

This Opinion is not a
Precedent of the TTAB

Hearing: September 14, 2016

Mailed: September 21, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re The Line and Dot LLC
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Serial No. 86170528
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Erik M. Pelton and John Heinbockel of Erik M. Pelton & Associates,
for The Line and Dot LLC.

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Before Seeherman, Greenbaum and Pologeorgis,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Line and Dot LLC (“Applicant”) has appealed from the final refusal of the Trademark Examining Attorney to register LUMIÈRE, in standard characters, for “women’s clothing, namely blouses, tops, dresses, pants and sweaters.”¹ The application includes the statement that “[t]he English translation of LUMIERE in

¹ Application Serial No. 86170528, filed January 21, 2014, asserting first use and first use in commerce as of 2010 (which is treated as December 31, 2010). See TMEP §903.06 (April 2016).

the mark is LIGHT.” Registration was refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the mark LUMIERE PLACE, registered in standard characters for the following goods, that as used in connection with Applicant’s identified goods, it is likely to cause confusion or mistake or to deceive:

Blouses; coats; foul weather gear; gloves; headwear; jackets; jogging suits; pants; polo shirts; robes; shirts; shorts; socks; sweat pants; sweat shirts; sweaters; swimwear; t-shirts; tank tops; vests; wristbands.

The registration includes this translation statement: “The English translation of ‘LUMIERE’ in the mark is ‘LIGHT.’”

We affirm the refusal to register.

Our determination of the issue of likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

We turn first to the *du Pont* factor of “the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.” *du Pont*, 177 USPQ at 567. Applicant’s identified blouses, pants and sweaters are legally identical to the blouses, pants and sweaters identified in the cited registration, while Applicant’s identified “tops” encompass the identified polo shirts, t-shirts and tank tops. In view of the identity of these goods, we need not discuss the relatedness of Applicant’s identified dresses to the goods in the

registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods). Moreover, because the goods are legally identical, and there are no restrictions in the channels of trade, they are deemed to be sold in the same channels of trade. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (absent restrictions in the application and registration, legally identical goods and services are presumed to travel in the same channels of trade to the same class of purchasers). Applicant does not dispute this; in fact, it does not even address these points in its brief. These two *du Pont* factors favor a finding of likelihood of confusion.

This brings us to a consideration of the marks, and in particular, the strength of the cited registration. Applicant argues that because Registrant's mark LUMIERE PLACE contains the French word LUMIERE (the same word that comprises Applicant's mark), we should apply the doctrine of foreign equivalents and consider the strength of the mark by looking at third-party registrations for clothing marks that contain the English word "LIGHT." Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of meaning and connotation in order to ascertain confusing similarity with English word marks. McCarthy on Trademarks and Unfair Competition, 4th ed. § 23.36. The rationale of the doctrine of foreign equivalents is that a foreign, non-English word familiar to an appreciable segment of American purchasers may be confusingly similar to its English

equivalent. *Id.* When the issue is likelihood of confusion, the doctrine is applied when one party's (or the Applicant's) mark is in one language, and another party's mark (or the cited mark) is in another language; the concern is that a consumer who speaks the foreign language and knows of the mark in that language, upon seeing a mark in English with that same meaning, will assume that this product or service comes from the same source, and is now being marketed to English-speaking consumers.

Applicant has cited no cases in which the doctrine of foreign equivalents has been applied in the manner it is seeking to use it, to show that the registration of various LIGHT marks to third parties should limit the protection to be accorded the mark LUMIERE PLACE. On the contrary, in *In re Seal Prods., LLC*, 107 USPQ2d 1580, 1588 (TTAB 2013), the Board found that third-party registrations for the marks FORCE and FORTE were not considered direct equivalents of FORZA, the term in the cited marks and also the mark for which registration was sought; the application translated FORZA as "force." Nor do we see a good rationale for applying the doctrine of foreign equivalents to the present situation. Normally the doctrine of foreign equivalents is used to avoid confusion by consumers who speak or understand both English and the foreign language. But treating the word LIGHT in third-party registrations as the equivalent of LUMIERE in order to conclude that consumers would distinguish between Applicant's mark LUMIÈRE and Registrant's mark LUMIERE PLACE would not take into consideration those consumers who do not understand the foreign language, and on whom the various LIGHT marks would have no impact. In any event, although the coexistence on the Register of a large number

