

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
September 12, 2017

Mailed:
November 3, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Durrset Amigos, Ltd. d/b/a Amigos Foods
v.
Amigos Meat Distributors, L.P.
—

Cancellation No. 92060896
—

Ted D. Lee and Nick Guinn of Gunn, Lee & Cave, PC
for Durrset Amigos, Ltd. d/b/a Amigos Foods.

John S. Egbert and Michael F. Swartz of Egbert Law Offices, PLLC
for Amigos Meat Distributors, L.P.
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Before Quinn, Mermelstein, and Heasley,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Durrset Amigos, Ltd. (“Petitioner”), doing business as Amigos Foods, seeks to cancel a registration owned by Amigos Meat Distributors, L.P. (“Respondent”) for the mark AMIGOS FOODS (in standard characters; FOODS disclaimed) for “wholesale distributorships featuring meat products” in International Class 35.¹ As its ground

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¹ Registration No. 3815857, issued July 6, 2010, alleging first use in April 2010; Section 8 affidavit accepted. The registration includes the following statement: “The English translation of ‘AMIGOS’ is ‘FRIENDS.’”

for cancellation pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), Petitioner asserts that Respondent's mark, when used in connection with Respondent's services, so resembles Petitioner's previously used common law mark AMIGOS FOODS, and previously used and registered mark shown below,



for "prepared tortillas, taco sauce, picante sauce (hot sauce) and taco shells" in International Class 30, and "manufacturing and packaging food to the order and specification of others" in International Class 37² as to be likely to cause confusion.

Respondent, in its answer, denied the salient allegations of the petition for cancellation.³

The record comprises the pleadings; the file of the registration sought to be cancelled; trial testimony, with related exhibits, taken by each party; Petitioner's


² Registration No. 1232088, issued March 22, 1983; renewed. The registration includes the following statement: "The lining in the mark on the drawing represents color, specifically red and gold, but no claim is made to color."

³ In its answer, Respondent set forth laches and acquiescence as affirmative defenses based on the coexistence of the parties' marks. However, Respondent did not pursue them through the presentation of evidence at trial or in its brief. Further, when specifically asked at the oral hearing about the defenses, Respondent's counsel indicated that the defenses were not pursued and, thus, not before the Board. Accordingly, these defenses are deemed waived. *Daniel J. Quirk, Inc. v. Vill. Car Co.*, 120 USPQ2d 1146, 1147 n.4 (TTAB 2016); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 (TTAB 2015). See TBMP § 311.02(b) (June 2017).

registrations,⁴ Respondent's answers to production requests, and portions of a discovery deposition taken of Respondent, all made of record by way of Petitioner's notices of reliance; and third-party applications and registrations, dictionary listings, Petitioner's responses to certain of Respondent's discovery requests, and excerpts of Respondent's website and third-party websites, all introduced through Respondent's notices of reliance.⁵ Both parties filed briefs, and both were represented by counsel at an oral hearing.

The Parties

According to Clint McNew, Petitioner's president and general manager, Petitioner has been engaged in the food manufacturing industry since 1925, and began using the mark AMIGOS in the 1950's.⁶ 71 TTABVUE 5. Beginning in 2001, Petitioner has used the mark AMIGOS FOODS in connection with its private label food manufacturing and packaging activities. 71 TTABVUE 36. Petitioner's business, based in San Antonio, Texas, is heavily focused (about 95%) on producing Tex-Mex food products, such as tortillas, bean dip, and sauces, for sale by third parties under those parties' various private labels. 22 TTABVUE 13.

⁴ In addition to its pleaded registration, Petitioner also owns, as conceded by Respondent, Registration No. 4504937, issued April 1, 2014, for the mark  for "processed beans; refried beans." 45 TTABVUE 9.

⁵ Petitioner, in its brief, initially objected to certain exhibits introduced by Respondent. In its reply brief, Petitioner subsequently withdrew these objections.

⁶ Mr. McNew's testimony (along with the related exhibits), taken on April 5, 2016, was submitted on a compact disc (CD). 30 TTABVUE. The contents of the CD have been uploaded into the Board's electronic database. *See* 62-71 TTABVUE (redacted filings); 52-61 TTABVUE (designated as confidential).

