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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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

In re: Application of Tropicana Las Vegas, Inc.

Mark: BACIO

Class: 043

Application Serial No.: 85/450,247

Filing Date: October 18, 2011

Trademark Law Office: 106

Examining Attorney: Sally Shih

**APPLICANT'S APPEAL BRIEF**

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## DESCRIPTION OF THE RECORD

### EVIDENCE

A true and correct copy of the United States Patent and Trademark Office's Final Office Action re BACIO, Serial No. 85/450,247, issued August 18, 2012,  
Attached hereto as Exhibit A

A true and correct copy of Tropicana Las Vegas, Inc.'s Response to Office Action Mailed February 5, 2012 re BACIO, Serial No. 85/450,247, submitted July 28, 2012,  
Attached hereto as Exhibit B

True and correct copies of printouts from Google Translate, available at <http://translate.google.com/>, downloaded on February 8, 2013,  
Attached hereto as Exhibit C

A true and correct copy of a Wikipedia article entitled *Italian Language in the United States*, available at [http://en.wikipedia.org/wiki/Italian\\_language\\_in\\_the\\_United\\_States](http://en.wikipedia.org/wiki/Italian_language_in_the_United_States), downloaded on February 8, 2013,  
Attached hereto as Exhibit D

A true and correct copy of a printout from Tropicana Las Vegas, Inc.'s website, available at <http://www.troplv.com/EatDrinkSubPage.aspx?page=Bacio#.URmTRvKDmSo>, downloaded on February 8, 2013,  
Attached Attached hereto as Exhibit E

A true and correct copy of Tropicana Las Vegas, Inc.'s Application to Register BACIO, Serial No. 85/450,247, filed October 18, 2011,  
Attached hereto as Exhibit F

A true and correct copy of the United States Patent and Trademark Office's First Office Action re BACIO, Serial No. 85/450,247, issued February 5, 2012,  
Attached hereto as Exhibit G

## I. INTRODUCTION

Applicant Tropicana Las Vegas, Inc. (“Tropicana” or “Applicant”) hereby appeals from the Examining Attorney’s final refusal to register the mark BACIO, Serial No. 85/450,247 for “bar and restaurant services; café and restaurant services; hotel, bar and restaurant services,” on the erroneous basis that BACIO creates a likelihood of confusion with KISS, Registration No. 3,307,901 (“Cited Mark”) for restaurant services, cafes, coffee bars, and coffee house services; carry-out restaurant and food preparation. *See* Final Office Action, Exhibit A.

The Examining Attorney’s final refusal should be disregarded as it is improperly based on a finding that BACIO and KISS are confusingly similar pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d) and the incorrect presumption that “bacio” and “kiss” are foreign equivalents. In fact, the discretionary doctrine of foreign equivalents should not have been applied in this case as it is unlikely that an appreciable number of ordinary American purchasers would “stop and translate” the foreign word “bacio” into “kiss.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005) (emphasis supplied); *see also* Trademark Manual of Examining Procedure (“TMEP”) §1207.01(b)(vi). There are simply no facts or law that support the Examining Attorney’s incorrect presumption that “kiss” is the sole or primary translation of “bacio” and consumers would be likely to translate the foreign word into its English equivalent. Moreover, Tropicana’s ample evidence cannot be ignored that “kiss” is not the only translation of “bacio” which can also be translated to “smack,” “threw,” “potty,” “berries” and “unfurnished” in various languages. *See* Response to Office Action, Exhibit B at 2; *see also* Exhibit C. With so many translations, it is unlikely that purchasers would “stop and translate” “bacio” into “kiss,” if they translate it at all. Further, less than one-half of one percent of the population of the United States

speaks Italian in the home, making it even less likely that ordinary consumers would choose the Italian translation “kiss.” See Exhibit D at 2.

Moreover, restaurants are commonly named using foreign words which consumers accept without translation and there is no evidence whatsoever to support the Examining Attorney’s position that purchasers would translate the restaurant name BACIO, and they would not. *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524, 525 (TTAB 1975) (holding that consumers will not translate TIA MARIA as the name of a Mexican restaurant because the marketplace makes it unfeasible for them to do so); *see also* Response to Office Action, Exhibit B at 3.

In any event, even if the Board determines that the marks are foreign equivalents, BACIO and KISS are not confusingly similar in appearance, sound, connotation or commercial impression and the marks are not used on the same or similar goods. Applicant’s BACIO mark is used in connection with an Italian trattoria in its Las Vegas hotel featuring white linens and fresh flowers. To the contrary, Registrant’s stylized KISS 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. Although BACIO and KISS share one overlapping service, restaurant services, even a cursory glance at the Applicant and Registrant’s restaurants below shows they are completely different establishments and pose zero risk of confusion.

Bacio, Las Vegas, Nevada	Kiss, Myrtle Beach, South Carolina
 <p data-bbox="191 743 776 802">See <a href="http://www.tropolv.com/EatDrinkSubPage.aspx?page=Bacio#.URReAfJsJ3E">http://www.tropolv.com/EatDrinkSubPage.aspx?page=Bacio#.URReAfJsJ3E</a></p>	 <p data-bbox="831 743 1302 802">See <a href="http://www.kisscoffeehouse.com/home2.htm">http://www.kisscoffeehouse.com/home2.htm</a></p>

In fact, the Examining Attorney did not perform a likelihood of confusion analysis in the final office action before improperly concluding that consumers are likely to be confused. *See In re E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563, 567 (CCPA 1973). Accordingly, as the Examining Attorney has not shown that BACIO and KISS are foreign equivalents or are confusingly similar, the final refusal of registration should be reversed.

## II. STATEMENT OF THE ISSUES

Whether the doctrine of foreign equivalents is applicable to the instant case and whether the Examining Attorney's final refusal under Trademark Action Section 2(d) to register Applicant's BACIO mark on the Principal register based on alleged likelihood of confusion was erroneous.

## III. RECITATION OF THE FACTS

Tropicana is the owner of the world-famous Tropicana Las Vegas hotel which is located in the heart of the Las Vegas Strip. Exhibit E. The Tropicana Las Vegas features a variety of dining experiences including Bacio, an Italian trattoria which was named one of the Top 10 New

Restaurants in Las Vegas. *Id.* On October 18, 2011, Tropicana filed an application with the United States Patent and Trademark Office’s (“USPTO”) to register the mark BACIO, Serial No. 85/450,247, for use on or in connection with “Bar and restaurant services; Café and restaurant services; Hotel, bar and restaurant services” in International Class 043 (the “Application”). Application, Exhibit F.

Pursuant to TMEP Section 809, since the applied-for mark includes the non-English word “bacio,” the Application included a statement that one translation of the Italian word “bacio” is “kiss.” However, Applicant never represented that “kiss” is the sole translation of “bacio” and it is not. *See* Response to Office Action, Exhibit B at 2. Indeed, the Italian word “bacio” also translates to “smack” or “smacker.” *Id.*; *see also* First Office Action, Exhibit G at 6-8. Further, the Latin word “bacio” translates to “berries,” the Portuguese word “bacio” translates to “potty,” the Croatian and Serbian word “bacio” translates to “threw,” and the Spanish word “bacio” translates to “unfurnished.” *See* Response to Office Action, Exhibit B at 2; *see also* Exhibit C.

On February 5, 2012, the USPTO issued an Office Action refusing registration of BACIO under Trademark Action Section 2(d), 15 U.S.C. § 1052(d) on the grounds that BACIO is purportedly confusingly similar to Kiss Catalog, Ltd.’s (“Kiss”) stylized mark KISS (depicted below), Registration No. 3307901, Registered on October 9, 2007 for use on or in connection with “Restaurant services, cafes, coffee bars, and coffee house services; carry-out restaurant and food preparation.” First Office Action, Exhibit G at 6-8. Kiss is the registrant of KISS and other trademarks relating to the band Kiss, an iconic rock band that has been performing and producing music since the 1970s and is known for its distinctive make up, unique costumes and performance theatrics. *Id.*



The Examining Attorney's confusing similarity analysis hinged on an erroneous finding that BACIO and KISS are foreign equivalents. Tropicana responded to the Office Action and provided evidence that BACIO and KISS are not foreign equivalents since "bacio" has many meanings other than "kiss." Response to Office Action, Exhibit B at 2. However, Tropicana's evidence was ignored and a final office action issued refusing registration on August 18, 2012. See Final Office Action, Exhibit A. The final refusal was primarily based on an improper presumption that "the term KISS is the primary and most common translation for the term BACIO for the applicant to submit it as the translation in the original application." *Id.* at 3. Further, the Examining Attorney refused to allow Tropicana to amend the translation in the Application to include additional meanings of the term "bacio." Thereafter, Tropicana filed this Appeal.

