of the facts associated with each *du Pont* factor support a finding that the registration of Applicant’s Mark will not create a likelihood of confusion with the Opposer’s marks.

1. The Applicant’s OLÉ CHAMOYLE Mark Is Not Confusingly Similar to Opposer’s OLÉ Marks (*Du Pont* Factor #1)

The first *du Pont* Factor examines the similarity of the parties’ marks in their entireties as to appearance, sound, connotation, and commercial impression. *du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. In its Trial Brief, the Opposer, for the most part, improperly dissects the Applicant’s Mark, and primarily argues the first *du Pont* factor under the “Sight, Sound and

Meaning” test. However, the law is clear, the two marks must be compared as a whole without dissection under the “Sight, Sound and Meaning” test. See *du Pont*, 476 F.2d at 1361; TMEP §1207.01(b)-(b)(v). The Opposer’s Mark and the Applicant’s Mark must be compared without dissection. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985)(“The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted). On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties (footnote omitted). Indeed, this type of analysis appears to be unavoidable.”); *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340, 115 USPQ 2d 1671 (Fed. Cir. 2015) (quoting *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981)).

Initially, the marks are not similar in appearance. The mere presence of two marks having the same term as part of the mark is usually not sufficient to support a holding of likelihood of confusion. *See In re Application of Ferrero*, 479 F.2d 1395, 1397 (C.C.P.A. 1973)(TIC TAC not confusingly similar to TIC TAC TOE); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520, 522 (T.T.A.B. 1975)(PROTEIN PLUS and PLUS not confusingly similar), *aff’d without op.*, 534 F.2d 336 (C.C.P.A. 1976). Furthermore, the concurrent use of a similar element, even if dominant, does not compel a finding that confusion is likely. *See In re Coors*

Brewing Co., 343 F.3d 1340, 1344 (Fed. Cir. 2003); *Kellogg Co.*, 951 F.2d 330 (finding FROOTEE ICE for flavored ice bars not likely to cause confusion with FROOT LOOPS for breakfast cereal and related products); *Keebler Co.*, 866 F.2d 1386 (finding PECAN SHORTIES not likely to cause confusion with PECAN SANDIES). The Applicant's Mark consists of OLÉ CHAMOYLE, while the Opposer's Mark is OLÉ. The similarity between the marks ends at the word OLÉ. Applicant's Mark also comprises the word CHAMOYLE after the OLÉ, making the visual appearance of the marks dissimilar. In addition, the sound of the two marks is quite different, with the Opposer's Mark having two syllables and the Applicant's Mark comprising five syllables, including a double rhyming of the "lay" syllable at the ends of the two words.

Opposer appears to improperly urge the Board to essentially disregard the CHAMOYLE element of Mission Laredo's Marks. In doing so, Opposer seems to suggest that the first word of a mark is generally the more prominent part of a mark. As noted by others, "It is impossible, to make any generalized statement as to whether the beginning or end of a mark is more important." 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:45 (5th ed. 2017) (citing several cases); *see also Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286 (Fed. Cir. 2016) (no likelihood of confusion between MAYA and MAYARI, both for wine); *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (there is no likelihood of confusion between VARGAS GIRL and VARGA, both for calendars); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (no likelihood of confusion between PECAN SANDIES and PECAN SHORTEES, both for cookies); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 USPQ 364 (Fed. Cir. 1986) (no likelihood of confusion between ROMAN and ROMANBURGERS,

both for food products); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 USPQ 392 (CCPA 1972) (no likelihood of confusion between ALL and ALL CLEAR, both for household cleaning products).

In the present matter, when considered in their entirety, the Opposer's Mark and the Applicant's Mark are dissimilar in as to appearance, sound, and connotation or meaning. The similarity or dissimilarity of two marks is determined by focusing on "the marks in their entireties as to appearance, sound, connotation, and commercial impression." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005). Relevant case law holds that marks must not be compared in the abstract when assessing likelihood of confusion, but rather must be compared as used in connection with their respective goods and in their entirety. See *In re National Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985). In addition to the foregoing, the marks are not tested for differentiation through a side-by-side comparison. See *Coach Servs., Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012); *Barbaras Bakery, Inc. v. Barbara Landesman*, 82 USPQ2d 1283 (TTAB 2007). Rather, to determine whether the marks are so similar to result in likely confusion, the Board focuses on the "general recollection" produced by the marks on the "average purchaser," as the buyer would see the marks in the marketplace. See *Johann Maria Farina Gegenüber Dem Julichs-Platz v. Chesebrough-Pond, Inc.*, 470 F.2d 1385, 1386 (CCPA 1972). When comparing the Applicant's Mark to the Opposer's Mark as a whole, it is clearly evident that the marks are dissimilar with regard to appearance, sound, connotation and commercial impression.

