

## LA TORTILLA RESPONSE TO EXAMINER

We respectfully submit that the applicant's mark SONOMA is not likely to be confused with the registered mark in U.S. Registration No 1,748,715 for the words SONOMA DELI.

Moreover, it is not the intent of applicant to cause confusion through the use of the proposed mark. Further, the mark is not geographically descriptive. Evidence and legal authorities are set forth below or attached as exhibits and incorporated herein.

In addition, applicant hereby deletes "sandwich" from its description of goods in the application to clarify and limit its identification solely to "tortillas and wraps", which further distinguishes its goods from those of the cited mark SONOMA DELI for "sandwiches".

**The goods are dissimilar.** With this response, the applicant amends its description of goods to specify only "tortillas and wraps". The cited mark is for "sandwiches".

Tortillas are unleavened bread products particularly associated with Mexican, Central and South American cuisine (see extract from Wikipedia attached hereto as Exhibit 1). Wraps are made from tortillas. Sandwiches are made from leavened bread products particularly associated with European origins (see extract from Wikipedia attached hereto as Exhibit 2). The distinction apparently was at the heart of a recent case in Worcester, Massachusetts, where the judge ruled that a burrito, based on one unleavened tortilla with fillings, is not a sandwich, recognized as two pieces of leavened bread with fillings (see Boston.com Business Article attached hereto as Exhibit 3).

Further, the type of sandwich served in a "deli" or "delicatessen" is also typically of European origin (see extract from Wikipedia attached hereto as Exhibit 4 and result of Google search attached hereto as Exhibit 5).

**The marks are dissimilar in their entirety as to appearance, sound, connotation and commercial impression.** The mark SONOMA taken in its entirety is not similar to the mark SONOMA DELI taken in its entirety. The word "DELI" differentiating these marks makes a big difference because it creates a mark suggestive of specific kinds of food. The mark SONOMA is capable of many, varied meanings and is currently being used in commerce to sell everything from cars to furniture to restaurant services and more (see discussion under "**SONOMA is not geographically descriptive**" below).

The different words also create composite marks which are aurally distinguishable. Applicant's mark SONOMA, when pronounced aloud, has three sounds of equal length. The cited mark, SONOMA DELI, when pronounced aloud, has five equal sounds.

Also, SONOMA is so commonly used that the public will look to other elements to distinguish the source of the goods or services. (T.M.E.P. 1207.01(d)(iii); *Plus Products v. Star-Kist Foods, Inc.* 220 U.S.P.Q. 541, 1983 T.T.A.B. LEXIS 40). This is proved by the number of

other marks registered on the Principal Register utilizing the term SONOMA for food products, including the following:

SONOMA COUNTY CLASSICS for syrups, mustard, vinegar and barbecue sauce in class 30 owned by Kozlowski Farms Corporation, Registration number 1,770,232;

WILLIAMS-SONOMA for bread mixes and numerous other food items in class 30 and 31 owned by Williams-Sonoma, Inc., Registration number 2,292,343;

SONOMA COAST for mustard in class 30 owned by Sonoma Coast Mustard Co., Registration number 1,535,603; and

SONOMA for tomato products in class 30 owned by Summerfield Foods, Inc., Registration number 1,764,691.

Printouts of these registrations taken from the electronic search records of the United States Patent and Trademark Office are attached hereto as Exhibits 6-9.

The case here is similar to the situation in *Dakota Industries, Inc. v. Dayton Hudson Corp.*, 60 USPQ2d 1590 (S.D. S.D. 2001), where DAKOTA BLUE was judged not confusingly similar to DAKOTA both for clothing. There, “Evidence was introduced showing that the word “Dakota” was used by third parties with regard to non-clothing products. Because the word “Dakota” is used to describe everything from trucks to water, this reinforces the conclusion that the mark “DAKOTA” is not publicly recognized as being associated with garments.” (At paragraph 17.)

The case here is also similar to the situation in *Texas Dairy Queen Operators Council v. The Feed Store, Inc.*, 1 USPQ2d 1804 (N.D. Tex. 1986), where TEXAS COUNTRY COOKIN was judged not confusingly similar to TEXAS COUNTRY. As stated there, “The use of a weak mark by more than one producer is not likely to cause confusion as to the source ... since consumers do not associate weak marks with a particular producer.” (At headnote 20.)

The case here is similar to the situation in *Clairol, Inc. v. Cosmair, Inc.* (S.D.N.Y. 1984) 592 F. Supp. 811, where SUMMER SUN was judged not confusingly similar to SUMMER BLONDE, both for hair lighteners. “In assessing likelihood of confusion, the mere fact that two marks may share words in common is not determinative.” (*Id.*, at p. 815.)