#### **IV. ARGUMENT**

##### **A. No Likelihood Of Confusion Exists Between BACIO and KISS**

The Examining Attorney's conclusion that Tropicana's BACIO mark creates a likelihood of confusion with the iconic rock band Kiss' stylized KISS mark should be revisited based upon the undisputed facts and well-settled law. As explained below, the doctrine of foreign equivalents should not have applied to bar registration of Tropicana's BACIO mark. Further, even if the Board nevertheless decides that the doctrine of foreign equivalents was properly applied, BACIO and KISS are not similar in appearance, sound, connotation or the services with which they are used and BACIO is not confusingly similar to KISS.

##### **1. The Doctrine of Foreign Equivalents is Not Applicable Here**

###### **a. The Doctrine of Foreign Equivalents is Discretionary**

As a threshold matter, the Examining Attorney erroneously treated the application of the

doctrine of foreign equivalents as mandatory, rather than discretionary. Final Office Action, Exhibit A at 2-3. Indeed, as the cases cited in the final office action demonstrate, it is well settled that the doctrine of foreign equivalents “*is a guideline and not an absolute rule.*” *Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1691 (emphasis supplied) (no likelihood of confusion between Applicant’s VEUVE ROYALE for sparkling wine and Registrant’s VEUVE CLICQUOT marks). Accordingly, as set forth in detail below, the Examining Attorney should not have applied the doctrine of foreign equivalents at all, and the improper analysis of the doctrine which formed the basis for a finding of confusing similarity should be disregarded.

**b. It Is Unlikely That an Ordinary American Buyer Would “Stop and Translate” “Bacio”**

The law is well established that the doctrine of foreign equivalents *will not be applied* where it is unlikely that an ordinary American buyer would “stop and translate” the word into its English equivalent. *Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1696 (“improbable that the average American purchaser would stop and translate ‘VEUVE’ into ‘widow’”); *see also* TMEP §1207.01(b)(vi); *see also In re Tia Maria, Inc.*, 188 U.S.P.Q. 524 (no likelihood of confusion between TIA MARIA for a Mexican restaurant and AUNT MARY’S for canned vegetables). In the final office action, the Examining Attorney did not meet the burden of proving the doctrine of foreign equivalents should be applied because there was no showing that an appreciable number of ordinary American buyers would “stop and translate” the Italian word “bacio” used for restaurant services into the English word “kiss.” In fact, the sole evidence relied on by the Examining Attorney was a single article written about Applicant’s restaurant entitled “Bacio Means Kiss.” Final Office Action, Exhibit A at 12. This article merely demonstrates that *one food critic* used the translation to create a catchy title for an article and does not stand for the

proposition that an ordinary American buyer would “stop and translate” the word “bacio” into “kiss,” as the doctrine of equivalents requires. Accordingly, it was error for the Examining Attorney to infer from that single translation that “[a]n average consumer would translate the term BACIO into KISS as the foreign equivalent.” Final Office Action, Exhibit A at 4. As set forth below, Applicant has provided ample evidence that an appreciable number of ordinary American purchasers are unlikely to translate the term “bacio” into “kiss” and the doctrine of foreign equivalents is therefore inapplicable.

(i) **“Kiss” is not the Primary Meaning of “Bacio”**

First, there are simply no law or facts that support the Examining Attorney’s incorrect determination that “kiss” is the primary and/or most common translation of “bacio.” Final Office Action, Exhibit A at 3. Rather, this determination was based solely on a presumption that “[p]resumably, the term KISS is the primary and most common translation for the term BACIO for the applicant to submit it as the translation in the original application.<sup>1</sup>” *Id.* However, there is no rule that an applicant is required to submit the “primary and most common translation” of a foreign term. *See* TMEP § 809 (“An application to register a mark that includes non-English wording must include a statement translating the wording.”) In fact, as is set forth in TMEP Sections 809.1 and 809.2, only a translation that is a clear and exact equivalent should be printed, and moreover, the existence of multiple translations, as here, usually indicates that there is no clear equivalent. TMEP §§809.1 and 809.2 (“*the existence of a variety of alternative translations or general explanations usually indicates a lack of a clearly recognized equivalent meaning.*”) (emphasis added). Further, the translation provided by Applicant has no bearing on

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<sup>1</sup> The Examining Attorney refused Applicant’s request to amend the translation on its application to include additional translations of “bacio.”

whether the ordinary American purchaser in the marketplace will translate “bacio” to that particular meaning as the purchaser has no way to know what the Applicant’s translation is. Accordingly, the Examining Attorney’s determination that “kiss” is the primary and/or most common translation of “bacio” is without merit and should be disregarded.

As the evidence submitted by Tropicana plainly shows, it is unlikely that ordinary purchasers would translate the term “bacio” into “kiss” because “bacio” has several English meanings in multiple languages. First, as Tropicana demonstrated in its Response to the Office Action, the Italian word “bacio” also means “smack” or “smacker.” *See* Response to Office Action, Exhibit B at 2. The Examining Attorney’s conclusion that “the terms KISS and SMACK are similar in connotation and meaning” focuses on one obscure slang definition of “smack” and simply ignores several other meanings including “a smell of flavor that is distinctive though faint,” “a small quantity, esp. a mouthful or taste,” “a distinctive trace or touch,” or “to have the characteristic smell or flavor (of something),” which are much more appropriate definitions in the context of a restaurant. *See also* First Office Action, Exhibit G at 6-8. Accordingly, assuming the ordinary consumer familiar with the Italian language decided to translate the Italian word “bacio” used in connection with a restaurant, it is more likely that he would translate it to “smack” than “kiss,” which has nothing to do with food.

Further, “bacio” has a variety of English translations from many other languages and the Examining Attorney failed to show that the ordinary consumer would prefer an Italian translation. For example, the Latin word “bacio” translates to “berries,” the Portuguese word “bacio” translates to “potty,” the Croatian and Serbian word “bacio” translates to “threw,” and the Spanish word “bacio” translates to “unfurnished.” *See* Response to Office Action, Exhibit B at 2; *see also* Exhibit C. Given that “bacio” has so many meanings, it can hardly be “likely” that

ordinary American purchasers who make the step of translation would “stop and translate” “bacio” into the Italian “kiss,” and the Examining Attorney has offered no evidence otherwise.

(ii) **It is Unlikely That an Appreciable Number of Purchasers Would Translate “Bacio” to “Kiss”**

Further, the Examining Attorney failed to show that an appreciable number of purchasers are likely to be aware that “bacio” means “kiss” and are likely to translate the marks from Italian into English. *Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1696 (holding the average American purchaser would not stop and translate “VEUVE” into “widow” based on finding that “an appreciable number of purchasers are unlikely to be aware that VEUVE means 'widow' and are unlikely to translate the marks into English.”) The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 90 U.S.P.Q.2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 U.S.P.Q.2d 1021, 1024 (TTAB 2006) (citing J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:26 (4th ed. 2006), which states “[t]he test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.”) Indeed, less than one-half of one percent (0.384% ) of the population of the United States speaks Italian at home and is sufficiently familiar with the Italian language. *See* Exhibit D at 2. Thus, very few Americans would be capable of recognizing that “bacio” and “kiss” have the same meaning. Accordingly, the Examining Attorney did not, and cannot demonstrate that an appreciable number of consumers would “stop and translate” “bacio” to “kiss.”

**(iii) It is Unlikely That Purchasers Would Translate “Bacio”  
At All**

Moreover, there is no basis for the Examining Attorney’s presumption that the ordinary American purchaser would take the step to “stop and translate” “bacio” into *any* English equivalent. Courts have found that there are foreign expressions that “even those familiar with the language will not translate, accepting the term as it is.” *In re Tia Maria, Inc.*, 188 U.S.P.Q. at 525 (holding that consumers will not translate TIA MARIA as the name of a Mexican restaurant because the marketplace makes it unfeasible for them to do so); *see also In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (TTAB 1976) (concluding that consumers are unlikely to translate LA POSADA when used as the name of a motor hotel into its English equivalent of “the inn,” because “la posada” creates a different commercial impression in English than it does in Spanish). Tropicana uses the BACIO mark in connection with its restaurant services, including as the name of its Las Vegas restaurant. Restaurants are commonly named using foreign words, particularly in Las Vegas where the flagship BACIO restaurant is located, and consumers have grown accustomed to referring to these restaurants by their one-word foreign names without translation. For example, Ago (meaning “needle” in Italian)<sup>2</sup>, Japonais (meaning “Japanese” in French), Aureole (meaning “haloes” in Italian)<sup>3</sup> and Tableau (meaning “table” in French)<sup>4</sup> are all restaurants in Las Vegas known by their foreign names. Response to Office Action, Exhibit B at 3. Since the commercial setting of a restaurant provides no impetus for consumers to

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<sup>2</sup> Note that the Application for AGO, Serial No., 76/506793, Registration No. 3,275,647, Registered on August 7, 2007 contains no foreign translation.

