

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
March 28, 2008  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SAS Lataste

Serial No. 79015771

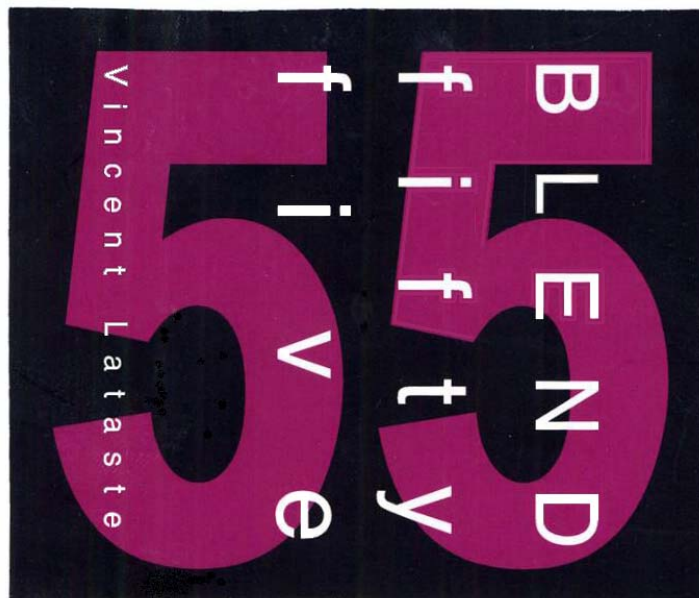
William C. Wright of Epstein Drangel Bazerman & James, LLP  
for SAS Lataste.

Leigh A. Lowry, Trademark Examining Attorney, Law Office  
115 (Tomas V. Vlcek, Managing Attorney).

Before Bucher, Taylor and Mermelstein, Administrative  
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

SAS Lataste seeks registration on the Principal  
Register of the following mark:



for goods ultimately identified in the application as "wines" in International Class 33.<sup>1</sup>

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the mark CINQUANTE-CINQ (*in standard character format*) for "wine"<sup>2</sup> also in International Class 33, as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. We *affirm* the refusal to register.

The Trademark Examining Attorney contends there is a likelihood of confusion inasmuch as the goods are identical and the marks are confusingly similar. As to the

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<sup>1</sup> Application Serial No. 79015771 was filed by SAS Lataste, a French *Societe Par Actions Simplifiee*, on June 13, 2005 based upon a request for extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a). The colors purple, black and white are claimed as a feature of the mark. The color purple appears in the number 55; the color black appears in the background; the color white appears in the wording BLEND • fifty five • Vincent Lataste. The name "Vincent Lataste" identifies a living individual whose consent to use and register his name is of record.

<sup>2</sup> Registration No. 3025988 issued on December 13, 2005. Applicant states that the foreign wording in the mark translates as "fifty-five."

similarity of the marks, the Trademark Examining Attorney argues that registrant's mark CINQUANTE-CINQ in the French language translates precisely to "Fifty-Five," the dominant portion of applicant's mark being the numeral **55** and the wording **fifty-five**.

In arguing for registrability, applicant argues that it would be inappropriate even to invoke the doctrine of foreign equivalents in this case. In the alternative, applicant contends that if one employs this doctrine herein, there is clearly no likelihood of confusion provided one compares the two marks in their entireties.

### **Likelihood of Confusion**

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the

similarities between the marks and the relationship between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

### **The Goods, Trade Channels and Conditions of Sales**

As seen above, the goods are identical. Applicant has submitted no arguments to the contrary. Where the goods are identical, and neither identification has any limitations as to channels of trade, we must presume that the respective goods would move through the same trade channels to all the same classes of ordinary purchasers of goods shown neither to be expensive nor purchased with utmost care. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981). Hence, these three *du Pont* factors favor the position of the Trademark Examining Attorney herein.

### **Similarity of the marks**

We begin this part of the analysis mindful of the fact that when marks would appear on identical goods, the degree of similarity in the marks necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

### ***Applicability of the Doctrine of Foreign Equivalents***

In addition to the translation statement printed on the cited registration certificate, the evidence of record clearly shows that the *single* translation of the wording "cinquante-cinq" is the number "fifty-five," and the *only* translation of "fifty-five" from English to French is "cinquante-cinq."<sup>3</sup> For this reason, we find that the situation in the instant appeal is distinguishable from a case relied upon by applicant. Unlike the factual conclusions of *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 112-13 (Fed. Cir. 1983) [no English-to-French definition was cited supporting the conclusion that "second chance" is an exact synonym or equivalent of "repechage" when translated into the French language], we find that the terms involved herein are exact equivalents.

