

From: Tanner, Michael

Sent: 11/27/2019 9:44:55 PM

To: TTAB E Filing

CC:

Subject: U.S. Trademark Application Serial No. 88004556 - MONFRÈRE FASHION - 2520-4 - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 88004556.doc

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 88004556

Mark: MONFRÈRE FASHION

Correspondence Address:

JOSHUA ZARABI

CARTER DELUCA & FARREL LLP

576 BROAD HOLLOW ROAD

MELVILLE, NY 11747

Applicant: Monfrere

Reference/Docket No. 2520-4

Correspondence Email Address:

docket@carterdeluca.com

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant, MONFRERE, appeals the refusal to register on the Principal Register the standard character mark MONFRÈRE FASHION for:

denim jackets; denim jeans; denim pants; jeans; men's and women's jackets, coats, trousers, vests; pants; shirts; coats of denim; denims; jackets

in International Class 025 pursuant to Section 2(d) of the Trademark Act of 1946 (as amended) (hereinafter “the Trademark Act”), 15 U.S.C. §§1052(d).

STATEMENT OF FACTS

On June 18, 2018, the applicant filed to register the standard character mark MONFRÈRE FASHION on the Principal Register for goods identified as “denim jackets; denim jeans; denim pants; jeans; men's and women's jackets, coats, trousers, vests; pants; shirts; coats of denim; denims; jackets,” in International Class 025.

In an Office action dated October 9, 2018, registration was refused pursuant to Trademark Act Section 2(d), because the mark when used in connection with the broadly identified goods so resembled the mark in U.S. Registration No. 1618855 (MY BROTHER) as to be likely to cause confusion, mistake, or to deceive. In addition, the applicant was required to: (1) provide a disclaimer for the word FASHION because the term was found to be descriptive in relation to the identified clothing goods, and (2) clarify the translation statement submitted with the initial application because the French wording “MON FRÈRE” means MY BROTHER in English.¹

In its November 19, 2018 response, the applicant: (1) argued its proposed mark was not confusingly similar to the cited MY BROTHER registration because reliance on the doctrine of equivalents was improper,² (2) asserted the disclaimer statement for the term FASHION was improper,³ and (3) claimed that “[t]he English translation of ‘mon frere’ in the mark is ‘my brother’” but that “the wording ‘monfrere’ has no meaning in a foreign language”.⁴

¹ See the Offc Action Outgoing dated October 9, 2018, TSDR at pg. 1.

² See the Response to Office Action dated November 19, 2018, TSDR at pg. 2.

³ *Id.*

⁴ *Id.*, at pg. 1; The applicant’s position with respect to the submitted translation statement was based on its dubious contention that even if the French wording MON FRÈRE means MY BROTHER, there is no French term “MONFRÈRE” despite the fact that the TMEP specifically states *the translation requirement applies to compound*

On December 15, 2018, the examining attorney issued an Office Action that: (1) continued and made final the prior likelihood of confusion determination with respect to U.S. Registration No. 1618855 (MY BROTHER) because the proposed mark was merely the French foreign equivalent of the wording in the cited mark, (2) continued and made final the prior translation requirement, and (3) continued and made final the prior disclaimer requirement.⁵

On June 17, 2019 the applicant filed a notice of appeal and a Request for Reconsideration. In its Request for Reconsideration, the applicant: (1) provided a disclaimer statement for the term FASHION,⁶ (2) provided a properly worded translation statement concerning the foreign wording in the mark,⁷ and (3) argued the Section 2(d) refusal was improper because the doctrine of foreign equivalents does not apply when a foreign term is combined with an English word.

On August 2, 2019, the examining attorney issued a reconsideration letter that: (1) accepted the applicant's disclaimer and translation statements thereby deeming such requirements satisfied, (2) objected to the applicant's reliance on third party registrations that were not properly made of record, and (3) denied the applicant's reconsideration request of the Section 2(d) refusal because the applicant misinterprets the relevant case law.⁸

ARGUMENT

THE DOCTRINE OF FOREIGN EQUIVALENTS COMPELS A FINDING THAT THE RESPECTIVE MARKS ARE SIMILAR IN COMMERCIAL IMPRESSION. THEREFORE, BECAUSE THE RESPECTIVE MARKS ARE BOTH USED ON CLOTHING ARTICLES THAT ARE HIGHLY RELATED, IF NOT IDENTICAL, FOUND IN THE SAME CHANNELS OF TRADE AND MARKETED TO THE SAME CONSUMERS, A LIKELIHOOD OF CONFUSION EXISTS BETWEEN THESE MARKS AND THE REFUSAL TO REGISTER UNDER SECTION 2(D) OF THE TRADEMARK ACT IS PROPER.

word marks comprised of two or more distinct words (or words and syllables) that are *represented as one word*. See TMEP §809.

⁵ See the Office Action Outgoing dated December 15, 2018, TSDR at pg. 1.

⁶ See the TEAS Request Reconsideration after FOA dated June 17, 2019, TSDR at pg. 2.