<sup>3</sup> Note also that the Application for AURELOE, Serial No., 85/404854, Registration No. 4,284,698, Registered on February 5, 2013 contains no foreign translation.

<sup>4</sup> Note also that the Application for TABLEAU, Serial No., 77/219584, Registration No. 3,381,539, Registered on February 12, 2008 contains no foreign translation.

translate the BACIO mark, it is unlikely that the ordinary American purchaser of Tropicana's restaurant services would do so, let alone decisively settle on "kiss" as the sole translation.

As can be seen from the foregoing, "kiss" is not the primary or even a common translation of "bacio," which has multiple translations in several foreign languages and it is unlikely that an appreciable number of ordinary American purchasers would "stop and translate" "bacio" into "kiss" over any of the other possible translations. Further, it is unlikely that ordinary American purchasers will translate the BACIO mark used in connection with Tropicana's restaurant services *at all*, and would instead take the foreign mark "as is." Accordingly, the discretionary doctrine of foreign equivalents should not be applied here, BACIO and KISS are not foreign equivalents, and BACIO is entitled to registration on the basis that BACIO and KISS are not confusingly similar.

## **2. There is No Likelihood of Confusion between BACIO and KISS**

Even if the Board finds that the doctrine of foreign equivalents applies to BACIO, the Examining Attorney has not shown that BACIO is confusingly similar to KISS and utterly failed to perform any likelihood of confusion analysis whatsoever in the final office action. Instead, the Examining Attorney merely stated that "Where the services of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. Accordingly, the Section 2(d) likelihood of confusion refusal is maintained and made FINAL."<sup>5</sup> Final Office Action, Exhibit A at 4. This is certainly not a sufficient basis for refusing to register BACIO.

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<sup>5</sup> Applicant assumes that the Examining Attorney completely ignored the Section 2(d) analysis submitted by Applicant in its response to the first office action, and will respond to the Examining Attorney's first office action again.

In any event, in a likelihood of confusion determination, the court applies the thirteen factors set forth in *In re E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. at 567. Here, the first *DuPont* factor requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc.*, 73 U.S.P.Q.2d at 1691 (citing *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. at 567). In the instant case, however, no weight has been given to the significant dissimilarities between the marks BACIO and KISS, and the inquiry relied entirely on the doctrine of foreign equivalents, which is not applicable here, as established above. The proper analysis should not focus on the sole similar translation of “bacio” to “kiss,” but rather a comparison of the marks in their entirety: the mark “BACIO” with the mark “KISS.” *Id.*

**a. The Marks Are Not Similar in Appearance**

Applicant’s mark BACIO is visually dissimilar from Registrant’s stylized mark KISS. The marks do not contain any of the same letters, except “I,” and are spelled completely differently. See *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (finding “CRISTAL” and “CRYSTAL CREEK” dissimilar). In addition, the KISS mark depicted in U.S. Registration No. 3,307,901 and shown below, is a stylized word mark, a fact that the Examining Attorney completely ignored, that is commonly associated with the famous band Kiss. The additional matter depicted in the stylized KISS mark, including the distinctive block lettering and jagged “S” design, is an immediate source identifier for the rock band and further distinguishes the KISS mark from BACIO. See *China Healthways Institute, Inc. v. Wang*, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007) (finding CHI PLUS in the stylized form not confusingly similar to the stylized mark CHI & Design both for electrical massagers because “the marks are distinguished by their respective additional matter.”) These visual differences are

especially apparent when the stylized KISS mark is compared to BACIO as the marks are displayed in their respective specimens, true and correct copies of which are shown below.

BACIO Word Mark	BACIO Specimen
	

KISS, Stylized Mark	KISS, Specimen
	

See Exhibit F at 6-7; see also Exhibit G at 8. Indeed, BACIO and KISS are not similar in appearance now, nor will they ever never adopt the same or similar appearance. As there is no risk that consumers will be confused, BACIO should be allowed registration.

**b. The Marks Do Not Sound Alike**

Applicant's BACIO sounds nothing like Registrant's KISS mark. Marks much more similar in sound than the marks in the instant case have been found not confusingly similar. See e.g. *Coca-Cola Co. v. Essential Products Co.*, 164 U.S.P.Q. 628 (CCPA 1970) (the Court of Customs and Patent Appeals found COCO LOCO not to be similar to COCA COLA). Here,

BACIO sounds much less like KISS than COCO LOCO sounds like COCA COLA. Further, BACIO is multisyllabic, while KISS is monosyllabic. Furthermore, the marks do not contain any of the same phonetic sounds, are different in rhythm and cadence and the words are not pronounced similarly. KISS is pronounced as \kis\ (*see* Merriam-Webster Online, <http://www.merriam-webster.com/dictionary/kiss>), whereas BACIO is pronounced as \BAH-cho\ (*see* <http://en.wikibooks.org/wiki/Italian/Pronunciation>). As BACIO and KISS sound completely dissimilar, there can be no likelihood of confusion on the basis of sound.

c. **There Are Virtually No Similarities in Connotation and Commercial Impression**

Although BACIO and KISS are both used on or in connection with restaurants, the similarities in connotation and commercial impression end there. Here, the Examining Attorney's conclusion that BACIO and KISS are confusingly similar was based on an erroneous finding that "kiss" is the primary connotation of BACIO. However, as discussed above, there are multiple meanings many languages. Further, even if BACIO is translated to "kiss," it is still not similar in connotation to Registrant's KISS mark, since there is no question that the stylized KISS mark references the iconic rock band Kiss, not a touch with the lips.

Further, commercial impression has been described as "what the probable impact will be on the ordinary purchaser in the marketplace." *T. W. Samuels Distillery, Inc. v. Schenley Distillers, Inc.*, 164 U.S.P.Q. 141 (CCPA 1972). BACIO, used in connection with a Las Vegas restaurant, conjures the impression of a charming trattoria, and gives the general consumer an idea of the type of authentic fresh Italian cuisine, white-linen ambiance and impeccable service he or she will encounter there. On the other end of the spectrum, the stylized mark KISS, as discussed above, is clearly and immediately associated in the minds of consumers with the

famously outlandish rock band Kiss. Accordingly, consumers would expect the KISS restaurant to play music by Kiss and be decorated with classic memorabilia related to the band. In no way does the mark KISS connote an upscale Italian restaurant, and the mark BACIO has nothing to do with the band Kiss. Accordingly the marks BACIO and KISS do not convey a similar commercial impression whatsoever and no one is going to confuse the stylized mark of a rock band with a fine dining Italian restaurant.

**d. The Goods And Services Are Not Related**

Applicant respectfully disagrees with the Examining Attorney's determination that all Applicant's marks' goods and services are "closely related, even identical" to Registrant's mark's goods and services. In fact, the only service BACIO and KISS have in common is restaurant services. Exhibit F at 2; Exhibit G at 6. Besides restaurant services, Registrant's KISS mark is also for use on or in connection with cafes, coffee bars, coffee house services and carry-out restaurant and food preparation. Exhibit G at 6. To the contrary, Applicant's BACIO mark is used on or in connection with bar services, cafe services, and hotel services in addition to restaurant services. Exhibit F at 2. Registrant's listing of goods and services for KISS makes no mention whatsoever of bars or hotel services. Additionally, BACIO is not used on or in connection with coffee bars or coffee house services, or with carry-out restaurant and food preparation. As only one service overlaps, all the goods and services of BACIO and KISS cannot be deemed "closely related, even identical."

**V. SUMMARY**

As can be seen from the foregoing, the discretionary doctrine of foreign equivalents does not apply because the ordinary American purchaser is not likely to "stop and translate" "bacio" into "kiss." Accordingly, BACIO is not the foreign equivalent of KISS. Further, there is no

evidence that purchasers are likely to translate BACIO at all in this context, especially given that restaurants are commonly named using foreign words that are accepted “as is” without translation. Further, even if the doctrine does apply, given the fact that BACIO has several English meanings translated from many languages, looks and sounds nothing like KISS and is used in connection with an upscale Italian trattoria, as opposed to a casual coffeehouse decorated with memorabilia from the iconic rock band Kiss, it is improbable that consumers will experience any confusion. For all of these reasons, Applicant asserts that the BACIO mark is entitled to registration and respectfully requests such action.

DATED: February 13, 2013

Respectfully submitted,

GLASER WEIL FINK JACOBS  
HOWARD AVCHEN & SHAPIRO LLP

By: /s/ Erica J. Van Loon  
ERICA J. VAN LOON  
JESSICA A. WOOD  
Attorneys for Applicant  
Tropicana Las Vegas, Inc.

