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Filing date: **05/10/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76696457
Applicant	AEGEAN ESTIATORIO, INC.
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Submission	Appeal Brief
Attachments	AIT2USAppealBrief.pdf (28 pages)(7893100 bytes)
Filer's Name	Mark A. Garzia
Filer's e-mail	Judy@patentcounsel.net
Signature	/Mark A. Garzia/
Date	05/10/2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Aegean Estiatorio, Inc. dba Estia	)	
MARK:	**ESTIA**	)	
SERIAL NO.:	76/696,457	)	**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
FILING DATE:	March 23, 2009	)	
INTERNATIONAL CLASS:	043	)	
EXAMINING ATTORNEY:	DELANEY, Zhaleh	)	
LAW OFFICE:	116	)	
ATTORNEY DOCKET NO.:	AEI-T2-US	)	

APPEAL BRIEF OF APPLICANT

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In re Dixie Rests, Inc., 105 F 3d 1405 (Fed. Cir. 1997) 14

In re E.I. du Pont de Nemours & Co., 476 F.2d 1357 (CCPA 1973) 13

In re Sarkli, Ltd., 721 F.2d 353 (Fed. Cir. 1983) 8, 9

Statutes

Trademark Act Section 2(d), 15 U.S.C. § 1052(d) 4

Other Authorities

Trademark Manual of Examining Procedures 1207.01(b)(vi)(B) 8

Certification by Professional Translator Tess Vassiliadou . . . . . EXHIBIT "A"

Certification by Lefteris Kritikakis . . . . . EXHIBIT "B"

Website Dictionaries . . . . . EXHIBIT "C"

www.babelfish.yahoo.com

www.kypros.org

www.systranet.com

www.translate.google.com

www.translation.babylon.com

www.wikiled.com

www.worldlingo.com

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I. INTRODUCTION

Applicant Aegean Estiatorio, Inc. has applied for registration of its ESTIA mark for "Restaurant services; bar services including serving hard drinks such as wine, beer, ouzo, and tsipouro, and serving soft drinks." The Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) based on a likelihood of confusion with the mark in U.S. Registration No. 3,253,373. The Examining Attorney's final refusal is erroneous.

II. STATEMENT OF ISSUE

Whether the Examining Attorney's final refusal under Trademark Act Section 2(d) to register Applicant's ESTIA mark on the Principal Register based on alleged likelihood of confusion was erroneous, particularly because of an improper application of the doctrine of foreign equivalents.

III. STATEMENT OF FACTS

Aegean Estiatorio, Inc. is a corporation based in Pennsylvania which operates a restaurant in Philadelphia, PA. Aegean Estiatorio, Inc. filed the subject trademark application for the mark ESTIA, which was assigned the Serial Number 76/696,457 and the filing date March 23, 2009. The Application was for "restaurant services; bar services including serving hard drinks (wine, beer, ouzo, tsipouro, etc.) and soft drinks; operating and running restaurants"

in International Class 043. See Application for Service Mark Registration executed on March 11, 2009.

The principals of Aegean Estiatorio, Inc. speak very little or no English; their primary language is Greek. This matter was referred to Applicant's undersigned attorney by Aegean's corporate attorney. Aegean's corporate attorney speaks very little Greek but conveyed to the undersigned that he believed the Greek word "estia" translated into the English word "fireplace." Accordingly, the undersigned Attorney, in attempting to meet the requirement of translating foreign words into English, included a statement in the original application that "[t]he subject mark closely resembles the Greek word "εστία" which translates into English as "fireplace." Id. at 2. All subsequent communications from the principals of Aegean Estiatorio, Inc. have been through an employee who's primary language is neither Greek nor English.

On June 15, 2009, the Examining Attorney issued an Office Action refusing registration of the mark based on Trademark Act Section 2(d), because of a likelihood of confusion with the mark THE FIREPLACE RESTAURANT which is the subject of U.S. Registration No. 3,253,373. See Office Action of June 15, 2009. The Examining Attorney made a requirement that the Applicant submit the statement that "[t]he word ESTIA is a transliteration of the Greek word **εστία** meaning 'fireplace.'" Id. at 3. The Examining Attorney included an unsigned "Certification" from Steven M. Spar of the PTO's Translations Branch that the word *estia* is a transliteration of the word εστία, and means "fireplace." The Examining Attorney also believed that Applicant's services included "franchising" and suggested that the Applicant adopt a second classification if accurate, and a corresponding amendment to the identification of services.

