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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

Mailed: November 30, 2006

Cancellation No. 92043837

Edward R. Acosta

v.

Barmar, LLC

Before Quinn, Rogers and Cataldo,
Administrative Trademark Judges

By the Board:

Barmar, LLC ("respondent") has obtained a registration for the word mark LA PALAPA for "restaurant and bar services" in International Class 43.¹

Edward R. Acosta ("petitioner") filed a petition to cancel on the ground that respondent's mark is likely to cause confusion with his previously used word mark LAS

¹ Registration No. 2794784, issued December 16, 2003, and reciting November 24, 2001 as the date of first use and date of first use in commerce. The involved registration matured from application Serial No. 78176411, which was filed on October 21, 2002, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a).

"La" is a Spanish singular form of the English word "the," while "palapa" is a Spanish word that means "palm roof." *The Collins Spanish Dictionary* (6th ed. 2000). In addition, a "palapa" is defined as "a traditional Mexican shelter roof with palm leaves or branches. . . a structure, esp. on a beach, of similar kind." *The New Oxford American Dictionary* 1230 (2001). We hereby take judicial notice of these dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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PALAPAS for "restaurant, catering, and prepared take-out services."² Respondent, in its answer, denied the salient allegations of the petition to cancel and asserted affirmative defenses.

On September 13, 2005, respondent filed a motion for summary judgment on the unpleaded affirmative defenses that petitioner has no standing in this case and is not the proper party plaintiff herein. After full briefing of that motion, the Board, in a May 16, 2006 order, denied that motion, stating that petitioner has demonstrated "a plausible claim of rights" in the pleaded mark.³ May 16, 2006 order at 3.

² "Las" is a Spanish plural form of the English word "the." *Cassell's Spanish Dictionary* (1959). We take judicial notice of this dictionary definition. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., supra*.

Although not stated expressly in the petition to cancel, petitioner's claim is made under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

Petitioner also alleged in the petition to cancel that registration of the involved mark would cause "dilution of the distinctive quality of" his pleaded mark. However, petitioner did not allege in the petition to cancel that his pleaded mark became famous prior to the filing date of the application that matured into respondent's involved registration and/or respondent's first use of its involved mark. See *Toro Co. v. Torohed, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, petitioner did not properly plead a dilution claim in this proceeding. Based on the foregoing, we will treat the petition to cancel as setting forth a Section 2(d) claim only.

³ In respondent's brief in support of its motion for summary judgment, respondent contended that petitioner's application Serial Nos. 76514282 and 76514283 for the marks LAS PALAPAS and design and LAS PALAPAS in standard character form, both for "[r]estaurant, catering, and prepared take-out food services" in International Class 43, were refused registration on the ground of likelihood of confusion with six applications that respondent

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This case now comes up for consideration of petitioner's motion (filed August 7, 2006) for summary judgment on his Section 2(d) claim. The motion has been fully briefed.

As an initial matter, we note that petitioner's reply brief is eleven pages long and thus exceeds the ten-page limit for reply briefs in connection with motions in Board *inter partes* proceedings. See Trademark Rule 2.127(a). Accordingly, petitioner's reply brief has received no consideration in our decision.

In support of his motion for summary judgment, petitioner alleges that he began operating his first restaurant under his pleaded mark as a sole proprietorship in 1981; that he subsequently opened and operated several additional restaurants under his pleaded mark as a sole proprietorship; that, on January 28, 1993, he was granted

previously filed, and that one of those six applications matured into the registration which is involved in this proceeding.

Exhibits to petitioner's brief in response to the motion for summary judgment include copies of USPTO records of petitioner's two applications, obtained from the Trademark Electronic Search System (TESS). A review of those copies indicates that petitioner's two applications were filed on May 15, 2003, i.e., more than sixteen months prior to the filing of petitioner's petition to cancel. However, petitioner did not rely upon those applications in the petition to cancel as bases for his standing to maintain this proceeding, and petitioner did not rely on his applications to establish his standing in response to respondent's motion for summary judgment. Further, petitioner has not sought leave of the Board to amend his petition to cancel to rely upon those applications as a basis for his standing herein, and the Board, in denying respondent's motion for summary judgment, did not deem the petition to cancel to have been

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Texas Registration No. 052410 for the involved mark;⁴ that, in 1985, he created Las Palapas de San Antonio, Inc. ("San Antonio, Inc."), a Texas corporation of which he was the sole shareholder, to oversee restaurants operated under the involved mark; that he authorized San Antonio, Inc. to use the pleaded mark in connection with the pleaded services, but at all times retained control of the goods and services offered thereunder; that, in 2001, he converted San Antonio, Inc. to Las Palapas de San Antonio, Ltd. ("San Antonio, Ltd."), a Texas limited liability company; that he was and is the sole member of L.P. ERA 1, LLC ("ERA"), the general partner of San Antonio, Ltd.; and that he authorized San Antonio, Ltd. to use the pleaded mark in connection with the pleaded services, but at all times retained control of the goods and services offered thereunder. Petitioner further alleges that, as his restaurants flourished, he became convinced that franchising was his next logical step; that, in 1997, he formed Las Palapas Enterprises, Inc.

