

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: September 24, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dimiccoli

Serial No. 79059011

John S. Egbert of Egbert Law Offices, PLLC for Mario Dimiccoli.

Michael Engel, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).¹

Before Walters, Zervas and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Mario Dimiccoli, seeks an extension of protection on the Principal Register for the mark displayed below for the following goods:

Headgear, namely, caps, hats; headwear; footwear, namely, boots, booties, sandals, shoes, slippers and sneakers; clothing, namely, anoraks, beachwear, belts, blouses, blousons, cardigans, coats, gloves, gym suits, jackets, jeans, jerkins, jerseys, jumpers, knickers, leather belts, leather coats, leather pants, leggings,

¹ This application originally was assigned to a different examining attorney, but subsequently was reassigned to the examining attorney whose name is shown above.

loungewear, neckwear, overalls, overcoats,
pajamas pants, pullovers, raincoats, shirts,
shorts, skirts, sleepwear, socks, stockings,
suits and dresses suspenders, sweat pants,
sweaters, sweat-shirts, tights, track suits,
trousers, T-shirts, underwear, vests, waistcoats

in International Class 25.²

**CEMENTO
ARMATO
JEANS**



Registration has been finally refused pursuant to
Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that
applicant's mark so resembles the mark shown below in
Registration No. 3202313,

² Application Serial No. 79059011 was filed on June 20, 2008 seeking an extension of protection under Trademark Act Section 66(a), as amended, based upon International Registration No. 0977681. "JEANS" is disclaimed. "The English translation of the foreign word(s) in the mark is REINFORCED CONCRETE JEANS." "The mark consists of the wording "CEMENTO ARMATO JEANS"; underneath there are the letters "C" "A" and lower the word "JEANS" where the letters "EANS" are smaller than the letter "J"; in the background there is a drawing that represents a wall made of rectangular bricks."



for a wide variety of clothing items including the following:

head wear, footwear, gloves, gym suits, jeans, jerkins, jerseys, jumpers, knickers, leather belts, leather coats, leather pants, leggings, loungewear, neckwear, overalls, over coats, pullovers, raincoats, shirts, shorts, skirts, sleepwear, socks, stockings, suspenders, sweat pants, sweaters, sweat shirts, tights, T-shirts, underwear, vests, waistcoats

in International Class 25³, as to be likely, if used on or in connection with the identified goods, to cause confusion, to cause mistake, or to deceive. Applicant and

³ Issued on January 23, 2007 as an extension of protection under Trademark Act Section 66(a), as amended, of International Registration No. 0861267. "FASHION" and "ITALIAN STYLE" are disclaimed. "The English translation of the word "CEMENTO" in the mark is "cement." "The logo is made up of the word CEMENTO above which there is a design of a skyscraper on which there are three letters CEM which are cemento's initials. Hanging beside the skyscraper is a man standing on a steel girder which is suspended on a steel cable held by a hook. The entire image is contained within an incomplete circle. Under the writing CEMENTO are the words FASHION CONSTRUCTOR contained inside a long rectangle and under these the words: Original & Strong Italian Style."

the examining attorney have filed main briefs on the issue under appeal.

Likelihood of Confusion

Our determination under Trademark Act §2(d) is based upon 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). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *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 considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

We review the relevant *du Pont* factors as they apply to this case.

The Goods and Trade Channels

Turning to our consideration of the recited goods, we observe that the goods in the application and the cited registration are, in part, identical. Many of applicant's goods, which are various items of clothing, are also recited among the large variety of clothing items identified in the cited registration. Specifically, the goods listed above from the cited registration are identical to clothing items recited in the involved application. Further, many of the additional items of apparel identified in the application and registration are typically worn together and thus are related.⁴

Because the goods are identical and/or closely related and there are no restrictions as to their channels of trade or classes of purchasers, we must assume that the goods are, or will be, sold in all the normal channels of trade to all the usual purchasers for such goods, and that the channels of trade and the purchasers for applicant's and

⁴ The identification of goods in the cited registration also includes such items as "costumes for use in role-playing games, jodhpurs, togas and zoot suits," which are more likely to be worn only on special occasions. However, the identification of such goods in the cited registration does not in any way diminish the fact that applicant's goods are, in part, identical to those in the cited registration.

registrant's goods would be the same. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

The Marks

We now turn to the *du Pont* factor to which the applicant and examining attorney have devoted most of their arguments, namely, the similarities or dissimilarities between applicant's mark and that of registrant. In coming to our determination, we must compare the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, supra*. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion as to the source of the goods offered under the respective marks is likely to result.