Finally, the Examining Attorney stated rules to be followed for combined or multiple class applications, and that the specimen of record would not be acceptable to support the International Class for franchising. Id. The Examining Attorney found that the translation of Applicant's mark was identical to the mark THE FIREPLACE RESTAURANT in meaning, and either identical or highly related in services. Id. at 1-3.

On September 1, 2009, Applicant filed a response to the non-final Office Action traversing the Examining Attorney's rejection based on Trademark Act Section 2(d). See Reply to Office Action of September 1, 2009. Along with said Reply, Applicant submitted a translation statement indicating that "[t]he word ESTIA is a translation of the Greek word "εστία" and translates into English as the word "home." The translation statement was supported by a statement signed by Tess Vassiliadou who certified that she was "fluent (conversant) in the English and Greek languages," and that she was an "experienced and qualified professional translator." The certification was notarized by a New York-certified Notary Public. Attached as Exhibit "A" is a copy of the Certified Translation.

In the Reply, Applicant reasoned that "the present case is not a simple translation. In contrast to many translations where there is no ambiguity... the difficulty in the present case makes the Applicant's mark a particularly strong mark." Id at 5. Applicant also amended the identification of goods and services to meet Examining Attorney's requirements and to limit the goods and services to a single International Class. Id.

On September 9, 2009, the Examining Attorney issued a final Office Action refusing registration of the mark based on Trademark Act Section 2(d). See Office Action of

September 9, 2009. The Examining Attorney found the translation statement in the Reply to the Office Action of September 1, 2009, to be unacceptable, and again made a requirement that the Applicant submit the statement that "[t]he word ESTIA is a transliteration of the Greek word **εστία** meaning 'fireplace.'" Id. at 3. The Examining Attorney again included an unsigned "Certification" from Stephen M. Spar of the PTO's translation branch that the word *estia* is a transliteration of the word εστία, and means "fireplace." Because the Examining Attorney placed no significance on the translation of the professional translator, Tess Vassiliadou, she found the mark to still mean "fireplace," and the refusal based on Trademark Act Section 2(d) was maintained and made final. Id. at 1-2.

On March 9, 2010, Applicant timely filed an appeal to the Trademark Trial and Appeal Board, along with an appeal fee of $100.

IV. ARGUMENT

In the *ex parte* examination of the mark ESTIA, the Examining Attorney erred in two related ways. First, the Examining Attorney concluded that the doctrine of foreign equivalents should apply to the Applicant's mark ESTIA. Second, based on this improper conclusion, the Examining Attorney concluded that the mark ESTIA, as used on or in connection with the specified goods and/or services, so resembles the registered mark THE FIREPLACE RESTAURANT as to be likely to cause confusion. Applicant respectfully disagrees with the Examining Attorney's final refusal of the mark ESTIA for the reasons stated below.

A. Examining Attorney Improperly Decided to Apply the Doctrine of Foreign Equivalents

The factors to be considered when determining whether to apply the doctrine of foreign equivalents are, "(1) whether the English translation is unambiguously literal and direct; (2) whether the foreign language is a common, modern language and not obscure; and (3) whether the mark has an alternate meaning, or marketplace circumstances or the commercial setting in which the mark is used make translation of the mark more or less likely." United States Patent and Trademark Office Examination Guide 1-08 at Section V. When the translation of the mark is not unambiguous, literal, and direct, the doctrine should generally not be applied. TMEP at 1207.01(b)(vi)(B), citing In re Sarkli, Ltd., 721 F.2d 353. In addition, "[t]he test to be applied to a foreign word vis-à-vis an English word with respect to equivalency is not less stringent than that applicable to two English words." TMEP at 1207.01(b)(vi)(B), citing In re Sarkli, Ltd., 721 F.2d at 354.