⁷ *Id.*

⁸ See the Reconsideration Letter dated August 2, 2019, TSDR at pg. 1.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, the similarity and nature of the goods and services, and the similarity of the trade channels for these goods and services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.* Not all the *du Pont* factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused, but rather, **whether there is a likelihood of confusion as to the source of the goods or services because of the marks used thereon.** See, e.g., *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source."). The overriding concern is not only to prevent buyer confusion as to the source of the goods, but also, to protect the registrant from adverse

commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

I. THE APPLICANT'S GOODS ARE HIGHLY RELATED, IF NOT IDENTICAL TO, THE REGISTRANT'S CLOTHING ARTICLES AND THESE GOODS ARE ALL FOUND IN THE SAME CHANNELS OF TRADE AND MARKETED TO THE SAME END CONSUMERS.

One part of any likelihood of confusion analysis is to compare the goods at issue to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983). As the Applicant is well aware, the compared goods do not need to be identical or even directly competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods emanate from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §1207.01(a)(i). The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to their source. See *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to

the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.").

In this case, the goods identified in U.S. Registration No. 1618855 (MY BROTHER) comprise "t-shirts" in International Class 025. The goods listed in the application comprise "denim jackets; denim jeans; denim pants; jeans; men's and women's jackets, coats, trousers, vests; pants; shirts; coats of denim; denims; jackets," in International Class 025.

A. None of the Respective Clothing Articles Have Any Limitation as to Channel of Trade or Class of Consumer. By Law, These Goods Must be Presumed to be Found in the Same Channels of Trade, and Encountered, Purchased and Used by the Same Consumer.

When analyzing the applicant's and registrant's goods for similarity and relatedness, such a determination is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); TMEP §1207.01(a)(iii). It is well settled that absent restrictions in an application or registration, the identified goods are presumed to "travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

In this case, the identifications set forth in the application and registration have no restrictions as to their nature, type, channel of trade or class of purchasers. Therefore, it is assumed that the registrant's and applicant's goods are sold everywhere that is normal for such items (e.g. clothing and department stores), that the same classes of purchasers shop for these items, and that these consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. v. KangaROOS*

U.S.A., Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

The relevant case law requires the Office to presume that the identified clothing articles all travel in the same channels of trade, and that these goods are marketed to, and encountered by, the same class of purchasers. *Id.* The applicant has not provided any evidence or cited any case law that would rebut this presumption. As such, the respective clothing products identified in the application and cited registration are deemed to use the same channels of trade and have the same class of purchasers for purposes of likelihood of confusion analysis.

B. The Unrestricted Term Shirts in the Application Necessarily Includes the T-shirts Listed in the Cited Registration. As Such, These Clothing Products are Closely Related, Found in the Same Channels of Trade and Purchased by the Same Consumers.

Where an application or registration describes the identified goods broadly, with no limitation as to their nature, type, channel of trade, or class of purchaser, the Office is required to presume the application or registration encompasses all goods of the type described, that these goods move in all normal channels of trade, and that they are available to all classes of purchasers. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); TMEP §1207.01(a)(iii).

The wording “shirts” listed in the applicant’s identification of goods is not limited to a particular type or kind of shirt. As such, this broad identification language must be presumed to comprise all kinds and types of shirts—including the t-shirts specifically identified in the registrant’s more narrow identification. *Id.* Therefore, the examining attorney must find that, as a matter of law, the various shirts identified in the application and cited registration are highly related, if not identical, found in the

same channels of trade, and marketed to, and used by, the same consumers. As such, these clothing products must be considered very closely related for purposes of the likelihood of confusion analysis.

C. The Remaining Clothing Products Listed in the Application Are Closely Related to, Found in the Same Channels of Trade as, and Purchased by the Same Consumers That Also Buy the T-shirts Listed in the Cited Registration.

In addition to the various shirts being very closely related, the evidence in this case also demonstrates that the applicant's remaining clothing products are also closely related to the t-shirts found in the cited registration. The compared goods need not be identical or even directly competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They 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 and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

While the applicant's remaining clothing articles are not identical to the t-shirts listed in the cited registration, the respective clothing goods are all closely related such that confusion would be likely if the clothing articles are marketed under the same or similar marks. Indeed, previous decisions regarding likelihood of confusion in the clothing field by this Court have consistently and repeatedly found many different types of apparel to be related. *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961) (women's boots related to men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's pants, blouses, shorts and jackets related to women's shoes); *In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985)

(women's shoes related to outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-99 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

As evidence that consumers are accustomed to a single source identifier in relation to a variety of different clothing articles all under the same mark, the examining attorney provided at least thirty (30) separate trademark registrations in which the same mark is used in relation to both t-shirts as well as jackets, pants, shirts, coats, trousers, jeans, vests and denims.⁹ These printouts have probative value to the extent that they serve to suggest that the identified clothing products are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

As additional support that the respective clothing articles are related, the examining attorney also provided numerous website pages from RALPH LAUREN¹⁰ H&M¹¹ LEVI'S¹² FOREVER 21¹³ and URBAN OUTFITTERS¹⁴ which show that a wide variety of clothing products are found in the same channels of trade, marketed to the same consumers, and commonly produced by the same entity under the same

⁹ See the fifteen (15) different registrations that were attached to the Offc Action Outgoing, dated October 9, 2018, all of which indicate that the same mark was used on both t-shirts as well as jackets, pants, shirts, coats, trousers, jeans, vests and denims, TSDR at pgs. 3-26 and 55-93; *see also*, the various registrations attached to the Offc Action Outgoing, dated December 15, 2018, all of which show that the same mark was used on both t-shirts as well as jackets, pants, shirts, coats, trousers, jeans, vests and denims, TSDR at pgs. 11-79.

