

This Opinion is not a
Precedent of the TTAB

Mailed: March 30, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re JS ADL, LLC.
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Serial No. 87200423
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Theodore R. Remaklus of Wood Herron & Evans LLP,
for JS ADL, LLC.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Cataldo, Hightower and Goodman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

JS ADL, LLC (“Applicant”) seeks registration on the Principal Register of the

mark **ARTISAN** **NY** (“NY” disclaimed) identifying “Belts; Gloves;
Hats; Headwear; Jackets; Jeans; Lingerie; Men’s suits, Women’s suits; Pants;
Scarves; Shawls; Shirts; Sleepwear; Socks; Suits; Sweaters; Swimsuits; T-shirts;
Underwear” in International Class 25.¹

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¹ Application Serial No. 87200423 was filed on October 12, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a *bona fide* intention

The Trademark Examining Attorney has refused registration to the application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as intended to be used in connection with the identified goods, so resembles the mark ARTESANO NEW YORK CITY (in standard characters, "NEW YORK CITY" disclaimed), previously registered on the Principal Register identifying "Jeans; Shirts; Sneakers; Socks; Sweaters; T-shirts; Underwear," in International Class 25,² as to be likely to cause confusion, to cause mistake, or to deceive.

After the Examining Attorney made the refusals final, Applicant appealed to this Board. We affirm the refusal to register.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See 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

to use the mark in commerce. The mark consists of the words "ARTISAN NY" and an x-shaped cross-stitch pattern between the words. Color is not claimed as a feature of the mark.

² Registration No. 3840723 issued on August 31, 2010. Section 8 and 15 affidavits accepted and acknowledged. The English translation of "ARTESANO" in the mark is "artisan" or "craftsman." The registration recites additional goods in International Classes 18 and 28. However, the Examining Attorney did not rely upon these goods with regard to the refusal of registration.

cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

1. *Relatedness of the Goods/Channels of Trade/Consumers*

With regard to the goods, channels of trade and classes of consumers, we must make our determinations under these factors based on the goods as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also 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 Sys., Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A proper comparison of the goods “considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett Packard*, 62 USPQ2d at 1004).

In this case, the goods recited in the application and cited registration are identical as to “jeans; shirts; socks; sweaters; T-shirts; underwear.” Thus, Applicant’s goods, all identified in International Class 25, and the Class 25 goods recited in Reg. No. 3840723 are legally identical in part. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) (it is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application); *Inter IKEA Sys.*

B.V. v. Akea, LLC, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004).

Because the goods identified in the application and the cited registration are in-part identical, we must presume that the channels of trade and classes of purchasers of these goods are the same with regard thereto. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *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 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.”); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also Octocom Sys., Inc.*, 16 USPQ2d at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”).

We find that the *du Pont* factors of the relatedness of goods, channels of trade and consumers weigh in favor of likelihood of confusion.

2. Conditions of Sale

Neither identification of goods restricts the identified clothing items by price. Because the identifications of goods in the application and cited registration contain no limitations as to price points, we must presume that the clothing includes lower cost clothing items that may be purchased without a high degree of care. “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). We therefore presume that the recited clothing items include inexpensive clothing that may be subject to casual, impulse purchase. As a result, this *du Pont* factor also favors a finding of likelihood of confusion.

3. Strength of the Mark in the Cited Registration

Applicant argues that the mark ARTESANO NEW YORK CITY in the cited registration “is highly suggestive of clothing, footwear and headwear that is manufactured by skilled persons or using traditional manufacturing methods as can be seen from the definition of the word, namely:

Artisan – ‘A person skilled in making a product by hand.’
(*The American Heritage Dictionary* online <https://www.ahdictionary.com/word/search.html?q=artisan>); and

Artisan – ‘1: a worker who practices a trade or handicraft;’ ‘2: one that produces something (as cheese or wine) in limited quantities often using traditional methods.’
(*Merriam Webster* online - <http://www.merriam-webster.com/dictionary/artisan>).”³

³ 4 TTABVue 12; 20-22. We hereby grant Applicant’s request to take judicial notice of these definitions. See *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of*

Applicant further argues the “Trademark Office undoubtedly had both the inherent weakness of the term ARTISAN as well as the proper scope of protection to be afforded to weak terms in mind when it registered the following ARTISAN-bearing marks for the same or highly-related goods in Class 25:”⁴ (All marks are registered in standard characters on the Principal Register unless otherwise noted.)


