

This Opinion is not a
Precedent of the TTAB

Mailed: March 21, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Iatichand R. Goojha
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Serial No. 88479529
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Russell D. Williams of R. Williams, P.C.,
for Iatichand R. Goojha.

Evonne M. Neptune, Trademark Examining Attorney, Law Office 127,
Mark Pilaro, Managing Attorney.

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Before Bergsman, Goodman and Lebow,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Iatichand R. Goojha (“Applicant”) seeks registration on the Principal Register of



Le Chocolat des Iles

the mark

(“chocolat” disclaimed) for

“Chocolate; Chocolate and chocolates; Chocolate bars;
Chocolate cakes; Chocolate candies; Chocolate chips;
Chocolate confections; Chocolate-coated nuts;

Confectionery, namely, candy and chocolate; Filled chocolate; Milk chocolate” in International Class 30.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on likelihood of confusion with the mark ISLAND CHOCOLATES (“chocolates” disclaimed) for “chocolate candies, chocolate covered nuts” in International Class 30.²

After the Trademark Examining Attorney made the refusal final, the application abandoned. Applicant concurrently filed a petition to revive to the Director, response to the final office action and an appeal to this Board. After the application was revived, the appeal was instituted and the case was remanded to the Examining Attorney for consideration of the response to the final office action, treated as a request for reconsideration.

¹ Application Serial No. 88479529 was filed on June 19, 2019, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as November 11, 2016. Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). “CHOCOLAT” is disclaimed. The description of the mark provided by Applicant states the following: “The mark consists of a stylized gold and yellow clipper ship, displayed on a gold and yellow beach containing a gold and yellow palm tree, all encased in a gold and yellow circle. The wording ‘LE CHOCOLAT DES ILES’ appears below the circle and design in yellow and gold. The white represents background and is not a feature of the mark.” The color(s) gold and yellow is/are claimed as a feature of the mark. Applicant provided a translation statement: “The English translation of ‘LE CHOCOLAT DES ILES’ in the mark is ‘THE CHOCLATE (sic) OF THE ISLANDS.’”

Page references to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Applicant’s brief is at 8 TTABVUE and the Examining Attorney’s brief is at 10 TTABUVE.

² Registration No. 3656388, renewed. The registration includes a concurrent use statement: “Registration limited to the area comprising Hawaii and Guam. Pursuant to Concurrent Use Proceeding No. 94002225. Concurrent registration with Registration No. 3250485.” Registration No. 3250485 was cancelled effective January 17, 2014.

After the Examining Attorney denied the request for reconsideration, the appeal was resumed.

We affirm the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or to deceive. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors and others are discussed below.

A. Second *DuPont* Factor

We first consider the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*,

177 USPQ at 567. *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

“[T]he identification of goods/services statement in the registration, not the goods/services actually used by the registrant, frames the issue.” *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003). *See also Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (“the relevant inquiry in an ex parte proceeding focuses on the goods and services *described in the application and registration*, and *not* on real-world conditions”) (emphasis in original). The goods need not be identical but “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 emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant’s goods are “Chocolate; Chocolate and chocolates; Chocolate bars; Chocolate cakes; Chocolate candies; Chocolate chips; Chocolate confections; Chocolate-coated nuts; Confectionery, namely, candy and chocolate; Filled chocolate; Milk chocolate.” Registrant’s goods are “chocolate candies, chocolate covered nuts.”

Applicant’s “chocolate candies” and “chocolate-coated nuts” are identical to Registrant’s “chocolate candies” and “chocolate covered nuts.”

Applicant argues that the goods are dissimilar because Applicant’s mark is used in connection with “imported foreign chocolates, etc, across the world” while Registrant’s mark references chocolates in the United States. 8 TTABVUE 15.

However, “[i]t is well established that the Board may not read limitations into an unrestricted registration or application,” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (citations omitted). As stated, we must confine our determination of relatedness to the goods as identified in the cited registration and involved application.

Therefore, in view of the identity of the goods, this *DuPont* factor strongly weighs in favor of a finding of likelihood of confusion.

B. Third and Fourth *DuPont* Factors

We next turn to the third *DuPont* factor which requires us to consider “the similarity or dissimilarity of established, likely-to-continue trade channels.” Just as when we compare the goods, under this factor, we are bound to compare the trade channels and classes of consumers for the goods as identified in the involved application and cited registration. *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant’s arguments do not discuss trade channels, but rather the uniqueness of its mark (“unique impression” and “unique colors”) to “sell foreign luxury chocolates,” 8 TTABVUE 16, which is not a relevant concern under this factor.