**Exhibit A**

**To:** TROPICANA LAS VEGAS, INC. ([jblinderman@glaserweil.com](mailto:jblinderman@glaserweil.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85450247 - BACIO - T-4  
**Sent:** 8/18/2012 1:42:41 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 85450247

**MARK:** BACIO

**\*85450247\***

**CORRESPONDENT ADDRESS:**

JONATHAN BLINDERMAN  
GLASER WEIL FINK JACOBS HOWARD AVCHEN

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LOS ANGELES, CA 90067-6219

**APPLICANT:** TROPICANA LAS VEGAS, INC.

**CORRESPONDENT'S REFERENCE/DOCKET NO. :**

T-4

**CORRESPONDENT E-MAIL ADDRESS:**

[jblinderman@glaserweil.com](mailto:jblinderman@glaserweil.com)

***OFFICE ACTION***

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 8/18/2012**

**THIS IS A FINAL ACTION.**

**TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE:** Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

This Office action is in response to applicant's communication filed on 7/28/2012. The applicant has argued against the Section 2(d) likelihood of confusion and indicated that the cited prior pending application has been abandoned. The cited prior pending application has been withdrawn. However, the argument against the Section 2(d) likelihood of confusion has been rejected.

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No. 3307901. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

### **Final Refusal - Section 2(d) Likelihood of Confusion**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8

USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In the present instance, the proposed mark is BACIO which is translated into KISS in English for bar and restaurant services; cafe and restaurant services; and hotel, bar and restaurant services. The registered mark is KISS for restaurant services, cafes, coffee bars, and coffee house services; carry-out restaurant and food preparation. The proposed mark and the registered mark are foreign equivalents. Furthermore, the services offered by the registrant and applicant are closely related, even identical.

The applicant was the one who provided the translation of the term BACIO as KISS. Now, the applicant argued that KISS is “not the sole meaning” of the term BACIO. Presumably, the term KISS is the primary and most common translation for the term BACIO for the applicant to submit it as the translation in the original application. Please see attached evidence for the translation of the Italian word BACIO into its English equivalent as KISS.

Under the doctrine of foreign equivalents, a mark in a foreign language and a mark that is its English equivalent may be held to be confusingly similar. TMEP §1207.01(b)(vi); *see, e.g., In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983). Therefore, marks comprised of foreign words are translated into English to determine similarity in meaning and connotation with English word marks. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Equivalence in meaning and connotation can be sufficient to find such marks confusingly similar. *See In re Thomas*, 79 USPQ2d at 1025.

The applicant argued that the proposed mark can also be translated as SMACK. The term SMACK is defined as a loud kiss. Please see attached dictionary definition #6. The terms KISS and SMACK are similar in connotation and meaning.

The doctrine is applicable when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696; TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d at 1024 (citing J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:26 (4th ed. 2006), which states “[t]he test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.”).

Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. *See In re Thomas*, 79 USPQ2d at 1021 (holding MARCHE NOIR for jewelry likely to be confused with the cited mark BLACK MARKET MINERALS for retail jewelry and mineral store services where evidence showed that MARCHE NOIR is the exact French equivalent of the English idiom “Black Market,” and the addition of MINERALS did not serve to distinguish the marks); *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (holding applicant’s mark LUPU for men’s and boys’ underwear likely to be confused with the cited registration for WOLF and design for various clothing items, where LUPU is the Italian equivalent of the English word “wolf”); *In re Hub Distrib., Inc.*, 218

USPQ at 284 (holding the Spanish wording EL SOL for clothing likely to be confused with its English language equivalent SUN for footwear where it was determined that EL SOL was the “direct foreign language equivalent” of the term SUN).

Please see attached article in which the applicant’s restaurant was the subject matter of the reporting. The title of the article specifically indicated that BACIO MEANS KISS. An average consumer would translate the term BACIO into KISS as the foreign equivalent.

Furthermore, Italian is considered a common modern language. Common, modern languages include Spanish, French, Italian, German, Chinese, Japanese, Russian, Polish, Hungarian, Serbian and Yiddish. See, e.g., *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411 (C.C.P.A. 1961) (Hungarian); *In re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB 2008) (Japanese); *In re Joint-Stock Co. “Baik,”* 80 USPQ2d 1305 (TTAB 2006) (Russian); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991) (Spanish); *In re Oriental Daily News, Ltd.*, 230 USPQ 637 (TTAB 1986) (Chinese); *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (Italian); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983) (German); *In re Westbrae Natural Foods, Inc.*, 211 USPQ 642 (TTAB 1981) (Japanese); *In re Optica Int’l*, 196 USPQ 775 (TTAB 1977) (French); *In re Bagel Nosh, Inc.*, 193 USPQ 316 (TTAB 1976) (Yiddish); *In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967) (Serbian); *In re New Yorker Cheese Co.*, 130 USPQ 120 (TTAB 1961) (Polish).

Where the services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Accordingly, the Section 2(d) likelihood of confusion refusal is maintained and made FINAL.

### **Proper Response to Final Office Action**

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to

review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Sally Shih/  
Sally Shih  
Trademark Examining Attorney  
Law Office 106  
571-272-9712  
sally.shih@uspto.gov

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**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

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# English Dictionary

## Definition of "smack"

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**1**

**smack** (smæk 𐀀 )

► Definitions

noun

1. a smell or flavour that is distinctive though faint
2. a distinctive trace or touch ⇒ *the smack of corruption*
3. a small quantity, esp a mouthful or taste

verb

*Intr foll by of*

4. to have the characteristic smell or flavour (of something) ⇒ *to smack of the sea*
5. to have an element suggestive (of something) ⇒ *his speeches smacked of bigotry*

► Word Origin

Old English *smæc*; related to Old High German *smoc*, Icelandic *smekkr* a taste, Dutch *smaak*

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- = [slap](#), [blow](#), [whack](#), [clout](#), [cuff](#), [crack](#), [swipe](#), [spank](#), [wallop](#)
- = [directly](#), [right](#), [straight](#), [squarely](#), [precisely](#), [exactly](#), [slap](#), [plumb](#), [point-blank](#)

2

**smack** (smæk 𐀀 )

► Definitions

verb

1. *tr* to strike or slap smartly, with or as if with the open hand
2. to strike or send forcibly or loudly or to be struck or sent forcibly or loudly
3. to open and close (the lips) loudly, esp to show pleasure
4. *tr* to kiss noisily

noun

5. a sharp resounding slap or blow with something flat, or the sound of such a blow
6. a loud kiss
7. a sharp sound made by the lips, as in enjoyment
8. See [have a smack at](#)
9. See [smack in the eye](#)

adverb

(informal)

10. directly; squarely
11. with a smack; sharply and unexpectedly

► Word Origin

C16: from Middle Low German or Middle Dutch *smacken*, probably of imitative origin

3

**smack** (smæk 𐀀 )

► Definitions

[WPBA](#)

Suggested by [Daved](#) (17 Aug 2012)

[PBA](#)

Suggested by [Daved](#) (17 Aug 2012)

[WAC](#)

Suggested by [Daved](#) (17 Aug 2012)

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"smack" photos from Flickr

noun

a slang word for heroin

Word Origin

C20: perhaps from Yiddish *schmeck*

4

**smack** (smæk 𐀀)

Definitions

noun

- 1. a sailing vessel, usually sloop-rigged, used in coasting and fishing along the British coast
- 2. a fishing vessel equipped with a well for keeping the catch alive

Word Origin

C17: from Low German *smack* or Dutch *smak*, of unknown origin

Translations

British English: **smack** 𐀀 If you *smack* someone, you hit them with your hand. She smacked me on the side of the head. **smæk** VERB

Arabic: ٤𐀀	Brazilian Portuguese: dar uma palmada 𐀀
Chinese: 𐀀	Croatian: udanti 𐀀
Czech: plácnout 𐀀 <i>plácatrukou</i>	Danish: smække 𐀀
Dutch: slaan 𐀀	European Spanish: dar un manotazo 𐀀
Finnish: läimäyttää 𐀀	French: gifler 𐀀
German: hauen 𐀀	Greek: παλιζω 𐀀
Italian: sculacciare 𐀀	Japanese: ビシヤリと打つ 𐀀
Korean: 세계 때리다 𐀀	Norwegian: klaske 𐀀
Polish: trzasnąć 𐀀 <i>traskać</i>	Portuguese: dar uma palmada 𐀀
Romanian: a pălmui	Russian: отшлепать 𐀀
Spanish: dar un manotazo 𐀀	Swedish: slå 𐀀 <i>smiska</i>
Thai: 𐀀	Turkish: tokat atmek 𐀀
Ukrainian: п'яскати <i>лягнути</i>	Vietnamese: phát 𐀀

Usage examples

Coke, smack, speed, White Cap, Tusker, anything yer like, me.  
**Dexter Petley** WHITE LIES (2003)

DUDE, EASE UP: Someone should remind Rodney Harrison not to smack around the Patriots anymore.  
TORONTO SUN (2003)

He said: 'Leo was smack dab in the middle of it, sleeping on cartons of underground comics.'  
SUN, NEWS OF THE WORLD (2000)

