

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Caribbean Family Foods, LLC  
SERIAL NO.: 88352995  
FILED: March 22, 2019  
MARK: PASEO CARIBBEAN FOOD  
EXAMINER: Marta Stadel  
LAW OFFICE: 123

**Response to Office Action**

The following responds to the office action dated June 5, 2019:

**SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

The Examining Attorney has refused registration of PASEO CARIBBEAN FOOD pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the basis that the mark is likely to be confused with the mark of U.S. Registration No. 4249267 (EL PASEO INN). For the following reasons, Applicant respectfully disagrees with this finding and requests that the Examining Attorney reconsider the statutory refusal and allow Applicant's mark to be registered on the Principal Register.

In determining the likelihood of confusion between two marks the Patent and Trademark Office considers the relevant factors under the test established in the *du Pont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1356, 1361 (CCPA 1973). The marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Vittera Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012). In some cases, a determination that there is no likelihood of confusion is appropriate, even where the marks share common terms, additions or deletions to the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions, are used in connection with different goods and services, or are used in connection with goods or services purchased by a sophisticated consumer. *See* TMEP § 1206.01(b)(iii). Applicant respectfully submits that registration of its mark will not result in likelihood of confusion pursuant to these standards.

The marks PASEO CARIBBEAN FOOD and EL PASEO INN are critically different in appearance, sound, meaning, and commercial impression. The marks are also each sufficiently famous that the relevant consuming public can (and for at least two decades, already has) distinguished the source of the services associated with each mark.

**Difference in Appearance, Sound, Meaning and Commercial Impression**

The Examining Attorney has rejected the application on the basis that each mark contains the word "PASEO" as the dominant portion of each mark, and that the additional elements of each mark are not sufficient to avoid a likelihood of confusion. However, determination of a likelihood of

confusion cannot be based on the dissection of a mark or only part of a mark; the ultimate conclusion must rest on the consideration of the marks in their entireties. *In re National Data Corporation*, 753 F.2d 1056 (Fed. Cir. 1985). A consumer's general impression of a trademark is influenced by the actual use of the marks in their entireties, and as such, all components of both marks must be given appropriate weight. *In re Hearst Corporation*, 982 F.2d 493, 494 (Fed. Cir. 1992) (finding less likelihood of confusion when GIRL component of VARGA GIRL is considered in comparison to VARGAS for similar goods). In this instance, the Examining Attorney seeks to compare PASEO vs. PASEO, but stripping each of the marks down to only their most dominant shared element (and in doing so, removing more words from each mark than allowing to remain) is inappropriate for purposes of the analysis. Moreover, the words other than PASEO matter here, because they non-trivially distinguish how the marks appear, how they sound, and the commercial impression created by each.

Visual inspection of the marks confirms they share a single word, but each also contains unique elements not found in the other. The only part of the marks that sounds the same is PASEO, which accounts for only a small portion of each mark. Therefore the two marks are distinct in terms of their visual appearance and pronunciation.

The differences in commercial impression and meaning between the marks is especially compelling. Both marks utilize the word PASEO, which translates roughly to "a leisurely evening stroll" or "a public walk." See Exhibit A. However, the registered mark EL PASEO INN also adds the words "EL" meaning "the" as the Examiner observes in the office action, and "INN" which is commonly defined as "an establishment for the lodging and entertaining of travelers" or "Tavern." See Exhibit B. Meanwhile, PASEO CARIBBEAN FOOD adds the additional matter CARIBBEAN, referring to a specific region of islands in the Atlantic ocean, and FOOD. By doing so, the two create distinctly different meanings. In the latter case, it specifically identifies itself with a discrete region and type of cuisine (notably different from Mexican food), which additionally serves to associate the image the word PASEO conveys with an island setting. By using the word INN, EL PASEO INN creates an image of an indoor setting, while PASEO CARIBBEAN FOOD creates an impression of an outdoor walk on an island. INN further differentiates the registered mark by associating PASEO with an establishment for lodging and entertaining of travelers, while PASEO CARIBBEAN FOOD specifically associates itself with a form of cuisine.

The Examining Attorney notes that the words/phrases that distinguish the two marks ("INN" and "CARIBBEAN FOOD") are generally descriptive in nature, and therefore should be afforded less weight when considering commercial impression. But less weight does not mean no weight, and here, some weight must be afforded to the commercial impression lent by these distinguishing terms.