Accordingly, the Trademark Examining Attorney contends that under the doctrine of foreign equivalents, the ordinary purchaser in the United States "who is knowledgeable in the foreign language" will translate the term "Cinquante-Cinq" into its English-language equivalent. *See In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006).

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<sup>3</sup> <http://www.wordreference.com/enfr/fifty-five>  
<http://www.logosdictionary.org/> and  
<http://ets.freetranslation.com/>

Applicant agrees with the general proposition that under the doctrine of foreign equivalents, foreign words from common languages are *usually* translated into the English language to determine similarity of connotation in order to ascertain confusing similarity with English word marks. See *Sarkli*, 220 USPQ at 111-13 (Fed. Cir. 1983).

On the other hand, applicant argues that when it is unlikely that the average American consumer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied, citing to *In re Tia Maria Inc.*, 188 USPQ 524 (TTAB 1975) [finding it unlikely that a person who had purchased AUNT MARY'S canned fruits and vegetables from a supermarket would, upon dining at the TIA MARIA restaurant surrounded by Mexican décor and serving Mexican food, translate "Tia Maria" into "Aunt Mary" and then mistakenly assume that both goods and services originated from the same source]. However, we find nothing in this record to indicate the cited mark would not be translated because of marketplace circumstances or the commercial setting in which the mark is used. See also *In re Pan Tex Hotel Corp.*, 190 USPQ 209, 210 (TTAB 1976) [given the circumstances of this case, it is unlikely that purchasers would *stop and translate* LA POSADA into its equivalent "the inn"].

Applicant highlights the manner in which our primary reviewing court used this same "stop and translate" language in its decision of *Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Based on its interpretation of *Palm Bay*, applicant argues that the Trademark Examining Attorney has erroneously applied the doctrine of foreign equivalents to the facts of the instant case. We turn then to applicant's arguments based upon its view of *Palm Bay*, which applicant argues compels a finding that the doctrine of foreign equivalents does not apply in this case.

Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine similarity of connotation in order to ascertain confusing similarity with English word marks. Applicant is correct in quoting the language from *Palm Bay* that the doctrine should be applied "when it is likely that the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Palm Bay*, 73 USPQ2d at 1696.

The "ordinary American purchaser" in this case refers to the ordinary U.S. purchaser of wine who is knowledgeable in French. See *In re Thomas*, 79 USPQ2d at 1024 [the "ordinary American purchaser" in a case involving a foreign

language mark refers to the ordinary American purchaser who is knowledgeable in the pertinent foreign language].

Inasmuch as French is a common, modern foreign language, we must consider that an appreciable segment of the buying public will speak or understand French. In fact, we have recently noted that in the United States, French is second only to Spanish in terms of the largest number of foreign-language speakers in the country. *Id.*

Nonetheless, Applicant argues that the Trademark Examining Attorney's position "flies in the face of well established case law," particularly as discussed in *Palm Bay* (i.e., since " ... it is improbable that the average American purchaser would stop and translate 'VEUVE' into 'widow.'"). We disagree with applicant's interpretation of the Federal Circuit's holding in the *Palm Bay* case, and note that a recent Board decision responded thoroughly to much the same argument. See *In re Spirits International N.V.*, \_\_\_ USPQ2d \_\_\_, Serial No. 74382759 (TTAB February 11, 2008). The Court in *Palm Bay* identified contradictory findings by the Board but did not address the definition of the "ordinary American purchaser." Applicant's interpretation of *Palm Bay* conflicts with long established case law involving the doctrine of foreign equivalents that



has consistently focused on the relevant consumer who speaks or understands the foreign language. *Id.*

Thus, applying the doctrine of foreign equivalents in this case, we find that "fifty-five" is an exact translation of "cinquante-cinq," and that this is a probative fact in making our determination herein as to whether these two marks are confusingly similar.