Because Applicant’s and Registrant’s “chocolate candies” and “chocolate-coated nuts” are identical, we presume that these goods will move in the same trade channels to the same classes of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade

and classes of purchasers are considered to be the same). Although Registrant's registration contains a geographic restriction statement, we must presume that Applicant is marketing his services in Registrant's trading area because Applicant is seeking an unrestricted registration. *See In re Integrity Mutual Insurance Company, Inc.*, 216 USPQ 895, 896 (TTAB 1982).

In view of the overlapping trade channels and classes of purchasers, the third *DuPont* factor weighs in favor of a finding of likelihood of confusion.

We now turn to the fourth *DuPont* factor which considers "the conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing."³ *DuPont*, 177 USPQ at 567.

Applicant's argument under this factor is limited to the same three sentences as those made under the third *DuPont* factor,⁴ and thus are misdirected. Because there is no argument and evidence in the record on this *DuPont* factor, we find it neutral.

³ Applicant has argued in connection with *DuPont* factors 3 and 4, and *DuPont* factors 2, 9, 11 and 13, that "it could find no evidence of the registered mark used" or "no actual use of the registered mark could be found." 8 TTABVUE 15-17. To the extent that Applicant is suggesting that the mark in the cited registration is not in use, that is irrelevant. If Applicant believed that the cited mark is not in use for these goods, his remedy was to petition to cancel the Registration. *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997) ("Dixie's argument that DELTA is not actually used in connection with restaurant services amounts to a thinly-veiled collateral attack on the validity of the registration ... the present ex parte proceeding is not the proper forum for such a challenge.").

⁴ The entirety of Applicant's argument under both the third and fourth factors is as follows: "LE CHOCLAT DES ILES' with its unique impression is being used to sell foreign luxury chocolates. The design element sets off this mark and along with the unique colors used. Applicant could find no evidence the registered mark used for the selling similar products." 8 TTABVUE 16.

C. Fifth and Sixth *DuPont* Factors

As to the fifth *DuPont* factor, Applicant argues that there is no evidence of fame. 8 TTABVUE 16.

However, “it is settled that the absence of such evidence is not particularly significant in the context of an ex parte proceeding.” *In re Davey Prods. Pty Ltd.* 92 USPQ2d 1198, 1204 (TTAB 2009). We find this *DuPont* factor neutral. *See In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016) (“in an ex parte appeal the ‘fame of the mark’ factor is normally treated as neutral because the record generally includes no evidence as to fame.”).

As to the sixth *DuPont* factor, Applicant argues that there are many registered marks for similar goods and services using “island” or “chocolate” “as one word” and that “[m]any marks are also registered with words similar to ‘CHOCOLATE’ as one word,” none of which prevented the registration of “ISLAND CHOCOLATE.”⁵ 8 TTABVUE 16.

However, Applicant has not submitted any third-party use or registration evidence for purposes of showing any weakness of ISLAND CHOCOLATES. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (“evidence of the extensive registration and use of a term by others can be powerful evidence of the term’s weakness.”) (citations omitted). Therefore, this *DuPont* factor also is neutral.

⁵ The portion of Applicant’s argument under this factor that states “the addition of the design in its mark avoids confusion” relates to the first *DuPont* factor, not the sixth *DuPont* factor.

D. First *DuPont* factor

The first *DuPont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1801, 1812 (TTAB 2014)).

In comparing the marks, 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 terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977).

Applicant argues that “the examiner incorrectly applied the Doctrine of Foreign Equivalents to find confusion” and “failed to properly weigh the significant differences” between the marks. 8 TTABVUE 10. Applicant points out that the doctrine of foreign equivalents is not an absolute rule and argues that “[t]he ‘ordinary American purchaser’ would be unable to translate ‘LE CHOCOLAT DES ILES’ into English.” 8 TTABVUE 12. Applicant argues that “the French translation would not be applied or understood by the average American consumer” given that there are

only “1,300,000 French speakers as opposed to 231,122,908 English only speakers [that] reside in the United States.” 8 TTABVUE 18.