("Enterprises"), a Texas corporation of which he was and is the sole shareholder; that he authorized Enterprises to use the pleaded mark in connection with the pleaded services,

amended by agreement of the parties. See TBMP Section 528.07(a) (2d ed. rev. 2004).

⁴ Petitioner's brief in support of his motion for summary judgment refers to Texas Registration No. "5241017." In view of the copy of Registration No. 052410 that was submitted in support

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but at all times retained control of the goods and services offered thereunder; that, in 1997, he also formed Las Palapas Franchises Ltd. ("Franchises"), a Texas limited liability company with Enterprises as the general partner; that petitioner authorized Franchises to use the pleaded mark in connection with the pleaded services, but at all times retained control of the goods and services offered thereunder; that, through various franchising agreements that petitioner authorized, Franchises licensed use of the pleaded mark in connection with the pleaded services and at all times retained control of the goods and services offered thereunder; and that, since 1999, use of the involved mark in connection with the involved services has expanded through a franchising system through which petitioner retains control. In addition, petitioner contends that there are currently thirteen restaurants open under the pleaded mark, eight of which were in operation prior to the filing date of the application that matured into respondent's involved registration and/or respondent's first use of its involved mark. Accordingly, petitioner contends that petitioner has standing to maintain this proceeding; that petitioner is the senior user of his pleaded mark; that the marks at issue are substantially identical and convey substantially the same commercial impression; that the marks

of petitioner's motion, we presume that the reference to Texas

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are used in connection with substantially identical services; that the services are provided to the same class of consumers in the same channels of trade; and that services provided under the marks at issue are relatively inexpensive and subject to impulse buying. Based on the foregoing, petitioner contends that his motion for summary judgment should be granted and that respondent's involved registration should be cancelled.

As evidentiary support for his motion for summary judgment, petitioner has included a declaration of his attorney, Michael A. Moreno, which introduces the following evidence: 1) a copy of Texas Registration No. 052410 for the mark LAS PALAPAS and design; 2) a copy of the articles of conversion of San Antonio, Inc. to San Antonio, Ltd.; 3) a copy of the articles of organization for ERA; 4) a copy obtained from the TESS database of the USPTO's record for application Serial No. 76514283 for the word mark LAS PALAPAS; 5) a copy obtained from the TESS database of the USPTO's record for application Serial No. 76514282 for the word mark LAS PALAPAS and design; and 6) copies of excerpts from petitioner's and respondent's Internet websites.

As additional support for his motion for summary judgment, petitioner has included his declaration. Therein, petitioner attests that he has used the pleaded mark in

Registration No. "5241017" is a typographical error.

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connection with the pleaded services since 1981; that he commenced franchising of restaurants under the involved mark in 1997; that he has controlled the nature and quality of goods and services sold under the mark; and that there are currently thirteen restaurants open under the pleaded mark, all of which are located in San Antonio, Texas.

Petitioner's declaration introduces the following evidence:

1) a copy of the articles of incorporation for San Antonio, Inc.; 2) a copy of the articles of incorporation for Enterprises; 3) copies of newspaper and magazine articles from 1981, 1994, and 1997 concerning his restaurants; 4) a copy of a television advertisement contract from 2000 between Enterprises and KMOL-TV, a San Antonio, Texas television station; and 5) a copy of a renewal application for Texas Registration No. 052410 for the mark LAS PALAPAS and design.

In response to petitioner's motion, respondent contends that genuine issues of material fact remain with regard to ownership of petitioner's pleaded mark.⁵ Accordingly, respondent asks that the motion for summary judgment be denied.

Summary judgment is an appropriate method of disposing of a case in which there are no genuine issues of material

⁵ Respondent submitted no evidence in support of its brief in response.

fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F. 2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In

general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 941, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

As a party moving for summary judgment on his Section 2(d) claim, petitioner must establish that there is no genuine dispute that 1) he has standing to maintain this proceeding; 2) that he is the prior user of his pleaded mark; and 3) that contemporaneous use of the parties' respective marks for their respective services would be likely to cause confusion, mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

We turn to whether there is a genuine issue of material fact as to petitioner's standing to maintain this proceeding.⁶ The starting point for a standing

⁶ Contrary to petitioner's assertion, the Board did not determine in the May 16, 2006 order that petitioner has standing to maintain this proceeding. Rather, the Board found that "respondent has failed to establish that there are no genuine issues of material fact regarding its assertion that petitioner has no standing, so that the petition should be denied and the case dismissed without trial." May 16, 2006 order at 3. Had the Board determined in that order that petitioner has standing to maintain this proceeding, the Board could have entered partial summary judgment in petitioner's favor on the issue of standing, notwithstanding that it was not the moving party on the earlier motion. The Board did not, however, do so.