of marks for clothing that contain the element LIGHT might indicate a determination by examining attorneys that additional words in such marks are sufficient to distinguish them from each other, here the mark is LUMIERE PLACE and the applied-for mark is LUMIÈRE, and the more relevant inquiry is whether they are distinguishable from each other. LUMIERE PLACE is already distinguished from the third-party LIGHT marks by the fact that LUMIERE has a different appearance and pronunciation (and, for non-French speakers, a different meaning). There are only two third-party registrations that contain the word LUMIÈRE, VOYAGE DE LUMIÈRE (VOYAGE OF LIGHT) (Reg. No. 4289398) and PALAIS LUMIÈRE (Reg. No. 4479340). The coexistence of just these two marks and the cited registration, all of which have distinguishing elements, is not sufficient for us to conclude that the cited mark is entitled to only a limited scope of protection.

We should add that normally third-party registrations are used in the manner of dictionary definitions, to show that a term has a certain significance within an industry. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). We cannot ascertain from the various third-party registrations that LIGHT has a particular significance for clothing, such that we can conclude that LUMIERE in the mark LUMIERE PLACE has a suggestive or even descriptive significance. This is because LIGHT has different meanings in these third-party marks. For example, it is used as a verb in marks such as LIGHT UP THE HALO (Reg. No. 3951477), LIGHT UP THE DARKNESS (LUTD) (Reg. No. 4515846), FOG IT LIGHT IT BLOW IT UP (Reg. No. 3797774) and LIGHT THAT SPARK WITHIN (Reg. No. 3189768), and as a

reference to God or inner spirit in I AM LIGHT (Reg. 4306343), LET YOUR LIGHT SHINE and design (Reg. No. 4511353), KINDGOM CONFIDENCE LIVE IN THE LIGHT and design (Reg. No. 4565445) and LIGHT SOURCE and Cross design (Reg. No. 4575432). In other marks the word or element LIGHT is part of marks that each appear to be arbitrary for clothing and different in meaning from each other, e.g., DREAMLIGHT (Reg. No. 4275193); HELP LIGHT (Reg. No. 4280877); NEON LIGHTS (Reg. No. 4429332); BLACKLIGHT (Reg. No. 2837338). LIGHT YEARS (Reg. No. 3402856); and FRIDAY NIGHT LIGHTS (Reg. 3872272).

In fact, the only mark in which LIGHT has a clearly descriptive meaning for clothing is in LW LIGHT WEIGHT and design, in which “light weight” has been disclaimed (Reg. No. 4046764), and it is the addition of the word WEIGHT that makes the term as a whole descriptive; it does not show that LIGHT, or by extension LUMIÈRE PLACE, has a descriptive or suggestive significance for clothing.

We now consider “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *du Pont*, 177 USPQ at 567. When marks would appear on virtually identical goods, as they do here, the degree of similarity 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). The similarities between the marks are obvious, Applicant’s mark consists of the first word of the cited mark, and to this extent, the marks are similar in appearance and pronunciation.² Moreover, LUMIERE is a