Applicant contends that its mark is dissimilar in appearance, sound, connotation and commercial impression from the cited mark. Applicant also contends that the words in each mark are “spelled differently, pronounced differently” and have “different meanings.” 8 TTABVUE 14. Applicant argues that its mark, “taken as a whole, is unique” with a “unique design and colors” and that the “impression on the consuming public of each mark is very different.” 8 TTABVUE 13-14. Applicant argues that it uses gold in its design “to reflect the upscale and fancy foreign product offered.” 8 TTABVUE 13.

The mark in Registration No. 3656388 is ISLAND CHOCOLATES (“chocolates”



disclaimed) and Applicant’s mark is *Le Chocolat des Iles* (“chocolat” disclaimed). The literal portion of Applicant’s mark “Le Chocolat des Iles” is in the French language, and Applicant has translated this phrase into English as “the chocolate (sic) of the islands.” The Examining Attorney has also provided a French-to-English translation that reflects the translation as “chocolate of the islands.” September 11, 2019 Office Action at TSDR 5.

The Examining Attorney submitted an article from Rutgers University that states there are 1.6 million French speakers in the United States. April 27, 2020 Office

Action at TSDR 27. A census chart submitted by the Examining Attorney for the period of 2009 through 2013, titled “Detailed languages spoken at home and ability to speak English for the population 5 years and over for United States: 2009-2013,” with a 2015 release date, shows more than 1,253,000 million French speakers. April 27, 2020 Office Action at TSDR 2. The Examining Attorney’s evidence also shows that French brands are commonly sold in the United States. April 27, 2020 Office Action at TSDR 31-60. We find that French qualifies as a common, modern language. *See also In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (“French is a common foreign language spoken by an appreciable segment of the population.”). We take judicial notice that “île” is French for “island” and “chocolat” is French for “chocolate,” and there are no other meanings for these terms. GLOBAL English-French Dictionary, dictionary.cambridge.org (accessed March 18, 2022). *See In re Thomas*, 79 USPQ2d at 1025 (taking judicial notice of the translation of “marche noir” in French-English dictionaries as “black market” “with no other qualifying information for either term.”).

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 Imps.* 73 USPQ2d at 1696. As Applicant has pointed out, the doctrine of foreign equivalents is a “guideline and not an absolute rule.” *Id.* The doctrine is applied when it is likely that “the ordinary American purchaser would ‘stop and translate [the term] into its English equivalent.’” *Id.*, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976).

Applicant argues that the average American consumer would not apply nor understand the French translation, given that there are only “1,300,000 French speakers” that reside in the United States out of a population of “231,122,908 English only speakers.” 8 TTABVUE 18. Applicant argues that “even if a common English speaker identified ‘CHOCOLAT’, they certainly would not understand what the terms ‘LE’ ‘DES ISLES’ means.” 8 TTABVUE 12-13. Applicant argues that “99% of American Consumers do not know what the French term ‘LE CHOCOLAT DES ILES’ means” as it neither sounds nor looks the same as ISLAND CHOCOLATES. 8 TTABVUE 12.

However, “the Board has determined that the ‘ordinary American purchaser’ in a case involving a foreign language mark refers to the ordinary American purchaser who is knowledgeable in English as well as the pertinent foreign language.” *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647-48 (TTAB 2008).

Thus, under the doctrine of foreign equivalents, we must consider the meaning of the literal portion of Applicant’s mark “Les Chocolat des Iles” to the American consumer who also speaks French. In view of the translation provided by the Examining Attorney, and the French-English dictionary we have judicially noticed, “chocolat” and “chocolate” are literal and direct equivalents, and the term “iles” is also the literal and direct equivalent of “islands.” There are no other meanings to these terms. The English translation of “Les Chocolat des Iles” is “Chocolate of the Islands,” which is confirmed by Applicant’s translation statement, “The Choclote (sic) of the Islands.” The evidence clearly shows that this is the only meaning of the phrase,

without question, and that is how the phrase would be recognized and understood by the French-speaking American public.

We find the doctrine of foreign equivalents applicable to Applicant's word and design mark, and that for purposes of determining the similarity of the marks in connotation and commercial impression, we may treat Applicant's mark as the foreign equivalent and synonymous with ISLAND CHOCOLATES. *See In re Dairimetrics, Ltd.*, 169 USPQ 572, 573 (TTAB 1971) (ROSE MILK, though not found in any dictionaries, is synonymous in meaning to the "recognized descriptive name" "Milk of Roses" for a rose scented cosmetic preparation). *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(b)(vi)(C) (July 2021) ("If the examining attorney has sufficient evidence to show that foreign wording comprising a mark has a relevant, literal, and direct English translation such that the foreign wording has an English language equivalent, then the doctrine generally should be applied.").

