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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tropicana Las Vegas, Inc.

Serial No. 85450247

Erica J. Van Loon of Glaser Weil Fink Jacobs Howard Avchen & Shapiro LLP for Tropicana Las Vegas, Inc.

Sally Shih, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Adlin, Masiello and Hightower, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Tropicana Las Vegas, Inc. filed an application to register on the Principal Register the mark BACIO, in standard character form, for "Bar and restaurant services; Cafe and restaurant services; Hotel, bar and restaurant services," in International Class 43.¹ The application contains the statement, "The English translation of bacio in the mark is kiss."

¹ Application Serial No. 85450247, filed under Trademark Act § 1(a), 15 U.S.C. § 1051(a), on October 18, 2011, with a claim of first use and first use in commerce on May 11, 2011.

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The trademark examining attorney refused registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, as used in connection with applicant's services, so resembles the registered mark shown below as to be likely to cause confusion, or to cause mistake, or to deceive.



The cited mark is registered on the Principal Register for "Restaurant services, cafes, coffee bars, and coffee house services; carry-out restaurant and food preparation," in International Class 43.² When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs and applicant has filed a reply brief.

We turn first to an evidentiary objection raised by the examining attorney in her brief.³ Applicant submitted with its brief, for the first time, several printouts from Google Translate and an entry from Wikipedia. We have not considered this evidence. "The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." 37 C.F.R. § 2.142(d). *See also* TBMP § 1207.01. The applicant has the responsibility to make sure that the record is complete prior to filing a

 $^{^2}$ Reg. No. 3307901, issued on October 9, 2007; Section 8 declaration accepted; Section 15 declaration acknowledged.

³ Examining attorney's brief at 12.

notice of appeal. *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n. 32, 1769 (TTAB 2011).

We turn next to the merits of the refusal. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Addressing first the services of applicant and registrant, we find that they are legally identical. "Restaurant" and "cafe" services are identified in both the application and the cited registration. In the context of an analysis under Section 2(d), it is sufficient if likelihood of confusion is found with respect to use of the mark on any service that comes within the description of services in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Applicant argues that its restaurant is "an Italian trattoria in [a] Las Vegas hotel featuring white linens and fresh flowers," whereas registrant's mark "signifies the iconic rock band Kiss and is used in connection with Kiss-themed coffeehouses and/or casual restaurants decorated with neon lights and Kiss memorabilia."⁴ We

⁴ Applicant's brief at 2.

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cannot give consideration to such distinctions because they are not reflected in either party's identification of services in either the involved application or the cited The scope of the registration applicant seeks is defined by the registration. identification of services in its application and not by its actual use. Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Similarly, in considering the scope of the cited registration, we look to the registration itself and not to extrinsic evidence about the registrant's services. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981), citing Kalart Co., Inc. v. Camera-Mart, Inc., 119 USPQ 139 (CCPA 1958). Accordingly, for purposes of our analysis, we treat applicant's "restaurant services" as equivalent to registrant's "restaurant services" and as sufficiently broad to encompass registrant's "carry-out restaurant Similarly, applicant's "cafe ... services" are identical to registrant's services." "cafes" and sufficiently broad to encompass registrant's "coffee bars" and "coffee house services." Accordingly, the *du Pont* factor of the similarity or dissimilarity of the services favors a finding of likelihood of confusion.

Because applicant's services are legally identical to those identified in the cited registration, we must presume that those services move in the same channels of trade and are available to the same classes of customers for those services. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531,

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1532 (TTAB 1994). These two *du Pont* factors also favor a finding of likelihood of confusion.

We now turn to the similarity or dissimilarity of the marks at issue as to appearance, sound, meaning, and overall commercial impression. In our analysis under Section 2(d) we compare the marks at issue in their entireties. However, 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 a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The marks at issue manifestly have no visual similarity to each other. We note that applicant seeks registration of its mark in standard character form, such that the protections of registration would not be limited to any particular font, size, style or color. *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010). However, even if applicant's mark were displayed in a style of lettering highly similar to that of registrant's mark, the two marks would still not be visually similar.

As to sound, as well, we perceive no similarity between the marks regardless of whether applicant's mark is pronounced as an Italian word or in any likely alternative pronunciation.

With respect to the meanings of the two marks, the examining attorney argues that BACIO and KISS are identical under the doctrine of foreign equivalents. Under that doctrine, foreign words from common, modern languages

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are translated into English to determine whether there is any similarity of connotation with English words in a likelihood of confusion analysis. See Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent." Id. at 1696, quoting In re Pan Tex Hotel Corp., 190 USPQ 109, 110 (TTAB 1976). See generally J.T. McCarthy, 4 McCarthy on Trademarks and Unfair Competition, § 23:36 (4th ed., rev. 2013). The Board has found 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 Thomas, 79 USPQ2d 1021, 1025 (TTAB 2006).