¹⁰ See the webpages from Ralph Lauren® showing a wide variety of clothing articles produced under the same mark that were attached to the Offc Action Outgoing, dated October 9, 2018, TSDR at pgs. 91-99.

¹¹ See the webpages from H&M® showing a wide variety of clothing articles produced under the same mark that were attached to the Offc Action Outgoing, dated October 9, 2018, TSDR at pgs. 100-112.

¹² See the webpages from Levis® showing a wide variety of clothing articles produced under the same mark that were attached to the Offc Action Outgoing, dated December 15, 2018, TSDR at pgs. 93-105.

¹³ See the webpages from Forever 21® showing a wide variety of clothing articles produced under the same mark that were attached to the Offc Action Outgoing, dated December 15, 2018, TSDR at pgs. 106-119.

¹⁴ See the webpages from Urban Outfitters® showing a wide variety of clothing articles produced under the same mark that were attached to the Offc Action Outgoing, dated December 15, 2018, TSDR at pgs. 120-135.

mark. Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009). The applicant has not disputed any of this evidence.

When this evidence is viewed *in toto* and considered in light of the relevant case law, the unmistakable conclusion is that even if the registrant's t-shirts are slightly different from the various clothing articles identified in the application, these clothing products are all found in the same channels of trade, and they are also all marketed to, purchased, and used by the same end consumers. Given the consuming public's typical encounter and experience with clothing products, they would naturally believe the clothing articles at issue in this case all emanate from a common source. As such, the respective clothing articles must be considered closely related for purposes of the likelihood of confusion analysis.

Given the relevant case law, this Court should consider the respective shirts to be identical, and thus, by definition, conclude that they are related goods found in the same channels of trade and purchased by the same consumers. In addition, given the volume of contradicted evidence in support thereof, this Court should also find that the registrant's t-shirts are so closely related to the other clothing articles in the application that it is commonplace for consumers to find these products in the same channel of trade, and that the circumstances surrounding their marketing and use are such that they would be likely to be encountered by the same persons. *In re Ass'n of the U.S. Army*, 85 USPQ2d 1264, 1270 (TTAB 2007). The identity or close similarity between the identified clothing goods and trade channels therefor, as well as the overlap in the purchasers of these clothing products, would naturally give rise to the mistaken belief by consumers that these goods emanate from the same source, when in fact they do not—a factor that weighs heavily in favor of a finding a likelihood of confusion.

II. IN LIGHT OF HOW CLOSELY RELATED THE RESPECTIVE GOODS ARE, THE DIFFERENCES BETWEEN THE RESPECTIVE MARKS IS NOT SUFFICIENT TO AVOID A FINDING OF LIKELIHOOD OF CONFUSION.

Another part of any likelihood of confusion analysis under Section 2(d) is to compare the respective marks in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

While the applicant does not dispute that the respective goods are either identical or very closely related, it argues that the likelihood of confusion determination is improper because: (1) the doctrine of foreign equivalents does not apply, (2) the respective marks are dissimilar in appearance and sound, (3) the similarity determination is based on only part of the mark, not the mark as a whole, and (4) the respective marks differ in connotation and commercial impression. The applicant’s arguments wholly ignore the established facts of this case and readily disregard the relevant case law.

A. The Doctrine of Foreign Equivalents Does Apply to Marks Comprising English and Non-English Terms.

With respect to likelihood of confusion, “[i]t is well established that foreign words or terms are not entitled to be registered if the English language equivalent has been previously used on or registered for products which might reasonably be assumed to come from the same source.” *Mary Kay Cosmetics, Inc. v. Dorian Fragrances, Ltd.*, 180 USPQ 406, 407 (TTAB 1973). This principal is embodied by the doctrine of foreign equivalents, a legal doctrine which acknowledges that the United States is a

country of immigrants, and many citizens are bilingual, speaking both English and a foreign language. *In re Peregrina Limited*, 86 USPQ2d 1645 (TTAB 2008).

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. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377, 73 U.S.P.Q.2d 1689, (Fed. Cir. 2005); *In re Am. Safety Razor Co.*, 2 U.S.P.Q.2d 1459, 1460 (T.T.A.B.1987) (finding BUENOS DIAS for soap confusingly similar to GOOD MORNING for shaving cream). Consequently, marks comprised of foreign words from modern languages are generally translated into English to determine similarity in meaning and connotation with English word marks. *See Palm Bay Imports, Inc.* 396 F.3d at 1377. Equivalence in meaning and connotation may be sufficient to find such marks confusingly similar. *See In re Aquamar, Inc.*, 115 USPQ2d at 1127-28; *In re Thomas*, 79 USPQ2d at 1025.

As the applicant correctly notes, the doctrine of foreign equivalents is not an absolute rule. *In re N. Paper Mills*, 20 C.C.P.A. 1109, 64 F.2d 998, 999 (1933); McCarthy on Trademarks, at § 11:34. The doctrine should only be applied when it is likely that the ordinary American purchaser would "stop and translate [the foreign word] into its English equivalent." *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B.1976). If it is unlikely that the ordinary American purchaser will translate the foreign mark, but rather, will take it as it is, then the doctrine of foreign equivalents should not be applied. *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524 (T.T.A.B.1975) (no likelihood of confusion between TIA MARIA for a Mexican restaurant and AUNT MARY's for canned vegetables because, inter alia, a person dining at the TIA MARIA restaurant surrounded by its Mexican décor and Mexican food, would be likely to accept "TIA MARIA" as it is and not translate it into "AUNT MARY").