Many of the instances where the doctrine of foreign equivalents was held to be appropriate involve foreign words or phrases which are well-known to the general public, such as LUPO for "wolf," EL SOL for "sun", and CHAT NOIR for "black cat". TMEP at 1207.01(b)(vi)(B). Other instances in which the doctrine was found applicable involve foreign words which only had one dictionary definition, such as LA PEREGRINA for "pilgrim," and MARCHE NOIR for "Black Market." Id. An example where the doctrine was held appropriate when the dictionary contained more than one definition, was where the mark was EL GALLO, which translates to mean "rooster," where the English translation was the first definition listed

in the Spanish-English language dictionary, GALLO was the only listed Spanish translation for the English word ROOSTER, and the design of a rooster on the specimen reinforced the translation of GALLO even though this word had other meanings. Id.

There have been many examples before the courts and the TTAB when the doctrine of foreign requivalents has not been applied, because the evidence shows that the English translation is not exact, literal, or direct. Id. The word REPECHAGE was not found to be the French equivalent of SECOND CHANCE because the translation dictionary evidence showed they were not direct foreign equivalents. In re Sarkli, Ltd.

Applicant respectfully submits that the issue at hand was addressed by the TTAB in In re Buckner Enterprises Corp, 6 USPQ 2d 1316 (TTAB 1988). In Buckner, the Examining Attorney refused registration of the mark DOVE for "solid fuel burning stoves and furnaces," in view of the prior registration for the mark PALOMA for various forms of gas heating apparatus. The TTAB, citing In re Sarkli, Ltd., overturned the Examining Attorney; it determined that the word PALOMA, which translates primarily into English to mean "pigeon, dove," has a different connotation from the applied for mark DOVE and, thus, the doctrine was not applied. Id. "Thus, several translation dictionaries showing variations in the English meaning constitute evidence that the foreign word or term may not have a literal and direct translation, and the doctrine should not be applied." In re Sarkli, Ltd.

The mark ESTIA does not have an unambigious, literal, and direct translation, and therefore the doctrine of foreign equivalents should not be applied in the subject application. The Examining Attorney cherry-picked definitions to give the false impression that the mark

ESTIA translates unambigiously, literally, and directly to the word "fireplace." However, reviewing all of the available translation evidence makes clear that the mark ESTIA does not have an unambiguous, literal, and direct translation.

As an introductory matter, even limiting the evidence to what the Examining Attorney cited, it is apparent that the mark ESTIA does not have an unambiguous, literal, and direct translation. In the final Office Action, the Examining Attorney attached evidence of the definition of the word "εστία" (the Greek word transliterated into English as "estia") from the website www.in.gr. First, the word "εστία" is ancient Greek and must be transliterated into the modern Greek word "estia." Second, there is no clear an unambiguous definition of the word "estia."

The website reference cited by the Examining Attorney lists "focal point" as the first definition of the word "estia," not "fireplace." In fact, the definition specifies the words "focal point, centre, cooker, cook-stove, fireplace, focal, focus, grate, kitchener, nucleus, range." The Examining Attorney's own reference lists four definitions before the word "fireplace." Next, at the www.in.gr website, is a definition for the capitalized word "ESTIA" which is listed as "Vesta." ESTIA is the ancient Greek goddess of the "hearth" but in modern Greek is sometimes spelled "Hestia," and is synonymous with Vesta, the Roman goddess of the hearth, home and family. See Wikipedia.com. Therefore, the reference dictionary used by the Examining Attorney has twelve different definitions for the word "estia."

The word PALOMA only had two definitions (pigeon, dove) and the TTAB found that it did not have a literal and direct translation. It is difficult to understand how a foreign word (i.e.,

"estia") with twelve different English definitions could be considered to have a direct, literal, and unambiguous translation.

Further, the Examining Attorney attempts to distract from the fact that the mark ESTIA does not have a direct, literal, and unambiguous translation, by attaching the translation of the English word "fireplace" into Greek, and to draw extra attention to it by attaching the English-Greek translation to the final Office Action first, before the translation of "εστία" into English. However, this translation is irrelevant, because the relevant inquiry in the subject application is the translation of the mark into English, <u>not</u> the translation of an English word into the language of the mark. Further, this translation lists another Greek word, "τζάκι", as a translation of "fireplace," which is the "more accurate" translation (because it does not have the various different possible meanings listed above for "εστία").

