

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: November 22, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Tatuaje Cigars, Inc.

v.

Nicaragua Tobacco Imports, Inc.

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Opposition No. 91185180  
to application Serial No. 77359141  
filed on December 25, 2007

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Rod S. Berman, Jessica C. Bromall and Brennan C. Swain of  
Jeffer Mangels Butler & Mitchell LLP for Tatuaje Cigars,  
Inc.

Jose Gutman of Fleit Gibbons Gutman Bongini & Bianco PL for  
Nicaragua Tobacco Imports, Inc.

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Before Bucher, Kuhlke and Ritchie, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Nicaragua Tobacco Imports, Inc., seeks  
registration of the standard character mark TATTOO for goods  
identified in the application as "cigar and cigarette boxes;  
cigar and cigarette boxes not of precious metal; cigar  
bands; cigar boxes; cigar boxes not of precious metal; cigar

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cases; cigar cutters; cigar holders; cigar humidifiers; cigar lighters; cigar tubes; cigars; tobacco, cigars and cigarettes; cigarillos" in International Class 34. The application was filed on December 25, 2007, based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

Opposer, Tatuaje Cigars, Inc., opposed registration of applicant's mark on the ground that, as used in connection with applicant's goods, the mark so resembles opposer's previously used and registered mark TATUAJE in typed form, in connection with "cigars," as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

By its answer, applicant denies the salient allegations.

In prior orders, the Board granted partial summary judgment in opposer's favor establishing opposer's standing and priority, the similarity of the goods, the overlap in the channels of trade and the classes of purchasers, and entering judgment against applicant's affirmative defense of unclean hands. See Board Orders dated September 17, 2009 and August 30, 2010. In addition, in its brief, applicant stipulated that the goods and channels of trade are similar and that "Spanish is a commonly spoken and understood language in the United States." App. Br. p. 9.

In view thereof, the only issues that remain for decision are findings of fact as to the similarity of the marks and a determination as to whether there is a likelihood of confusion.

By operation of Trademark Rule 2.122, 37 C.F.R. §2.122, the record in this case includes the pleadings and the file of the involved application. In addition, opposer submitted (1) notices of reliance (dated November 11, 2010 and February 24, 2011) on opposer's federal registration, applicant's discovery responses, and printed publications (dictionary and reference work excerpts), and (2) the testimony deposition of Diana V. Valori, opposer's expert witness.<sup>1</sup> Applicant submitted a notice of reliance (dated January 10, 2011) on official records (trademark application file excerpts) and printed publications (dictionary excerpts).

**LIKELIHOOD OF CONFUSION**

Our likelihood of confusion determination under Section 2(d) 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). As

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<sup>1</sup> Applicant's request to strike reference to certain evidence is denied inasmuch as these items were properly made of record under opposer's rebuttal notice of reliance.

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noted above, the factors pertaining to the relatedness of the goods, and the overlap in the channels of trade and consumers weigh in favor of opposer. Based on the arguments and evidence presented, the only du Pont factor in dispute concerns the similarities or dissimilarities between the marks.

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). 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 entireties that confusion as to the source of the services offered under the respective marks is likely to result. Finally, we are cognizant of the principle that the more closely related the goods are, the less similarity in the marks is required to support a conclusion of likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Opposer's position is that the marks are similar under the doctrine of foreign equivalents because opposer's mark TATUAJE is a Spanish word that translates directly to TATTOO

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in English. Opposer's registration for the mark TATUAJE includes the following translation statement, "The foreign wording in the mark translates into English as 'TATTOO.'"<sup>2</sup> In addition, opposer points to other similarities in sound and appearance. Specifically, opposer argues that the first syllables of each mark is "TAT" and the first two syllables of the marks are pronounced similarly and the only difference in sound are the two extra syllables at the end of opposer's mark.

By contrast, applicant argues that the doctrine of equivalents does not apply here because there is no evidence to support a finding that consumers would stop and translate opposer's mark and the words are not exact equivalents in that tatuaje and tattoo have other meanings. Further, applicant contends that the marks are dissimilar in appearance and sound, pointing to the difference in the number of letters and syllables, and the difference in pronunciation.

"Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine...similarity of connotation in order to ascertain confusing similarity with English word marks." Palm Bay, 73 USPQ2d at 1696.

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<sup>2</sup> Registration No. 2836665 issued on April 27, 2004. Opp. NOR Exh. A.

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The doctrine of foreign equivalents is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" Palm Bay, Id., quoting, In re Pan Tex Hotel Corp., 190 USPQ 109, 110 (TTAB 1976). See also In re Thomas, 79 USPQ2d 1021 (TTAB 2006). "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.

Here, the "ordinary American purchaser" refers to the ordinary American purchaser who is knowledgeable in Spanish. As noted above, it is stipulated that Spanish is a commonly understood language in the United States.

The record includes several dictionary entries where the English word TATTOO translates into the Spanish word TATUAJE. See, e.g., NOR Exh. D, Bilingual Richmond Dictionary; and Exh. E Webster's New World Pocket Spanish Dictionary.