Respondent's general manager, Francisco Moreno, testified that Respondent is based in Houston, Texas and began operations in 1994 as a distributor of meat, including beef, pork, poultry, lamb and goat. 39 TTABVUE 12-13. Respondent also distributes seafood, and other food products such as cheese, corn oil and sour cream; Respondent does not engage in any food processing. 36 TTABVUE 19; 39 TTABVUE 12-13. Respondent began use of its mark AMIGOS FOODS in 2010. 39 TTABVUE 25. This mark does not appear on any labels for meat products received from packers, and the meat is not sold to the public under the mark AMIGOS FOODS; rather, the only way Respondent's mark appears in connection with its identified services is on the sides of delivery trucks used to distribute the meat products. 39 TTABVUE 14-15. The mark as actually used is shown below:



65 TTABVUE 10. The meat products distributed by Respondent go straight from the delivery trucks to the grocer's meat case. 39 TTABVUE 17. Respondent's annual sales are \$1.1 billion. 39 TTABVUE 10. Respondent does not have an advertising budget. 39 TTABVUE 30. Ninety-five percent of Respondent's grocer accounts are repeat customers. 39 TTABVUE 18.

Respondent also owns Registration No. 3415775, issued April 22, 2008 (renewed) for the mark AMIGOS MEAT DISTRIBUTORS (in standard characters, MEAT

DISTRIBUTORS disclaimed) for “wholesale distributorships featuring food products” in International Class 35. 21 TTABVUE 55. This registration (which now is over five years old) has not been challenged by Petitioner, and it appears that the parties’ present dispute began when Respondent later adopted and registered the mark AMIGOS FOODS, which is identical to Petitioner’s common law mark AMIGOS FOODS.

Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. Any person who believes that it is or will be damaged by registration of a mark has standing to file a petition for cancellation under Section 14, 15 U.S.C. § 1064. Our primary reviewing court has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quotation omitted). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999). A claim of likelihood of confusion that “is not wholly without merit,” including prior use of a confusingly similar mark, may be sufficient. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Respondent does not dispute Petitioner’s standing. Moreover, Petitioner’s ownership of Registration Nos. 1232088 and 4504937 for the mark AMIGOS, which

are valid and subsisting, as well as its common law use of the mark AMIGOS FOODS, support a finding that Petitioner's claim of priority and likelihood of confusion "is not wholly without merit." We find that Petitioner has established its standing.

Priority

Section 2(d) permits cancellation on the basis of prior use of "a mark or trade name previously used in the United States by another and not abandoned." Thus, to assert rights based on an unregistered trademark, Petitioner must establish its priority of use.

Petitioner's first use of its registered mark AMIGOS, and subsequent use of its common law mark AMIGOS FOODS in 2001, predate Respondent's first use of its mark AMIGOS FOODS in April 2010. Indeed, Respondent does not dispute Petitioner's priority with respect to Petitioner's use of its marks in connection with manufacturing and packaging food to the order and specification of others.⁷

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Petitioner must establish that there is a likelihood of confusion by a preponderance of the

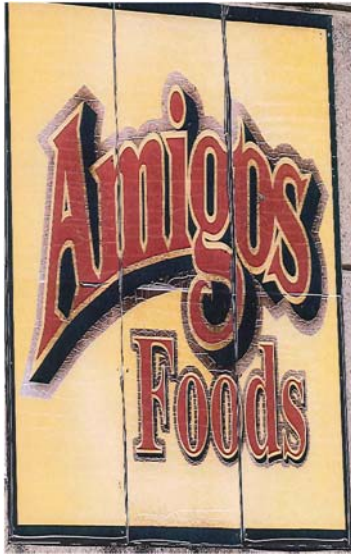
⁷ Petitioner overreaches when it argues that it also renders distribution services, which are "nearly identical" to Respondent's services. 44 TTABVUE 22-24. Rather, as pointed out by Respondent, "any 'food distribution services' of [Petitioner] would be the transport of [Petitioner's] own food products to [Petitioner's] customers. Merely selling one's own private-labeled goods would not constitute 'food distribution services' under trademark law." 45 TTABVUE 17-18. At the oral hearing, Petitioner essentially conceded this point, indicating that it was appropriate for the Board to focus on Petitioner's manufacturing and packaging services.

evidence. 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 (CCPA 1976). Varying weights may be assigned to each *du Pont* factor depending on the evidence presented. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687-88 (Fed. Cir. 1993). The relevant *du Pont* factors in this proceeding are discussed below.