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determination in a cancellation proceeding is Trademark Act Section 14, 15 U.S.C. Section 1064, which provides, in relevant part, that "[a] petition to cancel a registration of a mark, stating the grounds relied upon, may ... be filed as follows by any person who believes that he is or will be damaged... by the registration of a mark on the principal register...." Thus, Section 14 establishes a broad class of persons who are proper petitioners; by its terms, the statute only requires that a person have a belief that he would suffer some kind of damage by the continued registration of the mark. However, in addition to meeting the broad requirements of Section 14, a petitioner must have a real interest in the proceeding, i.e., a personal interest in the outcome of the proceeding, and must have a reasonable basis for a belief of damage. There is no requirement that actual damage be established to prove standing or to prevail in a cancellation proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Based on the foregoing, we find that the evidence of use of the LAS PALAPAS mark by petitioner and his related entities, in connection with his pleaded services, is sufficient to establish that there is no genuine issue of material fact that petitioner has a real interest in the proceeding and has a reasonable basis for a belief of

damage.⁷ Accordingly, there is no genuine issue of material fact regarding petitioner's standing to maintain this proceeding.

We turn next to the issue of whether there is a genuine issue of material fact regarding petitioner's asserted priority of use. To establish priority on a likelihood of confusion ground brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. Section 1052. A plaintiff may establish its own prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites, if sufficient to create a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act Sections 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d

⁷ The fact that respondent's involved registration was cited as a basis for a refusal of registration to petitioner's pending applications would be sufficient to confer upon petitioner standing to seek cancellation of respondent's registration for the registered mark. See *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); TBMP Section 309.03(b) (2d ed. rev. 2004). Although petitioner did not allege in the petition to cancel that respondent's involved registration was so cited, we deem the pleadings amended to rely thereupon. See TBMP Section 528.07(a) (2d ed. rev. 2004).

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1879 (Fed. Cir. 1996), vacating *PacTel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

Petitioner has established that there is no genuine issue of fact regarding his priority of use and that he and his related entities used his pleaded LAS PALAPAS mark prior to the October 21, 2002 filing date of the application that matured into the involved registration.⁸ Specifically, with regard to petitioner's use of his marks, petitioner has established, through his declaration, that he made his first actual use of the LAS PALAPAS mark in 1981, when he opened his first restaurant under the LAS PALAPAS mark, and has continuously used the mark since then. Petitioner's declaration is internally consistent and not characterized by uncertainty. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, *supra* at 1736. In addition, respondent has not challenged the veracity of petitioner's testimony.

Although respondent contends that petitioner has failed to establish ownership of the pleaded mark, petitioner's declaration indicates that petitioner has at all times retained control of the goods and services offered under his

⁸ The dates of use alleged in the application that matured into the involved registration are not evidence of such use, nor are the specimens of use in support of that application. See *Baseball America v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.10 (TTAB 2004). Inasmuch as respondent has submitted no evidence of use, it is entitled to rely only on the filing date of the underlying application as its constructive use date. See *id.* at 1847.

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pleaded mark by his various entities. Respondent has failed either to rebut petitioner's evidence or to raise a genuine issue concerning whether petitioner's mark functions as an indication of origin for petitioner's services. See *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985). Based on the foregoing, there is no genuine issue of material fact that petitioner is the prior user of his pleaded LAS PALAPAS mark.

Turning to the likelihood of confusion issue, two key factors are the degree of similarity of the parties' marks and the degree of similarity of their respective services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). As to the word marks at issue, LAS PALAPAS and LA PALAPA, the marks differ in that petitioner's mark is plural, whereas respondent's is singular. Nonetheless, when these marks are considered in their entireties, there is no genuine issue of material fact that they are substantially similar in sound, appearance, meaning and commercial impression. See *In re Appetito Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987); and *In re Pix of America, Inc.*, 225 USPQ 691, 692 (TTAB 1985) (pluralization of one of two involved marks found to be "almost totally insignificant in terms of the likelihood of confusion of purchasers").

With regard to the similarity of the services at issue, the question of likelihood of confusion must be determined

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based on an analysis of the services recited in respondent's registration vis-à-vis the services recited in petitioner's petition to cancel. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As such, the services identified in registrant's involved registration, i.e., "restaurant and bar services," are presumed to overlap with petitioner's services, which are shown by the evidence to be restaurant and catering services. Based on the foregoing, we find that petitioner has met his burden by supporting his motion with declarations and other evidence that establish his right to judgment.

Accordingly, the burden shifts to respondent to proffer countering evidence that establishes that there is a genuine factual dispute for trial, whether as to any of these aspects of petitioner's case, i.e., standing, priority and likelihood of confusion, or as to any affirmative defense respondent may have to petitioner's claim. However, respondent did not submit any evidence to show that there is a genuine issue of material fact for trial. In summary, considering the substantial similarity in sound, appearance, meaning, and commercial impression of the marks and the overlapping nature of the services, we find that there is no

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genuine issue of material fact and that confusion is likely to result.

In view thereof, petitioner's motion for summary judgment is granted. Judgment is hereby entered against respondent and the petition to cancel is granted. Registration No. 2794784 will be cancelled in due course.