

This Opinion is Not a
Precedent of the TTAB

Mailed: August 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re SBOX Holdings LLC*¹

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Serial No. 88886981

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Timothy S. Hsieh of MH2 Technology Law Group LLP and Evan A. Raynes of
Symbus Law Group PLLC, for SBOX Holdings LLC.

Verna B. Ririe, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Taylor, Lynch, and Johnson,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

¹ During the pendency of this appeal, the subject application was assigned, “together with the business and the goodwill associated with the” mark, from EWB Holdings LLC to SBOX Holdings LLC. The assignment document dated February 15, 2022 was recorded with the USPTO Assignments Database on February 21, 2022.

I. Background

SBOX Holdings LLC (“Applicant”) seeks registration on the Principal Register of the mark CAMBIO in standard characters for “jewelry” in International Class 14 and “retail store services featuring jewelry” in International Class 35.² The application includes the statement that “[t]he English translation of CAMBIO in the mark is ‘CHANGE.’” The Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the prior registered mark CAMBIARE in standard characters, for “jewelry” in International Class 14.³ The registration includes the statement that “[t]he English translation of ‘CAMBIARE’ in the mark is ‘TO CHANGE.’”

After the Examining Attorney made the refusal final, Applicant filed a request for reconsideration and appealed. The Examining Attorney denied the request for reconsideration, maintaining the likelihood of confusion refusal. The appeal then proceeded, and was fully briefed. As explained below, we affirm the refusal to register.

II. Evidentiary Matters

We first address a couple of evidentiary points to clarify the record. First, Applicant’s Request for Reconsideration and Brief cite to links to websites that Applicant contends “enable the listener to hear the actual pronunciations of the

² Application Serial No. 88886981 was filed April 24, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

³ Registration No. 5829466 issued August 6, 2019.

parties' marks.”⁴ Providing an Internet link to a webpage is insufficient to make the referenced audio materials of record. *See In re Fantasia Distrib., Inc.*, 120 USPQ2d 1137, at *21 n.13 ((TTAB 2016) (Board “cannot consider the video itself” which does not become part of the record through a YouTube link, and noting that multimedia files may be submitted through the TEAS Response to Office Action form). Because of the ephemeral nature of Internet websites, the “Board does not accept Internet links as a substitute for submission of a copy of the resulting page.” *TV Azteca, S.A.B. v. Martin*, 128 USPQ2d 1786, 1789 n.15 (TTAB 2018) (citing *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1194 n.21 (TTAB 2018) and *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017)). Given the lack of objection by the Examining Attorney, we have considered Applicant’s assertions about the audio, which are discussed below, but “we cannot consider the [audio] itself, which we do not have.” *Fantasia Distrib.*, 120 USPQ2d 1137, at *21 n.13.

Second, Applicant makes arguments in its Brief based on “the file history of the CAMBIARE registration,”⁵ but did not introduce it into the record. In an ex parte appeal such as this, while the prosecution file history of the involved application is automatically of record, the same does not hold true for the file history of the cited registration. *In re Sela Prods. LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013) (“there is no equivalent [to inter partes proceedings] rule for ex parte proceedings that makes the file of a cited registration of record”). Rather, for the prosecution file history of a

⁴ TSDR September 29, 2021 Request for Reconsideration at 3; *see also* 6 TTABVUE 7 (Applicant’s Brief).

⁵ 6 TTABVUE 9 (Applicant’s Brief).

cited registration or a portion thereof to be considered, it must be timely introduced as evidence. *Id.* During prosecution, Applicant did not submit the file history or make arguments explicitly based on the file history, which might have prompted the Examining Attorney to alert Applicant of the necessity of introducing it. Given that, we do not consider Applicant's assertions about the alleged content of the file history.

III. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The Board considers only those *DuPont* factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020). Two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *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.”).

A. The Goods and Services, Trade Channels and Classes of Consumers

The second and third *DuPont* factors address the relatedness of the goods and services and the trade channels in which they travel.

