

This Opinion is Not a  
Precedent of the TTAB

Hearing: February 26, 2020

Mailed: March 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

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*In re Monfrere*

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Serial No. 88004556

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Before Ritchie, Adlin and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Monfrere seeks registration of the mark MONFRÈRE FASHION (standard characters, FASHION disclaimed) for “denim jackets; denim jeans; denim pants; jeans; men's and women's jackets, coats, trousers, vests; pants; shirts; coats of denim; denims; jackets.”<sup>1</sup> According to the application: “The English translation of ‘MON FRÈRE’ in the mark is ‘MY BROTHER.’” The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark MY BROTHER

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<sup>1</sup> Application Serial No. 88004556, filed June 18, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use dates of October 30, 2016.

(typed form) for “t-shirts”<sup>2</sup> that use of Applicant’s mark in connection with Applicant’s goods is likely to cause confusion. After the refusal became final, Applicant appealed and filed a request for reconsideration which was denied. The appeal is now fully briefed, and at Applicant’s request, Applicant and the Examining Attorney appeared at an oral hearing.

### **I. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the 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); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *du Pont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, 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 cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

#### **A. The Goods**

Applicant’s “shirts” encompass Registrant’s “t-shirts.” Therefore, the goods are legally identical in-part. We need not go beyond our finding that Applicant’s and

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<sup>2</sup> Registration No. 1618855, issued October 23, 1990; renewed.

Registrant's goods are legally identical in-part. It is sufficient for a finding of likelihood of confusion if legal identity is established for any item encompassed by the identification of goods in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).<sup>3</sup>

Where, as here, the goods are in-part legally identical, we presume that the channels of trade and classes of purchasers for those goods are also the same. *See 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); *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); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Instit.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

The identity (in part) of Applicant's and Registrant's goods and their overlapping channels of trade and classes of consumers weigh heavily in favor of finding a likelihood of confusion. In addition, where, as here, the goods are in-part legally identical, the degree of similarity between the marks necessary to find a likelihood of

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<sup>3</sup> In any event, the Examining Attorney has introduced evidence establishing that the other goods for which Applicant seeks registration are also related to and travel in the same channels of trade as Registrant's goods. December 15, 2018 Office Action TSDR 104-146 (printouts from "levi.com," "forever21.com" and "urbanoutfitters.com") and 147-190 (third-party use-based registrations for marks used for t-shirts on the one hand and one or more of Applicant's goods on the other); October 9, 2018 Office Action TSDR 102-120 (printouts from "ralphlauren.com" and "hm.com").

confusion declines. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Grp., Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

## **B. The Marks**

We must consider the marks “in their entirety 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). “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* 777 Fed.Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

### **1. Appearance and Sound**

Here, the marks MONFRÈRE FASHION and MY BROTHER obviously look and sound quite different.

### **2. Meaning and Commercial Impression (Doctrine of Foreign Equivalents)**

The crux of this case is whether the marks convey similar meanings such that the marks are confusingly similar in their entirety.

Perhaps not surprisingly given the translation statement in the involved application, which indicates that MON FRÈRE (with a space between the two French words) means “my brother,” the Examining Attorney argues that the doctrine of foreign equivalents applies here.

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 Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The doctrine is applied when it is likely that “the ordinary American purchaser would ‘stop and translate [the term] into its English equivalent.’” *Palm Bay*, supra at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976) ... 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 1021, 1024 (TTAB 2006). See also *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355 \*6-7 (TTAB 2019). The Examining Attorney argues based on the doctrine that the marks convey similar meanings and are confusingly similar in their entireties.

Applicant argues that the doctrine does not apply. According to Applicant, “even a person familiar with the French language would not ‘stop and translate’ Applicant’s mark, and would instead ‘take it as it is,’ at least because Applicant’s mark includes a combination of foreign language words and an English language word, thereby changing the commercial impression of Applicant’s mark.” 7 TTABVUE 7 (Applicant’s Appeal Brief at 6).

