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Mailed: October 11, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re José R. Negrón Cruz

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Serial No. 78404496

Samuel F. Pamas Portalatin of Hogleund & Pamas for José R. Negrón Cruz.

Warren L. Olandria, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

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Before Walters, Rogers and Cataldo, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

José R. Negrón Cruz has filed an application to register the mark shown below on the Principal Register for "women's underwear and clothing, namely, brassieres, panties, pajamas, babydoll pajamas, shirts, jeans, blouses, tops, bathing suits, belts, socks," in International Class 25.<sup>1</sup> The application includes the following statements:

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<sup>1</sup> Serial No. 78404496, filed April 19, 2004, based on use of the mark in commerce, alleging first use and use in commerce as of May 27, 2003.

- The mark translates into English as "MY INTIMATE FASHION."
- No claim is made to the exclusive right to use MODA INTIMA apart from the mark as a whole.
- The mark consists of a pink square with the words "MIA MODA INTIMA" in white color inside it. There are seven light blue circles above the letter I of the word MIA, forming a star-like figure and the dot of the letter I appears in white color inside the center light blue circles.
- The color(s) pink, light blue and white is/are claimed as a feature of the mark.



The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark MIA, previously registered for "shoes and footwear,"<sup>2</sup> that, if used on or in connection with

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<sup>2</sup> Registration No. 2259181 issued July 6, 1999, to Mia Shoes, Inc. [Sections 8 (six-year) and 15 affidavits accepted and acknowledged, respectively.]

applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The examining attorney contends that the marks are substantially similar because MIA is the dominant portion of

applicant's mark; and that the goods are closely related because "shoes and clothes are manufactured by the same companies as well as sold together in retail stores" (brief, unnumbered p. 8). The examining attorney submitted copies of five third-party registrations that include in the identifications of goods both applicant's and registrant's identified goods.

Regarding applicant's position, we note that applicant's entire argument against the refusal focuses on the mark MIA SHOE COMPANY, which is one of two registered marks originally cited by the examining attorney. In his brief, the examining attorney noted that registration no. 1338013 for the mark MIA SHOE COMPANY was cancelled on March 4, 2006, subsequent to the filing of this appeal, and he withdrew the refusal based on this registration. Applicant did not file a reply brief modifying any of his arguments to focus on the registered mark MIA, which is the sole remaining basis for the refusal to register.

Applicant contends that the marks are different in connotation, appearance and commercial impression. Applicant asks that we apply the doctrine of foreign equivalents and concludes that, as translated, the marks are entirely different, although he translates and compares the mark "MY INTIMATE APPAREL" to the mark "MY SHOE COMPANY." See *Palm Bay Imports, supra*. Applicant

contends that the word "mia" is the only similarity between the marks and this word "translates to the word 'my' in English and is merely a common possessive of the language as well as a common possessive of the Italian language" (brief, p. 7). Applicant contends that the respective goods are also entirely different, citing *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) and *In re Sydel Lingerie Co. Inc.*, 197 USPQ 629 (TTAB 1977) in support of his position. Applicant argues that the consumers of his products are sophisticated purchasers, stating that "the courts are supposed to take judicial notice of 'a certain degree of sophistication' of women purchasers." Finally, applicant notes that he has used his mark since May 2003 and he reports no instances of actual confusion.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average

purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The cited registered mark is, in its entirety, MIA, with no claim to any particular design format. Not only does applicant's mark incorporate the cited mark in its entirety, but the MIA portion of applicant's mark is substantially larger than the other wording, MODA INTIMA, which is merely descriptive. The predominant design feature is the colored circles around the dot for the "i" in MIA. The word MIA dominates this design element as it appears in front of the bottom portion of the design and, since the circle design pertains to the "i" in MIA, the design serves to emphasize the word MIA in the mark.

The Federal Circuit recently stated that "[u]nder the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine ... similarity of connotation in order to ascertain confusing

similarity with English word marks." *Palm Bay Imports, supra*, 73 USPQ2d at 1377. The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Id.* 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. See *Trademarks and Unfair Competition, supra* at 23:26 (4th ed.). Italian is certainly a common language in the United States, however, both the registered mark and applicant's mark, if perceived as foreign words and translated, would translate similarly, i.e., "MY" and "MY INTIMATE APPAREL," respectively. Those consumers that translate MIA as MY are likely to do so with respect to both marks. Moreover, given the prominence of MIA in applicant's mark, while some consumers may translate the terms, it is equally likely that the term MIA could be perceived as standing alone and connoting a name, as could the registered mark. The small additional descriptive wording in applicant's mark could be perceived as merely indicating a particular line of apparel offered under the MIA mark. Thus, whether or not the doctrine of foreign equivalents is applied to this mark, the overall commercial impressions of these two marks are substantially similar.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in an applicant's application vis-à-vis the goods or services recited in the cited registration, rather than what the evidence shows the goods or services actually are.

*Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom*

*Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is also a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

In support of his contention that the goods are related, the examining attorney submitted copies of five third-party registrations based on use in commerce, each for marks used to identify a variety of apparel, including the goods listed in applicant's identification of goods and various items of footwear. Although third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). While the record would be stronger if the examining attorney had included evidence of use of the same mark in connection with both applicant's and registrant's goods, we find that this evidence is sufficient to establish that the involved goods are related. Further, we find it a matter of common sense that applicant's "socks" are complementary items to registrant's "shoes," so that, if such goods were identified by confusingly similar marks, confusion as to source would be likely.

Therefore, we conclude that in view of the noted similarity in the commercial impressions of applicant's mark, MIA MODA INTIMA and design, and registrant's mark, MIA, their contemporaneous use on the related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Applicant's argument regarding alleged sophistication of purchasers is not supported by any evidence and, based on the lack of limitations in the identifications of goods, the consumers would encompass all levels of sophistication. Additionally, applicant's contention of a lack of actual confusion is not persuasive because, while a factor to be considered, the absence or presence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See, *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

Similarly, the cases cited by applicant do not warrant a different conclusion. In the cases of *In re British Bulldog, Ltd.*, *supra* [PLAYERS and design for "men's underwear" and PLAYERS for "shoes" not confusingly similar] and *In re Sydel Lingerie Co. Inc.*, *supra* [BOTTOMS UP for ladies' and children's underwear versus men's suits, coats

and trousers not confusingly similar], the Board reiterated that there is no *per se* rule finding all items of wearing apparel related, and found no likelihood of confusion on the ground that the marks have different connotations in connection with the respective goods and that the subject goods differ primarily because they are sold in different areas of department stores and are not complementary items. The primary distinction between these two cases and the case now before us is that the connotation of the marks does not differ due to the nature of the goods involved. Additionally, we have no evidence as to how the respective goods are sold in stores that may carry all of the involved goods and, moreover, we have found that applicant's "socks" and registrant's "shoes" are complementary items.

To the extent that we might have any doubts as to the correctness of our ultimate conclusion based on the record before us, we resolve such doubts in favor of registrant. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

*Decision:* The refusal under Section 2(d) of the Act is affirmed.