Reg. No. 1687942 for the mark ARTISANS, INC. (“INC.” disclaimed) identifying “clothing; namely, shirts, sweaters, jackets, T-shirts, and caps;”

Reg. No. 5097574 for the mark VINTAGE ARTISAN identifying “belts; boots; hats; jeans; pants; shirts; shoes; T-shirts” (Supplemental Register);

Reg. No. 4135922 for the mark EVIL ARTISAN identifying a wide variety of clothing;

Reg. No. 2857003 for the mark BYARTISAN identifying “women’s clothing, namely, jackets, coats, vests, sweaters, shorts, skirts, pants and dresses;”

Reg. No. 3889299 for the mark STUDIO D’ARTISAN identifying “clothing, namely, sweat shirts, T-shirts, painter’s pants, pants, skirts, trousers, anoraks, overalls, parkas, blouses, cardigans, coats, shirts, dress shirts, open-necked shirts, button front aloha shirts, polo shirts, sweaters, pullovers, socks, mufflers, scarves, jeans, jumpers, shorts, vests, jackets, zip-up jackets, blousons, wind resistant jackets; children’s clothing, namely, jeans, T-shirts; suspenders; belts of leather and nonleather for clothing;”

Reg. No. 3864293 for the mark  (mark translated to “the artisan perfumer,” “PARFUMEUR” disclaimed) identifying goods in a variety of classes, including “clothing, namely, pullovers, shirts, T-shirts, suits, jackets, pants, jeans, coats, hats, ties, skirts, dresses, jumpers, socks, stoles,

Notre Dame du Lac v. J. C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁴ 4 TTABVUE 11.

Page references herein to the application record refer to the downloadable .pdf version of the United States Patent and Trademark Office (USPTO) Trademark Status & Document Retrieval (TSDR) system. References to the briefs refer to the Board’s TTABVUE docket system.

cloaks and muffs, gloves and belts; footwear, excluding orthopedic footwear; headgear, namely, headwear, hats and caps; underwear; peignoirs; kimonos;”⁵

Reg. No. 3205683 for the mark ARTISAN COLLECTION (“Collection” disclaimed) identifying “footwear, namely shoes, boots, clogs and sandals;”



Reg. No. 4093064 for the mark (disclaimed) identifying “belts sold at wholesale to garment manufacturers;” and

Reg. No. 2446410 for the mark ARTESANIA (translated to “craftsmanship” or “handicraft”) identifying “clothing, namely, cloth belts, swimsuits, sweaters, hats, gloves, shorts, slipper socks, scarves, skirts, pants, shorts, shirts, dresses, tops, T-shirts, sarongs and bandanas.”⁶

Applicant goes on to argue that the “same is true regarding the weakness of the phrases ‘New York City’ and ‘NY’ as shown by the following exemplary registrations that have been granted that include those phrases:”⁷ (All marks are registered in standard characters on the Principal Register unless otherwise noted.)

Reg. No. 5071677 for the mark GIOVANNY NEW YORK (“New York” disclaimed) identifying “women’s clothing, namely, shirts, dresses, skirts, blouses; bottoms for women; dresses for women; jackets for women; pants for women; shirts for women; tops for women; trousers for women;”

Reg. No. 5066929 JUNE 21 NEW YORK (“New York” disclaimed) identifying “clothing, namely, cowls and smoke ring scarves; eternity scarves; fingerless gloves; gloves; gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices; infinity scarves; kimonos; knitted

⁵ Subsequent to Applicant’s introduction of this third-party registration into the record, it was partially invalidated by the International Bureau (“IB”) to delete, *inter alia*, all of the identified goods in Class 25.