Johnny had shot upstairs to get to the computer before getting a smack round the head.  
**Salley Vickers** MR GOLIGHTLY'S HOLIDAY (2003)

Margaret, you could tell, wanted to smack him with a frying pan.  
GLOBE AND MAIL (2003)

PARENTS are to keep the right to smack their children, the Government revealed yesterday.  
SUN, NEWS OF THE WORLD (2000)

The glass shattered with the first smack of her umbrella.  
**Davis, John Gordon** SEIZE THE RECKLESS WIND

Tips on clothing, about carrying water and taking a hepatitis shot before eating out, smack of a manual for foreign tourists.  
INDIA TODAY (2000)

'Three pounds -- it's just for smack -- a bag costs a tenner,' sniffs Sam.  
**Alexander Masters** STUART: A LIFE BACKWARDS (2005)

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What's the opposite of  **Find It!** A B C D E F G H I J K L M N O P Q R S T U V W X Y Z

Meaning of the word  **Find It!**

Sentences with the word  **Find It!**

Words that rhyme with  **Find It!**

Pronounce the word  **Say It!**

Translate the Word  from Italian to English **Translate!**

Find the  Plural  **Find It!**

Find Words  All Words  Starting With  **Find It!**

### What is the meaning of the Italian word bacio?

#### English words for the Italian word bacio

kiss

#### More Words

- What is the meaning of the Italian word bacio appassionato?
- What is the meaning of the Italian word bacione?
- What is the meaning of the Italian word baco?
- What is the meaning of the Italian word baco da seta?
- What is the meaning of the Italian word bacolo?
- What is the meaning of the Italian word bacucco?

GET THE BONUS FIND A BRANCH Capital One Bank  
 WITH A BONUS OF **\$300**

What is the meaning of the Italian word bacio appassionato?  
What is the meaning of the Italian word bacione?  
What is the meaning of the Italian word bacio?  
What is the meaning of the Italian word bacio da seta?  
What is the meaning of the Italian word bacio?  
What is the meaning of the Italian word bacucco?

#### Translations for Other Languages

What is the Dutch word for kiss?  
What is the French word for kiss?  
What is the German word for kiss?  
What is the Portuguese word for kiss?  
What is the Spanish word for kiss?



## Restaurant Reviews- Bacio Means KISS- Las Vegas

Restaurant Openings, Tropicana Hotel,

 **Sandy Zimmerman**, Yahoo! Contributor Network  
May 23, 2011 "Share your voice on Yahoo! websites. [Start Here.](#)"

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**(Photos By Sandy Zimmerman)**  
The band was playing while guests filled the restaurant; it was a food tasting party to introduce the press and VIP's to Bacio by Carla Pellegrino's Mediterranean cuisine.

The moment you see the restaurant, your first impression is of a charming sidewalk cafe in Italy or on one of the Greek islands. I liked the restaurant's design flowing from the gate around the

enclosed patio with open windows facing into the dining room. Inside you have a choice of a pool view along the wall of windows or people watching.

I walked around the buffet table and was thrilled to see all of the selections. Once I noticed Carla's jumbo shrimp I was hooked! Their jumbo shrimp were really jumbo, six to a pound, and tasted great with a delicate butter, garlic, and lemon juice sauce. The shrimp were not swimming in the sauce, yet they held the taste in every bite.

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The shrimp were not swimming in the sauce, yet they held the taste in every bite. With such large shrimp, I decided to make them my meal along with some of the caprese and spinach salads. There were several different Italian rolls and bread as well as bread sticks. A chef stood at the carving section ready to cut your port reduction crusted ribeye exactly to your specifications.

Of course Carla's menu also offers pasta, not only one or two choices but penne, spaghetti, linguine, and rigatoni. Just add a bit of fresh Buffalo Mozzarella and what a meal!

I had a chance to interview Carla Pellegrino during the party. Carla expressed her feelings, "I'm happy everybody RSVP'D and everybody is here. We have all of the foodies, all the media, and I am so happy. I feel loved right now. Once you cross my door, you are family. You will find a lot of seafood, risottos, and especially lighter food, that's from where I lived, in Liguria, Northern Italy."

Sandy: "This style of cooking is healthier than the thick sauces and heavier meals served in other Italian provinces. I think it is always important when a restaurant provides a healthy menu for their guests."

Carla answered, "We make everything fresh day by day. You will eat like your mom's cooking for you.

I felt, "Better than your mom sometimes."

Carla laughed, "Thank you. I do respect my guests and know the American culture's love for spaghetti and meat balls with thick meat sauce. I keep that for my guests who want it. But healthy meals don't have thick sauces so you won't feel guilty. They need to be fresh, light, and well seasoned. The entire menu features my recipes and specialties. I enjoy when people are happy and love to see them eat. I put a lot of love in my cooking and really love what I do." Sandy, "You are brimming with happiness! Everyone can tell how enthused you are."

Carla added, "Another reason I am excited is the opportunity to work with those brilliant men who did wonders with the new Tropicana. I am happy and proud to be a part of it."

Carla's passion for food brought her to the United States where she found love and success. Carla married Frank Pellegrino, the owner of Rao's, in Harlem, and they

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success. Carla married Frank Pellegrino, the owner of Kao S, in Miami, and they opened the Baldoria Restaurant in New York's theater district, in 2000. After beating the celebrity chef Bobby Flay on his annual Christmas "Throwdown" on the Food Network, she cooked on the "Today Show" and is a VIP member of the James Beard Foundation and a Woman in Food Honoree at the 2009 James Beard Foundation Awards gala.

Bacio means "KISS", Carla would love to kiss your lips with her food! For information, call (800)-462-8767.

The Bacio by Carla Pellegrino is located on the Mezzanine, just take the elevator or escalator, inside the Tropicana Hotel, Las Vegas Boulevard and Tropicana Avenue, in Las Vegas. [www.tropiv.com/dining/bacio](http://www.tropiv.com/dining/bacio)

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**To:** TROPICANA LAS VEGAS, INC. ([jblinderman@glaserweil.com](mailto:jblinderman@glaserweil.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85450247 - BACIO - T-4  
**Sent:** 8/18/2012 1:42:42 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 8/18/2012 FOR  
SERIAL NO. 85450247**

Please follow the instructions below to continue the prosecution of your application:

**TO READ OFFICE ACTION:** Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

**RESPONSE IS REQUIRED:** You should carefully review the Office action to determine (1) how to respond; and (2) the applicable [response time period](#). Your response deadline will be calculated from 8/18/2012 (or sooner if specified in the office action).

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System [Response Form](#).**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

**Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.**

**Exhibit B**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Trademark Application of Tropicana Las Vegas, Inc.

For: BACIO

Serial No.: 85/450,247

Filed: October 18, 2011

Examining Attorney: Sally Shih

Law Office: 106

RESPONSE TO OFFICE ACTION,  
MAILED 02/05/2012

**RESPONSE TO OFFICE ACTION**

Applicant respectfully submits this response to the non-final Office Action mailed February 5, 2012 concerning the above referenced Application.

Applicant respectfully disagrees with the Examining Attorney's refusal to register BACIO based on the determination that there is likelihood of confusion with the mark KISS, U.S. Registration No. 3,307,901, for use in connection with restaurant services, cafes, coffee bars and coffee house services; and carry-out restaurant and food preparation pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), and the Trademark Manual of Examining Procedure ("TMEP") §§1207.01 *et seq.* Reconsideration is requested on the grounds that BACIO and KISS are not foreign equivalents and the marks are not confusingly similar in appearance, sound, meaning, connotation or commercial impression.

**The Marks Are Not Foreign Equivalents**

"Bacio" is not the foreign equivalent of "kiss" and the doctrine of foreign equivalents is not properly applied here because it is unlikely that the ordinary buyer would "stop and translate" the word "bacio" into "kiss". Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity in meaning and connotation with English word marks. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 U.S.P.Q. 2d 1689, 1696 (Fed. Cir. 2005). However, the law is well established that the doctrine of foreign equivalents is a guideline and not an absolute rule and will not be applied where it is unlikely that an ordinary American buyer would "stop and translate" the word into its English equivalent. *Palm Bay Imports, Inc.*, 73 U.S.P.Q. 2d 1689; TMEP §1207.01(b)(vi) (finding the average purchaser would not translate "VEUVE" into "widow"); *see also In re Tia Maria, Inc.*, 188 U.S.P.Q. 524 (T.T.A.B. 1975) (no likelihood of confusion between TIA MARIA for a Mexican restaurant and AUNT MARY'S for canned vegetables).

