

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB
JULY 15, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Molcasalsa Mexican Food International, Inc.
v.
Alberto Giraldo

—
Cancellation No. 21,244
—

Barry F. Soalt of Brown Martin Haller & McClain for
Molcasalsa Mexican Food International, Inc.

Mark G. Tratos of Quirk & Tratos for Alberto Giraldo.

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Before Quinn, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Molcasalsa Mexican Food International, Inc. has
petitioned to cancel the registration owned by Alberto
Giraldo for the mark "ALBERTO'S MEXICAN FOOD (and design)" as
shown below, for restaurant services.¹

¹ Registration Number 1,619,145, registered on October 23, 1990, for restaurant services in International Class 42. This application was filed with the U.S. Patent and Trademark Office on April 13, 1989, claiming first use dates of February 1, 1988. The words "World Famous Mexican Food" and "Chicken and Tacos" are disclaimed. The registration also states that the English translation of the term "Al Carbon" is "The Chicken."



As the ground for cancellation, petitioner alleges priority of use and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). Petitioner alleges that it is a rapidly growing franchiser having extensively used ALBERTOS as a service mark in the United States continuously since 1978.² Petitioner is also the owner of a trademark application for its service mark for "ALBERTOS and design," as shown below, for restaurant and restaurant carry out services.³

² Petitioner's service mark was first adopted and used by the founders of Albertos Mexican Food restaurants, Juan Diego Rodriguez and his brother, Alvaro Rodriguez, who owned the mark from 1978 to 1994 through a general partnership. After a change in the form of the restaurant chain's ownership in 1994, the partnership assets were assigned to Alberto's Mexican Food, Inc., which in turn assigned the mark to Molcasalsa in 1996. The Patent and Trademark Office assignment records confirm that the current owner of the service mark is Molcasalsa Mexican Food International, Inc.

³ Serial Number 74/244082, filed on February 7, 1992 for restaurants and restaurant carryout services, in International Class 42, claiming use since September 1978. This application was refused registration based upon the involved registration owned by respondent. Petitioner's application remains suspended pending the outcome of this cancellation proceeding.



In its answer to the petition to cancel, respondent denied the salient allegations, especially those regarding likelihood of confusion. Although respondent answered petitioner's requests for admission, requests for documents and interrogatories, respondent filed no testimony, evidence or brief. Petitioner has submitted the deposition testimony of Herbert E. Claudio, Vice President and Franchising Director of Molcasalsa Mexican Food International, Inc., along with attached exhibits. Petitioner has also relied upon respondent's answers to petitioner's requests for admission and requests for interrogatories, and relied upon respondent's responses to petitioner's requests for production of documents, under 37 C.F.R. §2.120(j)(8).⁴

⁴ For example, the following facts were obtained through discovery and were made of record by petitioner's First notice of Reliance, dated May 12, 1997:

- Respondent made the following admissions in response to Petitioner's Requests for Admission:
 - Respondent is unaware of any third-party U.S. registrations or pending applications for the term "ALBERTOS" in Class 42 for Mexican food restaurant services, other than the subject matter marks of the respective parties to this proceeding (Respondent's Response to Request for Admissions, No. 9);
 - Respondent admits that Mexican food and take out Mexican food is the food offered by Respondent's restaurants (Respondent's Response to Request for Admissions, Nos. 20 and 21).

Petitioner has also relied under 37 C.F.R. §2.122(e) upon a dozen different annual entries from the Pacific Telephone Yellow Pages Directory for San Diego, CA. Only petitioner filed a brief and an oral hearing was not requested. Based upon the record before us, we grant the petition to cancel.

As noted above, petitioner has taken the deposition testimony of Herbert E. Claudio, Vice President and Franchising Director of Molcasalsa Mexican Food International, Inc. Mr. Claudio's responsibilities ensure his familiarity with the history of petitioner and its predecessors, their marketing practices and the development of restaurant site locations, the operation of petitioner's successful franchising program, and the usage of the service mark and trade names. In fact, Mr. Claudio traced the entire history of petitioner's usage of these source indicators -- i.e., the trade names and service mark ("ALBERTOS" and "ALBERTOS MEXICAN FOOD") for restaurant services -- going all the way back to the adoption in 1978 by a predecessor in interest. In support of Mr. Claudio's testimony on this point, petitioner also relied upon an ever-increasing number of its franchise restaurants, each listed as "ALBERTOS MEXICAN FOOD." Specifically, petitioner's expanded presence in southern California from 1981 to 1994 was evidenced by year-to-year entries taken from the San Diego Yellow Pages. With testimony and evidence showing extensive and continuous use of this service mark since the late 1970's, petitioner's

use clearly precedes the filing date of respondent's registration (i.e., April 13, 1989). This is the earliest date to which respondent is entitled in the absence of any other evidence of use.