⁶ *Id.* at 11-12; Applicant’s March 15, 2017 response to the Examining Attorney’s first Office Action at .pdf 19-71. Applicant also submitted a copy of its own prior Registration No. 4211968.

⁷ 4 TTABVUE 13; Applicant’s March 15, 2017 response to the Examining Attorney’s first Office Action at .pdf 19-71.

gloves; mufflers; neck scarves; ponchos; scarves; shoulder scarves; silk scarves; slipper socks; socks;”

Reg. No. 5076393 for the mark BLL NEW YORK (“New York” disclaimed) identifying “clothing and active wear, namely, pants, skirts, shorts, jumpsuits, woven and knit tops and bottoms, sweaters, dresses, beachwear, loungewear, lingerie, footwear, head wear, outerwear, namely, coats and jackets, nightwear, scarves, evening wear and formal wear, namely, dresses, gowns, tuxedos, dinner jackets, trousers and footwear, yoga wear, namely, pants, shirts, dresses; textile based clothing, namely, shirts, sweaters and dresses with pockets specifically designed to hold hand-held electronic devices;”

HUNTER BELL

Reg. No. 4930927 for the mark —NEW YORK— (“New York” disclaimed) identifying “clothing, namely, shirts, pants, coats, jackets, sweaters, scarves, vests, dresses, blouses, skirts, shorts, jumpsuits;”

Reg. No. 4880149 for the mark YONA NEW YORK (“New York” disclaimed) identifying “blouses; business wear, namely, suits, jackets, trousers, blazers, blouses, shirts, skirts, dresses and footwear; dresses; skirts and dresses; tops; women’s clothing, namely, shirts, dresses, skirts, blouses;”

Reg. No. 4339712 for the mark WYTHE NY (“NY” disclaimed) identifying “clothing, namely, sweaters, tops, dresses, outerwear in the nature of jackets and hats, and footwear;”

Reg. No. 4540242 for the mark DIQUE NY (“dique” translated to “supposedly;” “NY” disclaimed) identifying “hats; socks; T-shirts;”

Reg. No. 3207714 for the mark BUILT NY (“NY” disclaimed) identifying “clothing, namely, shirts, coats, pants, T-shirts, blouses, hats, belts, shoes, vests, jackets, underwear, socks, sweaters, scarves, shorts, skirts, jeans; children’s and infants’ clothing, namely, bibs made from woven polyester fabric and synthetic rubber, overalls; wetsuits, footwear; sweatshirts; sweat suits; bathing suits, nightwear, namely pajamas; rainwear;”

SPRZNY

Reg. No. 4813009 for the mark SPRZNY (“NY” disclaimed) identifying a wide variety of clothing and footwear; and

Reg. No. 2428505 for the mark CLUB NY (“NY” disclaimed) identifying “clothing namely, t-shirts.”

Evidence of third-party use and registration of a term in the relevant industry is considered in the likelihood of confusion analysis. *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). The “existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Nevertheless, in determining the degree of weakness, if any, in the shared terms, we must “adequately account for the apparent force of [third-party use] evidence,” regardless of whether “specifics” pertaining to the extent and impact of such use have been proven. *Juice Generation*, 115 USPQ2d at 1674-75. “[E]xtensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin*, 116 USPQ2d at 1136 (citing *Juice Generation*, 115 USPQ2d at 1674).

In the case before us, however, Applicant points to no evidence of third-party use, and instead relies on third-party registrations of marks that include formatives of ARTISAN on the one hand and NY or NEW YORK on the other. Applicant’s record thus does not demonstrate commercial weakness from third-party use, and fails to show that consumers actually are conditioned to distinguishing among marks including ARTISAN or NY/NEW YORK.

