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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ing. Loro Piana & C.S.p.A.

Serial No. 79014582

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Before Quinn, Holtzman and Cataldo, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Ing. Loro Piana C.S.p.A., a corporation organized under the laws of Italy, to register the mark PECORA NERA for "yarns and threads" in International Class 23; "textiles and textile goods, namely fabrics for the manufacture of clothing, bedding, namely blankets, duvet covers, mattress covers, and pillow covers, fabric table cloths, textile napkins and placemats" in International Class 24; and "clothing for men, women and children, namely jackets, coats, skirts, trousers, cloaks,

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mantles, overcoats, vests, scarves, mufflers, shawls, and gloves; footwear; head wear" in International Class 25.¹ The application includes the following statement: "The English translation of the words PECORA NERA in the mark is 'Black Sheep.'"

Registration was refused by the trademark examining attorney in International Class 25 only. The examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods in International Class 25, so resembles the two previously issued registrations of the mark BLACK SHEEP for goods in several classes, including "sportswear and clothing, namely, hunting jackets, shirts, pants, coats, vests, camouflage clothing, chaps, underwear, coveralls, and caps" in International Class 25;² and "clothing for hunters and outdoorsmen, namely, poplin, cotton, mesh, flannel and vinyl hats (insulated and uninsulated); elastic suspenders; leather utility belts; insulated nylon sportsman's booties; and insulated nylon hoods" in International Class 25,³ as to be likely to cause

¹ Application Serial No. 79014582, filed June 6, 2005 under the Madrid Protocol, Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f), based on International Registration No. 0859674, issued June 5, 2005.

² Registration No. 0785434, issued February 23, 1965; renewed.

³ Registration No. 1302411, issued October 30, 1984; renewed.

confusion. The cited registrations are owned by the same entity.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

Applicant argues that confusion with the cited registered mark is unlikely to occur because of the dissimilarity between the marks, the differences between the goods and their channels of trade, the sophisticated nature of the purchasers, and the presence of third-party registrations of BLACK SHEEP and SHEEP marks in the clothing field. In support of its arguments, applicant submitted copies of third-party registrations, an English dictionary definition of the term "black sheep," and listings of the words "pecora" and "nera" in an English/Italian dictionary.

The examining attorney maintains that the doctrine of foreign equivalents applies in this case inasmuch as consumers would be likely to translate the Italian words into their English equivalents. The examining attorney contends that applicant has too narrowly construed the doctrine: "The doctrine states that the consumer would be likely to translate the foreign words into its English equivalent, and not that the consumer would translate the foreign words into the English equivalent AND ascribe its

American colloquial meaning to the foreign phrase as well.” (Brief, 4) (emphasis in original). The examining attorney finds that, because the marks are foreign equivalents, they are similar. As to the goods, the examining attorney points out that they are, at least in part, identical, and otherwise related. In support of the refusal the examining attorney introduced excerpts of third-party websites, and English/Italian dictionary translations of the words “pecora” and “nera.”

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Insofar as the goods are concerned, it is well settled that the question of likelihood of confusion must be

determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefore, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Applicant's argument that the goods are dissimilar ignores well established case law requiring that the comparison of the goods is based on how the identifications read in the involved application and the cited registration. The gist of applicant's argument is that opposer's clothing is for "hunters and outdoorsmen." The identification of goods in Registration No. 0785434,

however, is not so limited.⁴ The identification reads as follows: "sportswear and clothing, namely, hunting jackets, shirts, pants, coats, vests, camouflage clothing, chaps, underwear, coveralls, and caps." Thus, except in the case of "hunting jackets" (and, arguably, "camouflage clothing"), opposer's clothing is not limited to use by hunters and outdoorsmen. Based on a comparison of applicant's identification of goods and registrant's identification of goods in Registration No. 0785434, we find that the goods are identical in part, and otherwise related. More specifically, there is an overlap with respect to pants, coats, vests and headwear/caps. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) [likelihood of confusion found on basis of overlap of any item encompassed by the identifications of goods]. Inasmuch as the identifications of goods are legally identical, at least in part, we must presume, for purposes of the likelihood of confusion analysis, that the trade channels and classes of purchasers

⁴ In saying this, we recognize, of course, that the identification of goods in opposer's Registration No. 1302411 is prefaced with the limiting terminology "clothing for hunters and outdoorsmen." We therefore have confined our decision to Registration No. 0785434 that, of the two registrations cited by the examining attorney, forms the strongest basis for affirmance of the refusal.

are identical. *Id.* Further, purchasers would include ordinary members of the general public.