In its Trial Brief, the Opposer appears to primarily focus on the first half of Applicant's Mark and generally ignore the second part (the "Chamoyle") of the Applicant's

Mark. This dissection of Applicant's Mark results in the Opposer's focus on the OLÉ portion of the Applicant's Mark improper. In the Applicant's Mark, the OLÉ portion is just being utilized as a lead-in to the portion of the mark that is the primary distinguishing feature of the Applicant's Mark and of importance to the Applicant, which is the made-up CHAMOYLE word. As set forth in more detail below, the word Olé "is well-known as an exclamation of 'bravo' and 'hooray' to as part of a chant to cheer on a person or team and in a celebratory sense. The Opposer makes no argument, as well it should not, that there is any likelihood of confusion between the word CHAMOYLE and the Opposer's Mark. Instead, without any evidence, the Opposer argues that the OLÉ portion of the Applicant's Mark is the "dominant portion" and that the word OLÉ is an arbitrary term and, therefore according to the Opposer, there is a likelihood of confusion. As set forth in more detail below, the word OLÉ is a very common Spanish word that has crossed language barriers to be commonly utilized in a number of different languages, including English, as a word that has certain "charge-like" or celebratory connotations.

Despite the downplaying of Applicant's full mark, Applicant's Mark does have the made-up word CHAMOYLE and that word is utilized most prominently on the Applicant's goods. In addition to the use of its own made-up word, the special packaging is able to clearly distinguish the Applicant's Mark from the Opposer's Mark, as the Opposer does not sell any products that have two ingredients in separate compartments in a single package as is done for Applicant's Goods. When considered as a whole, as it should be, consumers of the Opposer's goods and Applicant's goods will easily appreciate that the two marks appear and sound very different from each other. The use of the strong and made-up word CHAMOYLE and the unique packaging allows the consumer to easily distinguish Applicant's Mark from Opposer's Mark just

on the basis of appearance and sound. In addition, consumers of Applicant's goods will readily recognize the relative importance between the lead-in OLÉ portion of the mark and the unique, not previously utilized CHAMOYLE portion of Applicant's Mark. As such, the Board should rule against the Opposer's opposition and rule instead in favor of Applicant and uphold the Examiner's decision to allow the Applicant's Mark to proceed to registration.

From the foregoing, it is clear that the parties marks convey entirely distinct commercial impressions. Due to the prominence on the packaging and the uniqueness of the word, consumers are not likely to ignore the CHAMOYLE portion of the Applicant's Mark and will readily distinguish the mark and goods from those of Opposer, including Opposer's Mark. Instead, consumers will view the Applicant's Mark as a whole and understand immediately that the OLÉ portion of the Applicant's Mark is merely just an expression that leads into the more important and distinctive CHAMOYLE. *See Juice Generation*, 794 F.3d at 1340 ("the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail")(citations omitted).

In its Trial Brief, the Opposer appears to argue that the CHAMOYLE portion of the Applicant's Mark is relatively weak and is not sufficient to distinguish the parties' marks. The Applicant disagrees strongly with this unsupported characterization of the Applicant's Mark. As set forth above, CHAMOYLE is a made-up word that is different in both appearance and sound and which generates a different connotation and commercial impression than use of OLÉ by itself. As set forth in more detail below, the Applicant's use of the made-up CHAMOYLE is much more distinctive than other registered trademarks that use the word OLÉ as part of the mark (i.e., GOURMET OLÉ, JOSÉ OLÉ, SANTA FE OLÉ, CASA OLÉ and FIDEO OLÉ - all

of which are set forth below) and provides a completely different connotation and commercial impression than just OLÉ.

2. Products Offered Under Applicant's Mark Are Sufficiently Dissimilar To Opposer's Goods (*Du Pont* Factor #2)

Although it is generally true that when assessing the relatedness of the goods or services in a likelihood of confusion analysis, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion (e.g., *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), it is also true that its converse applies. Specifically, if the goods or services in question in a likelihood of confusion analysis are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion may not be likely. *See, e.g., Coach Servs.*, 668 F.3d at 1371, 101 USPQ2d 1713 at 1723 (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (holding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their

channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers).

