

This Opinion is not a
Precedent of the TTAB

Mailed: May 28, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Talyoni, LLC

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Serial No. 87695323

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John S. Mortimer of Wood Phillips Katz Clark & Mortimer,
for Talyoni, LLC.

Jennifer D. Richardson, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

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Before Cataldo, Ritchie, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Talyoni, LLC, seeks registration on the Principal Register of the mark EL PATRÓN (in standard characters) for “perfumes and colognes” in International Class 3.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), contending that

¹ Application Serial No. 87695323 was filed on November 22, 2017 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant’s assertion of a bona fide intent to use the mark in commerce.

EL PATRÓN, as intended to be used in connection with Applicant's identified goods, is likely to cause confusion with the registered mark BOSS (in typed format)² for goods including "perfumery for personal use, namely, perfumes, eau de parfum," in International Class 3.³

In addition, the Examining Attorney refused registration on the basis of Applicant's failure to submit an acceptable translation of the non-English wording in its mark as required by Trademark Rule 2.32(a)(9), 15 U.S.C. § 2.32(a)(9).

When the refusals were made final, Applicant appealed. We affirm both refusals to register.

I. Translation Requirement

Because the meaning of the involved mark has a bearing on our likelihood of confusion determination, we begin with the requirement that Applicant provide a translation of the non-English wording comprising its mark.

Evidence of Record

Applicant's mark is EL PATRÓN. The Examining Attorney has provided numerous translations of the wording comprising the EL PATRÓN mark. The following examples are illustrative:⁴

patrón – (colloquial) boss, chief, owner, employer;
(WordReference.com)

² Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. §2.52, was amended to replace the term "typed" drawing with "standard character" drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark.

³ Registration No. 1429737 issued February 24, 1987. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Second renewal.

⁴ Examining Attorney's March 14, 2018 first Office Action at .pdf 9, 12-14;

patrón – boss (informal), employer, owner; and
(Collins Spanish to English Dictionary)

el patron – the boss.
(SpanishD!ct)

The Examining Attorney also made of record screenshots of webpages from Applicant's website, elpatronusa.com, for skin care products marketed under the EL PATRÓN mark, that include the following statements:⁵

The boss knows that looking his best starts with the best. From a lush, verdant shampoo enriched with eucalyptus and aloe to an intensely hydrating conditioner with algae, sea minerals, and Moroccan oil, El Patron delivers luxury and refinement to your regimen.

El Patron
Be the boss. This is the spirit of El Patron. Born out of the desire to bring out the best in a man's personal style.

In addition, the Examining Attorney has introduced into the record copies of a prior registration owned by Applicant, as well as registrations owned by third parties consisting of the term EL PATRÓN with an English translation.⁶ The following examples are illustrative:

Reg. No. 4744513, owned by Applicant, for the mark EL PATRÓN, identifying hair and skin care products. "The English translation of 'EL PATRÓN' in the mark is 'the boss;'"

⁵ Examining Attorney's October 14, 2018 final Office Action at .pdf 7-14.

⁶ Examining Attorney's March 14, 2018 first Office Action at .pdf 7; October 14, 2018 final Office Action at .pdf 21-33.

Reg. No. 2375947, owned by L.A. Foods, LLC, for the mark EL PATRON, identifying canned chili peppers. “The English translation of EL PATRON is THE BOSS;” and

Reg. No. 3366447, owned by Clear Channel Broadcasting, Inc., for the mark EL PATRON, identifying radio broadcasting services. “The English translation of ‘EL PATRON’ is ‘THE EMPLOYER,’ ‘THE BOSS,’ or, ‘THE LANDLORD.’”

Discussion

Applicant filed the involved application with the following translation:

The English translation of EL PATRÓN in the mark depends upon the context in which it is used: “THE OWNER” when referring to a business; “LANDLORD” when referring to a farming estate; “PATTERN” when used as a measurement unit; and “MASTER, CAPTAIN, GOVERNOR, EMPLOYER, MODEL, BOSS” in certain contexts.⁷

Applicant argues that “because of the multiple translations of EL PATRÓN, of which ‘the boss’ is one, it is accurate and appropriate to identify the English translation of ‘EL PATRÓN’ as encompassing such multiple translations.⁸ The Examining Attorney argues

In the present case, applicant’s proposed translation is too verbose and vague to be appropriate for printing and is in need of clarification in order for the statement to be clear and concise. Specifically, applicant’s proposed translation includes discussion relative to meaning that is not appropriate for printing in the Official Gazette or on the certificate of registration.⁹

⁷ November 22, 2017 application at .pdf 1.