Similarity of the Marks

With respect to the first *du Pont* factor, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Petitioner’s common law mark is AMIGOS FOODS. Petitioner’s prior use of AMIGOS FOODS is shown below as displayed on one of its warehouses (left, 62 TTABVUE 4) and on one of its delivery trucks (right, 62 TTABVUE 1).



Petitioner also has used its AMIGOS FOODS mark on packaging labels on boxes containing food products ready for shipment as shown below (62 TTABVUE 2):



Respondent's registered mark is AMIGOS FOODS in standard characters. Thus, we must assume that it could be displayed in any size, color, or font, including a size, color, and font identical to those in Petitioner's mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Group*, 98 USPQ2d at 1258-59.

Petitioner's mark AMIGOS FOODS is identical to Respondent's AMIGOS FOODS standard character mark in sound, and identical or nearly so in appearance. The dominant portion of the parties' AMIGOS FOODS marks clearly is AMIGOS, given the descriptive or generic designation FOODS that is properly disclaimed in Respondent's mark. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) ("DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE). Moreover, purchasers in general are inclined to focus on the first word or portion in a trademark; in each of the parties' marks, AMIGOS is the first portion. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered"). *See Palm Bay Imps.*, 73 USPQ2d at 1692. As to meaning, as disclosed by Respondent's registration, AMIGOS translates to the English word "friends." Thus, the parties' marks convey identical meanings.

Given the identical or nearly identical marks, they engender identical or virtually identical overall commercial impressions. This *du Pont* factor weighs heavily in Petitioner's favor.

Similarity of the Services

As to the *du Pont* factor regarding the similarity of the services, it is well settled that the services of the parties need not be identical or competitive, or even be offered through the same channels of trade, to support a holding of likelihood of confusion.⁸

⁸ Although Petitioner owns a registration covering "prepared tortillas, taco sauce, picante sauce (hot sauce) and taco shells," the parties have focused their attention on Petitioner's

The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722. Indeed, in the present case involving identical marks, the degree of similarity between the services that is required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 26 USPQ2d at 1688-89 (“even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”). *See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). It is only necessary that there be a viable relationship between the services to support a finding of likelihood of confusion. *In re Concordia Int’l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). The issue here, of course, is not whether purchasers would confuse the services, but rather whether there is a likelihood of confusion as to the source of these services. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Petitioner renders the identical services under both its registered mark and its common law mark. We thus compare Petitioner’s manufacturing and packaging food to the order and specification of others to Respondent’s wholesale distributorships

services. We do the same, recognizing that the services represent Petitioner’s strongest case for likelihood of confusion. *See, e.g., In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

featuring meat products. Although we agree with Respondent that Petitioner does not provide distribution services, identity between the parties' services is not required. Rather, as indicated above, when identical marks are involved, only a viable relationship between the services is required.

It is apparent that manufacturing and packaging of food products, and their distribution, are part and parcel of the process of getting food from producers to the grocery store. The food manufactured and packaged by Petitioner includes products with meat. Mr. McNew stated that "there are other food manufacturers out there that also do distribution," specifically naming two third parties "in the Mexican food realm" (Bruce Foods and Mizkan). 71 TTABVUE 29. A grocery store purchasing agent, when ordering food to be produced and packaged from Petitioner under the mark AMIGOS FOODS, will be likely to mistakenly believe, upon encountering Respondent's distribution services of meat products under the mark AMIGOS FOODS, that the services are rendered by the same entity or that there is some affiliation or connection between them. "It may be appropriate at this point to note, as has been observed by one commentator, that the statutory concept of 'likelihood of confusion' denotes any type of confusion, including not only source confusion but also 'confusion of affiliation; confusion of connection; or confusion of sponsorship.'" *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 n.7 (TTAB 1984) (quoting 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24.3.B).

The similarity of the services favors a finding of likelihood of confusion.

