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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Dark Horse Distillery, LLC*

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Serial Nos. 85104448 and 85125674

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Chris A. Caseiro of Verrill Dana LLP for Dark Horse Distillery, LLC.

Giancarlo Castro, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Kuhlke, Cataldo and Taylor, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Dark Horse Distillery, LLC (“applicant”) has filed applications to register on the Principal Register the standard character marks DARK HORSE for “Distilled spirits” in International Class 33;<sup>1</sup> and DARK HORSE DISTILLERY for “Spirits distillery services” in International Class 40.<sup>2</sup>

Registration has been refused in each application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the marks in the registrations set forth below, all owned by the same entity:

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<sup>1</sup> Application Serial No. 85125674 (‘674 application), filed September 9, 2010, and claiming a bona fide intention to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

<sup>2</sup> Application Serial No. 85104448 (‘448 application), filed August 10, 2010, and claiming a bona fide intention to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

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Registration No. 2919454,<sup>3</sup> ('454 registration) for the mark shown below, includes the following translation: "The foreign wording in the mark translates into English as "Dark Horse."



Registration No. 2952438,<sup>4</sup> ('438 registration) for the mark KUROUMA (in typed form), includes the following translation: "The foreign wording in the mark translates into English as "Dark Horse."

Registration No. 2960169,<sup>5</sup> ('169 registration) for the mark in non-Latin characters (in stylized form) shown below, includes the following translation: "The non-Latin characters in the mark transliterate into "KuroUma", and this means "Dark Horse" in English."



Registration No. 2921177,<sup>6</sup> ('177 registration) for the mark in non-Latin characters (in stylized form) shown below, includes the following description: "KUROUMA" as design with non-Latin Characters. The registration also includes the translation: "The non-Latin characters in the mark transliterate into "KuroUma", and this means "Dark Horse" in English."



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<sup>3</sup> Registered January 18, 2005, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>4</sup> Registered May 17, 2005, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>5</sup> Registered June 7, 2005, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>6</sup> Registered January 25, 2005, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

All four registrations are for goods identified as “Japanese distilled spirits of barley soju.” in International Class 33.

When the refusal in each application was made final, applicant appealed. The appeals have been fully briefed. Because they involve similar issues of law and fact and similar records, we are deciding both appeals in this single decision.

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. 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).

We turn first to a consideration of the goods and services. It is settled that the question of likelihood of confusion must be determined based on an analysis of the goods and services recited in applicant’s applications vis-à-vis the goods recited in the cited registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ 2d 1715 (TTAB 1991). Further, where the goods and services in the application and registration are broadly identified as to their nature and type (as is the case herein with applicant’s identifications), 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 and services encompasses not only all the goods and services of the nature and type described therein, but that the identified

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goods and services are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Moreover, in analyzing the relatedness of applicant's goods and services with respect to registrant's goods, it is not necessary that the goods and services of applicant and the goods of registrant be similar or even directly competitive to support a finding that there is a likelihood of confusion. It is sufficient that the respective goods and services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1795 (TTAB 1993); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source of the services and goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

With respect to the goods identified in the '674 application and those in the cited registrations, there is no question the "Japanese distilled spirits of barley" recited in the registrations are encompassed by applicant's "distilled spirits." Accordingly, for purposes of the likelihood of confusion analysis, applicant's goods are legally identical to those in the cited registration and must be deemed to be sold in the same channels of trade and to the same classes of consumers.

With respect to the services recited in the '448 application and the goods in the cited registrations, we find them related inasmuch as registrant's distilled spirits of barley soju could

be produced by applicant's distillery services.<sup>7</sup> The record is silent as to the normal channels of trade and classes of purchasers for these goods and services.

In view of the foregoing, we find the *du Pont* factor of the similarity of the goods and services favors a finding of likelihood of confusion in each of applicant's applications. We additionally find that the *du Pont* factors of the similarity of channels of trade and classes of consumers favor a likelihood of confusion in the '674 application.