As both marks contain foreign wording, in conducting our analysis of the marks, we must first determine whether the doctrine of foreign equivalents is applicable in this case. Applicant raised this question only in his brief and the examining attorney stated that "the Office has not invoked the doctrine of foreign equivalents in either

making or upholding the Section 2(d) refusal."⁵ Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English word marks. See *Palm Bay Imports, supra*. The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Id.* at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976).

In this case, it is inappropriate and unnecessary to invoke the doctrine of foreign equivalents. Both marks consist of wording in English and Italian. However, the foreign wording in each mark is unlikely to be translated. See *In re Universal Package Corp.*, 222 USPQ 344, 347 (TTAB 1984) ("This situation is different from that where we are presented with a mark consisting entirely of foreign word components. Here only one of the two components is foreign. Translation of an entire compound word mark is more likely to take place in the marketplace than is the translation of only part of the mark.") In applicant's mark, CEMENTO ARMATO, positioned above the word "jeans," appearing in tandem with the letters CA, and used in the clothing field where designers regularly include their

⁵ Examining attorney's brief, p. 6.

names as part of their marks, is likely to be perceived as an Italian name where all of the other wording is in English. Even if the phrase is translated, the identical portions of the two marks is CEMENTO, which means "cement" in Italian and looks very much like the English word "cement." This meaning of the term is emphasized in the registered mark by the design element suggesting the construction industry. As a result, our analysis of the similarity or dissimilarity between the marks is analogous regardless of whether the marks are likely to be translated.

(Applicant's Mark)



(Registrant's Mark)



We turn then to a comparison of the marks at issue. In this case, we note that applicant's mark is similar to the mark in the cited registration solely to the extent that both contain the word CEMENTO as a prominent element thereof. However, the marks are dissimilar in that

applicant's mark, CEMENTO ARMATO JEANS CA JEANS and design, contains additional wording as well as a brick wall design not present in the cited mark. Similarly, the cited mark, CEMENTO FASHION CONSTRUCTOR ORIGINAL AND STRONG ITALIAN STYLE and design, contains wording and the design of a worker, girder and skyscraper not present in applicant's mark. CEMENTO ARMATO and the wording CA JEANS superimposed upon the brick wall design are equally prominent portions of applicant's mark and contribute equally to the visual impression thereof. In registrant's mark the term CEMENTO is the largest portion thereof. However, CEMENTO is located below a prominent workman, girder and skyscraper design and above the additional wording FASHION CONSTRUCTOR ORIGINAL AND STRONG ITALIAN STYLE. Thus, the design element and other wording encompass the CEMENTO portion of the mark in such a way as to form a unique whole that should not be dissected for purposes of determining dominance within the appearance of the whole mark. Thus, when viewed as a whole, applicant's mark is notably dissimilar from that of registrant both in appearance and sound.

With regard to the overall impression conveyed by the marks, we note that the meaning or connotation of a mark must be determined in relation to the recited goods. See

In re Sears, Roebuck and Co., 2 USPQ2d 1312 (TTAB 1987); and *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984). In this case, whether translated or not, the term CEMENTO in each mark may convey the notion that the clothing items in question are durable and strongly made. However, if the CEMENTO ARMATO portion of applicant's mark is perceived as a name, this connotation is unlikely to occur to viewers of applicant's mark. Thus, the possible suggestion of durability present in registrant's mark and perhaps present in applicant's mark is not sufficient to overcome the differences in their appearance, sound and, to some viewers, their connotation.

Based upon the foregoing, we find that the dissimilarities between applicant's mark and the mark in the cited registration outweigh the similarities. Thus, the first *du Pont* factor regarding the dissimilarity of the marks strongly favors applicant. Moreover, we find this factor is determinative and, despite the identity of the goods, we conclude that the marks are sufficiently dissimilar that confusion is not likely between applicant's mark and the mark in the cited registration.

Decision: The refusal to register is reversed.