Trade Channels and Classes of Purchasers

Because there are no limitations or restrictions as to trade channels or classes of purchasers in the respective registrations, we presume that the services at issue would be marketed in all normal trade channels for such services and to all normal classes of purchasers of them. *See, e.g., Coach Servs.*, 101 USPQ2d at 1722; *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In addition to the presumption, the evidence shows that each party in fact renders its services through grocer pipelines and, to that extent, the trade channels overlap. 30 TTABVUE; 39 TTABVUE 16. The parties' respective services are offered to the same classes of purchasers, namely grocery stores. Because there is no limitation on the size of the grocery stores, both in the respective recitations of services as well as shown by the evidence, these stores would include national chains, such as Kroger and Safeway, as well as smaller independent grocers. *Id.* Further, there is no evidence bearing on industry practices involving the purchase of products by grocery stores. That is, the record is devoid of evidence (confirmed by Respondent's counsel in response to a question at the oral hearing) showing that major grocery chains have different purchasing agents for different products (*e.g.*, private label Mexican food items versus meat); or that in the case of smaller, independent grocery stores, the same purchasing agent may well buy all of the products (food items, including meat) carried by the store. *Cf. Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (likelihood of confusion must be shown to exist not in a purchasing institution, but in "a customer or purchaser").

The similarity in trade channels and overlap in purchasers are factors that weigh in favor of a likelihood of confusion.

Conditions of Sale

In its reply brief, Petitioner acknowledges that “both parties’ consumers are relatively sophisticated...” 47 TTABVUE 22. Indeed, we find that the food purchasing agents of grocers, whether large or small, whether buyers of meat or of other food products, or of both, are likely to be relatively sophisticated and knowledgeable about the food items they purchase for their grocery stores.

We find that this factor weighs in favor of finding no likelihood of confusion.

Third-Party Uses and Registrations

In the face of Petitioner’s contention that its mark AMIGOS FOODS is “strong, arbitrary or fanciful,” 44 TTABVUE 22, Respondent argues that the meaning of the term AMIGOS is familiar to both Spanish and English-speaking consumers as “friends,” and that this term in the parties’ marks “suggests the accessible and friendly aspects of the respective users’ goods and services.” 45 TTABVUE 23. Respondent goes on to assert that the terms AMIGO and AMIGOS are “extremely weak marks.” *Id.* In this connection, Respondent introduced numerous examples of third-party uses and registrations or applications of AMIGOS marks in the general arena of food products. 35 TTABVUE 2-114. Of record are forty-five third-party registrations and applications for marks that include AMIGO or AMIGOS for goods or services that, according to Respondent, “are *somewhat* related to food, such as food products, food distribution services, and restaurants.” (emphasis added). 45

TTABVUE 23-24. Respondent also submitted screenshots of Internet search results showing over 90 restaurants with a name that includes the term AMIGOS; and a Google search of “amigos” and “food” showing over 90 websites.

More specifically, the third-party registrations include the following examples: Reg. No. 4747416 for AMIGOS for retail grocery stores; Reg. No. 3434773 for AMIGOS UNITED and design for retail grocery stores; Reg. No. 4377390 for DOS AMIGOS for food products; Reg. No. 4228528 for 3 AMIGO CHEFS for blogs directed to food service professionals; Reg. No. 1321443 for DON AMIGOS and design for restaurant services; Reg. No. 1476309 for AMIGOS and design for restaurant services; Reg. No. 4399984 for SMOKIN’ AMIGOS for catering services; Reg. No. 4987012 for ALLERGY AMIGOS for charitable services; and Reg. No. 4186599 for AMIGOS for beer.⁹ 35 TTABVUE 57.

The record also includes examples of Google, Yelp and Open Table search results showing third-party uses of a variety of AMIGOS marks in connection with restaurant services. These various Mexican restaurants are located throughout the country. 35 TTABVUE 59-86.