With regard to the present Opposition, Applicant's Goods are substantially different than Opposer Goods. Although the Opposer appears to focus on the chamoy sauce and lime chile spice as separate goods, such a focus is incorrect. Applicant's goods (as set forth in the subject application for registration) is for "packaged combinations consisting of chamoy and chile lime seasoning in separate compartments". Applicant is not selling chamoy sauce nor chile lime seasoning by themselves as separate goods. Applicant's Good are specifically for the packaged combination that is a unique design to the Applicant in that the sauce and seasoning are included in separate compartments that can be selectively opened individually and then used on different products or they can be opened at the same time and used on the same product. None of Opposer's Goods are packaged in this manner and Opposer has not offered any evidence that is sells or offers for sale any goods that are even remotely similarly packaged. In focusing on the sales of spices and seasonings as separate goods, the Opposer appears to either misunderstand or intentionally mischaracterize the nature of Applicant's Goods. The subject application for registration is clearly for the "packaged combination" of the chamoy sauce and chile lime seasoning. This difference between the Applicant's Goods and Opposer's Goods leads to the conclusion for the likelihood of confusion analysis that they are not sufficiently related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source.

The fact that Applicant's goods can be utilized with Opposer's goods is not at all dispositive of the issue of whether there may be a likelihood of confusion between Applicant's

Mark and Opposer's Mark. As stated above, as a spice/condiment Applicant's goods can be utilized with a wide variety of different types of foods and beverages, including American, Italian and other "ethnic" foods or beverages. As will be readily appreciated, a wide variety of different types of spices and condiments can be utilized with Mexican-style foods, including those which are identified as Opposer's goods (as well as others listed on the table). For instance, people commonly place salt, pepper and other spices on Mexican-style foods. Likewise, some people will place honey and even ketchup on Mexican-style foods. There is virtually no limit to the type of spices and condiments which can be place on or otherwise consumed with Mexican-style foods and beverages. The fact that Applicant's goods, being sold under Applicant's Mark, can also be utilized with Mexican-style foods, including Opposer's goods, does not make Applicant's use of the OLÉ term (as part of its OLÉ CHAMOYLE mark) to cause a likelihood of confusion with Opposer's Mark, particularly in light of the others who use OLÉ as part of their mark with goods that are much closer than Applicant's goods.

3. The Term OLÉ Is Widely Used by Third Parties for Goods and Services in the Mexican Food Industry, Weakening the Strength of Opposer's Marks (Du Pont Factor #6)

Under the sixth *du Pont* factor, the "number and nature of similar marks in use on similar goods" is considered. *du Pont*, 476 F.2d at 1361. A sufficient showing of "evidence of third-party use of similar marks can show that customers have been educated to distinguish between different marks on the basis of minute distinctions." *Juice Generation, Inc.*, 794 F.3d at 1338. Thus, third-party use of similar marks on similar goods is relevant to show that a mark is entitled to a narrower scope of protection. See *id.*; *Palm Bay Imports, Inc.*, 396 F.3d at

1373; *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1372 (Fed. Cir. 2015).

In its Trial Brief, the Opposer argues that the Opposer's Mark is strong and, as such, is entitled to "a broad scope of protection". The Applicant respectfully disagrees. While it may be true that the Opposer has utilized OLÉ for a number of years, the mark is registered in a couple of classes and the Opposer is utilizing the mark on a number of Mexican-style products, this does not mean that the Opposer's Mark is strong. One problem is that the Opposer has as its mark a very common expressive word that is not only a word that is utilized commonly in its original Spanish language, but which is utilized in English and other languages for the same type of expressive purposes.

As noted by the Opposer, a mark's strength is first determined "by examining its inherent distinctiveness or conceptual strength" citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 U.S.P.Q.2d 1081, 1086 (1992) and 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 11:83 (4th ed. 2016). The problem with Opposer's Mark generally and specifically with regard to the present dispute, is that Olé is a very common word that is utilized in a wide variety of different contexts. While the mark OLÉ is not descriptive or generic in the context of Mexican-style foods, it cannot be ignored that the word is in fact very commonly utilized for purposes unrelated to Opposer's Mark (unlike Applicant's CHAMOYLE) and, as set forth in more detail below, is also utilized for other registered trademarks.