The applicant's position is unequivocal; the doctrine of foreign equivalents does not apply when a mark combines both foreign terms and English words because the combination of such terms necessarily changes the commercial impression of the entire mark thereby making it less likely that consumers will stop and translate the mark and more likely that they will take the mark as it is.¹⁵ As support for this position, the applicant relies on a pronouncement found in a single case from twenty-five (25) years ago, *French Transit Ltd. v. Modern Coupon Systems Inc.*, 29 USPQ2d 1626, 1626-27 (S.D.N.Y. 1993). The applicant's expansive interpretation of the statement "the doctrine does not apply when a mark is a combination of foreign and English words" appearing in *French Transit*, misreads and misapplies the actual holding in that case. *French Transit Ltd.*, 29 USPQ2d at 1626.

Despite the applicant's faulty assertion to the contrary, *French Transit* does not stand for the proposition that the doctrine of foreign equivalents is always inapplicable whenever a foreign term is combined with an English one. Rather, the facts of *French Transit* clearly show the court's pronouncement regarding the inapplicability of the doctrine of foreign equivalents is limited to a particular situation—determining if a mark is generic or descriptive when a generic English word for a good or service is combined with a foreign article. Indeed, the Court in *French Transit* seems to have explicitly curtailed reading its pronouncement in the expansive manner urged by the applicant by grounding support for its conclusion that the combination of the English word CRYSTAL and two French terms LE and NATUREL changed the commercial impression of the mark as a whole, "under the reasoning of *Johanna and Universal Package Corp.*". *Id.*, at 1627; see also, *In re Johanna Farms*, 8 U.S.P.Q.2d 1408, 1413 (TTAB 1988) (combination of the French article "La" with the English "Yogurt" changed the commercial impression of the mark as a whole such that La Yogurt was perceived as a trade name rather than a product, and was therefore protectable.); *In re Universal Package Corp.*, 222

¹⁵ See the applicant's Appeal Brief at pg. 7; see also, the June 17, 2019 Request for Reconsideration, TDSR, at pgs. 5, 14-15 and the November 19, 2018 Response to Office Action, TSDR at pg. 2.

U.S.P.Q. 344, 347 (TTAB 1984) (“[w]hen the French article “LE” is used before [CASE] the commercial impression created by the combination is something different than that which would be created by ‘THE CASE’”).)

While the applicant urges this Court to ignore any limits on the holding of *French Transit*, and transfer the holding of that case to situations where descriptiveness/genericness is not an issue, stare decisis precludes such a result. *French Transit* was decided more than 25 years ago, yet the applicant has not been able to point to a single subsequent case in which that holding (the doctrine of foreign equivalents is inapplicable whenever a foreign term is combined with an English one) has been applied outside the context of a descriptiveness/genericness determination. See e.g., *In re The Lex Group VA*, Serial No. 76665046, (T.T.A.B. 2009) (finding E-LEX descriptive and a combination of an English term and abbreviation for the term “electronic” despite translation evidence for the term LEX.); *In re Nikken, Inc.*, Serial No. 76573402, (T.T.A.B. 2007) (finding the English and Japanese combination KENZEN WELLNESS not descriptive in relation to dietary supplements.) Since there is no descriptive or generic refusal germane to this case, the rule concerning the inapplicability of the doctrine of foreign equivalents found in *French Transit*, as well as *In re Johanna Farms* and its progeny is not relevant.

B. While the Proposed Mark Combines Terms From Different Languages, Such Combinations Do Not Preclude Purchasers From Stopping and Translating the Mark.

While correctly noting the courts have found consumers more likely to stop and translate a mark when all of the words of the mark are in a single language, the applicant postulates that multi-language marks have the opposite effect, and thus, are unlikely to be translated by consumers.¹⁶ As support for this position, the applicant relies on *In re Johanna Farms* (finding LA YOGURT not descriptive) and *In re Universal Package Corp.*, (finding LE CASE not descriptive), for the premise that

¹⁶ See the applicant’s Appeal Brief at pg. 9.

when a mark combines both English and non-English terms consumers will not stop and translate the mark, but merely take it as it is.¹⁷

Johanna Farms and Universal Package Corp., however, both deal with a specific situation not present in this case—the avoidance of a descriptiveness refusal because the overall commercial impression of a mark comprising a foreign article and a generic English term is greater than the sum of the translation of the foreign article combined with the generic term (*e.g.* LE CASE is greater than THE CASE or LA YOGURT is greater than THE YOGURT). The applicant attempts to extract from this line of cases a universal rule—consumers will not stop and translate a multi-language mark that combines a foreign term and an English term.¹⁸ According to the applicant, *all* multi-language marks that combine a foreign term and an English term must necessarily change the commercial impression of the entire mark ***simply because of this combination***, and therefore, the consumer will not stop and translate the foreign wording in the mark, but will simply take it as it is.¹⁹ The applicant however, has not cited any case law that would support such a universal application of the limited exception to the doctrine of foreign equivalents created by *Johanna Farms and Universal Package Corp.* Nor has it provided any reasoning or explanation as to why or how the commercial impression of the proposed mark changes simply because English and non-English terms are combined.