Respondent further introduced, by way of Google search results, examples of third-party uses of various AMIGOS marks in connection with a variety of “food-related goods and services.” In a few cases, Respondent introduced portions of a few third-party websites listed in the results: amigofoods.com (Argentine food products);

⁹ Respondent also introduced a number of third-party applications. “[T]he third-party applications ... are of no probative value here; they merely serve to show the filing of each application.” *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1359-60 (TTAB 2014) (citing *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1201 (TTAB 2007)).

amigofoods.com (snack foods); amigos-foods.com (food products); and 3amigochefs.wordpress.com (culinary solutions for the food service industry). 35 TTABVUE 88-113.

Although Respondent's evidence tells us nothing about the specific extent to which the third-party marks may have been used or the amount of exposure relevant customers may have had to them, the Federal Circuit has held that "even where the specific extent and impact of the usage has not been established," evidence of third-party registrations and use "can show that customers have been educated to distinguish between different marks on the basis of minute distinctions." *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). In the words of the Federal Circuit, evidence of extensive use of a term by others as a mark can be "powerful on its face. . . ." *Jack Wolfskin*, 116 USPQ2d at 1136 (internal quotes omitted). "The weaker [a plaintiff's] mark, the closer [a defendant's] mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Juice Generation*, 115 USPQ2d at 1674.

This third-party evidence, which superficially may seem impressive, is not of the magnitude, either in quantity or quality, to persuade us that confusion is unlikely. First, the evidence falls short of showing extensive or voluminous registrations or use of AMIGOS marks *coexisting for the same or similar services as those involved herein*. In the present case, of all the registrations or uses, only two of the registrations,

covering retail grocery store services, are even arguably related to Petitioner's or Respondent's services. To reiterate, the record is devoid of even a single example of registration and use in connection with the manufacture and packaging of food products. Third-party use of AMIGOS for other services, directed to other classes of purchasers, are of little relevance.

Second, we find that *Jack Wolfskin* and *Juice Generation* are distinguishable from the present case for the same reason expressed by the Federal Circuit in the case of *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017): those cases involved oppositions to the registration of applied-for composite marks that were not identical to the opposer's marks. The present case involves identical word marks, AMIGOS FOODS, which "stands in sharp contrast" to the scenario involving different marks. *Id.*

Accordingly, the evidence showing the existence of AMIGOS marks for other services, such as restaurants, catering or blogs, or items such as snack foods or beer, does not support a finding that Petitioner's mark AMIGOS FOODS is weak with respect to the services rendered by Petitioner, namely, manufacturing and packaging food to the order and specification of others. *Id.* In other words, Respondent has not pointed to any record evidence to support a finding that multiple third parties use any AMIGOS mark, let alone AMIGOS FOODS for services similar to manufacturing and packaging food to the order and specification of others. *Id.* Indeed, Mr. Moreno stated that other than Petitioner, he is not aware "of any companies by the name Amigos Foods." 39 TTABVUE 36.

To the extent that the marks are suggestive, the marks convey, as noted above, the identical meaning. Thus, to the extent that any of the third-party registrations or uses could demonstrate the weakness of Petitioner's mark (which we find to be not the case), the weakness is outweighed by the other *du Pont* factors, such as the identity between the marks, discussed in this decision. The simple fact remains that, based on the record, Petitioner and Respondent are the only sources of manufacturing, packaging (Petitioner) and distribution (Respondent) services under the mark AMIGOS FOODS in the food industry.

This factor is neutral.

Actual Confusion and Survey

Petitioner argues that there is "strong" evidence of actual confusion. More specifically, Petitioner asserts 1) that it has encountered several instances of actual confusion; and 2) that Petitioner's likelihood of confusion survey shows a high rate of confusion, which is useful in predicting actual confusion. Respondent asserts that it is unaware of any actual confusion. 39 TTABVue 21. Respondent also objects to certain testimony and evidence introduced by Petitioner in connection with Petitioner's allegations regarding the existence of actual confusion between the marks, and otherwise contends that the evidence is not persuasive and that the survey is critically flawed.

Petitioner introduced evidence to show that its employees received phone calls meant for Respondent; that one of Petitioner's customers mistakenly confused Petitioner and Respondent; that Petitioner received inquiries regarding Respondent's

trucks from individuals who believed they were affiliated with Petitioner; that Petitioner received a job application from an applicant who mistakenly used Respondent's form; and that when Petitioner worked with a machine manufacturer to supply Petitioner with a new piece of equipment, the manufacturer's brochure prepared for Petitioner showed the equipment bearing Respondent's mark, not Petitioner's mark. 66 TTABVUE 1-22; 71 TTABVUE 23-28.