We now consider whether applicant's marks and registrant's marks are similar or dissimilar when compared in their entireties 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 their entireties 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 entireties, 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).

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<sup>7</sup> It frequently has been found that consumers are likely to be confused by the use of similar marks on or in connection with goods and services featuring or related to those goods. *See e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories).

The examining attorney applies the doctrine of foreign equivalents and contends that applicant's marks and the four cited registered marks are equivalent in meaning and connotation, and essentially that such equivalence in connotation is sufficient to find the marks confusingly similar. He specifically states that the non-Latin characters in the marks of the '169 and '177 registrations transliterate to "KUROUMA," which is the whole of, or the literal element, of the marks in the '438 and '454 registrations; and that "KUROUMA" translates into English as "DARK HORSE." The examining attorney argues with particular regard to the mark in the '454 registration, KUROUMA and design, that the translation is reinforced by the addition of the design element in the nature of a "black" horse. The examining attorney solely relies on the translation statements made in the cited registrations in support of this argument.

Applicant, in urging reversal of the refusal, argues that the doctrine of foreign equivalents is inapplicable because there is no evidence of record that the single literal and direct translation of KUROUMA, and the non-Latin (hiragana) characters くらうま, is "dark horse." Applicant particularly states that the Japanese written language consists of three alphabets: kanji (Chinese characters); hiragana (a syllabic alphabet that can be used to spell out kanji characters and is used together with kanji to modify verbs, etc.) and katakana (a syllabic alphabet not at issue in this case). Applicant explains that the four hiragana characters (くらうま, pronounced KU, RO, U, and MA, respectively) of the '169 and '177 registrations are written as a single word, as there are no "spaces" between words in written Japanese and, therefore, there is nothing to signify how KUROUMA should be read. It could be read as KURO UMA just as easily as KUROU MA or KU RO U MA. Splitting the mark into different "words," applicant further explains, results in very different meanings, depending on the how the word is split. This is so because a single hiragana will always be pronounced the same, but may be represented by three different "kanji,"

each with a dramatically different meaning. For this reason, applicant argues that the hiragana characters of the ‘169 and ‘177 could be interpreted in dramatically different ways, as shown in the table below, reproduced from applicant’s brief.<sup>8</sup>

Possible Readings of KUROUMA = くろうま	Possible Definitions
く <space> ろうま	<i>No meaningful definition</i>
くろ <space> うま	Black horse/animal*
くろ <space> うま	Dark horse/animal
くろ <space> うま	Evil horse/animal
くろ <space> うま	Guilty horse/animal
くろ <space> うま	Black bishop
くろ <space> うま	Dark bishop
くろ <space> うま	Evil bishop
くろ <space> うま	Guilty bishop
くろう <space> ま	Trouble/hardship time (connoting “difficult time”)
くろう <space> ま	Trouble/hardship demon
くろう <space> ま	Trouble/hardship pure (connoting “pure trouble”)

There is no indication, applicant urges, in the hiragana characters くろうま as to how the letters should be split into words, and as such, it is impossible to determine what meaning is intended, and even the black animal silhouette design of the ‘454 registration does not compel a translation of “dark horse,” because other possible translations would be equally suitable, such as “evil horse” or “black horse.” Applicant has supported its position with printouts from Japanese online dictionaries and translators.

“Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine ... 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). Application of the doctrine of foreign equivalents turns

<sup>8</sup> Applicant’s briefs in the involved applications are essentially the same with regard to the discussion on the similarity of the marks. All quoted material in this regard will be taken from the brief filed in the ‘674 application.