The partial identity between the goods, and the identity in trade channels and classes of purchasers are *du Pont* factors that weigh heavily in favor of finding a likelihood of confusion.

We next turn to consider the marks, the factor on which applicant and the examining attorney have focused their attention. At the outset of this consideration, it is noted that "when marks would appear on virtually identical goods or services, 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, 32 USPQ2d 1698 (Fed. Cir. 1992).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). 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 their entireties that confusion as to the source of the goods offered under the respective marks is likely to

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result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

The cited mark is BLACK SHEEP whereas applicant's mark is PECORA NERA, an Italian term that applicant has translated into English as "black sheep." Indeed, the translations of the individual words "black" and "sheep" that are of record establish this fact.

(www.ultralingua.com; www.allwords.com). Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English words. See *Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1696. The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Id.*, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). See generally J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 23:26 (4th ed. 2001).

The "ordinary American purchaser" in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language. *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006). The Board has already addressed

the issue of whether the doctrine is applicable to the Italian language, finding that "it does not require authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States." *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986). Lest there be any doubt on this point, the examining attorney in the present case has introduced evidence in further support of the notion that Italian is commonly understood in this country. The website of The National Italian American Foundation (www.niaf.org) indicates that there are nearly 25 million Italian Americans in this country which, according to NIAF, is the nation's fifth largest ethnic group. The examining attorney also filed a May 2002 summary report distributed by the American Council on the Teaching of Foreign Languages titled "Foreign Language Enrollments in Public Secondary Schools, Fall 2000" showing that the number of students studying Italian had significantly increased in recent years. The report indicated that increased enrollment in studying Italian "was the one bright spot of the non-Spanish languages." The report further indicated that Italian was the fifth most-studied language (behind Spanish, French, German and Latin). It is common knowledge that foreign language instruction would include, very early

on in the class, simple vocabulary words for colors and animals, in this case, "black" and "sheep."

Based on the record, we find that Italian is a common language and that it is likely that an appreciable segment of American consumers are speakers of Italian and would translate the Italian term "pecora nera" to the English term "black sheep."

When evaluating the similarities between an English word mark and a foreign word mark, we must, as in the comparison of two English word marks, consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. *In re Thomas*, 79 USPQ2d at 1025. Here, the marks BLACK SHEEP and PECORA NERA are obviously different in sound and appearance. The marks have, however, the same literal connotation, that is, a black-fleeced sheep.

Applicant offers, however, a slight twist on application of the doctrine of foreign equivalents in this case, essentially contending that the word "black sheep" has a figurative meaning in English while the word "pecora nera" does not have a figurative meaning in Italian. *Cf. In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). In responding to the refusal, applicant points out the Federal Circuit's instruction that "[a]lthough words

from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute bar and should be viewed merely as a guideline." *Id.* Applicant "agrees that the foreign wording in the mark translates into English as 'BLACK SHEEP.'" (Brief, p. 6). Applicant goes on to contend, however, that the term "black sheep" in English refers to a "misfit," whereas the term "pecora nera" in Italian translates to the literal meaning of "black sheep," that is, a dark wooly animal related to the goat. According to applicant, BLACK SHEEP in English calls to mind a misfit or disreputable person, while PECORA NERA in Italian calls to mind a black-colored sheep. Thus, applicant contends, the Italian language does not give the the same meaning to the term "pecora nera" that the English language gives to "black sheep." Applicant concludes by asserting that the meanings and commercial impressions of the marks are different, and that, therefore, application of the doctrine of foreign equivalents is improper in this case. In connection with its argument, applicant has relied upon the following English definition of the term "black sheep": "misfit: somebody regarded by the other members of a family or group as not living up to their standards and expectations [because black wool is less valuable than white]." (www.encarta.msn.com).

We further take judicial notice of the following meanings of "black sheep" in English:⁵

A recessive black-fleeced individual in a flock of normally white-fleeced sheep.

A member of a group that stands in conspicuous and unfavorable contrast to the other members esp. by reason of socially undesirable characteristics or behavior (he's the black sheep of his family).