⁸ Applicant’s brief; 4 TTABVUE 3.

⁹ Examining Attorney’s brief; 6 TTABVUE 11.

Trademark Rule 2.32(a)(9), 37 C.F.R. §2.32(a)(9), provides: “The application must be in English and include the following: If the mark includes non-English wording, an English translation of that wording.” “The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language.” TMEP § 809.02 (2018). “Sometimes translations that are not precise, or that give a variety of meanings, are placed in the record. While all possible translations, and discussions relative to meaning, are useful for informational purposes, not all such matter is appropriate for printing in the Official Gazette or on the certificate of registration. Only a translation that is the clear and exact equivalent should be printed. This normally means only one translation, because the existence of a variety of alternative translations, or the necessity of including explanatory context, usually indicates a lack of a clearly recognized equivalent meaning. If an applicant submits a translation that is too verbose or vague to be appropriate for printing, the examining attorney must require a clear, concise translation.” TMEP § 809.03.

The above translation submitted by Applicant with its original application seeks to impose contextual limitations and conditions upon the various definitions suggested, and thus is unnecessarily verbose and vague. Furthermore, the proposed definition is inconsistent with the majority of dictionary definitions as well as its own prior registration and website advertisements, third-party registrations, and examples of use of the term El Patron in context, all of which suggest that EL PATRÓN is defined as “the boss,” “the owner,” “the employer” and “the landlord.”

The meaning of words is of critical importance in a trademark application. A translation made part of the application provides public notice of the meaning of the words in applied-for matter, allowing third parties to assess the scope of an applicant's or registrant's rights. Accordingly, the requirement pursuant to Trademark Rule 2.32(a)(9) for submission of a clear and concise English translation of EL PATRÓN⁷ for the record was appropriate. In view thereof, the refusal to register Applicant's mark for failing to submit such a clear and concise translation is affirmed.

II. Refusal of Registration under Trademark Act Section 2(d)

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., 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); *In re Dixie Rests. 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 and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

A. Relatedness of the Goods and Trade Channels

We begin with the *du Pont* factor of the relatedness of the goods. We base our evaluation on the goods as they are identified in the cited registration and application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems, Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The goods of Applicant and Registrant are, in part, identical. Both Applicant's goods and the goods in the cited registration include "perfumes." Furthermore, the Examining Attorney introduced evidence that "cologne" is defined as "a kind of weak perfume."¹⁰ Applicant's "colognes" thus are related to the "perfumery for personal use, namely, perfumes, eau de parfum" identified in the cited registration.

There are also no limitations in the identifications of goods with respect to channels of trade or classes of customers. Accordingly, we must presume that both Applicant and Registrant offer various perfumes at all price points to all typical classes of consumers through identical distribution channels. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *see also Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any

¹⁰ Examining Attorney's March 14, 2018 first Office Action at .pdf 10.

restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”). Because the goods are widely offered to the general public, potential customers include ordinary purchasers. The second and third *du Pont* factors heavily favor a finding of likelihood of confusion.

B. Comparison of the Marks

We turn now to the first *du Pont* factor, i.e., whether the marks are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. *In re Viterro Inc.*, 101 USPQ2d at 1908; *Palm Bay*, 73 USPQ2d at 1692 (quoting *du Pont*, 177 USPQ at 567). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006) (holding MARCHE NOIR for jewelry likely to be confused with the cited mark BLACK MARKET MINERALS for retail jewelry and mineral store services); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). The test, under the first *du Pont* factor, 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 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). The focus is on the recollection of the average purchaser, who normally retains a general rather than a

specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014). Moreover, when marks would appear on virtually identical goods, the degree of similarity necessary to support a conclusion of likely confusion declines. *Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

According to the above translations introduced into the record by the Examining Attorney, “EL PATRÓN” in Spanish means, inter alia, “the boss” in English, along with other meanings such as “the owner” and “the landlord.” The gravamen of the Examining Attorney’s argument regarding the similarity of the marks is her contention that EL PATRÓN means “boss” in Spanish.

“Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay*, 73 USPQ2d at 1696. The doctrine is applicable when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Id.* “The ‘ordinary American purchaser’ in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language.” *In re Thomas*, 79 USPQ2d at 1024. Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. *See In re Thomas*, 79 USPQ2d at 1021; *In re Am. Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987) (finding BUENOS DIAS for soap confusingly

similar to GOOD MORNING for shaving cream); *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986) (holding applicant's mark LUPU for men's and boys' underwear likely to be confused with the cited registration for WOLF and design for various clothing items, where LUPU is the Italian equivalent of the English word "wolf").

In its brief Applicant presents the following argument as to why the doctrine of foreign equivalents should not be applied in this case:

The ordinary American purchaser, which includes all American purchasers, including those proficient in a non-English language per *In re Spirits Int'l N. V.*, 563 F3d 1347, 1352 (Fed. Cir. 2019), would not be likely to translate "El Patron" into English. This is particularly true since neither of [sic] "el patron" or "the boss" conveys anything informational associated with fragrances. A person fluent in Spanish would recognize EL PATRÓN, without translation, as an arbitrary identification on a product.

In other words, per the direction given in *Palm Bay Imports, Inc. v. Veve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1377 (Fed. Cir. 2005), it is unlikely, given the nature of the products and mark, that the ordinary American purchaser would "stop and translate [the word] into its English equivalent."¹¹

Applicant cites to no authority, and we are aware of none, for its position that the application of the doctrine of foreign equivalents in likelihood of confusion cases is restricted to foreign words that are descriptive or suggestive of the identified goods. Indeed, Applicant's position is contrary to the decisional authorities cited above. *See In re Am. Safety Razor Co.*, 2 USPQ2d at 1460; *In re Ithaca Industries, Inc.*, 230 USPQ at 703. In other words, the doctrine of foreign equivalents is not applied

¹¹ 4 TTABVUE 5.

selectively based upon whether the mark is arbitrary, suggestive or descriptive of the goods or services identified thereby.

Applicant also argues:

Further, since there are several relevant meanings of “el patron”, *even* if a consumer was inclined to stop and translate, which Applicant contends is not the case, the fact that a person fluent in Spanish would recognize the many different potential translations makes application of the doctrine of foreign equivalents *even* more inappropriate.¹²

Again, Applicant cites to no authority for its position that a term having more than one meaning will not be translated by individuals fluent in the foreign language in which the term appears.

It is well-established that in considering descriptiveness, genericness, or likelihood of confusion, the doctrine of foreign equivalents applies to “words from common, modern languages.” *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647-48 (TTAB 2008) (citing *Palm Bay*, 73 USPQ2d at 1696). The Examining Attorney’s Census Bureau evidence establishes that in 2015, over 37 million Americans spoke Spanish.¹³ *Accord In re Joint-Stock Co. “Baik”*, 80 USPQ2d 1305, 1310 (TTAB 2006) (“There is no question that Russian speakers living in the United States, according to the record approximately 706,000 in number, would immediately know that BAIKALSKAYA means ‘from Baikal.’”). In this case, the evidence clearly establishes that EL PATRÓN is a Spanish term that translates to “the boss,” “the owner” or “the landlord.” Applicant has translated EL PATRÓN as

¹² *Id.* (emphasis by Applicant)

¹³ October 14, 2018 final Office Action at .pdf 45.

“the boss” in at least one prior registration and emphasizes that meaning in website advertisements. Applicant’s own actions thus appear to associate its EL PATRÓN mark with “the boss” as opposed to other potential definitions of the term. This case is distinguishable from *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983) and *In re Ness & Co.*, 18 USPQ2d 1815 (TTAB 1991), where the marks were not considered exact equivalents. (SECOND CHANCE and REPÊCHAGE in *Sarkli*; GOODNESS and LABONTÉ in *Ness*). We find as a result that Spanish-speaking consumers will translate EL PATRÓN in accordance with the definitions of record and are particularly likely to translate the mark to “the boss.”