A number of references that clearly illustrate that the word Olé is common and used to express "bravo", "hurray", cry of approval or joy and like term, including the Oxford Dictionary definition of Olé, the Spanish dictionary definition of Olé, the Urban Dictionary

definition of Olé and the Wikipedia listing for Olé. 38 TTABVUE 184-210. At the very least, these references clearly show that Olé is a very common word and that Olé is utilized as an expressive term, which is how it is being utilized in the Applicant's Mark - to "introduce" the distinctive CHAMOYLE portion of the mark. As set forth in more detail below, the Board should find that Opposer's Mark is not in fact strong, or at least not so strong so as to prevent others from using the word Olé in the intended expressive fashion with Mexican-style foods.

As stated above, consumers will not ignore the CHAMOYLE portion of the Applicant's Mark. Instead, consumers will view the Applicant's Mark as a whole and understand immediately that the OLÉ portion of the Applicant's Mark is an expression that leads into the more important and distinctive CHAMOYLE. *See Juice Generation, Inc.*, 794 F.3d at 1340. The common use of the Olé portion of the Applicant's Mark for a wide variety of different purposes and situations will be seen exactly as it is presented by the Applicant. To discount several instances of third-party use because there are "no specifics regarding the extent of sales or promotional efforts surrounding the third-party marks," is inadequate, as it does not "account for the apparent force of the evidence." *See Juice Generation, Inc.*, 794 F.3d at 1339. Regardless of proof as to the extent and impact on the purchasing public, a showing of such extensive third-party use is "nonetheless powerful on its face." *See Id.*; *Jack Wolfskin*, 797 F.3d at 1373-74. Here, the evidence of record establishes that the word "OLÉ" is commonly used in marketing goods and services in the food industry to convey and suggest excitement in the products or services offered thereunder. "Such third-party registrations and uses are competent to show that the common term has an accepted meaning in a given field and that marks containing the term have been registered and used for related goods because the remaining portions of the marks may

be sufficient to distinguish the marks as a whole from one another.” *Promark Brands Inc. and H.J. Heinz Co. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1244 (TTAB 2015); *see also In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1745-46 (TTAB 2016) (“Third-party registrations used in this manner are not evidence that customers are accustomed to seeing the use of other, similar, marks in the marketplace, but rather evidence that a term is suggestive or descriptive of the relevant goods or services.”)

As set forth above, both the Opposer’s Mark and Applicant’s Mark are in Class 30. The lack of distinctiveness of Opposer’s Mark is clearly evidenced by the various trademarks that are registered with the PTO and which are not owned by Opposer. 38 TTABVUE 10-89. Upon information belief, the Opposer has not petitioned to cancel any of these registrations.

<u>TRADEMARK</u>	<u>REG. NO.</u>	<u>GOODS - CLASS 30</u>
OLE SWEET SAVANNAH	6,320,996	Sauces; Seasonings.
MRS. OLE ALABAMA TEA “THE FEEL BETTER TEA!”	6,319,438	Tea; Tea bags.
A-MAZE-ING OLÉ	5,929,716	Popped popcorn.
OLE SMOKES COFFEE	5,929,716	Coffee.
OLE SMOKES COFFEE	5,852,292	Coffee.
OLÉ HOT'N FRUITY	5,788,151	Sauces, namely, hot sauces.
DIRTY OLD BASTERS AWARD-WINNING BBQ SEED SAUCE XXX OL' BASTER DIRTY OLE' BASTERS	5,384,692	Barbecue dry rub; Barbecue sauce; Dry spice rub for meats and fish; Flavored salt; Grilling sauces; Hot pepper powder; Hot sauce; Steak sauce.
BUFFO'S CHARD ASS OLÉ MEXICAN HOT SAUCE	5,322,871	Hot sauce.
CAFÉ OLE	4,839,308	Coffee.