The other argument that the Examining Attorney makes is that the Translations Branch of the United States Patent and Trademark Office (PTO) translates the word "εστία" as "fireplace." This conclusion is reached after a transliteration of the modern Greek word "estia" into the ancient Greek "εστία."

Applicant has attached additional evidence indicating that the word "εστία" has a variety of accurate definitions. In addition to Exhibit "A" from the professional translator Tess Vassiliadou, attached as Exhibit "B" is a report from the professional translator Lefteris Kritikakis. He states that some dictionary definitions of the word include "Vesta", the ancient Greek and Roman Goddess, the protector of the home and family life, "home," "a room of a home used for cooking or heating, and/or the fireplace," "the part of a device in/on which a fuel

substance burns," "a 'focal point,'" and "A special building where a specific group of people reside." Finally, attached as Exhibit "C" are translations provided from numerous different additional websites. Of these, three translate the word "εστία" as "hearth" (see www.babelfish.yahoo.com, www.systranet.com and www.worldlingo.com), one translates it as "home," (see www.translate.google.com) with additional listings, and one lists the translations "fireside, fireplace, focus, furnace, hearth, Vesta." See www.wikiled.com, and one translates it as "Vesta." (see www.kypros.org.)

Also, it is important to note that www.kypros.org and www.babelfish.yahoo.com translate the Greek word τζάκι (or in modern Greek "tzáki") as "fireplace" only.

Applicant has found additional websites, all of which provide a definition of "estia" other than "fireplace" or multiple definitions.

Applicant agrees with the Examining Attorney that a translation of the Translations Branch of the PTO should be accorded some weight. However, given the various overwhelming evidence showing a variety of accurate translations of the word "εστία," plus the translations (and explanations) of two professional translators, the lone statement of a member of the Translations Branch of the PTO cannot prove that a word has an unambiguous, literal and direct translation. Moreover, the Examining Attorney's cited website indicates that "estia" does not unambiguously, literally and directly translate into "fireplace."

The situation involved in this application is like those listed above where the doctrine of foreign equivalents was held not to apply, and is different from those listed above where the doctrine of foreign equivalents was held to apply. In not one of the cases listed above where the

doctrine of foreign equivalents held to apply was the definition of the word other than the sole definition, or the first definition listed in the dictionary; however, in this case the Examining Attorney is arguing that the mark has an unambiguous, literal and direct translation which is not once listed as the first definition in any dictionary – not even in the website reference cited by the Examining Attorney!

It must be kept in mind that the test between a foreign and English word is no less stringent than between two English words. In this context, the Spanish word "Paloma" was not found to translate to "Dove", because the dictionary translation of "Paloma" was "pigeon, dove." In this case, there is an even greater variety of translations for the mark ESTIA than there were for the mark PALOMA. Therefore, the mark ESTIA does not have a direct, literal and unambiguous translation, and the doctrine of foreign equivalents may not be applied.

B. Refusal to Register Based on Likelihood of Confusion

Because the subject mark does not have a direct, literal, and unambiguous translation there is no likelihood of confusion with the mark THE FIREPLACE RESTAURANT in U.S. Registration No. 3,253,373. In comparing two marks, both marks must be viewed in their entirety - each mark's respective appearance, sound, connotation, and commercial impression, all must be taken into consideration. In re E.I. du Pont de Nemours & Co., 476 F.2d 1347 (CCPA 1973). The question of likelihood of confusion is determined on a case-by-case basis in view of the factors set forth in *In re E.I. Dupont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The Court of Customs and Patent Appeals in *DuPont* listed thirteen factors that should be considered when making a determination of the likelihood of confusion. Not all factors may be relevant or of equal weight in a given case, and "any one of the factors may control a particular case." *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

On page one of the final Office Action, the Examining Attorney cites *DuPont* for the statement, "The examining attorney must look at the marks themselves for similarities in sound, appearance, meaning or connotation."

Of these thirteen *DuPont* factors, the first, and many believe the most important factor, is consideration of the similarity or dissimilarity of the marks <u>in their entireties</u> as to appearance, sound, connotation and commercial impression.