The central tenant of the applicant’s brief is that whenever a foreign term is combined with an English one, the doctrine of foreign equivalents does not apply. Furthermore, the applicant has repeatedly argued that a mark comprising the combination of a foreign word and English term necessarily changes the commercial impression of the mark as a whole in that it must be different and distinct from a mark comprising a combination of the translation of the foreign term and the English

¹⁷ *Id.*, at pg. 10.

¹⁸ *Id.*, at pgs. 9-10.

¹⁹ *Id.*, at pgs. 11-12.

word. Such a rule however, would lead to perverse results—subsequent applicants would be able to avoid a likelihood of confusion finding simply by adding highly descriptive foreign wording to an established mark (*e.g.* MY BROTHER vs. MY BROTHER ÉTAGÈRE) since according to the applicant “the mixed nature of the mark will not prompt consumers” to undertake a translation of the foreign term and because consumers will not stop and translate the mark the commercial impression is different than if the term was translated under the doctrine of foreign equivalents.²⁰

Finally, the applicant’s notion that the case law establishes that marks comprised of a foreign term and English word are not translated misinterprets what actually happened in each of these cases. In every case relied on by the applicant, the court did in fact translate the entire mark into English even though it was comprised of both a foreign term and an English word. In each case however, the court was able to articulate a specific reason as to why the commercial impression of the combination of the foreign term and English word made a different impression on the consumer than the commercial impression given by a mark comprised of a ***translation*** of the foreign term and English word. It is only because of this articulated difference that the court did not apply the doctrine of foreign equivalents in those cases. Nowhere in this case has the applicant made such an analysis or articulated a specific reason why its combined mark has a different commercial impression than a translation of that mark. Absent such analysis, the applicant’s argument must fail.

C. The Entire Mark Was Considered When Evaluating the Proposed Mark’s Commercial Impression and Whether Consumers Would Stop and Translate the Proposed Mark or Take It Like It Is

According to the applicant, the Section 2(d) refusal is problematic because the examining attorney failed to take the commercial impression of the mark as a whole into account ***prior to*** applying the doctrine of foreign equivalents. The applicant claims that *Johanna Farms* and *Universal Package*

²⁰ *Id.*, at pg. 15.

Corp., requires an evaluation of the mark as a whole before making any translation or any determination as to whether the mark is likely to be confused with any potential registration. This novel argument is not supported by the case law.

The applicant claims *Johanna Farms* and *Universal Package Corp.*, buttress its position, but the applicant seems to have misinterpreted what actually happened in each of these cases. In *Universal Package Corp.*, the court states that “[w]hen the French article “LE” is used before” the English word CASE “the commercial impression created by the combination is something different than that which would be created by ‘THE CASE’.” *Universal Package Corp.*, 222 U.S.P.Q. at 347. Furthermore, while speaking about a prior case, same court notes “[o]ur more fundamental difficulty with the “LE JAR” decision, however, is the assertion that the commercial impression made by “LE JAR” is “THE JAR.”” *Id.*, at 346-47. Despite the applicant’s claim to the contrary, it is difficult, if not impossible to fathom how that court can make these statements if it did not translate the term LE into the term THE prior to evaluating the commercial impression of the marks LE CASE or LE JAR as a whole.

In *Johanna Farms*, the court, when evaluating whether the proposed mark LA YOGURT was generic, stated “[w]e believe, as did the Board in the *Universal Package* case, that the use of the French article combined with the English generic changes the commercial impression of the mark as a whole”. While unstated, procedurally this statement cannot be made unless the court first translates the term LA into the article THE before evaluating whether the proposed mark as a whole is otherwise descriptive under Section 2(e)(1). *In re J.D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), *aff’d*, 360 F.2d 650.

Despite the applicant’s claims to the contrary, what the court is really doing in both these cases is translating the mixed foreign term and English word mark into one that is entirely comprised of English terms and then comparing that all English result to the mark actually applied for to see if there is

an articulable commercial impression difference between the two. If there is such an articulable difference, then the doctrine of foreign equivalents does not apply.

Finally, to the extent the applicant is correct as to when the actual translation occurs in these cases, both *Johanna Farms* and *Universal Package Corp.*, concern the issue of descriptiveness, not likelihood of confusion, and therefore, the order of the steps necessary to undertake the relevant Section 2(d) analysis for a mark that combines a foreign term and English word would seem to be somewhat different than what is required to evaluate the descriptive nature of a particular mark that combines English and non-English wording.

D. The Applicant Has Failed to Identify Any Reason Why Consumers Would Not Translate the Applied-for Mark.

While the doctrine of foreign equivalents is not an absolute rule, its use is appropriate if the "ordinary American purchaser" would "stop and translate" the foreign wording in a mark into its English equivalent. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). The applicant claims the numerous situations in which a foreign term in a mark has not been translated into its English equivalent, justifies not applying the doctrine of foreign equivalents in this case. However, the cases relied on by the applicant to justify its position are exceptions to the doctrine of foreign equivalents; the applicant has not provided any reason that would justify the use of these exceptions.

Exceptions to the doctrine of foreign equivalents generally entail: (1) whether the foreign wording has a meaning in the relevant marketplace that differs from the translated meaning in English; or (2) whether it is more or less likely that the foreign expression will be translated by purchasers because of the manner in which the term is encountered in the marketing environment as used in connection with the goods.