OLE' SOUTHERN SECRET POTS-ABILITIES	5,096,298	Sauces.
OLE SCHOOL CORN FLAKE CHEWY KIMBLE'S	4,895,263	Cereal based snack food.
OLE LEO'S	4,684,138	Honey.
OLE YELLER	3,954,521	Barbeque sauce.
OLE & STEEN	5,398,786	Coffee, tea, cocoa, rice, tapioca, sago, artificial coffee; flour; preparations made from cereals namely, cereal bars, cereal-based snack food, biscuits, tarts, cakes made with cereals, pies; bread; pastry; confectionery, namely, custards, chocolate confections, frozen confections, frozen confections, namely, ices and frozen custards; yeast, baking-powder; the aforementioned not in relation to Mexican food products.
CAFÉ OLÉ	3,769,282	Ready-to-drink coffee-based beverages.
GOURMET OLÉ	5,266,157	Mexican-style foods, namely, burritos.
TASTE THE FIESTA! JOSÉ OLÉ	3,110,852	Frozen Mexican entrees consisting primarily of tortillas, rice and sauce; frozen Mexican foods, namely, burritos, taquitos, tacos, enchiladas, quesadillas, chimichangas, tamales, and tortillas filled with meats, cheeses, vegetables, rice, beans and/or sauce.
JOSÉ OLÉ	2,628,945	Frozen Mexican entrees, consisting primarily of tortillas, rice and sauce; frozen Mexican foods, namely, burritos, taquitos, tacos, enchiladas, quesadillas, chimichangas, tamales; and tortillas filled with meats, cheeses, vegetables, rice, beans and/or sauce.
OLE PODNER BAR-B-QUE RUB	4,358,228	Dry seasonings in the nature of barbeque meat rub.
SANTA FE OLÉ	3,003,428	Chili sauce, namely salsa.

OLE RAY'S	2,514,634	Sauces and spices.
JOSE OLE	2,510,986	Frozen Mexican entrees, consisting primarily of tortillas, rice and sauce; frozen Mexican foods, namely, burritos, taquitos, tacos, enchiladas, quesadillas, chimichangas, tamales and tortillas filled with meats, cheeses, vegetables, rice, beans and or sauce.
CASA OLÉ	2,489,885	Nachos, tacos, tortillas, enchiladas, chalupas, tamales, coffee, and tea.
CASA OLÉ FINER MEXICAN FOOD	2,489,884	Nachos, tacos, tortillas, enchiladas, chalupas, tamales, coffee, and tea.
CAFÉ OLÉ	2,645,987	Coffee.
FIDEO OLE'	1,841,976	Processed herbs and spices.
OLE SMOKY	1,249,192	Candies-Namely, Caramels, Fudge, Divinity, Nut Brittles, Pecan Log Rolls, Sugar Coated Pralines, Hard Candy Sticks and Drops, Chocolates, Caramel and Chocolate Covered Nuts.
OLE BARREL BRAND	553,966	Table syrup.
OLE SMOKY	720,401	Candies, [Shelled Nuts], Other Foodstuffs Containing Sugar and/or Coated with Sugar or Sugar-Containing Material-Namely, Coated Fruits or Portions of Fruits, as Represented by Chocolate Covered Cherries and Chocolate Covered Orange Peel; [Crystallized Fruits; Glaceed Fruits, Represented by Glaceed Cherries, Glaceed Apples and Glaceed Pecans; Spiced Nuts, as Represented by Spiced Pecans] [and Spreads, as Represented by] [Honey, Marmalades and Jellies].

Based on the number of registered trademarks set forth above (which are in Class 30, the same as Applicant's Mark) that have the word "OLE" or "OLÉ" in their mark, there is no

potential for confusion with the Opposer’s Mark. One of the relevant du Pont factors is the number and nature of similar marks on similar goods. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1701 (C.A.F.C. 1992); *Olde Tyme Foods Inc.*, 22 USPQ2d at 1545. Other registrations, in particular, of similar marks for similar goods is given substantial weight when determining the likelihood of confusion of a second party using an allegedly similar name. (*Century 21*, 23 USPQ2d at 1701; *Olde Tyme Foods Inc.*, 22 U.S.P.Q. at 1545.) The existence of similar marks on the same type of goods substantially reduces the potential for a likelihood of confusion. *Century 21*, 23 U.S.P.Q. at 1701.

The lack of distinctiveness of Opposer’s Mark is further evidenced by the various trademarks that are registered in Class 029 with the PTO and which are not owned by Opposer. 38 TTABVUE 141-183. Applicant relies on these registrations for the purposes of showing, *inter alia*: (i) the many third parties who use either OLE or OLÉ who sell goods in International Class 029 that are at least related to goods sold by the parties under similar trademarks; and (ii) the lack of a likelihood of confusion between Opposer’s and Applicant’s respective marks. Upon information belief, the Opposer has not petitioned to cancel any of these registrations.