The examining attorney's contention that BACIO means "kiss" is based on applicant's translation statement in the original application; a definition of "bacio" from the website Word Hippo (<wordhippo.com>);⁵ and a restaurant review regarding applicant's restaurant entitled "Bacio Means KISS."⁶ Applicant counters this with the argument that the Italian word "bacio" also means "smack" or "smacker"; this contention is supported by a definition from Google Translate.⁷ Neither Word Hippo nor Google Translate is a standard, authoritative dictionary; accordingly, they are not highly probative. Neither resource provides a detailed definition, usage notes, etymologies, alternative meanings, or the other information

⁵ Final Office action dated August 18, 2012.

 $^{^{6}}$ Id.

⁷ Response to Office action dated July 28, 2012.

that might be provided by an authoritative dictionary. In particular, the format of the definition from Google Translate is so spare that it does not reliably indicate that "smack" and "smacker" are synonyms for "bacio." In any event, applicant's translation statement and the definitions of record establish, *prima facie*, that an accepted meaning of "bacio" is "kiss." Moreover, we take judicial notice of the first definition of "bacio" in CASSELL'S ITALIAN DICTIONARY (1977), p. 57, which is as follows:

(1), n.m. Kiss. **Mandare un** ____, to throw a kiss ; **baci** affetuosi da, (in letters) love from.⁸

Applicant argues that "bacio" has other meanings in other languages, such as Portuguese, Croatian, Serbian, Spanish and Latin.⁹ Even assuming that this is true, it does not render irrelevant the Italian significance of the mark. For purposes of an analysis under Section 2(d), confusion need not be found to be likely among all customers in the United States, merely among an appreciable number of customers. *McGregor Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 202 USPQ 81, 86 (2d Cir. 1979); *Bottega Veneta, Inc. v. Volume Shoe Corporation*, 226 USPQ 964, 967 (TTAB 1985). Those who understand the Italian meaning of BACIO are not immunized from confusion by the mere fact that speakers of Portuguese or Croatian may see no connection between BACIO and KISS.

⁸ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁹ Applicant's brief at 8.

Applicant also argues that the doctrine of foreign equivalents should not be applied to the analysis of its mark because there is no showing that an appreciable number of customers would be likely to "stop and translate" the mark.¹⁰ While it is true that the examining attorney has not presented any evidence as to the extent to which Italian is understood in the United States, the Board has frequently applied the doctrine of foreign equivalents to Italian terms with little or no discussion of how many Americans speak the language. In re Martinoni Co., 189 USPQ 589, 590 (TTAB 1975) ("[W]e take judicial notice that there are many people in the United States who speak and read Italian."); In re Ithaca Indus., Inc., 230 USPQ 702, 704-705 (TTAB 1986) ("it does not require any authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States.") See also In re La Peregrina Ltd., 86 USPQ2d 1645, 1648 (TTAB 2008) ("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 goods at issue.") Moreover, if we accept applicant's claim that 0.384% of the population of the United States speaks Italian at home¹¹ (a figure that would not include those who have casual knowledge of certain common words of the Italian language), that percentage would account for over a million people (based on a total U.S. population of 300 million).

We see no reason to ignore the Italian significance of the mark BACIO. As the definition from CASSELL'S ITALIAN DICTIONARY confirms the other evidence of

¹⁰ *Id.* at 9-11.

¹¹ Applicant's brief at 9.

record, indicating that an accepted English translation of "bacio" is "kiss," we find that, in terms of literal meaning, applicant's mark and the cited registered mark are equivalent.

Considering the overall commercial impressions created by the two marks at issue, we perceive a meaningful distinction, even though both of the words "bacio" and "kiss" suggest a loving or affectionate gesture. The registered mark contains suggestions that run contrary to the impression of a loving or affectionate gesture. The stylized lettering is jagged, aggressive, and perhaps threatening. The stylized letters SS suggest lightning bolts and the style of the mark creates an impression that, when combined with the standard meaning of "kiss," is incongruous. Such incongruity is absent from applicant's mark. Accordingly, we find the overall commercial impressions created by the two marks to be quite different. *See In re Ness*, 18 USPQ2d 1815 (TTAB 1991). Considering that the marks are different in appearance and sound, albeit similar in literal meaning, we find that the marks are dissimilar in overall commercial impression and that the *du Pont* factor of the similarity or dissimilarity of the marks weighs against a finding of likelihood of confusion.

Having considered the evidence of record and all relevant *du Pont* factors, including those not specifically discussed herein, we find the dissimilarity of the marks to be dispositive of this case. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.") We find that

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applicant's mark, as applied to applicant's services, is not likely to give rise to confusion, mistake or deception as to the source of applicant's services.

Decision: The refusal under Trademark Act § 2(d) is reversed.