### ***Comparing the marks in their entirety***

Applicant argues as follows:

The Examiner in concluding that there is a likelihood of confusion between the marks at issue has improperly dissected the respective marks, totally disregarding the significance of the term "BLEND," the name "Vincent Latase," and the color and arrangement of the applied for mark. However, when the marks are viewed in their entirety, as is required, ... the marks - as discussed in detail in Applicant's Appeal Brief - are distinguishable in sound, appearance, meaning, and perhaps most noticeably, commercial impression.

Applicant's reply brief, at 3.

We disagree with this assessment. The Trademark Examining Attorney's appeal brief summarizes the similarities in the marks as follows:

Here, the numeral 55 in the applicant's mark is clearly the dominant portion of the mark. Although the marks are compared in their entirety under a Section 2(d) analysis, one feature of a mark may be recognized as more significant in creating a

commercial impression. Thus, greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915 (CCPA 1976); and *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987). Here, the overall visual representation of the applied-for mark clearly shows that the number 55 is the dominant portion.

As clearly evident, the numeral 55 dominates the mark in its contrasting bright purple color and central placement that fills almost the entire solid black background of the mark. Thus, the eye is immediately drawn to the numeral 55, which is the only element seen at any distance. Additionally, reinforcing the dominance of the numeral 55, a second instance of "FIFTY FIVE" (spelled out), covers the entire center third of the mark.

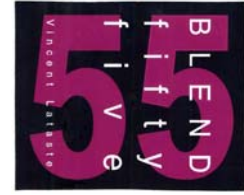
The design portion and disclaimed portion BLEND are not given as much weight when comparing the marks. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The remaining wording in the mark, which is the name VINCENT LATASTE, appears in much smaller font than any other term in the mark, is written sideways and is almost flush left. Compared to the other elements, it is the least visible portion of the mark.

Trademark Examining Attorney's appeal brief, unnumbered pages 10 - 11.

To the extent we find that the ordinary purchaser in the United States knowledgeable in the French language will readily translate CINQUANTE-CINQ into "Fifty-Five," we

also find that registrant's mark creates a connotation and commercial impression most similar to applicant's mark - if one focuses on the large purple digits or on the written-out form of the numeral "fifty-five" in white letters. Irrespective of whether the "fifty-five/55" combination has suggestive connotations or is seen as an arbitrary designation, it will have exactly the same connotation for registrant's wines and for applicant's wines, as identified. To focus on the "fifty-five/55" designation is not a dissection of the mark, or our ignoring the other parts of applicant's composite mark. While we must consider the marks in their entirety, there is nothing improper when articulating reasons for reaching a conclusion on the issue of similarity of the marks, to set out as the Trademark Examining Attorney has done quite rational reasons for why more weight is to be given to the two portions of applicant's mark that reinforce each other and create a dominance for the designation "fifty-five/55," while suggesting that less weight is to be given to other features of the composite mark (e.g., a disclaimed term, words written vertically in much smaller letters, a mere background color, etc.).



Of course there are obvious differences in the appearance of the two marks. Moreover, if one sounds out the entire wording in applicant's mark in English, and contrasts this with the pronunciation of registrant's mark in French, the aural differences are unmistakable. Nonetheless, we find that with marks having quite similar connotations and commercial impressions, we weigh this strong similarity against the dissimilarity in appearance and sound before reaching a conclusion on the similarity of the marks. See *Sure-Fit Products v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958). Accordingly, we find after weighing all the types of similarities and dissimilarities of the marks, that this *du Pont* factor too weighs in favor of the position of the Trademark Examining Attorney.

**Likelihood of Confusion: Conclusions**

With identical goods, and marks that create similar connotations and commercial impressions, we find that there will be a likelihood of confusion herein. The fact that applicant itself is French exacerbates the likelihood of confusion herein. The Trademark Examining Attorney correctly notes that inasmuch as the geographical origins of wines are important to prospective purchasers, given

applicant's corporate headquarters in France, it is even more likely that consumers would assume common source between applicant's "fifty-five/55" and registrant's "cinquante-cinq."

Finally, to the extent we harbor any doubts about our conclusions, we resolve such doubt, as we must, in favor of the prior registrant and against applicant. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004). It is well established that one who adopts a mark similar to the mark of another for the same goods does so at his own peril. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

*Decision:* The Trademark Examining Attorney's refusal of registration under Section 2(d) of the Lanham Act is hereby affirmed.