The Examining Attorney also argues that the inclusion of "EL" in Registrant's mark does not have any trademark significance since "EL" translates to "the" and the appearance of "the" is generally not considered useful for distinguishing two marks. The problem with that argument is that Registrant didn't use the word "the;" it used the word "EL" (the Spanish word for "the") in the context of a mark registered for restaurant services provided by a Mexican restaurant. That is

hugely significant because consumers will naturally come to identify Spanish language words with goods/services originating from Spanish-speaking countries; in this case, Mexican food.

As noted previously, the marks must be considered as a whole, even in light of disclaimed or otherwise descriptive material. In the present case, the additional matter serves to differentiate the marks significantly and ensure that consumers would not be confused by their coexistence. As such, the marks have notably different meaning and a significantly different commercial impression.

Finally, prosecution histories of the following U.S. trademark registrations reveal that descriptive matter may distinguish two marks for likelihood of confusion purposes, especially in a context where the descriptive matter can be used to distinguish between different types of restaurant services and/or different types of cuisines:

- U.S. Reg. No. 4522589 (PAZZO POMODORO); overcoming refusal based on PASSO'S; and
- U.S. Reg. No. 3974953 (FLIP BURGER BOUTIQUE); overcoming refusal based on FLIP'S.

Registration Certificates of the trademark registrations cited above are attached as Exhibit C.

### **Fame of the Marks**

Finally, the fame of the respective marks should be regarded as a “dominant factor” in determining likelihood of confusion. See TMEP 1207.01(d)(ix). The TTAB has noted, “As the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines.” *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1750 (TTAB 2006). Here, we have an unusual fact pattern in that both marks have acquired substantial fame. This fact, supported by the evidence below, weighs heavily in favor of finding no likelihood of confusion, since the relevant consumer has come to recognize the two marks as being distinct from each other.

PASEO CARIBBEAN FOOD is a well-known mark associated with the small but nationally-recognized chain of Caribbean restaurants located in Seattle, Washington. See: <https://www.paseorestaurants.com/>. Applicant's restaurants have been a fixture in the Pacific Northwest for over two decades, but they gained national prominence in 2014 after Yelp.com named them as #2 on a list of the “Top 100 places to Eat in the U.S.” In a similar list published by Yelp.com in 2016, they ranked #3. They have been featured in television specials aired by Food Network and The Learning Channel, in an episode of Anthony Bourdain's television show, *The Layover*, as well as articles published by Esquire, HuffPost, Thrillist and numerous regional media outlets. See Exhibit D. The large amount of media attention has made Applicant's Caribbean restaurants a national food destination, and Applicant's marks – including PASEO CARIBBEAN FOOD – inextricably associated with Applicant's services.

In the other corner, EL PASEO INN is a mark associated with a storied Mexican restaurant and bar located in Los Angeles, California. See: <https://www.elpaseoinn.com/>. Established in the 1930's, the establishment claims to be the oldest Mexican bar in Los Angeles and a designated historical landmark. The bar further claims to have "served many special guests over the years, including civil rights leader Cesar Chavez and Presidents George H. W. Bush and Bill Clinton." Though not the subject of substantial media attention similar to Applicant's restaurants, the EL PASEO INN mark does appear to be well-known by people who live in or visit historic Olvera Street in Los Angeles.

Applicant submits that, while EL PASEO INN appears to have been used for decades longer, PASEO CARIBBEAN FOOD is the more famous mark between the two. That said, both marks have acquired national, or at least regional fame, based on their owners' respective use in connection with two different genres of restaurant services. The result is that consumers will not expect Applicant's iconic Caribbean sandwiches to be served at an establishment using the EL PASEO INN mark, and likewise will not expect Registrant's Mexican food to be delivered under the name PASEO CARIBBEAN FOOD. The fact that the marks have coexisted in the marketplace for at least two decades without any known consumer confusion is further proof of this.

### **DISCLAIMER REQUIRED**

Applicant has submitted a disclaimer in connection with this response. No claim is made to the exclusive right to use "CARIBBEAN FOOD" apart from the mark as shown.

### **CONCLUSION**

Based on the arguments above, Applicant respectfully requests the examining attorney withdraw its refusal and allow Applicant's mark to proceed to publication.

### **EXHIBITS**

Exhibit A – Meriam-Webster Definition of "PASEO"

Exhibit B – Meriam-Webster Definition of "INN"

Exhibit C – Registration Certificates for Cited U.S. Trademark Registrations

Exhibit D – Articles Regarding "PASEO CARIBBEAN FOOD"