Of the nine third-party registrations introduced into the record by Applicant that include formatives of the term ARTISAN, none include the term in combination with a geographic term such as NEW YORK, NY, or NEW YORK CITY. Thus, while all of the marks identify clothing items, all of them differ in commercial impression from the marks at issue herein. In the third-party marks VINTAGE ARTISAN, EVIL ARTISAN, BYARTISAN and STUDIO ARTISAN, the term ARTISAN modifies a preceding term, all four of which differ from each other and the term NEW YORK CITY or NY, and suggest very different connotations from the marks at issue. In the third-party marks ARTISANS, INC., ARTISAN COLLECTION, *L'Artisan Parfumeur* and



, the term ARTISAN[S] modifies a highly descriptive or generic term that follows, but again not a geographic term such as NEW YORK CITY or NY. The third-party mark ARTESANIA differs from the marks at issue inasmuch as it stands alone, with no additional wording. With regard to the

marks ARTISAN COLLECTION and , because the file

histories are not of record we do not know what agreements the owners of these registrations may have executed to allow them to coexist on the Principal Register, although we note that the goods in the latter registration are limited to “belts sold at wholesale to garment manufacturers.” Similarly, the third-party NEW YORK or NY formative marks introduced into the record are all dissimilar

from the marks at issue herein inasmuch as in each mark the term NEW YORK or NY modifies a term that is completely dissimilar from ARTISAN.⁸ The marks are consistent in that the term NEW YORK or NY is disclaimed in each, much as the terms NEW YORK CITY and NY are disclaimed in the marks at issue. However, each third-party mark differs significantly in meaning and commercial impression from the marks under consideration herein.

From the totality of the evidence, including the dictionary definitions and third-party registrations, we find that ARTISAN[S] suggests clothing items created by skilled tradespersons, and that the term thus is suggestive of Applicant's goods and the goods identified in the cited registration. Further, the third-party registrations suggest that the Trademark Office has consistently required disclaimers of NEW YORK, NY, and NEW YORK CITY, treating those terms as geographically descriptive. However, the evidence does not support a finding that ARTISAN[S] is so widely registered for clothing items that the cited registration is only entitled to a narrow scope of protection. As discussed above, the ARTISAN[S] formative marks all differ from the marks at issue herein, and none of them also includes a geographic term like NEW YORK, NY or NEW YORK CITY.

⁸ For these reasons, we do not find probative Applicant's evidence (Applicant's March 15, 2017 response to the Examining Attorney's first Office Action at .pdf 50-61) of pairs of registrations containing the term NEW YORK NATIVES and NATIVE NEW YORK and design on the one hand and NY APPAREL and NYC APPAREL and design on the other, inasmuch as neither includes the term ARTISAN or ARTESANO.

Overall, given the nature and quantity of the dictionary and third-party registration evidence, we find it insufficient to diminish the scope of protection to be afforded the mark in the Registration. *Cf. Juice Generation*, 115 USPQ2d at 1675 (weakness shown by at least 26 third-party uses and registrations containing the same phrase for the same services); *Jack Wolfskin*, 116 USPQ2d at 1136 (third-party weakness evidence characterized as “voluminous”).

4. Similarity or Dissimilarity of the Marks

We next address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks 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 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead 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) (quotation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d

1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat’l Data*, 224 USPQ at 751.

Finally, when the goods are identical or legally identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1477 (TTAB 2007).

Applicant’s mark **ARTISAN**✻**NY** and the registered mark **ARTESANO NEW YORK CITY** are similar in that both begin with the term **ARTISAN** or **ARTESANO**. These terms are highly similar in appearance and sound and, as discussed above, appear to be suggestive as applied to the identified clothing items. With regard to the term **NEW YORK CITY** in the registered mark and **NY** in Applicant’s mark, disclaimed matter is often “less significant in creating the mark’s commercial impression.” *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). However, while a disclaimed term ... may be given little weight ... it may not be

ignored.” *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006). The third-party evidence of record establishes that, consistent with the marks in the involved application and cited registration, the terms NY, NEW YORK and NEW YORK CITY are routinely disclaimed as geographically descriptive terms. Neither Applicant nor the Examining Attorney disputes that these terms denote the State of New York or the internationally famous city located therein. The disclaimed term NY or NEW YORK CITY in the marks thus describes a geographic feature of the recited goods. “Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’” *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data*, 224 USPQ at 752). Nonetheless, even descriptive and generic terms have some impact on the overall commercial impression created by the marks. *See Juice Generation*, 115 USPQ2d at 1676 (Board paid insufficient heed to the word JUICE in context of juice bar services). In addition, the small cross stitch design in Applicant’s mark suggests the nature of the clothing items identified under the mark and does not contribute as significantly to the overall impression of the mark as the preceding term ARTISAN.