We first consider Respondent's two objections, both based on hearsay. 45 TTABVUE 13-14. More specifically, Respondent objects to Mr. McNew's testimony regarding an alleged misdirected phone call, as well as testimony related to several inquiries about Respondent's delivery trucks, that is, whether the trucks were affiliated with Petitioner.

The hearsay objections are sustained, and we decline to give this evidence any probative value. Likewise, the remaining evidence bearing on actual confusion is entitled to little or no weight. Without direct testimony from the individuals who allegedly were confused, there is insufficient information to ascertain what they were specifically thinking, or what specifically caused the purported confusion. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 701 (CCPA 1980) (statements offered to prove the state of mind of a third party concerning confusion between two marks is hearsay: "Actual confusion is entitled to great weight but only if properly proven.... Such is not the case here."); *see also Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1334 (TTAB 1992) (inquiries as to corporate affiliations is not evidence of confusion because, without

more, they “indicate that these persons were aware that [the companies at issue] were two different entities”); *Elec. Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 164 (TTAB 1984) (“That questions have been raised as to the relationship between firms is not evidence of actual confusion of their trademarks.”) (citation omitted). Simply put, the testimony relating to these incidents lacks sufficient detail to demonstrate actual confusion.

We next turn to a likelihood of confusion survey that was prepared and conducted by Isabella Cunningham, Ph.D. Survey results may act as circumstantial evidence of likelihood of confusion, if the survey is designed and conducted using generally-accepted principles and methodology. Dr. Cunningham indicated, in her twenty-four page testimony, that she is a professor of advertising, public relations and marketing at the University of Texas in Austin. She has published more than ten books, authored fifty articles, made numerous presentations and received awards, and served on the boards of professional associations. 22 TTABVUE 75-84. Her research has delved into the general areas of advertising. 22 TTABVUE 85. Dr. Cunningham testified that she has been retained as an expert in other third-party lawsuits. 22 TTABVUE 144-146. Dr. Cunningham indicated that she has designed likelihood of confusion surveys in “two or three” Board proceedings, and “in excess of 20” in “trademark proceedings in general including litigation.” 22 TTABVUE 96.

In the present case, Dr. Cunningham surveyed “people that work in the food industry, food preparation industry,” using the protocol approved in the case of *SquirtCo. v. Seven-up Co.*, 628 F.2d 1086, 207 USPQ 897 (8th Cir. 1980). Petitioner

contends that the survey “was carefully prepared and can therefore be relied upon to accurately predict the degree of confusion in terms of percentages among the relevant universe of customers.” 44 TTABVUE 26. Dr. Cunningham conducted two surveys, the first showing a confusion rate of 65.9%, and the second showing 55.7%. The survey report is of record. 22 TTABVUE 136-45.¹⁰ To the contrary, Respondent argues that the survey “exhibits a number of fatal flaws that undermine the integrity of the survey,” and therefore the survey results are “of little probative value.” 45 TTABVUE 29-30.

The online survey results are based on the responses of 211 (in the first survey and 210 in the second survey) “consumers who work for a supermarket, a grocery store, a food discount store, a convenience store or another food service organization” regarding confusion between the parties’ AMIGOS FOODS marks. Screening questions were used to exclude respondents who worked for either of the parties, or any related companies. Dr. Cunningham conducted two surveys:

Two different surveys were developed; one survey was designed to assess whether confusion was found between the mark AMIGOS FOODS [Petitioner] and the mark AMIGOS FOODS [the Registrant’s] as they appear on each of the companies’ websites. The second survey was designed to assess whether consumers were confused when they saw the companies’ marks, URLs, and a brief description of each company displayed on a typical search results engine page. 22 TTABVUE 136.

She concluded the following:

[I]n my expert opinion, the results of the two surveys clearly indicate that there is substantial confusion between the Petitioner’s AMIGOS FOODS marks and the

¹⁰ For reasons unknown, the appendices to the report are not in the record.