We note further that the table was compiled from printouts from Japanese online dictionaries (<http://jisho.org>) and translators (<http://translation.babylon.com/japanese/>), originally submitted with Applicant’s response, filed March 9, 2011.

upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record, including, dictionary and Internet evidence. *See generally* TMEP § 1207.01(b)(vi) (8<sup>th</sup> ed. 2011) and the authorities cited therein. The Federal Circuit has stated the “[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.” *In re Sarkli, Ltd.*, 721 F.2d 353, 354, 220 USPQ 111, 113 (Fed. Cir. 1983). For this reason, the English translation evidence is a critical factor for the Board and the courts when determining whether to apply the doctrine. If evidence shows that the English translation is unambiguously literal and direct, with no other relevant connotations or variations in meaning, the doctrine is applicable. *See, e.g., In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986) (holding LUPO for men’s and boy’s underwear and WOLF and design for various clothing items, likely to cause confusion, because, *inter alia* “LUPO” is clearly the foreign equivalent of the English word “wolf”). However, where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar. *See In re Sarkli*, 220 USPQ2d at 112-13 (holding REPECHAGE for various skin-products, and SECOND CHANCE for face creams and other toiletries, not likely to cause confusion, where the evidence failed to show that the terms were direct foreign equivalents); *see also In re Buckner Enterprises*, 6 USPQ2d 1316 (TTAB 1987) (holding DOVE (with design) for stoves and furnaces, and PALOMA for various forms of gas heating apparatus, not likely to cause confusion, because, *inter alia*, the Spanish word “paloma” and the English word “dove” are not exact synonyms in that “paloma” can be translated into either “dove” or “pigeon”).

After careful consideration of the evidence of record, we find applicant’s reliance on the doctrine of foreign equivalents misplaced. We also find the examining attorney’s sole reliance

on the translation statements in the cited registrations improper, as they are not proof of the truth of the matter asserted. *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993). In addition, the translation statement is not included in the presumptions listed under Section 7(b) of the Act. Moreover, applicant's evidence clearly establishes that "dark horse" is not an exact equivalent of "KUROUMA," the subject of, or the literal portion of the marks in the '438 and '454 registrations and the transliteration of the hiragana characters くらうま in the '169 and '177 registrations, being only one of several relevant meanings. Because other relevant translations of "KOROUMA exist, such as black horse, black animal, evil horse or evil animal, the doctrine of foreign equivalents is inapplicable. The addition of a stylized horse design in the '454 registration does not compel a different result.

The examining's attorney's arguments regarding the pronunciation of KOROUMA are unpersuasive and, in fact, bolsters our finding that the term is subject to more than one English meaning.

Viewing applicant's marks DARK HORSE and DARK HORSE DISTILLERY and the cited marks くらうま (presented horizontally and diagonally), KUROUMA and KUROUMA and design as they appear, we find that they are substantially different in sound, appearance and commercial impression. Moreover, in view of the lack of equivalency in meaning, any possible similarity in meaning does not outweigh the strong similarities.<sup>9</sup> As such, the *du Pont* factor of the similarity of the marks favors applicant.

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<sup>9</sup> Although the examining attorney did not raise the issue that the horse design in the KUROUMA and design mark of the '454 registration is the legal equivalent of the words DARK HORSE in applicant's marks, we note that the stylization of the horse and the fact that the term "dark horse" is a double entendre results in a different overall commercial impression. In this regard we take judicial notice of the definitions of "dark horse" from the online version of the Merriam Webster Dictionary ([www.merriam-webster.com/dictionary/dark+horse](http://www.merriam-webster.com/dictionary/dark+horse)):

1. a : usually little known contender (as a racehorse) that makes an unexpectedly good showing

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Accordingly, even though applicant's goods in the '674 application are legally identical to the goods in the cited registrations, and the services of the '448 application are related to the goods of the cited registrations, we conclude that the doctrine of foreign equivalents is not applicable and that applicant's marks DARK HORSE and DARK HORSE DISTILLERY are different in sound, appearance and commercial impression from the cited non-Latin characters of the marks of the '169 and '177 registrations and the KUROUMA and KUROUMA and design marks, respectively, of the '438 and '454 registrations .

**Decision:** The refusals to register under Section 2(d) of the Act in Application Serial Nos. 85125674 and 85104448 are reversed.