For these reasons, we find that ARTISAN and ARTISANO, the highly similar terms which the marks share in common, and also the first term in both, are the dominant portions of the marks. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“...[it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a

purchaser and remembered”). *See also Palm Bay Imps.*, 73 USPQ2d at 1692 (“The presence of this strong distinctive term as the first word in both parties’ marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE.”).

With respect to the meanings of the two marks, the Examining Attorney contends that the dominant portions of the marks are ARTISAN and ARTESANO, respectively; and that these terms should be considered equivalent under the doctrine of foreign equivalents. The Examining Attorney has established that ARTESANO is the Spanish equivalent of the word ARTISAN.⁹

Our primary reviewing court has stated:

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. [Citations omitted.] When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied. ...

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline. [Citations omitted.] The doctrine should be applied only when it is likely that the ordinary American purchaser would “stop and translate [the word] into its English equivalent.”

Palm Bay Imps., 73 USPQ2d at 1696. The court and the Board have recognized that, in some contexts, even a person familiar with the foreign language at issue will not

⁹ November 1, 2006 first Office Action at .pdf 9-17.

“stop and translate,” but rather “take it as it is.” In *In re Spirits International N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009), the court stated that in some cases, “the literal translation is irrelevant” to customers (providing the examples of VEUVE CLICQUOT and CORDON BLEU); or the context in which the marks appear may render translation unlikely (providing the example of TIA MARIA Mexican restaurant *versus* AUNT MARY canned vegetables). See *Palm Bay Imps.*, 73 USPQ2d at 1492; *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975).

Marks that are expressed in different languages are confusingly similar under Section 2(d) when customers would perceive them as representing the same entity. The registered mark ARTESANO NEW YORK CITY is a combination of Spanish and English words, in which the words that describe the geographic location of the business are in English and the suggestive portion of the mark is in Spanish. This mark appears to be directed to an English-language market, and is not an attempt to translate another mark for the purpose of reaching the Spanish-language market. Customers are likely to appreciate this fact, and those that speak Spanish would be unlikely to believe that ARTESANO is intended as a translation of an English-language mark. In our view, in this context, customers would take the Spanish wording “as it is,” rather than translate it for the purpose of associating it with another mark. We therefore find that, in this case, it is not appropriate to apply the doctrine of foreign equivalents for the purpose of treating ARTESANO and ARTISAN as equivalents. However, even though we do not apply the doctrine in this case, we do nonetheless take into consideration that the two words have identical meanings.

Turning to the marks in their entireties, we find that ARTESANO NEW YORK CITY and ARTISAN^{NY} are more similar than dissimilar in appearance and sound. More significantly, the marks are similar in meaning, even if consumers do not translate the term ARTESANO to “artisan,” but merely view it as a novel spelling thereof resembling “artisan” in appearance and spelling. Viewed as a whole, the mark ARTESANO NEW YORK CITY suggests clothing items created by tradespersons in New York City, while ARTISAN^{NY} also suggests clothing created by tradespersons either in the City or State of New York. We find, as a result, that the differences between the marks are outweighed by their similarity particularly in meaning. Considered in their entireties, we find that the marks convey similar overall commercial impressions. This *du Pont* factor thus supports a finding that confusion is likely.

5. Summary

Considering all the evidence of record, including any evidence not specifically discussed herein, we find that the marks in their entireties are similar and that the identified goods are identical in part and will be encountered by the same consumers in common channels of trade at all price points. Applicant’s evidence of third-party registration of somewhat similar marks is insufficient to mitigate in favor of a finding of no likelihood of confusion. We find therefore that Applicant’s mark is likely to cause confusion with the mark in the cited registration when used in association with the identified goods.

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Decision: The refusal to register Applicant's mark on the ground of likelihood of confusion is affirmed.