

THIS OPINION
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re OpBiz, LLC

Serial No. 77055011

Floyd A. Mandell, Lisa K. Shebar and Breighanne A. Eggert
of Katten Muchin Rosenman for OpBiz, LLC.

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(Michael W. Baird, Managing Attorney).

Before Quinn, Hairston and Holtzman, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

OpBiz, LLC filed an application to register the mark
HEART for "cocktail lounges; restaurant and bar services"
in International Class 43.¹

The trademark examining attorney refused registration

¹ Application Serial No. 77055011, filed December 1, 2006,
alleging a bona fide intention to use the mark in commerce.
Applicant subsequently filed an amendment to allege use setting
forth a date of first use anywhere and first use in commerce of
December 6, 2006. The application originally included "nightclub
services" in International Class 41, but applicant elected to
delete the services when it filed the amendment to allege use.

under Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark KOKORO (in typed form),² and the mark shown below³



both for "restaurant services," as to be likely to cause confusion. The registrations are owned by the same entity. Both registrations include the following statement: "The English translation of 'KOKORO' is 'heart.'"

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. Applicant's counsel and the examining attorney appeared at an oral hearing.

At the outset, we direct our attention to two evidentiary matters. Applicant's brief is accompanied by Exhibits A-W. The examining attorney, in her brief, objected to this evidence, asserting that the exhibits are untimely filed because they were not submitted before the appeal. However, as pointed out by applicant in its reply

² Registration No. 1927260, issued October 17, 1995 under Section 2(f); renewed.

³ Registration No. 1927261, issued October 17, 1995; renewed.

brief, it submitted prior to the appeal each and every one of these exhibits through the TEAS online filing system with its response on September 27, 2007. Confirmation of the "successful" filing of these exhibits was e-mailed to applicant on that same date via the TEAS e-mail notification system. It was not until the filing of the examining attorney's brief that applicant was alerted to the fact that, despite having received confirmation that the exhibits were successfully filed, and despite the examining attorney's subsequent issuance of the final refusal, the exhibits did not appear in the electronic file wrapper on the TDR (Trademark Document Retrieval) system. Applicant then contacted the TDR Scanning Center, applicant's exhibits were retrieved from the USPTO's computer files, and the exhibits were uploaded to the TDR website. This sequence of events is supported by a declaration of the paralegal at applicant's counsel's law firm who handled the filing of the exhibits, along with copies of the relevant e-mails between applicant and the USPTO.

Inasmuch as Exhibits A-W were timely filed, the examining attorney's objection is overruled. In making this ruling, we share applicant's concern that the examining attorney did not notify applicant's counsel that

she did not have access to the exhibits, despite reference to them in applicant's response, prior to the filing of the examining attorney's final refusal and/or appeal brief; had she done so, the matter easily could have been resolved at an earlier juncture. Applicant questions, quite reasonably, "how the Examining Attorney was able to fully and fairly evaluate the arguments of Applicant set forth in the Response without these exhibits." Applicant believes, again quite reasonably, that the examining attorney should have notified applicant that the exhibits referenced in its response were not in the electronic file wrapper as reflected by the TDR system; according to applicant, such notification routinely occurs during examination when this situation occurs.

Insofar as the Section 2(d) refusal based on the doctrine of foreign equivalents is concerned, the examining attorney relied on the translation statement set forth in the cited registrations and one listing from a Japanese-English dictionary. The examining attorney subsequently attached evidence to her appeal brief, and requested that the Board take judicial notice of this evidence. Applicant, in its reply brief, objected to the untimely submission.

The evidence attached to the examining attorney's appeal brief comprises the following: (i) three third-party registrations; (ii) listings from online Japanese-English dictionaries; (iii) excerpts of an entry from Wikipedia regarding the number of Japanese speakers in the United States; and (iv) an excerpt from an encyclopedia regarding Japan's business dealings in the United States.

Trademark Rule 2.142(d) provides that the application should be complete prior to appeal. Additional evidence filed after appeal normally will not be considered by the Board. TBMP §1207.01 (2d ed. rev. 2004). The examining attorney's evidence clearly is untimely and, in response to the Board's questioning at the oral hearing, the examining attorney was unable to offer a good reason for the delayed submission.