In particular, the doctrine of equivalents is not applicable in the instant case because “kiss” is only one of multiple acceptable translations of “bacio” in English. As is set forth in TMEP §§809.1 and 809.2, only a translation that is a clear and exact equivalent should be printed, and moreover, the existence of multiple translations, as here, usually indicates that there is no clear equivalent:

“Sometimes translations that are not precise, or that give a variety of meanings, are placed in the record. While all possible translations, and discussions relative to meaning, are useful for informational purposes, not all such matter is appropriate for printing in the Official Gazette or on the certificate of registration. **Only a translation that is the clear and exact equivalent (see TMEP §809.01) should be printed.** This normally means only one translation, because **the existence of a variety of alternative translations or general explanations usually indicates a lack of a clearly recognized equivalent meaning.**” (emphasis added).

Although Applicant provided in the Application that the English translation of “bacio” is “kiss”, Applicant never represented “kiss” to be the sole translation. In fact, a quick search performed on a reputable online translation dictionary, Google Translate, reveals that “kiss” is not the only translation of “bacio”. According to Google Translate, “bacio” can also mean “smack” or “smacker”, which has a very different meaning from “kiss” in English. See a true and correct copy of a printout from <http://translate.google.com/> depicting the Google Translate translation of “bacio” below. The existence of other acceptable translations of “bacio” besides “kiss”, with very different meanings, indicates that there is no clear English equivalent.

Google Translate

<http://translate.google.com/>

+You Search Images Maps Play YouTube News Gmail Documents Calendar More +

Google

Try a new browser with automatic translation. [Download Google Chrome](#) [Dismiss](#) [Sign in](#)

Translate From: Italian To: English Translate

Spanish **Italian** English English Spanish Arabic

bacio

kiss

New! Click the words above to edit and view alternate translations. [Dismiss](#)

**noun**

kiss	bacio
smack	schiaffo, schiocco, ceffone, pacca, bacio, gusto
smacker	sterlina, pezzo, bacio, dollaro

Google Translate for Business: [Translator Toolkit](#) [Website Translator](#) [Global Market Finder](#)

Additionally, it is unlikely that the ordinary consumer would “stop and translate” the word “bacio” used as the name of a restaurant into any English equivalent. It has become a recent trend to name restaurants using foreign words, particularly in Las Vegas where the flagship BACIO restaurant is located, and consumers have grown accustomed to referring to these restaurants by their one-word foreign names. (See, e.g. Ago (meaning “needle” in Italian), Japonais (meaning “Japanese” in French), Aureole (meaning “haloes” in Italian) and Tableau (meaning “table” in French)). Further, even if a consumer were so compelled to translate “bacio”, they could very well translate “bacio” into one of the other acceptable meanings such as “smack”. Thus, the doctrine of equivalents does not apply to “bacio” and “kiss” and there is no likelihood of confusion between BACIO and KISS.

### **There is no Likelihood of Confusion**

In addition to the fact that BACIO and KISS are not foreign equivalents, there is no likelihood of confusion as the marks are quite dissimilar in several respects. In a likelihood of confusion determination, the court applies the thirteen factors set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Here, the first *DuPont* factor requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc.*, 396 F.3d 1369, 1371 (citing *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361.). In the instant case, however, no weight has been given to the significant dissimilarities between the marks BACIO and KISS, and the inquiry relied entirely on the doctrine of foreign equivalents, which is not applicable here, as established above. The proper analysis should not focus on the sole similar translation of “bacio” to “kiss”, but rather a comparison of the marks in their entirety: the mark “BACIO” with the mark “KISS”. *Id.*

Appearance. Applicant’s mark BACIO is visually dissimilar from Registrant’s mark KISS. The marks do not contain any of the same letters, except “I”, and are spelled completely differently. See, *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374-75 (Fed. Cir. 1998) (finding “CRISTAL” and “CRYSTAL CREEK” dissimilar). In addition, the KISS mark depicted in U.S. Registration No. 3,307,901, is actually a stylized word mark, shown below, that is commonly associated with the famous band, Kiss. The additional matter depicted in the stylized KISS mark, including the distinctive block lettering and jagged design, further distinguishes the KISS mark from BACIO. See *China Healthways Institute, Inc. v. Wang*, 83 U.S.P.Q. 2d 1123 (Fed. Cir. 2007) (finding CHI PLUS in the stylized form not confusingly similar to the stylized mark CHI & Design both for electrical massagers because “the marks are distinguished by their respective additional matter”). This is especially true when the stylized KISS mark is compared to BACIO as it is displayed in the specimen submitted with the Application, a true and correct copy of which is shown below.

<p align="center"><b>BACIO Word Mark, U.S. Serial No. 85/450,247</b></p>	<p align="center"><b>BACIO Specimen, U.S. Serial No. 85/450,247</b></p>
<p align="center"><b>BACIO</b></p>	



Sound. Applicant’s BACIO sounds nothing like Registrant’s mark KISS. Marks much more similar in sound than the marks in the instant case have been found not confusingly similar. See e.g. *Coca-Cola Co. v. Essential Products Co.*, 421 F.2d 1374, 1376 (C.C.P.A. 1970) (the Court of Customs and Patent Appeals found COCO LOCO not to be similar to COCA COLA). Here, BACIO sounds much less like KISS than COCO LOCO sounds like COCA COLA. Further, BACIO contains three syllables, while KISS is monosyllabic. Furthermore, the marks do not contain any of the same phonetic sounds, are different in rhythm and cadence and the words are not pronounced similarly. As BACIO and KISS sound completely dissimilar, there can be no likelihood of confusion on the basis of sound.

Connotation and Commercial Impression. Although BACIO and KISS are both used on or in connection with restaurants, the similarities in commercial impression end there. Commercial impression has been described as “what the probable impact will be on the ordinary purchaser in the marketplace.” *T. W. Samuels Distillery, Inc. v. Schenley Distillers, Inc.*, 458 F.2d 1403, 1404 (C.C.P.A. 1972). Here, BACIO, an Italian word, used in connection with a restaurant, conjures the impression of a charming trattoria, and gives the general consumer an

idea of the type of authentic fresh Italian cuisine, white-linen ambiance and impeccable service he or she will encounter there. On the other end of the spectrum, the stylized mark KISS, as discussed above, is clearly and immediately associated in the minds of consumers with the famously outlandish rock band, Kiss. As the term “kiss” is not associated with any particular cuisine, when used in connection with a restaurant Registrant’s mark KISS gives the impression that the restaurant is associated with the band Kiss. Accordingly, consumers would expect the KISS restaurant to play music by Kiss and be decorated with classic memorabilia related to the band. In no way does the mark KISS connote an upscale Italian restaurant, and the mark BACIO has nothing to do with the band Kiss. Accordingly the marks BACIO and KISS do not convey a similar commercial impression whatsoever and they are not confusingly similar.

*Relatedness of Goods and Services.* Applicant respectfully disagrees with the Examining Attorney’s determination that all Applicant’s marks’ goods and services are “closely related, even identical” to Registrant’s mark’s goods and services. In fact, the only service BACIO and KISS have in common is restaurant services. Besides restaurant services, Registrant’s KISS mark is also for use on or in connection with cafes, coffee bars, coffee house services and carry-out restaurant and food preparation. To the contrary, Applicant’s BACIO mark is used on or in connection with bar services, cafe services, and hotel services in addition to restaurant services. Registrant’s listing of goods and services for KISS makes no mention whatsoever of bars or hotel services. Additionally, BACIO is not used on or in connection with coffee bars or coffee house services, or with carry-out restaurant and food preparation. As only one service overlaps, all the goods and services of BACIO and KISS cannot be deemed “closely related or even identical”.

### **The Prior Pending Application for KISS, Serial No. 85/412,901 was Abandoned**

On July 18, 2012 the Applicant of the mark, KISS, Serial No. 85/412,901 filed a Notice of Abandonment with the USPTO. Accordingly, there can be no conflict between BACIO and the prior pending application of KISS, Serial No. 85/412,901, and BACIO should not be refused registration on that basis.

### **BACIO Is Entitled to Registration**

As can be seen from the foregoing, the doctrine of equivalents is not applicable here as “kiss” is but one of multiple translations of “bacio”. Further, even if the doctrine of equivalents were to apply, given the fact that other translations such as “smack” have completely different meanings and connotations from “kiss”, the doctrine should be given very little weight in considering whether confusion is likely. Further, examination of the appearance, sound, connotation and commercial impression of BACIO and KISS demonstrates that consumers are not likely to believe the goods and services associated with BACIO come from the same source as the goods and services associated with KISS. Accordingly, Applicant respectfully submits that BACIO, as found in the instant Application, is entitled to registration on the Principal Register.