Applicant's mark ESTIA differs completely in sight and sound from the mark THE FIREPLACE RESTAURANT. The letters in the two marks and the sounds that they make when pronounced do not bear any similarity to one another. In addition, there are no marketplace circumstances or commercial settings in which the mark is used to make the translation of the mark ESTIA as "fireplace" more likely. When presented with only the word ESTIA, consumers are most likely to interpret it as the mythical Greek goddess. Therefore, the sight, sound and meaning of the mark ESTIA taken as a whole weigh too strongly against finding a likelihood of confusion, therefore no matter how similar Applicant's goods and services may be to the registered mark, a likelihood of confusion cannot be found.

V. CONCLUSION

Based on the above, Applicant respectfully submits that the Board reverse the Examining Attorney's refusal under Trademark Act Section 2(d) and remand the Application to the Examining Attorney for passage of the mark to publication.

Respectfully submitted,
Aegean Estiatorio, Inc. dba Estia

Dated: 10 MAY 2010

Mark A. Garzia, Esquire
Attorney for Applicant

EXHIBIT "A"

MEJ Personal Business Services Inc – Official Certified Translation

The word Estia in Greek means home; Estia was the ancient Greek Goddess for home. In Roman mythology the corresponding Goddess was Vesta. However, if this is the name of the ancient Greek Goddess, you should just write Eozia.

Certification by Translator

I Tess Vassiliadou certify that I am fluent (conversant) in English and Greek languages, experienced and qualified professional translator and that, in my best judgment, the translated text truly reflects the content, meaning, and style of the original text and constitutes in every respect a correct and true translation of the original document attached. (Word Translation)

Signature: Tess Vassiliadou
Date: 6-26-2009

Typed Name: Tess Vassiliadou
Address: 245 East 116th Street
New York, NY 10029

State of New York County of NEW YORK

Sworn (or affirmed) to before me this 26th day of June 2009

Notary Signature

Elizabeth Johnson
Notary Public, State of New York
No-01J06172998
Qualified in New York City
Certificate Filed in New York County
Commission Expires August 20,2011

CERTIFIED TRANSLATION

EXHIBIT "B"

Lefteris Kritikakis - Greek Language Services
Translations: Legal, Financial, Technical, Medical
Transcripts, DTP, Cultural Consulting, Brand analysis,
Software localization, Professional Editing/Reviewing
Member ATA, CHICATA, SFSP, NAJIT
NASD registered 6, 63
Athens - New York - Philadelphia - Chicago
Tel. (Worldwide) 847-508-7255
Fax (Worldwide) 775-249-6528

1. The Greek word "Εστία" according to the dictionary of Mr. Babiniotis and other dictionaries:

a. Εστία (Estia) or Vesta is the ancient Greek and Roman Goddess, **protector of the home and family life.**

b. A home, the place where someone lives.

c. εστία (estia) - a room of a home used for cooking or heating, and/or the fireplace.

d. the part of a device in/on which a fuel substance burns (for example, the part of a cooking stove on which a fire burns to cook food).

e. A "focal point", a point where somewhere happens or from which something originates (example: *The "estia" of this local protest was the university*).

f. A special building where a specific group of people reside ("φοιτητική εστία", that is, an "estia for students" which is the students' dorm).

2. The most common uses of this word relate also to the meaning of the word "estiazo" (εστιάζω) which means **gathering somewhere to eat (indirectly, "a home" or "a restaurant")**, or "focus" on something.

The vast majority of Greeks would understand and translate "estia" as "home". Many Greeks are aware that the word has many different meanings, one of which is "fireplace", however, the most prevalent interpretation/translation is "home".

The reason is that although the translation "home" is unique (when we say "estia" and we mean home, there is no ambiguity), the translation "fireplace" is ambiguous (because it could also mean "home", directly or metaphorically).

Conclusion: The prevalent translation of the word "estia" is "home". If this interpretation creates any conflicts or ambiguities, then **the word "Estia" (capitalized first letter) could be used as the name of the Greek and Roman Goddess, protector of home and family life** (such as "Zeus Restaurant", we would have "Estia Restaurant" in this case, where Estia means the Greek Goddess).