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), that sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

Under the first *du Pont* factor, we examine the similarities or differences in sound, appearance, meaning and overall commercial impression of the two marks.

Both marks share a single literal element (presented as "ALBERTO'S" or "ALBERTOS") that one would use in speaking the name of the restaurant. These words are substantially identical, differing only in that respondent's mark, in the possessive form, contains an apostrophe. In both cases, the restaurant name is presented in a scripted fashion, angled slightly upward from left to right.

In this case, it is appropriate to give greater weight to the common, verbal portion of the marks because it is by the word "ALBERTOS" that purchasers will remember and refer to the restaurant services of both parties.⁵ The words,

⁵ We agree with petitioner that the other wording in respondent's mark is less prominent than the word "ALBERTO'S" given its placement and relative size. Furthermore, given the

rather than the design features of the respective logos, will therefore have a greater impression on customers. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987) [Mark having the word "Appetito" in block letters, prominently displayed between broad geometric stripes of applicant's mark, as used on Italian sausages, likely to cause confusion with "Appetito's" printed in small script letters across a large capitalized letter "A" and "Appetito's Inc." with a large capitalized letter "A" and the design of a sandwich, for restaurant services].

Moreover, in considering these marks in their entirety, the similarities in the design portions of the respective marks actually enhances the likelihood of confusion. Accordingly, we turn next to a closer examination of the design elements in the respective marks. One can elicit any number of "discernable" differences after a studied comparison of these respective composite logos, and perhaps those differences might well be enough to distinguish one design from the other. See Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc., 177 USPQ 720 (TTAB 1973) and cases cited therein. Furthermore, reactions to the instant marks may well vary among a group of individuals as this kind of comparison can be quite subjective.

descriptive if not generic nature of this disclaimed matter, it has very little, if any, source-indicating significance.

However, the test to be applied in determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison, but rather whether the marks, as they are used in connection with the parties' services, so resemble one another as to be likely to cause confusion. Under actual marketing conditions, consumers do not necessarily have the opportunity to make side-by-side comparisons between marks. Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). The proper emphasis is thus on the recollection of the average customer, and the correct legal test requires us to consider the fallibility of human memory. The average purchaser normally retains a general rather than a specific impression of trademarks or service marks. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973) [the figure of a stooped, elderly man holding a cane and the words "G•R•A•N•D•P•A PIDGEON" v. the figure of a seemingly more spry but elderly man in a mark having no wording, both used with retail store services]; Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), affirmed in unpublished opinion, Appeal No. 92-1086 (Fed. Cir. June 5, 1992) ["SILVER SPOON CAFÉ" and "SILVER SPOON BAR & GRILL" for

"restaurant and bar services" v. "SPOONS," "SPOONBURGER," "SPOONS with cactus design," and "SPOONS within a diamond logo design"⁶; Envirotech Corp. v. Solaron Corp., 211 USPQ 724, 733 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

We conclude these marks, when considered in their entireties, have overriding similarities. Based upon the general impressions created by the respective marks, they are confusingly similar.

We turn next to the second du Pont factor, the relationship between the parties' services. Since both are restaurants serving Mexican food to eat on the premises or to take out of the establishment, these are obviously identical services.

As to the fourth du Pont factor (viz., the conditions under which sales are made and the type of buyers to whom they are made), it is noteworthy in reviewing the *a la carte* menus of both parties, that these fast-food items are quite inexpensive and are purchased with less than a great deal of care by ordinary consumers.

Turning to the sixth du Pont factor (i.e., the number and nature of similar marks in use on similar goods), respondent in its answer alleged that there are numerous



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and



third-party users of the name "ALBERTOS" for restaurants. However, inasmuch as respondent has put no evidence into the record of this proceeding, there is nothing in the record suggesting the name "ALBERTOS" is weak as applied to restaurant services. In fact, respondent later admitted that he is unaware of any third-party registrations or applications in the U.S. for the term "ALBERTOS" in Int. Class 42 for Mexican food restaurant services, other than the marks of the parties to this proceeding.⁷

Finally, we turn to the twelfth du Pont factor. As noted above in discussing petitioner's growth, arguably given the current pace of Molcasalsa's aggressive franchising operations, the extent of potential confusion, particularly in the Southwestern region of the United States of America, becomes more substantial each year as petitioner continues to push into contiguous and even overlapping geographical areas with respondent.

DECISION: We find a likelihood of confusion and hence grant the petition to cancel. Respondent's registration will be cancelled in due course.

T. J. Quinn

P. T. Hairston

⁷ See respondent's admissions contained in footnote 4, on page 3, *supra*.

Cancellation No. 21,244

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board