It is also similar to the situation in *Bell Laboratories, Inc. v. Colonial Products, Inc.* (S.D. Fla. 1986) 644 F. Supp. 542, where FINAL FLIP was judged not confusingly similar to FINAL, both for rodenticides. “[M]ere following usage by one party of a word contained in a mark of another party does not, without more, require a finding of likelihood of product or source confusion.” (*Id.*, at p. 545.) “Where a trademark is itself weak, minor additions may effectively negate any confusing similarity.” (*Id.*, at p. 548.)

The case here is also similar to the situation in *Redken Laboratories, Inc. v. Clairol, Incorporated* (C.D. Calif. 1974) 501 F.2d 1403, where CURL & CONDITION was judged not confusingly similar to CONDITION, both for hair-care products. “Having selected a common, useful, and descriptive term as a trademark, Clairol cannot expect for the word ‘condition’ the same broad scope of protection that may be accorded to more distinctive and arbitrary marks.” (*Id.*, at p. 1405.)

The case here is also similar to the situation in *In re Ferrero* (C.C.P.A. 1973) 479 F.2d 1395, where TIC TAC for candy was judged not confusingly similar to TIC TAC TOE for ice cream and sherbet. “The fact that one mark may bring another mark to mind does not in itself establish likelihood of confusion as to source.... The very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, two marks.... Seeing a yellow traffic light immediately ‘calls to mind’ the green that has gone and the red that is to come, or vice versa; that does not mean that confusion is being caused.” (*Id.*, at p. 1397.)

**It was and is not the intent of applicant to cause confusion.** Applicant obtained the services of counsel experienced in trademark matters who conducted a search before filing this application. It was and is counsel’s opinion that the number of similar marks affords each mark some weak measure of protection and precludes a finding of likelihood of confusion among them, for this and the reasons above cited.

Due to all of the above, there is no likelihood of confusion between SONOMA and SONOMA DELI.

**SONOMA is not geographically descriptive.** The primary significance of the mark is to suggest a certain lifestyle, not a specific origin. As illustrated by a recent newspaper article in the Press Democrat, published on November 4, 2007 in Sonoma County, California, (which is attached hereto and incorporated herein as Exhibit 10), the word “Sonoma” is now a brand name being used by restaurants in Washington, D.C. and Auckland, New Zealand, by GMC for a truck, by Crabtree & Evelyn for a soap, by Ace Hardware for a chair, by Farberware for tea kettles, by Coach for handbags, and by Montgomery Ward for furniture, among other items.

The records of the U.S. Patent & Trademark Office show that SONOMA is currently the registered trademark for trucks, audio equipment, metal door hardware, kitchen and bathroom cabinets, handbags, cigarettes and hot tubs, among other products. Printouts of these registrations taken from the electronic search records of the U.S. Patent & Trademark Office are attached as Exhibit 11.

According to the Press Democrat article, “Sonoma carries what marketing experts call ‘geographic equity.’ Manufacturers, restaurants and retailers can gain an immediate response from consumers, even without marketing, by co-opting the cachet of a place, even if the product was made in China and has no connection to the area at all, said Damon Aiken, a professor of marketing at Western Washington University, who has studied the phenomenon.... ‘Everyone around the world knows Napa ...’. But Sonoma, he said, is more of a ‘blank slate’. ‘It’s got an exotic-sounding name that connotes luxury,’ he said, ‘without being so specific.’”

The website for applicant La Tortilla Factory shows its brand SONOMA as a “wholesome” and “environmentally-conscious” choice, but does not associate it specifically with Sonoma County, California (see attached Exhibit 12).

As Professor McCarthy has written: “If the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” (2 McCarthy, McCarthy on Trademarks and Unfair Competition (4th ed. 2004), §11:67, p. 11-129).

“Because the line between merely descriptive and only suggestive terms is ‘so nebulous,’ the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in ex parte examination.” (McCarthy, *supra*, at p. 11-113).

In addition, as stated in *Boden Products, Inc. v. Doric Foods Corporation*, 552 F. Supp.493 (N.D. Ill. 1982), “In some cases geographic designation may be suggestive and thus protectable even without proof of secondary meaning, see *In re RJR Foods, Inc.*, 189 U.S.P.Q. 622, 623-624 (TMT & App. Bd. 1976) (holding ‘Hawaiian Maid’ suggestive for frozen concentrate drink mix); *Plough, Inc. v. Florida Tan Products*, 174 U.S.P.Q. 46, 47-48 (TMT & App. Bd. 1972) (holding ‘Florida Tan’ suggestive for suntan lotion).”

In conclusion, we believe that the term SONOMA is not geographically descriptive.

For these reasons, we respectfully request that the examiner reverse the office action of May 18, 2007 and approve applicant’s registration of the mark SONOMA.