As our primary reviewing court recognized in *In re Sarkli, Ltd.*, 220 USPQ at 113, “the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark.” Generally, however, applying the doctrine of foreign equivalents is only part of the determination of whether the marks being compared are confusingly similar. Citing *Sarkli*, the Board in *In re Ness & Co.*, 18 USPQ2d at 1816, explained, “As has been stated, ‘such similarity as there is in connotation [between the foreign word mark and the English word mark] must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.’” *See also Ithaca Industries*, 230 USPQ at 704 (“We recognize, however, that this equivalency in connotation does not, in and of itself, determine the question of likelihood of confusion in this case.”). In addition to similarity in connotation:

other factors to be considered are the dissimilarity in overall appearance and pronunciation of the marks, the differences in the goods to which the marks are applied, and the degree of suggestiveness of applicant's mark and the cited mark as applied to the respective goods. *Id.*

Considering such other factors relevant to the case at hand, we find that Applicant's mark, EL PATRÓN, is dissimilar in appearance and sound from the registered mark BOSS. Applicant asserts that EL PATRÓN is arbitrary as applied to its goods. Applicant further asserts that the registered BOSS mark connotes its owner's founder, Hugo Ferdinand Boss, and that advertisements and packaging for goods identified by the BOSS mark reinforce that connotation.¹⁴ However, we must make our determination based upon the marks as they appear in the involved application and cited registration. *See, e.g., In re Viterra Inc.*, 101 USPQ2d at 1908. There is insufficient evidence that consumers encountering the registered BOSS mark will necessarily associate the mark with its owner's founder and little, if any, evidence to suggest that the term BOSS is suggestive as applied to perfumes. Thus, BOSS is conceptually strong as a trademark. A strong mark "not only entitles the registered mark to a broad scope of protection, but significantly increases the likelihood that the marks, when used in connection with the identical goods, would cause confusion." *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (citing *Palm Bay*, 73 USPQ2d at 1692 ("VEUVE is an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark.")). *Cf. In re Lar Mor International, Inc.*, 221 USPQ 180 (TTAB 1983) (finding no likelihood of

¹⁴ 4 TTABVUE 4; Applicant's September 14, 2018 Response to Office Action at .pdf 5.

confusion between TRES JOLIE and the registered mark BIEN JOLIE given the highly laudatory meaning of the registered mark).

Finally, considering “the differences in the goods to which the marks are applied,” we observe that the goods at issue are identical in part, and sold to the same customers through identical trade channels, which also increases the likelihood of confusion. In view of the foregoing, we find that the Spanish term EL PATRÓN, which may be translated as “the boss,” and BOSS share a nearly identical meaning, while differing in appearance and sound but nonetheless, overall, convey similar connotations and commercial impressions. Accordingly, the first *du Pont* factor also somewhat favors a finding of likelihood of confusion.

C. Consumer Sophistication

There is nothing in the identifications of goods to indicate that the perfumes offered under the respective marks are restricted to expensive perfumes, offered at only high prices and purchased only by consumers with specialized knowledge and discerning tastes. “When a buyer class is mixed, the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer in the class.” *Stone Lion Capital Partners*, 110 USPQ2d at 1163 (quoting with approval *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 18 USPQ2d 1417 (3d Cir. 1991)). In addition, there is nothing in the record to support a finding that the goods and purchasing process are of such a nature that purchasers could distinguish similar marks for virtually or legally identical goods. *See, e.g., Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388

(Fed. Cir. 1992) (record confirms that opposer's services are expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation and that the evaluation process used in selecting applicant's products requires significant knowledge and scrutiny). As such, we find this *du Pont* factor is, at best, neutral, or slightly favors a finding of likelihood of confusion.

III. Conclusion

In summary, Applicant's goods are identical in part to those in the cited registration, and must be presumed to be offered to the same classes of consumers through the same channels of trade. We find that the ordinary purchaser of perfume who is knowledgeable in the Spanish language will understand that EL PATRÓN may be translated to "the boss," and that, as a result, Applicant's EL PATRÓN mark is substantially the same in meaning, although dissimilar in appearance and sound to the cited mark BOSS. Accordingly, viewed as a whole, the marks convey more similar than dissimilar commercial impressions as applied to these identical goods. We further find that the consumers of Applicant's goods and Registrant's goods include ordinary purchasers of perfume who will not necessarily exercise a high degree of care or discernment.

Decision: The refusal to register for failure to submit an acceptable translation of the non-English wording in Applicant's mark, as required by Trademark Rule 2.32(a)(9), and the refusal to register Applicant's mark EL PATRÓN under Section 2(d) of the Trademark Act are affirmed.