Typically, the doctrine will not be applied where the foreign wording has developed an alternate meaning in the relevant marketplace that is different from the translated meaning in English, and the evidence shows that this alternate meaning would be understood by the relevant purchasing public. See *In re La Peregrina Ltd.*, 86 U.S.P.Q.2d 1645, 1649 (TTAB 2008) (finding that if sufficient evidence had been provided to show that the Spanish-language mark LA PEREGRINA, which translates to mean "the pilgrim," for goods including pearls and pearl jewelry, was viewed by the relevant purchasing public as the "name of a very famous and unique pearl," such would be a situation "where purchasers would not translate the name"); cf. *Cont'l Nut Co. v. Le Cordon Bleu S.a.r.l.*, 494 F.2d 1395, 1396-97, 181 USPQ 646, 647 (C.C.P.A. 1974) (finding that applicant's ownership of a prior registration for "BLUE RIBBON" did not preclude opposer from asserting damage resulting from applicant's registration of the mark CORDON BLEU, (which literally translates to "blue ribbon") because CORDON BLEU would not be translated by, or have the same significance to, an American purchaser in view of the adoption by the English language of the wording CORDON BLEU, as evidenced by American English dictionary entries indicating that such wording refers to a highly skilled cook).

The doctrine also typically is not be applied where evidence in the record indicates that it is unlikely purchasers would stop and translate the mark because of "marketplace circumstances or the commercial setting in which the mark is used." *La Peregrina*, 86 USPQ2d at 1648; see also *Thomas*, 79 USPQ2d at 1026 (finding "MARCHE NOIR" confusingly similar to "BLACK MARKET MINERALS," but suggesting that a different conclusion might have been reached if the marketplace circumstances or commercial setting in which the mark was used were such that it would be unlikely for purchasers to translate "MARCHE NOIR"); *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975) (holding TIA MARIA (which translates to "Aunt Mary") for restaurant services, and AUNT MARY'S for canned fruits and vegetables, not likely to cause confusion, because, inter alia, a person dining at the TIA MARIA

restaurant surrounded by its Mexican décor and Mexican food, would be likely to accept "TIA MARIA" as it is and not translate it into "AUNT MARY").

As support for its position that the doctrine of foreign equivalents applies, the examining attorney has provided evidence that the wording MY BROTHER in the cited registration is a direct and literal translation of the French wording MON FRÈRE appearing in the proposed mark.²¹ The applicant has not refuted this evidence. Thus, the burden switches to the applicant to justify why the doctrine of foreign equivalents should not be applied.

Other than stating the mark comprises both a foreign word and an English term, and that such a combination necessarily alters the commercial impression of the mark as a whole (without explaining how or why this alteration occurs,) the applicant has not articulated any reason or basis that justifies use of the noted exceptions to the doctrine of foreign equivalents. For instance, the applicant has provided no evidence that the ordinary American purchaser familiar with French would recognize the unitary term MONFRÈRE as something other than the French wording MON FRÈRE, nor has it provided any evidence that MONFRÈRE or MON FRÈRE is a colloquial French expression or has developed an alternate meaning in the relevant marketplace that is different from its translated meaning in English. Absence such evidence, the applicant cannot satisfy its burden and the doctrine of foreign equivalents should be applied.

In sum, “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”.

²¹ See the entries from the *Cambridge French-English Dictionary* for the terms MON and FRÈRE attached to the October 9, 2018 Office Action Outgoing, TSDR at pgs. 32-37; *see also*, the webpages attached to the December 15, 2018 Office Action Outgoing from the *Collins French to English Dictionary*, (2018) which notes that MON is a French word that translated to the term MY in English and the term FRÈRE is a French word that translates to BROTHER in English. Notably, in the list of usage examples under MON is the wording MON FRÈRE which is indicated to translate to MY BROTHER. Found at: <https://www.collinsdictionary.com/dictionary/french-english/mon>; <https://www.collinsdictionary.com/dictionary/french-english/fr%C3%A8re>; TSDR at pgs. 85-92.

In re La Peregrina Ltd., 86 U.S.P.Q.2d at 1648. Therefore, the foreign wording in the proposed mark must be translated into English for purposes of making a likelihood of confusion determination.

E. Despite Their Differences in Sound and Appearance, the Respective Marks Have a Highly Similar Meaning and Commercial Impression When Considered in Connection With the Identified Goods.

“Marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used”. *Glenwood Laboratories v. American Home Products Corp.*, 455 F.2d 1384, 1385, 173 USPQ 19, 20 (CCPA 1972); 2 J. McCarthy, *Trademarks and Unfair Competition § 23:15A* (2nd ed. 1984). The applicant correctly notes that when making such comparison, a likelihood of confusion determination cannot be predicated on an improper dissection of a mark. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (CCPA 1974); see *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007, 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, in articulating the reasons for reaching a particular conclusion on the issue of confusion, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (“[Regarding the issue of confusion,] 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 consideration of the marks in their entireties.” (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))). Indeed, this type of analysis [a weighing of the individual components of a mark to determine its overall commercial impression] appears to be unavoidable. *In re Nat’l Data Corp.*, 753 F.2d at 1058.