² We note that Applicant’s mark includes the French *grave* accent over the first “E” in LUMIÈRE, and the cited mark does not. We do not regard this as a distinguishing feature

prominent feature of the cited mark because it is the first word. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that the marks have different meanings and commercial impressions because LUMIERE PLACE indicates a location due to the inclusion of PLACE, which means, *inter alia*,; “a specific area or region of the world: a particular city, country etc.” and “a building or area that is used for a particular purpose.”³ This same dictionary also defines “place” as, e.g., “physical environment: SPACE; “physical surroundings: ATMOSPHERE”; “a building or locality used for a special purpose <a *place* of learning> <a fine eating *place*>”; “a particular region, center of population, or location <a nice *place* to visit>”; “a proper or designated niche or setting <the *place* of education in society>”; “an appropriate moment or point <this is not the *place* to discuss compensation – Robert Moses>”; and “a distinct condition, position, or state of mind <the postfeminist generation is in a different *place* - Betty Friedan>”. The many dictionary definitions for “place” also includes “a public square; PLAZA” and “a small street or court,” but in view of the different meanings that “place” has, we cannot conclude that consumers will view LUMIERE PLACE when used as a mark for clothing as a definite geographic location. Instead, they are just as, or even more, likely to regard LUMIERE PLACE as an inchoate spot or area, akin to a store, where

(nor does Applicant argue this). The presence or absence of the accent is not likely to be noticed by consumers, or if it were, it would not be viewed as having source-indicating significance.

³ Merriam-Webster, m-w.com, August 13, 2014 response, p. 13-14.

clothes are sold. As a result, upon encountering the mark LUMIÈRE for the identical goods sold under the mark LUMIERE PLACE, they are likely to believe that these goods come from the same source, and view LUMIÈRE as merely a shortened form of the LUMIERE PLACE mark.

It must also be remembered that the goods are general consumer items, and that, as identified, they may include inexpensive items that may be purchased without a great deal of thought. Consumers who are aware of LUMIERE PLACE clothing, upon seeing LUMIÈRE for the identical piece of clothing, are not likely to go through an extended analysis and then conclude that the absence of the word PLACE in the LUMIÈRE mark indicates a different source for the goods. They are more likely to assume, as stated above, that the similar marks LUMIÈRE and LUMIERE PLACE indicate a single source for the clothing.

We are not persuaded by Applicant's arguments that because LUMIERE PLACE is the name of a casino and hotel in St. Louis,⁴ consumers would associate the mark as used for clothing with the physical location of that establishment, and that the mark's primary function is as an identifier of source for those hotel and casino services. In an analogous situation, in *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983), the opposer relied, in part, on its registration of the mark SQUIRT for balloons. The Board discounted the significance of the use of SQUIRT on these goods, characterizing the use as merely of promotional value. However, the

⁴ Applicant submitted evidence from LumierePlace.com and Wikipedia regarding this casino and hotel. Response filed August 13, 2014, pp. 18-23.

Federal Circuit found that the Board erred because the opposer's registration had no limitation that restricted the usage of SQUIRT to balloons to promote soft drinks, and by treating the balloons as being promotional items, the Board "improperly read limitations into the registration." *Id.* at 940. "There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks." *Id.* In the present case, we will not read a restriction into the Registrant's goods, and limit the registration by treating the mark solely as indicating a secondary source. Rather, we must consider the Registrant's goods to be sold throughout the United States in all trade channels in which such clothing may be sold, and its customers—the public at large—may include people who have never heard of the hotel and casino in St. Louis. *See In re Big Pig Inc.*, 81 USPQ2d 1436, 1438 (TTAB 2006) (because identification in application does not limit the sale of applicant's clothing items to applicant's restaurants and the identification in the cited registration does not limit the sale of registrant's clothing items to skateboarding venues and sporting goods stores, the goods must be assumed to travel through all normal trade channels for clothing to all usual classes of purchasers). Echoing what the court said in *Squirtco*, the issue presented here is a simple one: is Applicant's use of LUMIÈRE for sweaters, blouses, pants and tops likely to cause confusion with the Registrant's LUMIERE PLACE mark for sweaters, blouses, pants and tank tops, t-shirts and shirts. For the reasons discussed above, the answer is yes.

Decision: The refusal to register Applicant's mark LUMIÈRE is affirmed.