

THIS OPINION  
IS NOT A PRECEDENT  
OF THE TTAB

Mailed: September 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Manuel Jacinto, LDA

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Serial No. 78905244

John S. Egbert of Egbert Law Offices for Manuel Jacinto, LDA.

James W. MacFarlane<sup>1</sup>, Trademark Examining Attorney, Law Office  
104 (Chris Doninger, Managing Attorney).

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Before Holtzman, Taylor and Wellington, Administrative Trademark  
Judges.

Opinion by Taylor, Administrative Trademark Judge:

Manuel Jacinto, LDA has filed an application to register on  
the Principal Register the mark CAVALINHO and design, shown  
below,



for "leather and imitation leather goods, namely, handbags, all  
purpose carrying bags, tote bags, wallets, purses, key cases,

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<sup>1</sup> The application was assigned to the current examining attorney for  
consideration of the request for reconsideration and writing of the  
brief.

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briefcases, backpacks, suitcases, trunks, [and] travelling bags" in International Class 18.<sup>2</sup>

Registration has been refused on the ground that applicant's mark is likely to be confused with the mark PONY (in typed format and the subject of Registration No. 2741220) for "bags, namely all purpose sports bags and wallets" in International Class 18<sup>3</sup> under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). In addition, registration has been refused based on applicant's failure to comply with the requirement to provide a translation of the term CAVALINHO pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b).

When the refusals were made final, applicant appealed and requested reconsideration of the final refusals. On February 1, 2008, the examining attorney denied the request for reconsideration and, on February 13, 2008, this appeal was resumed. Briefs were filed by both applicant and the examining attorney. For the reasons discussed below, we affirm the refusals to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I.*

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<sup>2</sup> Serial No. 78905244, filed June 9, 2006, and alleging a bona fide intention to use the mark in commerce.

<sup>3</sup> Registration No. 2741220, issued July 29, 2003.

du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The examining attorney contends that there is a likelihood of confusion between applicant's mark and the cited mark inasmuch as the goods are identical or closely related, and because applicant's mark and registrant's mark are confusingly similar in meaning and commercial impression, in that CAVALINHO means "pony" in Portuguese, and the pony design in applicant's mark reinforces the translation.

Applicant, on the other hand, maintains that there is no likelihood of confusion because its mark and the cited mark differ in appearance and commercial impression. Applicant also contends that the examining attorney has misapplied the doctrine of foreign equivalents to come to the "incorrect" conclusion that applicant's mark is similar to the cited mark.

We consider first the goods based on a comparison of the identifications in the application and the cited registration.

In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 at n. 4 (Fed. Cir. 1993). In the present case, the identified goods of applicant and those of the cited registrant have two items in common, i.e., wallets and, because applicant's broadly identified all purpose carrying bags clearly include registrant's more narrowly identified all purpose sports bags, all purpose carrying and sports bags. The additional goods in applicant's application (i.e., handbags, tote bags, purses, key cases, brief cases, backpacks, suitcases, trunks and traveling bags) are otherwise closely related items used to carry an individual's personal items. Applicant does not argue otherwise.

Further, with regard, at least, to the identical goods, we must presume that they will be sold in the same channels of trade and will be bought by the same classes of purchasers, while the related goods will be sold in some of the same channels of trade, and will be bought by some of the same purchasers. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994). In view of the above, the *du Pont* factors of the relatedness of the goods, channels of trade and classes of purchasers favor a finding of likelihood of confusion.

We now consider the similarity or dissimilarity of the marks, keeping in mind that when marks would appear on even some identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In determining whether the marks are confusingly similar, we must first consider whether the term "cavalinho" is the foreign equivalent of the word "pony."

Under the doctrine of foreign equivalents, foreign words from common, modern 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 in a likelihood of confusion analysis. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005).  
... 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.. (*id*).

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, supra* at 1696, citing *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). While applicant appears to suggest that the "ordinary American consumer" may or may not speak Portuguese,<sup>4</sup> the Board has

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<sup>4</sup> Applicant particularly states:

determined that the "ordinary American purchaser" in a case involving a foreign language mark refers to the ordinary American purchaser who is knowledgeable in English as well as in the pertinent foreign language. In re Thomas, 79 USPQ2d 1021, 1024-25 (citing J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:26 (4<sup>th</sup> ed. 2006), which states "[t]he test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.").