Philadelphia, PA
March 10, 2010

Lefteris Kritikakis

EXHIBIT "C"

www.babelfish.yahoo.com	εστία τζάκι	hearth fireplace
www.kypros.org	εστία τζάκι	Vesta fireplace
www.systranet.com	εστία	hearth
www.translate.google.com	εστία	fireside fireplace focus furnace hearth Vesta
www.translation.babylon.com	εστία	Fireside, fireplace, focus, furnace, hearth, Vesta
www.wikiled.com	εστία	fireside fireplace focus furnace hearth Vesta
www.worldlingo.com	εστία	hearth

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YAHOO! BABEL FISH

Search **Web Search**

In English

hearth

Search the web with this text

Translate again

(Enter up to 150 words)

εστία

Greek to English Translate

Translate a web page

http://

Greek to English Translate

Translation Tips:

Tips 1: Use correct spelling, grammar, and punctuation for the highest quality translations.

Tips 2: After you've translated some text, click the button marked "Search the web with this text" in order to launch a search using the translation results as your query.

Tips 3: Compare a translated web page with the original by clicking "View page in its original language."

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Search **Web Search**

In English

fireplace

Search the web with this text

Translate again

(Enter up to 150 words)

τζάκι

Greek to English Translate

Translate a web page

http://

Greek to English Translate

Translation Tips:

Tips 1: Use correct spelling, grammar, and punctuation for the highest quality translations.

Tips 2: After you've translated some text, click the button marked "Search the web with this text" in order to launch a search using the translation results as your query.

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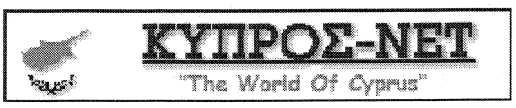

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...x y z

Greek - English Dictionary

εστία

Ancient Greek

Find Reset

English - Greek Dictionary

Ancient Greek

Find Reset

Instructions

Το λεξικό βρήκε 1 λέξη.
The dictionary found 1 word.

Εστία = Vesta
Estia

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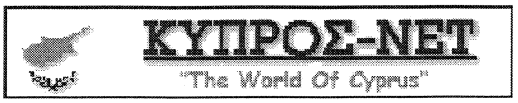

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Greek - English Dictionary

τζάκι

Ancient Greek

Find Reset

English - Greek Dictionary

Ancient Greek

Find Reset

Instructions

Το λεξικό βρήκε 1 λέξη.
The dictionary found 1 word.

τζάκι = fireplace
tzaki

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Greek ⇄ English Options:

εστία

hearth

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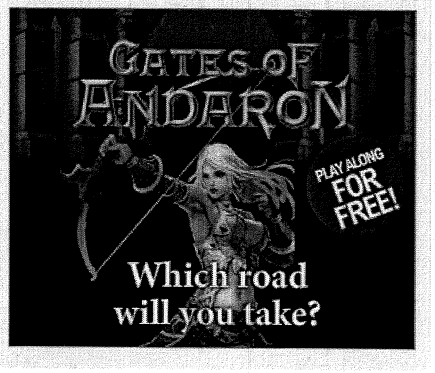

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home

Dictionary:

noun
1. fire side
2. fireplace
3. focus
4. furnace
5. hearth
6. vesta

more

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n. fire side, fireplace, focus, furnace, hearth, Vesta

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Translation Greek - English : εστία

ASK A QUESTION

Translation (Hide...)

It was detected, that requested translation language probably is:
GREEK
The most probable translation:

focus

1	fire side	
2	fireplace	
3	focus	
4	furnace	
5	hearth	
6	vesta	

Last Questions (Show...)

History:

Reset
(Greek - English)
estia (Greek - English)
fireplace (English - Greek)
εστία (Greek - English)

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εστιακός
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εστιάτορας
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εστιατόριο αυτοεξυπηρέτησης
εστιατόριο ελαφρών φαγητών
εστιατόριο με θεατρική διασκέδαση
εστιατόριο όπου οι τροφές σερβίρονται αυτομάτως
εστιατόριο τρένου
εστιάτωρ
εστιώ
εστονικός
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έστω

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εσπευσμένος - Greek
έστειλα - Greek
εστέρας - Greek
εστία - Greek
εστία - Greek
εστία ενέργειας - Greek
εστία τόξου - Greek
εστιάζω - Greek
εστιάζω - Greek
εστιακός - Greek
εστίας - Greek
εστιάτορας - Greek

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Original (Greek):

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Translation (English):

hearth

English to Spanish Subject: General