

THIS DISPOSTION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 24, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Taco John's Seasonings Limited Partnership
v.
Kenneth Walter Kniaz

Opposition No. 107,884
to application Serial No. 75/196,364
filed on November 12, 1996

Thomas S. Birney of Dorr, Carson, Sloan & Birney, P.C. for
Taco John's Seasonings Limited Partnership

Kenneth Walter Kniaz, pro se.

Before Seeherman, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On November 12, 1996, applicant filed an intent-to-use application by which he seeks registration of the mark TACO JONES for "restaurant services." The mark is depicted in typed form, and applicant has disclaimed the exclusive right to use TACO apart from the mark as shown.

Opposer filed a timely notice of opposition to registration of applicant's mark. As its ground of

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opposition, opposer alleged that applicant's mark, as used in connection with applicant's recited services, so resembles opposer's mark TACO JOHN'S, previously used and registered by opposer in connection with restaurant services and various food items, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant answered the notice of opposition by denying the allegations thereof which are essential to opposer's claim.

The evidence of record in this proceeding includes the pleadings, the file of the opposed application, the testimony deposition of one of the partners in opposer, Harold W. Holmes, and status and title copies of seven pleaded registrations which opposer has submitted under notice of reliance. Applicant submitted no evidence. Opposer, but not applicant, filed a brief on the case. Neither party requested an oral hearing.

The seven registrations made of record by opposer are as follows:

Registration No. 1,088,950 (issued April 4, 1978; §§8 and 15 affidavits accepted and acknowledged; renewed under §9), of the mark **TACO JOHN'S** in typed form (TACO disclaimed), for "flat filled and folded filled tacos and tortillas, enchiladas, burritos, tamales and chili";

Registration No. 1,617,184 (issued October 9, 1990; §§8 and 15 affidavits accepted and acknowledged), of the mark **TACO JOHN'S** in typed form (TACO disclaimed), for "restaurant services";

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Registration No. 1,627,389 (issued December 11, 1990; §§8 and 15 affidavits accepted and acknowledged), of the mark TACO JOHN'S in typed form (TACO disclaimed), for "fried potatoes, refried beans and garden salads for consumption on or off the premises; chimichangas, hamburger sandwiches, nachos, and prepared rice for consumption on or off the premises";

Registration No. 1,108,259 (issued December 5, 1978; §§8 and 15 affidavits accepted and acknowledged; renewed under §9), of the mark depicted below (TACO disclaimed), for "restaurant services";

Registration No. 1,631,765 (issued January 15, 1991; §§8 and 15 affidavits accepted and acknowledged), of the mark depicted below (TACO disclaimed), for "chili, fried potatoes, refried beans and garden salads for consumption on or off the premises; tacos, tortillas, enchiladas, burritos, tamales, chimichangas, hamburger sandwiches, prepared rice and nachos, for consumption on or off the premises";

Registration No. 1,885,666 (issued March 21, 1995), of the mark depicted below (TACO disclaimed), for "restaurant services";

Registration No. 1,974,209 (issued May 14, 1996), of the mark depicted below (TACO disclaimed), for "restaurant services."

It appears from the deposition transcript that the testimony deposition of opposer's witness Mr. Holmes took seven minutes to complete; applicant did not attend and was not represented at the deposition. In essence, Mr. Holmes testified that he is a partner in opposer; that opposer started business under the mark TACO JOHN'S in 1969, with carry out restaurants; that opposer's business grew over the years to include drive-thru restaurants and sit down restaurants; that opposer now has a chain of approximately 475 "quick service" restaurants located in twenty-nine states; and that opposer's restaurants carry about thirty items on their menus, including "everything in the Mexican line of food."

Because opposer has made status and title copies of its registrations of record, there is no dispute as to opposer's priority. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to be decided in this case is whether

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confusion is likely to result as between applicant's TACO JONES mark and opposer's TACO JOHN'S marks.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Applicant's recited "restaurant services" are legally identical to the "restaurant services" recited in several of opposer's pleaded registrations, and we find that they also are related to the food items identified in opposer's other registrations. We also find that applicant's and opposer's services, as recited in the application and the registrations, are marketed to the same classes of customers. These factors weigh in favor of a finding of likelihood of confusion.