Exh.	<u>TRADEMARK</u>	<u>REG. NO.</u>	<u>GOODS - CLASS 29</u>
1	OLE SOUTH	6,183,520	Bacon; Sausage meat; Sausages; Smoked sausages; Turkey sausages; Uncooked sausages.
2	OLÉ-O	5,909,146	Edible Oils.
3	OLÉ FRESCO LA BANDERITA AUTHENTIC	5,854,298	Cheese.
4	GOOD OLE JERKY	5,501,732	Kosher beef jerky.

5	OLE & STEEN	5,398,786	Frozen and dried fruits and vegetables, excluding such food products sold in bulk packages, and excluding baked and processed beans; eggs, milk and milk products namely, cheese, yogurt, curd, butter, cream, whipped cream, smetana, sour cream, custard-style yogurts; the aforementioned not in relation to Mexican food products.
6	TASTE THE FIESTA! JOSÉ OLÉ	3,110,852	frozen Mexican entrees consisting primarily of meats, cheeses, vegetables and/or refried beans.
7	JOSÉ OLÉ	2,628,945	Frozen Mexican entrees, consisting primarily of meats, cheeses vegetables and/or refried beans.
8	OLE' HENRY'S NUT HOUSE	2,825,750	Roasted and salted mixed nuts.
9	JOSE OLE	2,510,986	Frozen Mexican entrees, consisting primarily of meats, cheeses vegetables and/or refried beans.
10	CASA OLÉ	2,489,885	Milk, beef steak and chili con queso.
11	OLE CAROLINA BRAND	1,705,198	Bacon.
12	POTATO OLÉS	1,923,888	Cooked potatoes.
13	OLE IKES	1,856,863	Meat products and processed meat products; namely, sausage, hot link sausage, polish sausage, polish and cheddar sausage, and hot cheddar polish sausage with jalapeno peppers.

14	OLE SMOKY	720,401	Candies, [Shelled Nuts,] Other Foodstuffs Containing Sugar and/or Coated with Sugar or Sugar-Containing Material-, namely, Coated Fruits or Portions of Fruits, as Represented by Chocolate Covered Cherries and Chocolate Covered Orange Peel [; Crystallized Fruits; Glaced Fruits, Represented by Glaced Cherries, Glaced Apples and Glaced Pecans; Spiced Nuts, as Represented by Spiced Pecans] [and Spreads, as Represented by] [Honey, Marmalades and Jellies].
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The lack of distinctiveness of Opposer's Mark is further evidenced by the various trademarks that are registered in Class 043 with the PTO and which are not owned by Opposer. 38 TTABVUE 214-253. Applicant also relies on these registrations for the purposes of showing, *inter alia*: (i) the many third parties who use either OLE or OLÉ who sell goods in International Class 029 that are at least related to goods sold by the parties under similar trademarks; and (ii) the lack of a likelihood of confusion between Opposer's and Applicant's respective marks. Upon information belief, the Opposer has not petitioned to cancel any of these registrations.

Exh.	<u>TRADEMARK</u>	<u>REG. NO.</u>	<u>GOODS - CLASS 29</u>
1	ENCHILADA OLE'	6,665,355	Restaurant services.
2	OLE MOLE	5,987,374	Offering business management assistance in the establishment and/or operation of restaurants.

3	THE OLE DOG TAVERN	5,240,079	Beer garden services; Providing of food and drink; Restaurant services featuring pub fare, beer wine and liquor; Restaurant services, including sit-down service of food and take-out restaurant services.
4	OLE RED	5,927,529	Restaurant and bar services.
5	OLE RED	5,509,624	Restaurant and bar services.
6	TACOS OLÉ	5,605,590	Authentic Mexican restaurant; Providing of food and drink via a mobile truck; catering services, mobile catering, outside catering services, and catering services for providing authentic Mexican cuisine.
7	OLÉ MEXICAN GRILL	5,511,596	Restaurant services.
8	OLE RED	5,324,922	Restaurant and bar services.
9	OLE & LENA'S PIZZERIA	4,367,862	Restaurant and café services; Restaurant services; Restaurants featuring home delivery.
10	OLE & STEEN	5,398,786	Providing of food and drink.
11	OLÉ FOR JOSÉ'S	3,285,774	Restaurant and bar services.
12	FIESTA OLÉ	2,947,761	Restaurant services.
13	CAFÉ OLÉ	3,840,143	Café and restaurant services offering Southwestern style cuisine.