Registrant's AMIGOS FOODS mark among persons who are employed by food companies like a supermarket, a grocery store, a food discount store, a convenience store or another food service organization. Between 55% and 65% of the respondents in Versions 2 and 1 of the survey were deemed confused by the two marks.

In my opinion there is a likelihood of confusion between Petitioner's mark AMIGOS FOODS as used by Petitioner and Registrant's mark AMIGOS FOODS as used and registered by Registrant. 22 TTABVUE 143-44.

In version 1 of the survey, the survey respondents were first shown Petitioner's mark on the screen, and then they were directed to a second screen showing Respondent's mark, along with the names of three other food distribution companies, namely Labatt Food Service, El Norteno del Norte Foods, Inc., and Glazier Foods Company. No reference was made to any goods or services that might be sold under the various marks, but consumers were asked if any of the companies shown on the second screen were affiliated, associated or connected with Petitioner, the company shown on the first screen. The results show that 65.9% of the survey respondents picked Respondent's AMIGO FOODS mark, with reasons such as "it's the same name" and "they both say Amigos."

In the second survey, respondents were shown one screen displaying the results of a hypothetical internet search showing the company names, their URLs, and a brief description of the company as follows:

- (1) Amigos Foods: www.amigosfoods.com
- (2) Glazier - Food Company: www.galzierfoods.com
- (3) Labatt Food Service: www.labattfood.com
- (4) Del Norte Foods: www.delnortefoods.com
- (5) Amigos Foods: amigosfoods.biz

Respondents were given further information as follows:

Assume you are doing a search on the Internet for “food distribution companies” and the results of your search are displayed in the next screen. The image on the screen contains a listing of food distribution companies including the plaintiff’s and the defendant’s companies as they are typically shown on a search page.

The respondents were asked to select “the search results that you think are affiliated, associated or connected.” Dr. Cunningham concluded that 55.7% were confused between the parties’ marks. Reasons given for the confusion included “they are both Amigos Foods,” “it’s the same name the same company” and “similar web domain names.”

The first survey suffers from a flaw pointed out by Respondent, namely that the goods or services sold under the marks were not shown. Similarity between the marks, which would appear to be the only factor confirmed by the survey, is but one factor in the likelihood of confusion analysis. Given the choices from which to select, it is hardly surprising that the survey respondents chose the parties’ marks as indicating association, affiliation or connection.

The second survey suffers from the same deficiency in that it focuses on the marks, virtually demanding a confusion response given the wholly unrelated names of the three additional options. That is, it is hardly surprising that when confronted with the Google search engine results, respondents chose Petitioner and Respondent (both using Amigos Foods) as affiliated or connected entities, but not Labatt Food Service, Del Norte Foods or Glazier Food Company.

Although we have considered Dr. Cunningham's survey, we accord very little probative value to the results in showing actual confusion. At best, it weighs slightly in favor of Petitioner.

In sum, Petitioner's evidence of purported actual confusion is not persuasive, and its survey is entitled to little weight on the question of confusion. We find that this factor is neutral.

Conclusion

We have considered all of the evidence properly made of record pertaining to the likelihood of confusion issue, as well as all of the arguments related thereto, including any evidence or arguments not specifically discussed in this opinion. The *du Pont* factors of the identity of the marks, the similarity of the services and trade channels, and the identity of classes of purchasers weigh in Petitioner's favor; the conditions of sale weigh in Respondent's favor. The factors involving the nature and number of third-party uses and registrations, as well as actual confusion, are neutral. On balance, we find that the relevant *du Pont* factors weigh in favor of a finding of likelihood of confusion. We conclude that customers familiar with Petitioner's manufacturing and packaging food to the order and specification of others rendered under the mark AMIGOS FOODS will be likely to mistakenly believe, upon encountering Respondent's mark AMIGOS FOODS for wholesale distributorships

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featuring meat products, that these services originate from or are associated with or sponsored by the same entity.¹¹

Decision:

The petition for cancellation is granted. Registration No. 3815857 will be cancelled in due course.

¹¹ In reaching this result, we recognize that Respondent's Registration No. 3415775 for the mark AMIGOS MEAT DISTRIBUTORS for "wholesale distributorships featuring food products" (issued almost 10 years ago) remains on the Principal Register.