Notwithstanding the untimely submission, we consider, pursuant to the examining attorney's request, whether any of the evidence is proper subject matter for judicial notice. (i) The Board does not take judicial notice of third-party registrations. See *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999). (ii) The Board takes judicial notice of online dictionaries that are available in printed format or have regular fixed editions. See *In re Hotels.com L.P.*, 87

USPQ2d 1100, 1103 (TTAB 2008); and *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). There is no indication, however, that the examining attorney's dictionary evidence meets either of these criteria. (iii) The Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. See *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007). Firstly, Wikipedia is not proper subject matter for judicial notice because of its inherent lack of trustworthiness. Secondly, applicant had no opportunity to rebut this evidence. (iv) The Board may take judicial notice of encyclopedia entries. See *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.5 (TTAB 2001).

In view of the above, the third-party registrations, the online dictionary listings, and the Wikipedia entry have not been considered. We are able to take judicial notice of the encyclopedia evidence and, thus, we have considered the excerpt from The Columbia Encyclopedia.

The examining attorney maintains that Japanese is a common and modern language, and those American buyers familiar with Japanese will stop and translate the Japanese

term "kokoro" to the English term "heart" which is, according to the examining attorney, an exact translation. The examining attorney also contends that the services are identical or otherwise closely related. Lastly, the examining attorney urges that any doubt must be resolved in favor of the prior registrant. The examining attorney introduced one listing from a Japanese-English dictionary.

Applicant contends that "while the services are similar in an extremely broad sense, they are, in fact, very distinctive from each other." (Brief, p. 14). Applicant states that its mark is used in connection with an upscale cocktail lounge inside of the Planet Hollywood Resort and Casino in Las Vegas, Nevada, and that it does not employ a Japanese theme or offer Japanese food. According to applicant, this is to be contrasted with registrant's three family-owned and operated restaurants in Colorado that serve Japanese food. As to the marks, applicant argues that the doctrine of foreign equivalents is inapplicable because the ordinary American purchaser is unlikely to stop and translate either of registrant's KOKORO marks into any English equivalent. Even assuming that purchasers will stop and translate registrant's marks, applicant contends that the Japanese word "kokoro" has multiple English meanings besides "heart," including

"mind," "spirit," "mentality," "thought," "will" and "intention." Further, applicant argues, the marks HEART and KOKORO are dissimilar in sound, appearance, and overall commercial impression, outweighing any similarity in meaning. Applicant also points to the co-existence of third-party registrations of various KOKORO and HEART marks for goods and/or services within the same class. And, in a third-party application relied upon by applicant, the word "kokoro" was translated as "from the heart to heal mind, body and soul." In support of its arguments, applicant submitted listings from Japanese-English dictionaries, third-party registrations showing various translations of "kokoro," excerpts of third-party websites containing information about registrant's restaurants, and advertisements for applicant's bar.

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

and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to compare applicant's "cocktail lounges; restaurant and bar services" with registrant's "restaurant services." In comparing the services, the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services 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 services 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 services encompasses not only all the services of the nature and type described therein, but that the identified services 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 has attempted to distinguish its restaurant services from those of registrant. The problem with applicant's argument is that the distinctions pointed out by applicant are not reflected in either recitation of services, and it is not proper for the Board to read limitations into either recitation. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). Although applicant also submitted evidence to show the specific nature of registrant's restaurants, an applicant may not restrict the scope of the goods and/or services covered in a cited registration by argument or extrinsic evidence. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Rather, as indicated earlier, we determine the likelihood of confusion issue based on the services as identified in the involved application and registration. Thus, as recited in the respective recitations, the "restaurant services" are legally identical for purposes of the likelihood of confusion analysis. Further, applicant's "cocktail lounges" and "bar services" are closely related to registrant's "restaurant services." This factor weighs heavily in favor of likelihood of confusion.

The services are rendered through the identical trade channels (restaurants, bars and cocktail lounges) to the

same classes of purchasers. These purchasers would include ordinary consumers who would be expected to exercise nothing more than ordinary care in choosing the types of services offered by applicant and registrant. These factors weigh in favor of a likelihood of confusion.

The crux of the likelihood of confusion issue in this appeal is the similarity between the marks based on the applicability of the doctrine of foreign equivalents. 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 Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant's mark HEART and registrant's KOKORO marks obviously have no similarity whatsoever in terms of sound, appearance and commercial impression. The design feature in registrant's mark shown in Registration No. 1927261 further distinguishes the marks in appearance and commercial impression.