Under the second factor, “likelihood of confusion can be found ‘if the respective goods [and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal citations omitted). In analyzing such relatedness, we look to the identifications in the application and cited registration. *See In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018); *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The cited registration’s identification of “jewelry” is identical to Applicant’s “jewelry” and highly related to Applicant’s “retail store services featuring jewelry.” Applicant does not contest the relatedness of jewelry and retail stores that feature it, and the record shows that such goods and services tend to emanate from the same source, under the same mark.⁶ We agree that consumers are accustomed to

⁶ *E.g.*, TSDR July 21, 2020 Office Action at 30-43 (TIFFANY used for retail jewelry stores and jewelry); TSDR April 14, 2021 Office Action at 14-51 (use-based third-party registrations with jewelry and retail jewelry store services under the same mark). *See Detroit Ath. Co.*, 128 USPQ2d at 1050 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1140 (TTAB 2012) (third-party use-based registrations are relevant to show

encountering under the same mark jewelry such as in the cited registration and retail store services featuring it, such as Applicant's. "[S]tore services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion." *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (clothing is related to retail outlet services for camping and mountain climbing equipment); *see also In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (retail general merchandise store services are related to furniture). This general principle holds true in the particular context of jewelry and jewelry stores. *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (jewelry store services are related to jewelry); *In re Best Prods. Co., Inc.*, 231 USPQ 988, 989 (TTAB 1986) (retail jewelry store services are related to men's and ladies' bracelets and watch bracelets).

Under the third *DuPont* factor, to the extent the goods in the cited registration and the application are identical, we must presume that the trade channels and classes of consumers for those goods also are identical. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *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 Inter IKEA Sys. B.V. v. Akea*, 110 USPQ2d 1734, 1743 (TTAB 2014); *L. & J.G.*

that the respective goods and services are of a type that may emanate from a single source under one mark).

Stickley, Inc. v. Cosser, 81 USPQ2d 1956, 1971 (TTAB 2007) (“Because the goods of both parties are at least overlapping, we must presume that the purchasers and channels of trade would at least overlap.”). As to the retail jewelry services and the jewelry, the record, including webpages from Tiffany, Zales, and Jared,⁷ shows that retail jewelry services such as those recited in the application feature jewelry such as the cited registration identifies, and therefore these goods and services travel in some of the same trade channels to the same classes of consumers. Accordingly, the trade channels and classes of consumers, at a minimum, overlap.

The second and third *DuPont* factors weigh heavily in favor of likely confusion.

B. Similarity of the Marks

We compare the marks CAMBIO and CAMBIARE “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (quoting *DuPont*, 177 USPQ at 567). “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 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are similar enough that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d at 1721; *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d

⁷ TSDR July 20, 2021 Office Action at 6-43.

1546, 1551 (TTAB 2012). Where, as here, the goods in Class 14 are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs. Inc.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

As an initial matter, Applicant and the Examining Attorney dispute the proper framework for comparing the marks, particularly regarding consideration of them as foreign-language words. The Examining Attorney argues that “both consist of a variant of the Latin root CAMBIARE which is used in various conjugations in modern language.”⁸ More specifically, the Examining Attorney points to evidence that “both marks are conjugations of the same word in the Spanish language” ... “with the word ‘CAMBIO’ being the present tense of [CAMBIAR] and ‘CAMBIARE’ being the future tense of the word.”⁹ Applicant, on the other hand, insists that the cited mark is an Italian word, and that “two foreign words should not normally be compared to determine whether a likelihood of confusion exists.”¹⁰

The record indicates that CAMBIO and CAMBIAR both are Spanish words, both are Italian words, and both are Latin words.¹¹ As discussed below, Applicant’s designation of its mark as a Spanish-language word does not control consumer

⁸ 8 TTABVUE 5 (Examining Attorney’s Brief).

⁹ 8 TTABVUE 5 (Examining Attorney’s Brief).

¹⁰ 6 TTABVUE 9 (Applicant’s Brief).

¹¹ TSDR April 14, 2021 Office Action at 2-3 (Latin -- latin-is-simple.com), 5-7 (Latin -- latin-dictionary.net), 8-10 (Spanish -- spanishdict.com); TSDR December 14, 2021 Denial of Reconsideration at 2-3 (Italian -- wordsense.eu)

perception of the word, as consumers proficient in Latin or Italian may perceive and recognize the word in accordance with their familiarity with it as a Latin or Italian word. The same holds true for the cited mark.

Bearing this in mind, we find Applicant's mark, CAMBIO, and the cited mark, CAMBIARE, similar in appearance, sound, connotation and commercial impression. Each mark consists of a single term, and the first two syllables of the marks are identical – CAMBI. As the first portion of the marks, this identical component, CAMBI, stands out and makes more of an impression on potential purchasers. *See Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1755 (TTAB 2009) (finding PALOMA and PALOMITA confusingly similar where “it is the first portion of a mark that is more likely to make an impression on potential purchasers and here the beginning and core elements of the words are the same”); *Hercules Inc. v. National Starch & Chemical Corp.*, 223 USPQ 1244, 1246 (TTAB 1984) (“considering the marks NATROL and NATROSOL in their entireties, the clearly dominant aspect of both marks is that the first four letters and the final two are the same”); *see also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Following the identical CAMBI portions of each mark, Applicant's ends with an O and the cited mark ends with ARE. While this creates some difference in the appearance and phonetics of the marks, overall, CAMBIO and CAMBIARE still look and sound similar.