However, even if we did not apply the doctrine of foreign equivalents, a significant number of American purchasers who are not familiar with the French language upon encountering the term "Les Chocolat des Iles" would guess its translation is "Chocolate of Isles," if not "Chocolate Islands."⁶

Our determination of the applicability of the doctrine of foreign equivalents does not end our analysis under the first *DuPont* factor. We must determine whether the

⁶ We take judicial notice that "isles" is defined as an island, especially a small one. Cambridge Academic Content Dictionary, dictionary.cambridge.org. (accessed March 18, 2022).

marks are similar in meaning when they are considered in their entirety and, if so, whether that similarity in meaning outweighs any dissimilarities in appearance and sound. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 (TTAB 2015).



In comparing the marks, *Le Chocolat des Iles* and ISLAND CHOCOLATES, we find the marks are similar in appearance to the extent that they both contain a similar looking term for “chocolate” (CHOCOLAT/CHOCOLATES), although they are otherwise distinct in appearance and in sound. As to connotation, their meanings are essentially identical, both connoting chocolate(s) from an island or islands. The design elements of an island in Applicant’s mark further reinforces the island portion of Applicant’s mark. *Cf. In re Aquamar*, 115 USPQ2d at 1127 (noting that Applicant’s display of the mark on its specimens “in blue, with a blue nautical-themed logo, together with the phrase ‘productos del mar,’ further increases the likelihood that consumers will translate” the compound term “marazul” as “mar azul” or “blue sea”).

We also find that ISLAND CHOCOLATES and LE CHOCOLAT DES ILES and design not only have the same literal meaning, but they create the same overall commercial impression in relation to the respective goods, both marks suggesting chocolate(s) that originate from an island or islands. *See In re Thomas*, 79 USPQ2d at 1025 (“MARCHE NOIR and BLACK MARKET MINERALS not only have the same literal meaning, but they create the same overall commercial impression in relation

to the respective goods and services, both marks suggesting contraband or illicit goods.”).

In spite of the dissimilarities in the sound and appearance of the two marks, we must weigh this against the strong similarity in connotation and commercial impression before reaching a conclusion on the similarity of the marks. *See In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (similarity of connotation of the marks, must be weighed against the dissimilarities in sound and appearance of the marks and all the other relevant factors bearing on the likelihood of confusion).

We find the equivalency in meaning of ISLAND CHOCOLATES and LE CHOCOLAT DES ILES outweighs any differences in how the marks look and sound. *See In re Aquamar*, 115 USPQ2d at 1127 (“[E]ven when there are differences in the sound and appearance of two marks, likelihood of confusion can be found when the equivalency in meaning or connotation outweighs the differences in the marks.”) (citing cases).

E. Seventh, Eighth, Tenth and Twelfth *DuPont* Factors

As to the seventh, eighth, and twelfth *DuPont* factors, Applicant merely presents argument that there is no confusion, no potential for confusion, and no evidence of confusion. 8 TTABVUE 16-17. As to the tenth *DuPont* factor, Applicant notes its inapplicability. 8 TTABVUE 17. Because there is no evidence in the record as to these *DuPont* factors, we find them neutral.

F. Ninth, Eleventh and Thirteenth *DuPont* Factors

As to these factors, Applicant argues that its mark creates a unique impression.⁷ However, this argument is inapplicable to the matters addressed by these particular *DuPont* factors. Because Applicant's argument is misdirected, and there is no evidence in the record as to these *DuPont* factors, we find them neutral.

II. Conclusion

When we consider the similarity in connotation of the marks, together with the identical goods, trade channels and classes of consumers, these factors combine to outweigh any dissimilarities in the marks' sound and appearance. *See In re Ithaca Industries, Inc.*, 230 USPQ 702, 705 (TTAB 1986) (finding LUPU, for men's and boy's underwear likely to be confused with WOLF for sportswear, in large part because LUPU means "wolf" in Italian).



Le Chocolat des Iles

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

⁷ Applicant has essentially repeated the statements made under *DuPont* factors three and four. *See* n.4.