The tables above lists the registered trademarks that have the word “OLE” or “OLÉ” in their mark. Some of these trademarks may be utilizing the word “OLE” as an abbreviation for “OLD” and not pronounced the same as “OLÉ”. Likewise, some of these trademarks appear to be use “OLE”, without the accent mark, but are nevertheless pronounced the same as OLÉ (i.e., the CAFÉ OLE and JOSE OLE marks). However, it is clear that a

number of the trademarks listed in the table above are utilizing OLÉ in the same manner as being utilized in the Opposer's Mark and the Applicant's Mark and for goods that are related, if not the same, as the Opposer's goods. These marks and the associated goods are set forth below:

- 1) OLÉ HOT'N FRUITY for sauces, namely, hot sauces (specimen indicates used for Mexican-style foods).
- 2) GOURMET OLÉ for Mexican-style foods, namely, burritos.
- 3) TASTE THE FIESTA! JOSÉ OLÉ for frozen Mexican entrees consisting primarily of tortillas, rice and sauce; frozen Mexican foods, namely, burritos, taquitos, tacos, enchiladas, quesadillas, chimichangas, tamales, and tortillas filled with meats, cheeses, vegetables, rice, beans and/or sauce.
- 4) JOSÉ OLÉ for frozen Mexican entrees, consisting primarily of tortillas, rice and sauce; frozen Mexican foods, namely, burritos, taquitos, tacos, enchiladas, quesadillas, chimichangas, tamales; and tortillas filled with meats, cheeses, vegetables, rice, beans and/or sauce.
- 5) SANTA FE OLÉ for chili sauce, namely salsa.
- 6) JOSE OLE for frozen Mexican entrees, consisting primarily of tortillas, rice and sauce; frozen mexican foods, namely, burritos, taquitos, tacos, enchiladas, quesadillas, chimichangas, tamales and tortillas filled with meats, cheeses, vegetables, rice, beans and or sauce.
- 7) CASA OLÉ for nachos, tacos, tortillas, enchilladas, chalupas, tamales, coffee, and tea.
- 8) CASA OLÉ FINER MEXICAN FOOD for Nachos, tacos, tortillas, enchiladas, chalupas, tamales, coffee, and tea.

8) FIDEO OLE' for processed herbs and spices (specimen indicates for Mexican-style foods).

As stated above, in addition to the foregoing, there are a number of trademarks in Class 30 that utilize OLÉ in the mark, but are not or at least do not appear to be directly related to the Mexican-style foods associated with the Opposer's Mark. For instance, the following trademarks use OLÉ (or OLE that appears to be pronounced the same as OLÉ) for goods that can be enjoyed with or after Mexican-style foods:

- 1) A-MAZE-ING OLÉ for popped popcorn.
- 2) CAFÉ OLE for coffee (Reg. No. 4,839,308).
- 3) CAFÉ OLÉ for ready-to-drink coffee-based beverages (Reg. No. 3,769,282).
- 4) CAFÉ OLÉ for coffee (Reg. No. 2,645,987).

Due to the frequency with which the term OLÉ is incorporated into marks for Mexican-style foods and other foods and other related goods and services, consumers are accustomed to encountering the term and using peripheral cues to distinguish one product from another. *See Miles Labs, Inc. v. Naturally Vitamin Supplements, Inc.*, 1 U.S. P.Q.2d 1445, 1462 (T.T.A.B. 1986). More specifically, the widespread use of the term OLÉ (or OLE) in marks shows that consumers have been conditioned to look at other elements of the mark as the means of distinguishing the source of goods. *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559, 1565-1566 (T.T.A.B. 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.”) Although the marks set forth above that use OLÉ for or with Mexican-

style foods are all nearly identical, there is no evidence of any confusion that these goods originate from the same source or that confusion has occurred or is likely to occur in the future. Like Applicant's Mark, the marks that are being utilized in Class 30 for or with Mexican-style foods all have an additional word that is being utilized with the OLÉ that is Opposer's Mark. Most of these are much more commonly utilized and, therefore, significantly less distinctive than the made-up word CHAMOYLE (i.e., "Hot'N Fruity", "Gourmet", "Taste the Fiesta", "José", "Santa Fe", "Casa" and "Finer Mexican Food"). In addition, at least some of the trademarks in Class 30 for Mexican-style foods have registration dates that pre-date the registration of the Opposer's Mark (i.e., at least the JOSE OLE, CASA OLÉ, CASA OLÉ FINER MEXICAN FOOD and FIDEO OLE' marks). In light of the above, the sixth du Pont factor supports Applicant's position that there is no likelihood of confusion between Applicant's Mark and the Opposer's Mark.