The examining attorney maintains, however, that the marks have the same meaning in that the Japanese term "kokoro" is the foreign equivalent of the English term "heart."

Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine similarity of connotation with English words in a likelihood of confusion analysis. See *Palm Bay Imports*, 73 USPQ2d at 1696. Similarity in connotation is but one factor to be considered in the overall evaluation of the likelihood of confusion. See *In re L'Oreal S.A.*, 222 USPQ 925 (TTAB 1984). In fact, it is improper to compare a foreign word mark with an English word mark solely in terms of connotation or meaning. See *In re Ness & Co.*, 18 USPQ2d 1815 (TTAB 1991); and *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986) (equivalency in connotation does not, in and of itself, determine the question of likelihood of confusion). "Such similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound and all other factors, before reaching a conclusion on likelihood of confusion as to source...But, where the only similarity between the marks is in connotation, a much closer approximation is necessary...to justify a refusal to register on that basis alone where the marks otherwise are totally dissimilar." *In re Sarkli*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (REPECHAGE not confusingly similar to SECOND CHANCE). See *In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB

1987) (PALOMA, meaning both "dove" and "pigeon," not confusingly similar to DOVE). This doctrine "is not an absolute rule, but merely a guideline." TMEP §1207.01(b)(vi) (5th ed. 2007).

The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Palm Bay Imports*, 73 USPQ2d at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). See generally J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:36 (4th ed. 2006). The Board has 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 the pertinent foreign language. *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647-48 (TTAB 2008); and *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006).

In this case, neither applicant nor the examining attorney has introduced any evidence regarding the extent to which the Japanese language is spoken in households in the United States. Nevertheless, it is reasonable to find that Japanese is a common and major language in the world. "We 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 International N.V.*, 86 USPQ2d 1078, 1085 (TTAB 2008). We also find that the ordinary American purchaser who is knowledgeable in English and Japanese will stop and translate the foreign term.

Thus, the relevant inquiry here for applying the doctrine of foreign equivalents is the translation of the Japanese term to English. In *Sarkli*, the English term was not the exact translation of the foreign term and in *Buckner*, the foreign term translated into two different English terms.

The Japanese-English dictionary evidence shows that the Japanese term "kokoro" has other meanings besides "heart." These meanings include "mind"; "spirit"; "mentality"; "thought"; "will"; and "intention." See, e.g., Kernerman English Multilingual Dictionary (2006); Kenkyusha's New Japanese-English Dictionary (4th ed.); and www.englishjapaneseonlinedictionary.com.

The record also includes a scholarly article captioned "Pragmatic Considerations for an English-Japanese Dictionary." 2 International Journal of Lexicography 315, 315-16 (1989). The article posits the following:

For language pairs that do not share the same cultural traditions, **the notion of one-to-one equivalents is**

likely to become less and less reliable. In the case of English and Japanese, the cultural conventions that govern communication differ to such an extent that English learners would be led into error if they only sought semantic equivalents because Japanese do not use the same expressions as we do to communicate the same messages in similar situations.

"Shiru" has to do with "awareness" and is associated with **"kokoro" (heart, mind, spirit, feeling)**, whilst "wakaru" is to do with "understanding" and associated with "ri" (reason) and that part of the body, the head, that executes the task of reasoning.
(emphasis added)

The evidence of record is insufficient to establish that "kokoro" in Japanese is the foreign equivalent of "heart." The Japanese term has multiple English translations, only one of which is "heart." While the translations may be somewhat similar, they are not exact. Based on the dictionary evidence, we agree with applicant that "kokoro" has a broader meaning than just "heart," thereby rendering the two words not foreign equivalents. See *In re Buckner*, 6 USPQ2d at 1317.

We have reached our decision with giving little to no probative value to the several coexisting third-party registrations of KOKORO and HEART marks for goods and/or services in the same class. We recognize applicant's point, that is, the coexistence of these marks suggests

that the Office did not view the marks to be foreign equivalents. However, we are not privy to the files of these registrations, and differences between the marks, coupled with differences in the goods and/or services, may have also influenced the examining attorney's decision.

In sum, the term "kokoro" has multiple English translations; thus, registrant's KOKORO marks and applicant's HEART mark are not foreign equivalents. In addition, the marks are completely different in sound, appearance and commercial impression. On the record before us, we are convinced that confusion is unlikely to occur, even though the services are identical or otherwise closely related.

Decision: The refusal to register is reversed.