In urging that the doctrine of foreign equivalents does not apply in this case, applicant maintains that "the average American does not speak Portuguese, and only approximately 560,000 Americans speak the Portuguese language at all." (Br., unnumbered p. 6). To support this contention, applicant made of record data from the 2000 U.S. Census, obtained from Wikipedia,<sup>5</sup> indicating the number of speakers of Portuguese (as well as

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an American consumer encountering applicant's mark would either 1) not know the English equivalent of the word "cavalinho" or 2) know the exact colloquial meaning of the word as it is used in Portugal. Add to this fact that an ordinary American consumers [sic] speaking Portuguese would have a clear understanding that the English word "pony" translates into "pônei." ... Therefore, an ordinary American purchaser encountering Applicant's "CAVALINHO" design mark would almost certainly not confuse Applicant's mark with the mark of the cited registrant.

<sup>5</sup> The web pages are located at [http://en.wikipedia.org/wiki/Languages\\_in\\_the\\_United\\_States](http://en.wikipedia.org/wiki/Languages_in_the_United_States).

other languages) in the home, which translates to .21% of the United States population. Applicant concludes from this data that "[s]ince there is such a small number of Portuguese-speaking Americans, it is clear that the average American consumer will not 'stop and translate' the Portuguese term "CAVALINHO" into the English word 'pony.'" (*Id.*).

We disagree with applicant's assertion that the doctrine of foreign equivalents does not apply to marks in the Portuguese language because it is not spoken by enough people in the United States. As noted, words from common, modern languages are generally translated into English. According to applicant's census data, more than half a million people speak Portuguese in the home. However, because this figure reflects the language that is primarily spoken as the primary language in peoples' homes, it does not include persons who know a particular language such as those who speak Portuguese as a second or third language. Notably, with the exception of Spanish, there is no other language listed in the table that reaches the level of even one percent. Indeed, Board precedent has recognized the application of the foreign equivalents doctrine to other languages even less common in the United States (according to applicant's census data) than Portuguese. *See, for example, Matsushita Electric Industrial Co. v. National Steel Contr. Co.*, 442 F.2d 1383, 170 USPQ 98 (CCPA 1971) (the doctrine of foreign

equivalents was applied to the Japanese equivalent of NATIONAL in Katakana characters); and In re Bagel Nosh, Inc. 193 USPQ 316 (TTAB 1976) (Yiddish). "[W]e presume that a word in one of the common, modern languages of the world will be spoken or understood by an appreciable number of U.S. consumers for the product or service at issue." In re Spirits Int'l N.V., 86 USPQ2d 1078, 1085 (TTAB 2008) (applying doctrine to mark in Russian). We see no reason to deviate from this presumption in this case. It is clear that Portuguese is a common, modern language to which the doctrine of foreign equivalents applies.

The question now becomes whether those consumers who understand Portuguese will "stop and translate the term into its English equivalent." Palm Bay Import, Inc., 73 USPQ2d at 1696.

In the present case, the examining attorney submitted the declaration of Steven M. Spar that is set out below:

I, Steven M. Spar, declare that I am fluent in the Portuguese language, that I am a Technical Translator at the Patent and Trademark Office, and that the word *cavalinho* means "little horse" or "pony."

Therefore, the examining attorney has provided evidence the term "cavalinho" can be translated as "pony."

The examining attorney also made of record evidence from an online translation site, Babel Fish Translation (<http://babelfish.com/tr>), showing that the translation of the word "cavalinho" from Portuguese to English is "pony." In

addition, the examining attorney made of record copies of web pages from various websites showing the word Portuguese word "cavalinho" translated to the English word "pony," or vice versa, including a lyric website translating Nelly Furtado's "One-Trick Pony" song, an advertisement for a toy, a guitar tablature (including lyrics and "translations" thereof), a famous Portuguese idiom and a blog site. For example, the title of Nelly Futado's song "One-Trick Pony" translates to "Um Cavalinho Amestrado."

Based on the evidence of record, we find that the examining attorney has established prima facie that the Portuguese term "cavalinho" directly translates to the English term "pony." The record further establishes that Portuguese speakers will "stop and translate" the term "cavalinho" to the English term "pony." We find this especially so because the pony design in applicant's mark reinforces the translated meaning of the term "cavalinho." We thus find that the doctrine of foreign equivalents applies in this case, and that the terms "cavalinho" and "pony" have the same meaning.