4. The Remaining Du Pont Factors Do Not Support Denying Registration of Applicant's OLÉ CHAMOYLE Mark

The Opposer suggests that the *du Pont* factors not specifically discussed above favor a finding of a likelihood of confusion. The Applicant disagrees with this conclusion. The other du Pont factors include the channels of trade (Factor #3) and the relative sophistication of the consumers (Factor #4). Although Applicant's goods can be utilized with Mexican-style food (as well as other styles of food and beverages), it is not clear at all that the goods will move in the same channels of trade due to the fact that Applicant's goods are "packaged combinations consisting of chamoy and chile lime seasoning in separate compartments" than the Opposer's separately packaged and sold Mexican-style foods. In addition, Applicant's goods are likely to

be distributed through channels of trade that are directed to persons wanting to “spice up” their food or beverage, due to the nature of the compartmentalized packaging, as opposed to purchasing Mexican-style food products. With regard to the sophistication of the consumers, Applicant has no information who the consumers are or will be for Applicant’s goods and the Opposer’s goods. Applicant does not believe that the Opposer can definitively opine on this factor as well. With regard to either factor, the Applicant considers the various OLÉ trademarks set forth above to be much closer, if not exactly the same, channels of trade and level of sophistication than for Applicant’s goods. In light of the various other OLÉ trademarks, the channels of trade and sophistication of the consumers has little to no impact on whether there is or is not (as Applicant believes) a likelihood of confusion between the parties’ marks.

With regard to du Pont factors #7, #8, #10, #11, #12 and #13, the Opposer makes quick mention of these factors near the end of its Trial Brief. While Applicant does agree that there has been no actual confusion (factor #7) and the time of concurrent use (factor #8) is relatively low and not widely an impact, Applicant does believe that there is not likely to be any confusion between the Opposer’s Mark and the Applicant’s Mark. This is particularly true when, as here, there are a number of marks that use the OLÉ word for goods which are much more closely related to the Opposer’s goods than are the Applicant’s goods. In light of the difference between the goods, the Applicant believes that there is not likely to be any direct market interface between the Applicant and the Opposer (factor #10). With regard to the extent which Applicant has the right to exclude others from use of its mark on its goods (Factor #11), the Applicant has created the previously non-existing word CHAMOYLE to use as part of its Applicant’s Mark and will seek to prevent others from using CHAMOYLE in conjunction with

similar goods. In addition, the packing system for Applicant's goods are believed to be unique and were the subject of a patent application pending before the USPTO. Despite the statement by Opposer in its Brief that the extent of potential confusion (factor #12) is "substantial", there is no evidence supports this claim and that in light of the other existing OLÉ marks (as set forth above), it is unlikely that Applicant's goods and Applicant's Mark will result in any "substantial" potential confusion. Factor #13 regarding any other facts appear to be covered in the discussion that is set forth above.

VI. CONCLUSION

The various du Pont factors that are most relevant to the determination of the present Opposition strongly favor the Applicant. In particular, the Applicant's Mark and the goods associated therewith are dissimilar to Opposer's Mark and Opposer's goods and the common usage and registered trademark use of OLÉ for goods similar to those of the Opposer support registration of Applicant's Mark. As such, the Applicant's Mark is not likely to cause confusion, mistake or deception with regard to the Opposer's Mark. In light of the foregoing, the Applicant respectfully requests the Board to find in favor of the Applicant and allow the Applicant's Mark to move forward to registration and for such other and further relief the Board deems just.

Dated: March 13, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE BY EMAIL

I hereby certify that a true and complete copy of the foregoing APPLICANT'S TRIAL BRIEF has been served on Opposer by emailing a copy to Opposer's attorney of record on March 13, 2023 to Paul S. Owens, Esq. (email: psowens@bellsouth.net).

Signature: /Richard A. Ryan/ Dated: March 13, 2023
Richard A. Ryan, Esq. (PTO Reg. #39,014)