We agree with Applicant. There is no dispute that MON FRÈRE means “my brother” in French, or that French is a “common language” in the United States. October 9, 2018 Office Action TSDR 40-62 (Cambridge French-English dictionary definitions of “mon” and “frère” and United States Census American Community Survey Report on “Language Use in the United States: 2011” indicating that well over 1 million people in the United States speak French); see *In re Thomas*, 79

USPQ2d at 1024 (applying doctrine of foreign equivalents to the French term in question based on evidence that more than 1.5 million people in the United States speak French, finding that “French is a common foreign language spoken by an appreciable segment of the population.”). Nevertheless, in this case we find it unlikely that American clothing consumers, including those who speak French, would “stop and translate” MONFRÈRE FASHION. Rather, they will “take it as it is.” *Palm Bay*, 73 USPQ2d at 1696.

Indeed, because the term MONFRÈRE FASHION combines a French compound word with an English word, translation would in many ways be illogical. That is, typically translations involve converting words from one language into another language, but here the terms which comprise Applicant’s mark are in two different languages. *See In re Universal Package Corp.*, 222 USPQ 344, 347 (TTAB 1984) (“Here only one of the two components is foreign. Translation of an entire compound word mark is more likely to take place in the marketplace than is the translation of only part of the mark.”). The Examining Attorney’s apparent assumption, unsupported by any evidence, that consumers would translate just one part of the mark, but not the other, is unconvincing. *See Palm Bay*, 73 USPQ2d at 1696 (“[T]he doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline”).

In this case, because Applicant’s mark is in two different languages, it is an incongruous, unitary term, such that attempting to translate it into a single language would not make sense. In this regard, we have kept in mind that marks must be

considered “in their entirety,” not component by component. *See e.g. Palm Bay*, 73 USPQ2d at 1691. *See also Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-546 (1920) (“The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety ....”). For consumers to translate Applicant’s mark in part but not in whole would be to ignore that its commercial impression is “derived from [the mark] as a whole,” which is in two languages. We hasten to add that our finding applies to this case only, and it is possible that the situation would be different with a different multi-language mark or different goods or services.

In analogous circumstances, courts and the Board have found that consumers would not “stop and translate” marks comprised of terms in multiple languages. *See e.g. In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (reversing genericness refusal to register LA YOGURT for yogurt, finding that French speakers in the United States would not perceive the mark “as a corruption of the French generic term for ‘yogurt’,” because “the use of the French article combined with the English generic changes the commercial impression of the mark as a whole”); *In re Universal Package*, 222 USPQ at 347 (reversing descriptiveness refusal of LE CASE for jewelry and gift boxes, finding that the use of the French article LE with the English word CASE changes the mark’s commercial impression, and “imparts to the mark a French flavor, a continental connotation which is presumably desirable from the perspective of manufacturers of jewelry boxes”); *French Transit, Ltd. v. Modern Coupon Sys., Inc.*, 818 F.Supp. 635, 29 USPQ2d 1626 (S.D.N.Y. 1993) (finding that doctrine of foreign

equivalents does not apply to LE CRYSTAL NATUREL because it includes both French (LE and NATUREL) and English (CRYSTAL) terms, pointing out that evidence indicated that two languages were used “to highlight that the product was imported from France”) (citing *Johanna Farms* and *Universal Package*).

Here, the mark’s commercial impression is, essentially, that Applicant offers French “fashion,” or fashion with “French” style or features. Indeed, because Applicant’s mark combines an apparently arbitrary French term with a merely descriptive or generic English word, and is used in a primarily English-speaking country in connection with goods described by its English word, the entire mark MONFRÈRE FASHION conveys the types of goods Applicant offers, and signals that the goods have some connection to France or another French-speaking location, or are French-style. It would not make sense for consumers to translate the mark’s French term, which conveys that the goods have a “French” connection, as doing so would destroy that intended meaning, which is absent from Registrant’s mark.

### **3. Conclusion Regarding the Marks**

The marks look and sound completely different. While they would convey essentially the same meaning if consumers translated only the French portion of Applicant’s mark, we find that United States consumers are not likely to do so, but will instead take Applicant’s mark “as it is.” See *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975) (finding that consumers would not translate TIA MARIA for a Mexican restaurant into “Aunt Mary,” its English equivalent). Thus, the marks convey different meanings and commercial impressions, and are completely different.

## II. Conclusion

Although the goods, channels of trade and classes of consumers are identical, and there is therefore a lower threshold for establishing a likelihood of confusion, the marks are so different in their entireties that confusion is unlikely. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single duPont factor may not be dispositive.”).

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