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Mailed: October 20, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

El Encanto, Inc. d/b/a Bueno Foods
v.
La Tortilla Factory Inc.

Opposition No. 91159343
to application Serial No. 76422163
filed on June 17, 2002

Paul Adams of Peacock, Myers & Adams, P.C. for El Encanto, Inc. d/b/a Bueno Foods.

William J. Arnone, Jr. of Merrill, Arnone & Jones, LLP for La Tortilla Factory Inc.

Before Seeherman, Hairston and Walsh, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

La Tortilla Factory Inc. has filed an application to register the mark SOY BUENO (in standard character form) for "tortillas."[1]

Registration has been opposed by El Encanto, Inc. d/b/a Bueno Foods on the ground that applicant's mark, when

[1] Serial No. 76422163, filed on June 17, 2002, which is based on a bona fide intention to use the mark in commerce. The application contains the statement that "The English translation of 'SOY BUENO' is 'I am good.'"

applied to applicant's goods, so resembles opposer's previously used and registered marks, shown below, for the goods identified in the respective registrations, as to be likely to cause confusion under Section 2(d) of the Trademark Act.[2]

1) Registration No. 1,538,311 for the mark shown below for tortillas. The word "BUENO" is disclaimed.

2) Registration No. 2,374,448 for the mark BUENO (in standard character form) for a variety of Mexican foods including corn tortillas, blue corn tortillas, and flour tortillas. The registration issued under Section 2(f).

3) Registration No. 2,190,265 for the mark shown below for tortillas. The registration includes a Section 2(f) claim with respect to the word "BUENO"; a statement that "The English translation of 'BUENO' is 'GOOD'"; and a disclaimer of the wording "Since 1951."

[2] Opposer pleaded ownership of several other marks. However, in its brief on the case, opposer argued its claim of likelihood of confusion only with respect to the above marks. Thus, we have not listed the other marks or given them any consideration.

Applicant, in its answer, has denied the salient allegations set forth in the notice of opposition. As an affirmative defense, applicant asserts that "opposer's rights in its mark are of a narrow or limited scope because the mark is weak and because of numerous third party uses of similar marks." (Paragraph 15).

Evidentiary matters

At the outset, we must discuss several evidentiary matters. Accompanying opposer's notice of opposition are photocopies of opposer's pleaded registrations Nos. 1,538,311; 2,190,265; and 2,374,448 submitted pursuant to Trademark Rule 2.122(d). Applicant has objected to the photocopies of the registrations, arguing that they are not admissible evidence because they do not show the current status of and title to the registrations. Under Trademark Rule 2.122(d), the original or photocopy of a pleaded registration submitted with a notice of opposition will be received in evidence and made part of the record if it "[shows] both the current status of and current title to the registration." Inasmuch as the photocopies of Registration Nos. 1,538,311 and 2,374,448 do not show current status and title, and opposer has not submitted any further documentation issued by the PTO as to the status and title of these registrations, applicant's objections to these

registrations are well taken.[3] Such registrations do not comply with Rule 2.122(d), and are not part of the record in this proceeding. However, insofar as the photocopy of Registration No. 2,190,265 is concerned, opposer also, with its notice of reliance, submitted a photocopy of the Notice of Acceptance of the affidavit of use which was issued by the PTO on July 29, 2004. Because the Notice shows that during the pendency of this proceeding the registration was current and owned by opposer, we find that together the photocopy and the Notice of Acceptance satisfy the requirement that the copy of the registration show current status and current title. Thus, applicant's objection to this registration is overruled and the registration is accordingly considered part of the record in this proceeding.

Accompanying opposer's brief on the case is the affidavit (with exhibits) of Monica Camarillo. Applicant objected to the affidavit and exhibits on the ground that such evidence was not properly made of record. Opposer

[3] Moreover, these two registrations issued too far in advance of the filing of the notice of opposition to show current status and current title.

subsequently withdrew the affidavit and exhibits, and we have given them no consideration.[4]

As "evidence" that opposer has been involved in other proceedings before the Board, applicant requests, in its brief on the case, that the Board take judicial notice of several terminated oppositions in which opposer was plaintiff, as well as the applications involved therein. Opposer does not object to the Board taking judicial notice of the proceedings and the applications, and indeed maintains that the proceedings demonstrate that opposer is the owner of the registrations pleaded in the notice of opposition herein. Although the parties have agreed that the Board may take judicial notice of these proceedings, the records were not submitted, so we cannot treat them as stipulated evidence. In any event, opposer may not rely on prior proceedings in which it was the plaintiff to establish that it is the owner of the registrations pleaded herein.