With respect to likelihood of confusion, "[i]t is well established that foreign words or terms are not entitled to be registered if the English language equivalent has been previously used on, or registered for, products which might reasonably be assumed to come from the same source." *Mary Kay Cosmetics, Inc. v. Dorian Fragrances, Ltd.*, 180 USPQ 406, 407 (TTAB 1973). Under the doctrine of foreign equivalents, a foreign word from a language familiar to an appreciable segment of American consumers and its English equivalent may be held to be confusingly similar. *See, e.g., In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (holding MARCHE NOIR for jewelry, and BLACK MARKET MINERALS for retail jewelry and mineral store services, likely to cause confusion); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983) (holding EL SOL for clothing and footwear, and SUN and design for footwear likely to cause confusion). The doctrine is applied when "the ordinary American purchaser" would "stop and translate" the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); TMEP §1207.01(b)(vi)(A). The ordinary American purchaser includes those proficient in the foreign language. *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d at 1024.

In this case, the proposed mark comprises the wording MONFRÈRE FASHION. As previously noted, MON FRÈRE is a French term, the direct and literal translation of which is MY BROTHER when translated into English.²² Thus, the "ordinary American purchaser" for purposes of analysis under the doctrine of foreign equivalents includes those U.S. consumers who are proficient in French. The U.S. Census Bureau shows a large number of U.S. consumers (more than 2,050,00) speak French or French Creole;²³ as such, there is no question that French is a common, modern language in the United States.

²² *Id.*

²³ See the report from the U.S. Census Bureau entitled Language Use in the United States 2011 as well as the attached statistical evidence showing the number of those proficient in French residing in the United States attached to the 12/15/18 Office Action Outgoing, TSDR at pgs. 180-204. *See also*, the October 9, 2018 Office Action Outgoing, TSDR, at pgs. 38-54. (Due to a server error some of the pages from this report were not displayed in the October 9, 2018 Office Action).

See also, *In re Optica Int'l*, 196 USPQ 775 (TTAB 1977) (finding that French is a common, modern language spoken by appreciable number of consumers in the United States.)

That the proposed mark contains the unitary term MONFRÈRE, rather than the proper spelling MON FRÈRE is not relevant. See, e.g., *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“[T]he marks ‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical [internal citation omitted].”); *Stock Pot, Inc., v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), aff’d 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”). It stands to reason because this Court has repeatedly found that, with respect to consumers proficient in English, there is no difference between a two-term compound mark and a unitary compound mark having the same terms, the same would hold true with respect to an ordinary American purchaser who would naturally stop and translate the mark because they are proficient in French. Logically speaking, there is little, if any, difference between a compound mark comprising two separate terms and the same compound mark arranged as a single unitary term to those who are proficient in the particular language in which the compound mark appears.

The record evidence in this case clearly shows that the one and only meaning of the phrase MON FRÈRE is MY BROTHER and, without question, that is how it would be recognized and understood by the French-speaking public.²⁴ Thus, given the number of consumers throughout this country who are proficient in French or French Creole, and considering that the foreign wording in the application, MON FRÈRE, is a literal and direct translation for the English wording MY BROTHER, it is likely that the foreign

²⁴ See the entries from the *Cambridge French-English Dictionary* for the terms MON and FRÈRE attached to the October 9, 2018 Offc Action Outgoing, TSDR at pgs. 32-37; see also, the webpages attached to the December 15, 2018 Offc Action Outgoing from the *Collins French to English Dictionary*, (2018) which notes that MON is a French word that translated to the term MY in English and the term FRÈRE is a French word that translates to BROTHER in English. Notably, in the list of usage examples under MON is the wording MON FRÈRE which is indicated to translate to MY BROTHER. Found at: <https://www.collinsdictionary.com/dictionary/french-english/mon;> [https://www.collinsdictionary.com/dictionary/french-english/fr%C3%A8re;](https://www.collinsdictionary.com/dictionary/french-english/fr%C3%A8re) TSDR at pgs. 85-92.

language in the proposed mark would be translated into its English equivalent by an appreciable number of U.S. consumers.

The applicant claims there is no likelihood of confusion because its proposed mark is “distinctly different” in sound and appearance from the cited registration, and that its mark has a different commercial impression than the cited registration despite the fact that MON FRÈRE means MY BROTHER.²⁵ In addition, the applicant asserts the likelihood of confusion comparison conducted by the examining attorney is improper because it did not include the term FASHION when determining the commercial impression of the mark.²⁶ On both counts the applicant is mistaken.

The fundamental problem with the applicant’s similarity analysis is that it compares the respective marks in a vacuum without any consideration of how closely related the respective goods are, thereby violating the basic principle that governs likelihood of confusion analysis. It is well settled that “marks must be compared in their entireties **and** must be considered in connection with the particular goods or services for which they are used”. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). When the goods or services are identical or virtually identical, the degree of similarity between the marks necessary to support a determination that confusion is declines. *See Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1337, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). The applicant’s argument fails because it did not evaluate the similarity in the commercial impression of and meaning between MONFRÈRE FASHION and MY BOTHER while taking into account that the respective clothing products

²⁵ See the applicant’s Appeal Brief at pgs. 17-18.

²⁶ See the applicant’s Appeal Brief at pgs. 12-13. (“Applicant respectfully submits that such a parsing of Applicant’s mark is improper and ignores the commercial impression imparted by the mark as a whole onto the consumer”.)

are highly similar, if not identical, found in the same channels of trade and marketed to the same consumers.