In an attempt to rebut this showing, applicant argues that "it is clear ... that the word "cavalinho" has only a loose colloquial meaning within Portugal of "little horse," and no direct translation at all." (Br., unnumbered p. 3). This, added to the fact that an ordinary American consumer speaking

Portuguese would understand that the English word "pony" translates into Portuguese as "pônei," applicant contends, makes it more likely that the average purchaser would "take it [its CAVALINHO and design mark] as it is." (Brief, unnumbered p. 4). Applicant also questions the probative value of the examining attorney's Internet evidence, arguing that "online Internet translation websites such as the one supplied by the Examiner in the Official Action are notoriously inaccurate. Furthermore, the reliability of the other sources attached by the Examiner is not easy to determine." (Br., unnumbered p. 5).

In support of its position, applicant made of record evidence from the Larousse Concise Dictionary, Portuguese-English English-Portuguese, which includes an entry showing a translation of the word "pony" from English to the Portuguese word, "pônei," and an absence of an entry for the word "cavalinho."

We are not persuaded these arguments and evidence. The lack of an entry for the term "cavalinho" in a single "Concise" dictionary does not invalidate the fact that the term "cavalinho" is an exact translation of "pony." Nor is the fact that "pony" may also be translated as "pônei" controlling. Portuguese speaking consumers and potential consumers of registrant's goods sold under the PONY mark, upon seeing CAVALINHO used in connection with identical and closely related

goods will "stop and translate" the term "CAVALINHO" to "PONY," and therefore are likely to be confused as to the source of those goods. Further, although applicant maintains that the term "cavalinho" has only the loose colloquial meaning of "little horse," there is no evidence to support this claim.

We also find unpersuasive applicant's unsupported statements that the examining attorney's Internet evidence is somehow unreliable. The Internet examples showing the Portuguese term "cavalinho" used in place of the English term "pony" in translated matter corroborate the Spar translation. Significantly, applicant did not question the Spar translation.

Having found that the doctrine of foreign equivalents applies and that the term "cavalinho" and "pony" have the same connotation, we now compare applicant's CAVALINHO and design mark and the cited mark PONY in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, supra*. 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 offered under the respective marks is likely to result. In addition, as pointed out by applicant, in articulating reasons for reaching a conclusion on the issue of likelihood 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. In re National Data Corp., *supra*.

Applicant argues that the marks differ in connotation and appearance, and that the addition of its unique design gives its mark an overall commercial impression that differs from the cited mark in a manner sufficient to overcome any similarities between the two marks.

We disagree. While the literal portion of applicant's mark clearly differs in sound and appearance from the cited mark, the equivalency in meaning or connotation is sufficient to support a finding of likelihood of confusion when used in connection with the identical and closely related goods. Moreover, the pony/horse design in applicant's mark does not distinguish it from the registered mark. Rather, the design merely reinforces the meaning of the literal portion. Quite simply, despite the differences in sound and appearance, the fact that applicant's mark and the registrant's mark have the same meaning leads us to conclude that applicant's mark the cited mark, when viewed in their entireties, have a highly similar overall commercial impression. Accordingly, the *du Pont* factor of similarity of the marks favors a finding of likelihood of confusion.

One final argument made by applicant requires comment. Applicant contends that the marks at issue in this proceeding currently coexist within Portugal and other European Community countries, and that "such coexistence shows a lack of confusion, as well as a dissimilarity in connotation, between the two marks." (Br, unnumbered p.8). To the extent that applicant is arguing a lack of actual confusion based on this coexistence, such argument is unavailing. The coexistence of the marks outside of the United States is irrelevant to our determination of likelihood of confusion in this case. Applicant has neither alleged in its application nor argued that it has used the mark in the United States. Therefore, there is no evidence that there has been an opportunity for confusion to occur. Moreover, in the context of an ex parte proceeding, "the lack of evidence of actual confusion carries little weight." In re Majestic Distilling Co., *supra*. Therefore, this *du Pont* factor is neutral.

In sum, when we consider the record and the relevant likelihood of confusion factors, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, CAVALINHO and pony design, and registrant's mark, PONY, their contemporaneous use on identical and closely related goods is likely to cause confusion as to the source or sponsorship of such goods.

We add that the examining attorney's requirement for a translation of the term CAVALINHO is also affirmed. The examining attorney has made of record the declaration of Mr. Spar, the USPTO's Technical Translator, that specifies that CAVALINHO can be translated as "pony," as well as Internet evidence confirming this translation. As noted previously, we find the absence of the word "CAVALINHO" from a single "Concise" dictionary insufficient to rebut this evidence, and the requirement for a translation is appropriate.

**Decision:** The refusals to register under Section 2(d) of the Trademark Act and that applicant must provide a translation of the term CAVALINHO are affirmed.