Finally, each party has submitted, under notice of reliance, the adverse party's answers to requests for production of documents and things. While there is no provision in the Trademark Rules of Practice for filing

[4] We should add that applicant's objection is well taken. A party may not submit testimony by affidavit unless the adverse party has stipulated thereto. Also, exhibits and evidentiary materials attached to a party's brief can be given no consideration unless they were properly made of record during the party's testimony period.

answers to requests for production of documents and things under notice of reliance, we deem the parties as having stipulated to the submission of the answers.

The record therefore consists of the pleadings; the file of the opposed application; and opposer's pleaded Registration No. 2,190,265. Opposer submitted, under notice of reliance, applicant's answers to opposer's interrogatories and requests for production of documents and things; opposer's own answers to applicant's interrogatories[5]; a copy of the file history of the opposed application[6]; and, as previously noted, a copy of the Notice of Acceptance of the affidavit of use for Registration No. 2,190,265. Applicant submitted, under notice of reliance, opposer's answers to applicant's interrogatories and requests for production of documents and things; dictionary excerpts for the words "bueno" and "soy;" and copies of third-party registrations for marks that include the word BUENO (BUENA). Neither party took testimony.

Opposer and applicant filed briefs on the case; neither party requested an oral hearing.

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[5] A party normally may not rely on its own answers to interrogatories. However, applicant did not object thereto, and indeed submitted the identical materials with its notice of reliance.

[6] This is superfluous inasmuch as the file of the opposed application is automatically part of the record, without any action by either party.

Standing and Priority

The photocopy of opposer's pleaded Registration No. 2,190,265 along with the Notice of Acceptance of the affidavit of use show that the registration is valid and is owned by opposer. In view thereof, we find that plaintiff has established its standing to bring the opposition. Moreover, priority is not at issue with respect to the mark and goods in this registration. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). However, opposer failed to make its pleaded Registration Nos. 1,538,311 for the mark BUENO and design and 2,374,448 for the mark BUENO properly of record. Moreover, opposer failed to take testimony in order to establish prior proprietary rights in these marks. See Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).[7] Opposer's answers to applicant's interrogatories and requests for production of documents are insufficient to establish such rights. As the plaintiff in this proceeding, it was incumbent upon opposer to submit evidence to demonstrate its prior proprietary rights in

[7] As discussed infra, the word "bueno" is laudatory. Where an opposer is relying on an unregistered mark that is not inherently distinctive, the opposer must show that the mark had become distinctive of its goods prior to applicant's first use of its mark or, in the case of an intent-to-use applicant, the filing date of the application.

these pleaded marks. Opposer failed to meet its burden in this regard with respect to the marks in Registration Nos. 1,538,311 and 2,374,448, and thus cannot prevail on its claim of likelihood of confusion based on these marks.[8]

Likelihood of Confusion

The only issue to be determined, therefore, is whether applicant's mark SOY BUENO, if used in connection with tortillas, so resembles opposer's mark in Registration No. 2,190,265 for tortillas, that confusion as to the source or sponsorship of the parties' products is likely.

As indicated, neither party took testimony. Thus, the only information we have about the parties comes from each party's answers to the adverse party's interrogatories and requests for production of documents and things.

Opposer is a manufacturer and distributor of Southwestern food products and services. (Opposer's answer to Interrogatory No. 4). Opposer sells its products nationwide to distributors, grocers, restaurants and other food service businesses and sells directly to consumers by mail order and the Internet. (Opposer's answer to Interrogatory No. 19). Opposer advertises on television and

[8] We note that in response to applicant's Document Request No. 1, opposer stated that it adopted its BUENO mark in 1951. However, it is not clear from this response which of the pleaded BUENO marks opposer adopted in 1951. As noted, it is opposer's burden to prove prior proprietary rights in each of the pleaded marks and we will not assume that this response related to all three of the pleaded marks.

radio, on billboards, in magazines and newspapers, and at point of purchase in restaurants and grocers. (Opposer's answer to Interrogatory No. 14).