We turn next to a consideration of the parties' respective marks. Applicant's TACO JONES mark and the literal portion of opposer's various TACO JOHN'S marks each begin with the word TACO, but that word is descriptive, if

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not generic, for the parties' restaurant services. It has been disclaimed by both parties and is entitled to relatively little weight in our analysis of the similarity of the marks. See *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *Taco Time International, Inc. v. Taco Town, Inc.*, 217 USPQ 268 (TTAB 1982). The remaining words in the parties' marks, i.e., JONES and JOHN'S, whether viewed alone or in combination with the word TACO, are quite dissimilar to and easily distinguishable from each other in terms of appearance and connotation.¹ One is the possessive case of a very common given name, i.e., John, while the other is a very common surname, i.e., Jones. Phonetically, JOHN'S and JONES are somewhat similar, but we are not persuaded that these two names are likely to be mispronounced in such a way as to create confusion.

Viewed in their entireties, TACO JOHN'S and TACO JONES are highly dissimilar in terms of their connotations and overall commercial impressions. Opposer's mark, which is in the possessive case, suggests, as applied to opposer's goods and services, that such goods and services are being offered by a person named John, whose nickname is the compound "Taco John." Applicant's mark, in contrast, is not presented in the possessive case, and if it suggests a person's name, it

¹ Opposer's Registration No. 1,974,209, see *infra* at p. 4, is further distinguishable from applicant's mark by the presence in the registered mark of the apparently coined word MEXPRESS.

suggests a person whose surname is Jones and whose given name or nickname is "Taco."²

In short, the only points of similarity between TACO JONES and TACO JOHN'S are their shared use of the disclaimed

² Additionally, it is possible that applicant's mark is not meant to be and would not be perceived as suggesting a name at all. Rather, the mark might be perceived to be using the word "jones" in its slang sense, meaning "any sort of habit, habitual craving, or fixation, usu. regarded as perverse or consuming; yen." J. E. Lighter, Random House Historical Dictionary of American Slang, Volume II (1997) at 313. This definition of "jones," as set forth in the cited standard reference work, is an adjudicative fact of which the Board may properly take judicial notice. See Fed. R. Evid. 201; TBMP §712. The dictionary's entry for "jones" includes the following examples of the word's usage history:

1970 Major *Afro-Amer. Slang* 71: *Jones*: a fixation;...compulsive attachment. **1970** *Current Slang V* (Fall) 9: *Jones*, n. A great need for stimulus - drugs, coffee, tobacco. **1971** in T.C. Bambara *Gorilla* 3: Blind people got a hummin jones if you notice. **1972** Burkhardt *Women in Pris.* 448: *Jones*. A strong desire for something or someone; also, a habit. **1972** *Tuesday Mag.* (May) 17: This young man's parents didn't know that they were subsidizing their son's card-playing "jones" (habit), but for all we know they might be heavy card players, too. **1973** I. Reed *La. Red* 95: She knows that La Bas has a "twenties" jones. **1974** *Black World* (Nov.) 61: With a jones for jockey straps. **1978** W. Brown *Tragic Magic* 13: It's a well-known fact that we have a heavy jones for highly seasoned foods and fine threads. **1981** *N.Y. Post* (Dec. 15) 58: There's a far greater chance of curing herpes than The Phantom's Basketball Jones. **1982** Sculatti *Catalog of Cool* 151: Potato Chips of the Gods: The Ultimate Junk Food Jones. **1987** E. Spencer *Macho Man* 95: In Nam I have a real bad jones - an addiction - to food. **1987** Cher, in *Newsweek* (Nov. 30) 69: When I feel stress, I get this chocolate jones. **1988** H. Gould *Double Bang* 163: That's what the junkie needs for his sugar jones. **1992** G. Wolff *Day at Beach* 154: I've got a bad root beer...jones. **1993** *Lompoc* (Calif.) *Record* (USA Weekend) (June 25-27) 8: He gets the jones for rich, cholesterol-straight-to-the-heart Mexican tripe soup. **1994** *CBS This Morning* (CBS-TV) (July 25): So I've got a carbohydrate jones. What do I do about it?

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word TACO and a tenuous phonetic similarity. Those points of similarity are outweighed, in our opinion, by the marks' fundamental differences in appearance and connotation. The highly stylized design features of several of opposer's marks further distinguish those marks from applicant's mark. We conclude that parties' respective marks, when viewed in their entireties, create quite dissimilar commercial impressions.

Having considered all of the evidence of record pertaining to the relevant likelihood of confusion factors, we conclude that there is no likelihood of confusion. Despite the legal identity of the parties' respective services and classes of customers, applicant's mark simply is too dissimilar to opposer's marks to warrant a refusal of registration under Section 2(d). *See Kellogg Co. v. Pack'Em Enterprises*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The opposition is dismissed.

E. J. Seeherman

P. T. Hairston

C. M. Bottorff

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