Applicant points to one Spanish dictionary excerpt that provides an alternate meaning of TATUAJE<sup>3</sup> as "a circle or mark that is left around the wound from a gun fired in very close proximity." App. Br. p. 14. Applicant also points to

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<sup>3</sup> Applicant did not submit a translation for this document, however, opposer has not objected to this evidence and opposer's witness provides testimony and translation as to this dictionary reference.

alternate meanings of the word TATTOO as "a rapid rhythmic rapping" and "a call sounded shortly before taps." Def. NOR Exh. J.

Opposer's expert witness testifies that "tatuaje" is a common Spanish word that means "engraving under the skin" and that she was not aware of any other meanings, as a native Spanish speaker and professional translator, until consulting a dictionary in preparation of her report. Test. pp. 15-17. Further, she also testifies that she was not familiar with the other dictionary listed meanings for the English word "tattoo." Based on the expert's testimony we find applicant's alternate meanings for "tatuaje" and "tattoo" to be obscure, and they do not impact the equivalency between TATUAJE and TATTOO.

In sum, we find that the doctrine of foreign equivalents applies, and that TATTOO is the equivalent of TATUAJE.

Applicant's reliance on *In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987) does not persuade us of a different result. In *Buckner*, the Board found that PALOMA and DOVE were not exact synonyms because the "Spanish word 'paloma' has a broader meaning than the English word 'dove' in that 'paloma' also includes 'pigeon' [and] [i]n English, the words 'dove' and 'pigeon' are understood to mean two different, although related birds." *Id.* at 1317. The Board

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then analyzed and weighed the similarities and dissimilarities in those marks finding them "quite dissimilar in terms of sight (appearance) and sound(pronunciation), and (2) are not exact synonyms." Id.

Here, we determine that the other meanings of the words are too obscure and do not "broaden" their respective meanings such that they cannot be considered equivalents. In addition, the record does not establish that "the common experience of smokers being burned by lit cigars, would tend to create an impression in the mind of consumers of the translated meaning of 'tatuaje' as being a gun powder burn on the skin." App. Br. p. 7. We find it more likely that Spanish-speaking cigar smokers, like any other person, would immediately perceive the meaning of "tattoo" when presented with a cigar under the mark TATUAJE.

While the marks have some differences in sound and appearance, the identity in connotation is sufficient to support a finding of likelihood of confusion, especially as used in connection with identical goods, cigars. The fact that the marks have the same connotation, resulting in a similar overall commercial impression, is sufficient for us to conclude that confusion is likely, despite the differences in their appearance and sound. In re American Safety Razor Co., 2 USPQ2d 1459 (TTAB 1987).

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Further, we find that the mark would be translated by those who are familiar with the Spanish language. Whether the relevant purchasers “‘will stop and translate the word’ necessarily depends on the particular facts and circumstances of the case.” In re La Peregrina Ltd., 86 USPQ2d 1645, 1648 (TTAB 2008). There is no compelling evidence in the record to establish that the mark would not be translated because of marketplace circumstances or the commercial setting in which the mark is used. See In re Thomas, 79 USPQ2d at 1025-26, citing, In re Tia Maria, Inc. 188 USPQ 524 (TTAB 1984); and Pan Tex, 190 USPQ 190. Here, the marks are equivalent and the goods are identical.

We acknowledge that this doctrine is not absolute and “where the only similarity between the marks is in connotation, a much closer approximation is necessary...to justify a refusal to register on that basis alone.” In re Sarkli, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (REPECHAGE not confusingly similar to SECOND CHANCE). See also Buckner, 6 USPQ2d at 1317 (PALOMA, meaning both “dove” and “pigeon,” not confusingly similar to DOVE). However, in this case, but for remote alternative meanings for tatuaje and tattoo, the only translation of TATUAJE is TATTOO. In addition, the marks share similarities in sound and appearance inasmuch as both begin with TAT and can be pronounced similarly.

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We are not persuaded by applicant's argument that "in the common Spanish pronunciation of 'tatuaje,' the second syllable of TATUALE ends in an 'ah' sound while the second syllable of 'tattoo' clearly ends in an 'oo' sound." App. Br. 18. It is settled that there is no correct pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. *Kabushiki Kaisha Hattori Tokeiten v. Acuotto*, 228 USPQ 461 (TTAB 1985). Thus, even if the second syllables are pronounced differently, for our purposes they may also both be pronounced as "oo."

Finally, the fact that two separate examining attorneys passed applicant's and opposer's subsequent marks on for publication is of little to no probative value. At a minimum, the records in the ex parte examinations would be quite different from the record in this inter partes proceeding. Moreover, previous decisions by examining attorneys are without evidentiary value and are not binding on the agency or the Board. *In re Davey Prods. Pty*, 92 USPQ2d 1198, 1206 (TTAB 2009).

Taking into consideration the foreign equivalency of the marks, their similarities in sound, appearance, connotation, and overall commercial impression, we find the marks to be similar and this factor weighs in favor of a finding of likelihood of confusion.

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In view of the above, opposer has proven its claim of likelihood of confusion under Section 2(d) of the Trademark Act between applicant's standard character mark TATTOO and opposer's mark TATUAJE.

**Decision:** The opposition is sustained.