## **Exhibit C**

Sign in

Translate From: Latin ▾ To: English ▾ Translate

Spanish Lao Latin Detect language

English Spanish Arabic

bacio

berries

Translate from: Italian

Alpha

New! Click the words above to edit and view alternate translations. Dismiss

Google Translate for Business: [Translator Toolkit](#) [Website Translator](#) [Global Market Finder](#)

Sign in

Translate

From: Portuguese ▾

To: English ▾

Translate

Spanish Portuguese Latin Detect language

English Spanish Arabic

bacio

potty

New! Hold down the shift key, click, and drag the words above to reorder. [Dismiss](#)

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Sign in

Translate

From: Croatian ▾

To: English ▾

Translate

Croatian

Portuguese

Latin

Detect language

English

Spanish

Arabic

bacio

threw

New! Hold down the shift key, click, and drag the words above to reorder. [Dismiss](#)

Google Translate for Business: [Translator Toolkit](#) [Website Translator](#) [Global Market Finder](#)

Sign in

Translate From: Serbian ▾ To: English ▾ Translate

Croatian Portuguese Serbian Detect language

English Spanish Arabic

bacio

threw

New! Hold down the shift key, click, and drag the words above to reorder. Dismiss

Google Translate for Business: Translator Toolkit Website Translator Global Market Finder

Sign in

Translate

From: Spanish ▾

To: English ▾

Translate

Croatian

Spanish

Serbian

Detect language

English

Spanish

Arabic

bacio

Unfurnished

New! Hold down the shift key, click, and drag the words above to reorder. [Dismiss](#)

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## **Exhibit D**

# Italian language in the United States

From Wikipedia, the free encyclopedia

The Italian language has been a widely spoken language in the United States of America for more than one hundred years, due to large-scale immigration beginning in the late 19th century. Today it is the eighth most spoken language in the country.

## Contents

- 1 History
  - 1.1 During World War II
- 2 The language today
  - 2.1 Forms of Italian
- 3 Media
- 4 See also
- 5 References

### Italian speakers in the US

Year	Speakers
1910 <sup>a</sup>	1,365,110
1920 <sup>a</sup>	1,624,998
1930 <sup>a</sup>	1,808,289
1940 <sup>a</sup>	1,561,100
1960 <sup>a</sup>	1,277,585
1970 <sup>a</sup>	1,025,994
1980 <sup>[1]</sup>	1,618,344
1990 <sup>[2]</sup>	1,308,648
2000 <sup>[3]</sup>	1,008,370

<sup>a</sup> Foreign-born population only<sup>[4]</sup>

## History

The first Italian Americans began to immigrate en masse began around 1880. The first Italian immigrants, mainly from Sicily and other parts of Southern Italy, were largely men, and many planned to return to the Italy after making money in the US, so the speaker population of Italian was not always constant or continuous. Between 1890 and 1900, 655,888 Italians went to the United States, and more than 2 million between 1900 and 1910, though around 40% of these eventually returned to Italy. All told, between 1820 and 1978, some 5.3 million Italians went to the United States. Like many ethnic groups, such as the Germans in Little Germany, French Canadians in Little Canadas, and Chinese in Chinatowns, who emigrated to the Americas, the Italians often lived in ethnic enclaves, often known as Little Italies, especially in New York City, Chicago, Boston, and Philadelphia, and continued to speak their original languages.



In Little Italy, Chicago, some Italian language signage is visible (e.g. *Banca Italiana*)

## During World War II

During World War Two, use of Italian languages in the U.S. was discouraged. In addition, many Italian-Americans were interned [1] ([http://www.usdoj.gov/crt/Italian\\_Report.pdf](http://www.usdoj.gov/crt/Italian_Report.pdf)) , property was confiscated [2] ([http://www.usdoj.gov/crt/Italian\\_Report.pdf](http://www.usdoj.gov/crt/Italian_Report.pdf)) , and Italian-language periodicals were closed<sup>[citation needed]</sup>.

## The language today

Today, though 15,638,348 American citizens report themselves as Italian Americans, only 1,008,370 of these



report speaking an Italian language at home (0.384% of the national population). But Italian is the 3rd foreign language spoken at home in US and it represents the 2nd largest ethnic market in the US behind only the Hispanic market.<sup>[6]</sup> Cities with Italian and Sicilian speaking communities include Buffalo, Chicago, Miami, New York City and Philadelphia. Assimilation has played a large role in the decreasing amount of Italian speakers today. Of those who speak Italian at home in the United States, 361,245 are over the age of 65, and only 68,030 are below

the age of 17.

Despite it being the fifth most studied language in higher education (college & graduate) settings throughout America,<sup>[7]</sup> the Italian language has struggled to maintain being an AP course of study in high schools nationwide. It was only in 2006 where AP Italian classes were first introduced, and they were soon dropped from the national curricula after the spring of 2009.<sup>[8]</sup> The organization which manages such curricula, the College Board, ended the AP Italian program because it was "losing money" and had failed to add 5,000 new students each year. Since the programs termination in the spring of 2009, various Italian organizations and activists have attempted to revive the course of study. For example, Margaret Cuomo, sister of New York Governor Andrew Cuomo, was the impetus for the program's birth in 2006 and is currently attempting to secure funding and teachers to reinstate the program. Also, Italian organizations have begun fundraisers to revive AP Italian. Organizations such as the National Italian American Foundation (NIAF) and Order Sons of Italy in America have made strides in collecting money, and are prepared to aid in the monetary responsibility any new AP Italian program would bring with it.

Moreover, web based Italian organizations, such as ItalianAware (<http://www.ItalianAware.com>), have begun book donation campaigns to improve the status and representation of Italian language and Italian/ Italian American literature in New York Public Libraries. According to ItalianAware, the Brooklyn Public Library is the worst offender in New York City.<sup>[9]</sup> It has 11 books pertaining to the Italian language and immigrant experience available for checkout spread across 60 branches. That amounts to 1 book for every 6 branches in Brooklyn, which (according to ItalianAware) cannot supply the large Italian/Italian American community in Brooklyn, New York. ItalianAware aims to donate 100 various books on the Italian/ Italian American experience, written in Italian or English, to the Brooklyn Public Library by the end of 2010.

## Forms of Italian

Traditionally, most Italian Americans did not speak Standard Italian which originated from the regional Tuscan dialect. Instead they spoke other Italo-Romance varieties, particularly from Southern Italy, such as Calabrese, Neapolitan, and other Southern Italian dialects, as well as the Sicilian language. Today, the Standard Italian



Current distribution of the Italian language in the United States.

**Italian speakers by states in 2000<sup>[5]</sup>**

State	Italian speakers	% of all Italian speakers
New York	294,271	29%
New Jersey	116,365	12%
California	84,190	8%
Pennsylvania	70,434	7%
Florida	67,257	6%
Massachusetts	59,811	6%
Illinois	51,975	5%
Connecticut	50,891	5%

language, which is most similar to the Tuscan dialect (although not the same), is used in schools instead of the other dialects and languages.

## Media

Although the Italian language is much less used today than it has been previously, there are still several Italian-only media outlets, among which are the New Jersey daily paper *America Oggi* and ICN Radio.

*Il Progresso Italo Americano* was edited by Carlo Barsotti (1850–1927).<sup>[10]</sup>

*Arba Sicula* (Sicilian Dawn) is a semiannual publication of the society of the same name, dedicated to preserving the Sicilian language. The magazine and a periodic newsletter offer prose, poetry and comment in Sicilian, with adjacent English translations.