(Webster's Third New International Dictionary of the English Language (unabridged ed. 1993)).

There is no issue herein that the Italian word mark PECORA NERA is translated in only one way to English, namely as "black sheep." The difference in this case, applicant argues, is that the English term "black sheep" (not the Italian term) may be subject to more than one meaning: the literal meaning of a sheep that is black in color versus the idiomatic meaning of a misfit. Thus, according to applicant, the English word "black sheep" has a broader meaning than the Italian word in that the term "pecora nera" translates to the literal meaning "black sheep," but not to the idiomatic meaning "misfit."

We are not persuaded by applicant's argument. The

⁵ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

major problem is that there is no evidence in support of applicant's contention that, unlike the English term "black sheep," the Italian term "pecora nera" has no idiomatic meaning. To the contrary, we find that Italian-speaking individuals in this country would be just as likely to ascribe the idiomatic meaning to "pecora nera" as they would the literal meaning. In this connection, we take judicial notice of these additional English/Italian dictionary definitions:

Pecora: -nera FIG. black sheep

Black sheep: n. FIG. Pecora f. nera
(Oxford Paravia Italian/English
Dictionary 2001)

pecora nera: (figurato) black sheep

black sheep: N (fig) pecora nera
(Collins Italian/English Dictionary
1995)

Sono la pecora nera della famiglia:
I am the black sheep of the family.
(Streetwise Italian
Dictionary/Thesaurus: The User-Friendly
Guide to Italian Slang and Idioms
(2005))

This dictionary evidence contradicts the basis of applicant's argument, namely that there is no figurative meaning of "pecora nera" in Italian. Rather, the evidence shows that "pecora nera" in Italian and "black sheep" in English have the same literal and idiomatic meanings. See

In re Thomas, 79 USPQ2d at 1025. In any event, given the nature of the goods (clothing), it is reasonable to expect, in the absence of contravening evidence, that Italian speakers in this country, when encountering "pecora nera," would be just as likely to ascribe the literal meaning to the translated term (a black-fleeced sheep) as they would the idiomatic meaning (misfit).

In view of the above, we find that the doctrine of foreign equivalents applies. While the marks differ in sound and appearance, the identity in connotation (both literal and figurative) is sufficient to support a finding of likelihood of confusion, especially as used in connection with identical clothing items. The fact that the marks have the same connotation, resulting in a similar overall commercial impression, is sufficient for us to conclude that confusion is likely, despite the differences in their appearance and sound. *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987).

Applicant contends that the cited mark is weak and entitled to a narrow scope of protection due to the existence of numerous third-party registrations of marks that "immediately call to mind a 'BLACK SHEEP'" and other SHEEP marks, all for clothing items in Class 25. This evidence is not persuasive. Not a single one of these

registrations is for the mark BLACK SHEEP; rather, most of the marks are pictorial representations, some highly stylized, of black sheep. The other registered marks comprise the word "SHEEP" with other words, or marks comprise pictorial representations of white sheep, again several being highly stylized. In any event, the third-party registration evidence is entitled to limited probative value. The registrations are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as a result would be able to distinguish between "BLACK SHEEP" marks based on differences between them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

Applicant's argument based on sophisticated purchasers is entirely unpersuasive. According to applicant, "[t]he complexity, danger and expense related to the purchase of hunting equipment also dictates that consumers acquiring such goods expend a significant amount of care and sophistication when making purchasing decisions." (Brief, pp. 13-14). Firstly, the goods listed in Registration No. 0785434 are not limited to hunters and hunting equipment;

rather, the identification of goods includes ordinary items of clothing, and these clothing items would be purchased by consumers with nothing more than ordinary care. Secondly, there is no evidence to establish that applicant's "target customers" are "highly sophisticated." In any event, as in the case of the cited registration, applicant's identification of goods includes ordinary clothing items that would be purchased by ordinary consumers. Further, even if some of applicant's customers were sophisticated, that does not necessarily mean that they are knowledgeable about trademarks or are immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

We conclude that consumers familiar with registrant's clothing sold under the mark BLACK SHEEP would be likely to believe, upon encountering applicant's mark PECORA NERA for clothing, that the goods originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

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Decision: The refusal to register in International Class 25 is affirmed. The application will proceed in International Classes 23 and 24.