Applicant has not begun use of the mark SOY BUENO. (Applicant's answer to Interrogatory No. 1). With respect to its adoption of the SOY BUENO mark, applicant states:

> Applicant's development of low calorie and low carbohydrate tortillas and its use of soy base products suggested to its executive staff that use of a product name incorporating the word "SOY" would be appropriate. Addition of the Spanish language word "BUENO" was deemed appropriate given the popularity of Applicant's products among the Spanish speaking community, and because of the play on words arising from the fact that the words "SOY BUENO" mean "I am good" in the Spanish language.

(Applicant's answer to Interrogatory No. 11).

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.

Considering first the goods, they are obviously identical. Although applicant argues that it intends to sell soy tortillas which are different from the corn and flour tortillas marketed by opposer, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods recited in opposer's registration, rather than what the goods are asserted or shown to actually be. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Here, the goods recited in applicant's application and in opposer's registration are simply tortillas.[9] Further, we must presume that the parties' goods would travel in all the normal channels of trade for goods of this type, e.g., grocery stores and convenience stores, and that they would be purchased by the same class of customers, namely ordinary consumers.

Applicant's argument that tortillas are bought by sophisticated purchasers who exercise a high degree of care in purchasing such goods is not persuasive. Apart from the fact that applicant has offered no support for

[9] We should add that even if the goods recited in applicant's application were soy tortillas and the goods recited in opposer's registration were corn and flour tortillas, such goods would still be highly related.

this argument, it is common knowledge that tortillas are inexpensive food items. Sales of tortillas may often be subject to impulse purchasing.

Notwithstanding the identity of the goods, trade channels and purchasers, in this case, opposer's mark and applicant's mark are so significantly different in sound, appearance, meaning and commercial impression that there is no likelihood of confusion.

Initially, we find that in applicant's mark, shown below, the dominant feature is the word GRANDMA'S.

This is because the word GRANDMA'S is in large, bold lettering, which stands out in sharp contrast to the wording FROM OUR FAMILY TO YOURS SINCE 1951 and BUENO in smaller non-distinct lettering. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) [It is not improper to give more or less weight to a particular feature of mark].

Further, because purchasers are likely to use GRANDMA'S when referring to or calling for opposer's goods, the design does not create a strong commercial impression. See In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). [The word portion of a mark comprised of both a word and a design is normally accorded greater weight because it would be used by purchasers to request goods]. As a result of the dominant role that GRANDMA'S plays in opposer's mark, the marks in their entireties are different in appearance and pronunciation.

In terms of meaning, applicant's mark translates as "I am good," and also is a play on the word, "soy," the product from which applicant's tortillas will be made. Opposer's mark, on the other hand, due to the dominant word "GRANDMA'S," connotes tortillas from Grandma or Grandma's recipe. Thus, the marks differ in connotation.

Lastly, we find that, because of the various differences discussed above, the overall commercial impressions of the marks differ.

In finding that the marks in their entireties are dissimilar, we have not overlooked that the marks share the term "BUENO." However, the mere inclusion of this word in both parties' marks is an insufficient basis to

find that the marks, in their entireties, are similar. As evidenced by opposer's Section 2(f) claim and the meaning of "bueno" as "good" in English[10], the word is highly laudatory as used in connection with tortillas. The third-party registrations made of record by applicant corroborate the laudatory significance of the word as used in connection with Mexican-style food.[11]

In sum, we find that confusion is unlikely to result from contemporaneous use of opposer's mark and applicant's mark, even where the marks are used on identical goods marketed in the same trade channels to the same class of purchasers. We find that the dissimilarity of the marks simply outweighs the other relevant du Pont factors. See e.g., Kellogg Co. v. Pack-Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1889), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The opposition is dismissed.

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[10] Applicant submitted the following excerpt from Vox Compact Spanish and English Dictionary (Second Edition):

bueno,-a: good

[11] For example, the mark QUE BUENO is registered for Mexican foods, sauces and spices; ROGELIO BUENO is registered for Mexican sauces and flour tortillas; BUENO CHILADA is registered for Mexican-style food; BUENO SIZE is registered for restaurant services; and BUENO EXPRESS is registered for restaurant services.