Applicant contends that “the differences in the pronunciations of the parties’ marks is [sic] stark” because the cited mark “is pronounced **cam-biar-ay**.”¹² As discussed above, the record does not include pronunciation materials. Also, U.S. consumers may vary in their views of the marks and the pronunciations thereof, depending on whether a consumer views the words as coined terms, a coined term and an English-language word, Spanish words, Italian words, or Latin words. *See, e.g., StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014) (“There is no correct pronunciation of a trademark that is not a recognized word.”); *In re Allegiance Staffing*, 115 USPQ2d 1319, 1325 (TTAB 2015) (agreeing that there is no correct pronunciation of mark that is a coined term); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (stating that “there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner”). Moreover, even if the cited mark is pronounced as Applicant suggests, we still find the sound of the marks similar because of the shared CAMBI component. Bearing this in mind, we find that the pronunciations of CAMBIO and CAMBIARE likely would be fairly similar.

Turning to the connotation and commercial impression, according to the Examining Attorney, “Spanish speaking consumers in particular will view the marks as having the same commercial impression.”¹³ The Examining Attorney also argues

¹² 6 TTABVUE 7 (Applicant’s Brief) (emphasis in original).

¹³ 8 TTABVUE 5 (Examining Attorney’s Brief).

that the translation in the application, “change” and the translation in the cited registration, “to change,” confirm that “the marks essentially have a common meaning.”¹⁴ Applicant counters, relying on the cited registration’s prosecution history that is not in the record, that CAMBIARE is Italian, and therefore is from a different foreign language than Applicant’s mark, such that their similar meanings would not be recognizable, because “it is highly unlikely that an ordinary American purchaser would be fluent in two different foreign languages.”¹⁵ Markedly, the cited registration includes a translation statement that does not indicate what foreign language is being translated. Where wording such as this is part of multiple languages appears in a mark without other indicia of a particular language, the trademark owner’s intent would not control consumer perception of the relevant foreign language. *See In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1125 (TTAB 2008) (“[A]n applicant’s or registrant’s intended interpretation of the mark is not necessarily the same as the consumer’s perception of it.”); *Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1465 (TTAB 2003) (“[I]t does not matter what applicant’s intentions were in creating its mark or what its characterization of its mark is.”).

The Examining Attorney and Applicant both made arguments regarding the connotation of the marks involving whether the doctrine of foreign equivalents applies in this case. Regarding the doctrine of foreign equivalents, which typically involves, “foreign words from common [modern] languages [being] translated into

¹⁴ 8 TTABVUE 6 (Examining Attorney’s Brief).

¹⁵ 6 TTABVUE 9 (Applicant’s Brief).

English to determine ... similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay Imps.*, 73 USPQ2d at 1696. The doctrine of foreign equivalents is normally applied where one mark is in a foreign language, and the other mark is in English. *Brown Shoe Co. v. Robbins*, 90 USPQ2d at 1756. Although the doctrine also may apply in other scenarios, we need not resort to it here. As noted above, where these words of Latin origin in each mark might be viewed by some consumers as Latin, by some consumers as Spanish, by some consumers as Italian, and by those consumers without proficiency in any of the relevant languages, as coined terms. *See id.* (“Here, where both marks are Spanish words we must consider the connotation of the marks to both non-Spanish-speaking consumers and to Spanish-speaking consumers.”). To the extent we consider the connotation of the marks to speakers of the relevant foreign languages, the words would not require translation, and they share a very similar meaning as different conjugations of the same verb. To the extent we consider the connotation of the mark to non-speakers of the foreign languages, the words in the marks would be viewed as coined terms without a particular meaning but with a similar appearance and pronunciation. *See id.* (“In English the words have no meaning and therefore, although non-Spanish-speaking consumers would not understand the words, because of the similarity in appearance and pronunciation the marks likely would be perceived as having similar meanings”).

Given their overall resemblance in appearance, sound, connotation and commercial impression, we find Applicant’s mark and the cited mark similar,

particularly because we must consider the marks “in light of the fallibility of memory.” See *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)).

Thus, the first *DuPont* factor favors a finding of likelihood of confusion.

IV. Conclusion

The similarity of the marks for in part identical goods and highly related goods and services that move in overlapping channels of trade to the same classes of customers renders confusion likely.

Decision: The refusal to register Applicant’s mark CAMBIO under Section 2(d) of the Trademark Act is affirmed.