Despite their differences in sound and appearance, the examining attorney must conclude that in the context of the respective goods, the meaning and commercial impression given by the wording MONFRÈRE FASHION in the proposed mark is highly similar to the commercial impression created by the cited registration MY BROTHER. Similarity in any one of the elements (sound, appearance, meaning or commercial impression) is sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB (1988)); *In re Mack*, 197 USPQ 755 (TTAB 1977); see TMEP §§1207.01(b).

The examining attorney provided evidence that the wording MY BROTHER in the cited registration is a direct and literal translation of the French wording MON FRÈRE appearing in the proposed mark.²⁷ As such, under the doctrine of foreign equivalents, this Court should conclude that MY BROTHER and MON FRÈRE have the same meaning in the context of the goods. While the applicant's addition of the highly descriptive term FASHION to MONFRÈRE makes a slight change in the overall commercial impression comparison versus MY BROTHER vis-à-vis the term MONFRÈRE alone, this change is not significant enough to avoid a finding of likelihood of confusion.

The applicant's inclusion of the highly descriptive and disclaimed term FASHION in its mark does not alter the determination that MY BROTHER and MONFRÈRE are foreign equivalents and have the same meaning in the context of the identified goods. It is well settled that adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor

²⁷ See the entries from the *Cambridge French-English Dictionary* for the terms MON and FRÈRE attached to the October 9, 2018 Office Action Outgoing, TSDR at pgs. 32-37; *see also*, the webpages attached to the December 15, 2018 Office Action Outgoing from the *Collins French to English Dictionary*, (2018) which notes that MON is a French word that translated to the term MY in English and the term FRÈRE is a French word that translates to BROTHER in English. Notably, in the list of usage examples under MON is the wording MON FRÈRE which is indicated to translate to MY BROTHER. Found at: <https://www.collinsdictionary.com/dictionary/french-english/mon>; <https://www.collinsdictionary.com/dictionary/french-english/fr%C3%A8re>; TSDR at pgs. 85-92.

does it overcome a likelihood of confusion under Section 2(d). *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). When the respective marks are viewed as a whole, the similarity between them, because of the foreign equivalence between the terms MY BROTHER and MONFRÈRE, outweighs the difference between them that results from the applicant's addition of the descriptive and disclaimed term FASHION. This ultimate determination is especially true considering, (as was more fully explained above,) that the respective clothing goods are deemed to be highly related, if not identical, found in the same channels of trade, and marketed to the same consumers. The courts have consistently and repeatedly found that where the goods of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *See, In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

It is noted that this case is highly similar to the comparison made in *In re Mark Thomas*, wherein the court found MARCHE NOIR when used on jewelry to be confusingly similar to BLACK MARKET MINERALS used with jewelry stores because "while decidedly different in sound and appearance" the respective marks "have the same connotations" despite the additional descriptive and disclaimed term MINERALS appearing in the mark. *In re Mark Thomas*, 79 U.S.P.Q.2d 1021, 1025 (T.T.A.B. 2006). Even if potential purchasers proficient in French realize the apparent differences between the respective marks, they could still reasonably assume, because the respective goods are so closely related and due to the overall similarities in meaning and commercial impression in the respective marks, that applicant's

clothing articles sold under the “MONFRÈRE FASHION” mark constitute a new or additional product line from the same source as the clothing products sold under the “MY BROTHER” mark with which they are acquainted or familiar, and that “MONFRÈRE FASHION” is merely the French variation of the registrant’s “MY BROTHER” mark. *See, e.g., SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant’s marks ALSO ANDREA and ANDREA SPORT were “likely to evoke an association by consumers with opposer’s preexisting mark [ANDREA SIMONE] for its established line of clothing.”).

CONCLUSION

When viewed *in toto*, the case law and evidence in the record all point to the unmistakable conclusion that the respective clothing products are either identical or closely related to one another and travel in the same channels of trade to the same consumers, and thus, are related in the mind of the consuming public as to origin, and that the French wording MON FRÈRE is a direct and literal translation of the English wording MY BROTHER, and thus, is a foreign equivalent of the English wording MY BROTHER. As such, the applicant’s proposed mark MONFRÈRE FASHION, when viewed in the context of how closely related the respective clothing goods are, is highly related in meaning and commercial impression, and thus, confusingly similar to, the cited MY BROTHER registration.

Unlike the Office’s findings which are well supported by the evidentiary record, the applicant’s arguments are mere legal conclusions without any evidentiary support. In sum, given the similarity between the respective marks when viewed in light of the relatedness between the respective clothing goods as well as the similarity between the channels of trade and relevant purchasers for such clothing articles, it is likely that consumers proficient in French will be confused as to the ultimate source of these products and associate the applicant’s proposed mark MONFRÈRE FASHION with the cited MY BROTHER registration. The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by

a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). Accordingly, the examining attorney strongly urges this Court to uphold the Section 2(d) refusal contained in the Final Office Action and deny registration of the applicant's proposed mark pursuant to Section 2(d) of the Trademark Act.

/Michael Tanner/

Respectfully submitted,

Michael Tanner

Trademark Attorney

Law Office 119

USPTO

571-272-9706

michael.tanner@uspto.gov

Brett Golden

Managing Attorney

Law Office 119

571-272-9257

ecom119@uspto.gov