## See also

- Italian American internment
- Languages of the United States

## References

- ↑ "Appendix Table 2. Languages Spoken at Home: 1980, 1990, 2000, and 2007." (<https://www.census.gov/hhes/socdemo/language/data/acs/Table2.xls>) . United States Census Bureau. <https://www.census.gov/hhes/socdemo/language/data/acs/Table2.xls>. Retrieved August 6, 2012.
- ↑ "Detailed Language Spoken at Home and Ability to Speak English for Persons 5 Years and Over --50 Languages with Greatest Number of Speakers: United States 1990" (<http://www.census.gov/hhes/socdemo/language/data/census/table5.txt>) . United States Census Bureau. 1990. <http://www.census.gov/hhes/socdemo/language/data/census/table5.txt>. Retrieved July 22, 2012.
- ↑ "Language Spoken at Home: 2000" ([http://factfinder2.census.gov/faces/tableservices/jsf/pages/productview.xhtml?pid=DEC\\_00\\_SF3\\_QTP16&prodType=table](http://factfinder2.census.gov/faces/tableservices/jsf/pages/productview.xhtml?pid=DEC_00_SF3_QTP16&prodType=table)) . United States Bureau of the Census. [http://factfinder2.census.gov/faces/tableservices/jsf/pages/productview.xhtml?pid=DEC\\_00\\_SF3\\_QTP16&prodType=table](http://factfinder2.census.gov/faces/tableservices/jsf/pages/productview.xhtml?pid=DEC_00_SF3_QTP16&prodType=table). Retrieved August 8, 2012.
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- ↑ "Table 5.Detailed List of Languages Spoken at Home for the Population 5 Years and Over by State: 2000" (<http://www.census.gov/population/cen2000/phc-t20/tab05.pdf>) . United States Census Bureau. February 25, 2003. <http://www.census.gov/population/cen2000/phc-t20/tab05.pdf>. Retrieved October 3, 2012.
- ↑ Capricorn Agency, [http://netcapricorn.com/newsletter/italian\\_ethnic\\_market.html](http://netcapricorn.com/newsletter/italian_ethnic_market.html)
- ↑ [http://www.vistawide.com/languages/us\\_languages.htm](http://www.vistawide.com/languages/us_languages.htm)
- ↑ Pilon, Mary (2010-05-10). "Italian Job: Resurrect the AP Exam" ([http://online.wsj.com/article/SB10001424052748703674704575234232176866638.html?mod=WSJ\\_hpp\\_MIDDLENexttoWhatsNewsForth](http://online.wsj.com/article/SB10001424052748703674704575234232176866638.html?mod=WSJ_hpp_MIDDLENexttoWhatsNewsForth)) . *The Wall Street Journal*. [http://online.wsj.com/article/SB10001424052748703674704575234232176866638.html?mod=WSJ\\_hpp\\_MIDDLENexttoWhatsNewsForth](http://online.wsj.com/article/SB10001424052748703674704575234232176866638.html?mod=WSJ_hpp_MIDDLENexttoWhatsNewsForth).
- ↑ [www.italianaware.com/literaturedonations](http://www.italianaware.com/literaturedonations)
- ↑ "Verdi Monument - Historical Sign" ([http://www.nycgovparks.org/sub\\_your\\_park/historical\\_signs/hs\\_historical\\_sign.php?id=12899](http://www.nycgovparks.org/sub_your_park/historical_signs/hs_historical_sign.php?id=12899)) . Nycgovparks.org. [http://www.nycgovparks.org/sub\\_your\\_park/historical\\_signs/hs\\_historical\\_sign.php?id=12899](http://www.nycgovparks.org/sub_your_park/historical_signs/hs_historical_sign.php?id=12899). Retrieved 2010-03-11.

- <http://www.spartacus.schoolnet.co.uk/USAEItaly.htm>
- US Demographic Census ([http://factfinder.census.gov/servlet/IPTable?\\_bm=y&-reg=ACS\\_2005\\_EST\\_G00\\_S0201:543;ACS\\_2005\\_EST\\_G00\\_S0201PR:543;ACS\\_2005\\_EST\\_G00\\_S0201T:543;ACS\\_2005\\_EST\\_G00\\_S0201TPR:543&-qr\\_name=ACS\\_2005\\_EST\\_G00\\_S0201&-qr\\_name=ACS\\_2005\\_EST\\_G00\\_S0201PR&-qr\\_name=ACS\\_2005\\_EST\\_G00\\_S0201T&-qr\\_name=ACS\\_2005\\_EST\\_G00\\_S0201TPR&-ds\\_name=ACS\\_2005\\_EST\\_G00\\_-TABLE\\_NAMEX=&-ci\\_type=A&-redoLog=false&-charIterations=031&-geo\\_id=01000US&-format=&-\\_lang=en](http://factfinder.census.gov/servlet/IPTable?_bm=y&-reg=ACS_2005_EST_G00_S0201:543;ACS_2005_EST_G00_S0201PR:543;ACS_2005_EST_G00_S0201T:543;ACS_2005_EST_G00_S0201TPR:543&-qr_name=ACS_2005_EST_G00_S0201&-qr_name=ACS_2005_EST_G00_S0201PR&-qr_name=ACS_2005_EST_G00_S0201T&-qr_name=ACS_2005_EST_G00_S0201TPR&-ds_name=ACS_2005_EST_G00_-TABLE_NAMEX=&-ci_type=A&-redoLog=false&-charIterations=031&-geo_id=01000US&-format=&-_lang=en))
- MLA Data Center Results for Italian ([http://www.mla.org/cgi-shl/docstudio/docs.pl?map\\_data\\_states](http://www.mla.org/cgi-shl/docstudio/docs.pl?map_data_states))
- *America Oggi* (<http://www.americaoggi.info>)
- *ICN Radio* (<http://www.ICNRADIO.com>)

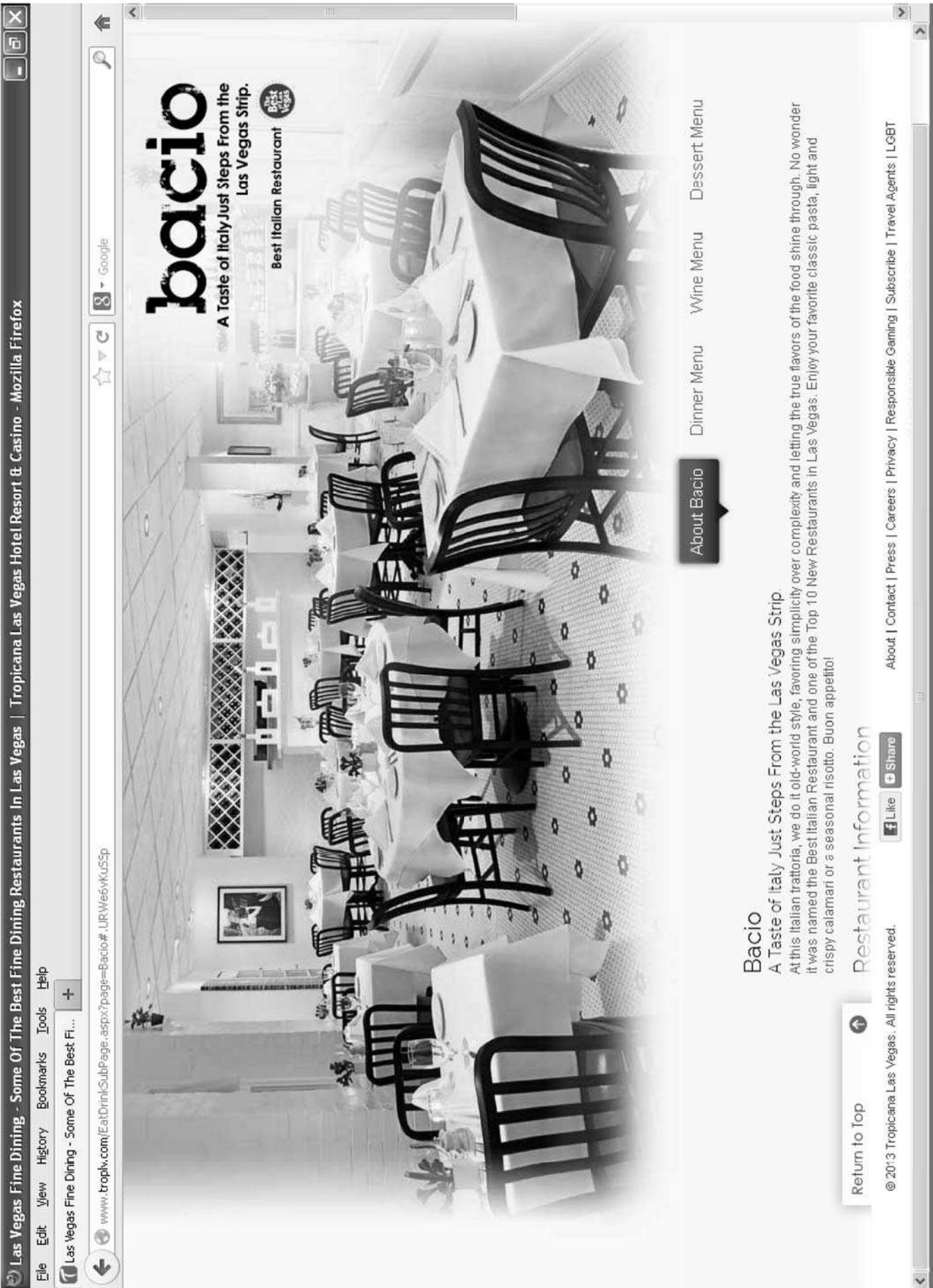
Retrieved from "[http://en.wikipedia.org/w/index.php?title=Italian\\_language\\_in\\_the\\_United\\_States&oldid=523253013](http://en.wikipedia.org/w/index.php?title=Italian_language_in_the_United_States&oldid=523253013)"

Categories: Italian-American culture | Italian language | Languages of the United States

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**Exhibit E**



# bacio

A Taste of Italy Just Steps From the Las Vegas Strip.

Best Italian Restaurant **Best of Las Vegas**

About Bacio

Dinner Menu

Wine Menu

Dessert Menu

## Bacio

A Taste of Italy Just Steps From the Las Vegas Strip.

At this Italian trattoria, we do it old-world style, favoring simplicity over complexity and letting the true flavors of the food shine through. No wonder it was named the Best Italian Restaurant and one of the Top 10 New Restaurants in Las Vegas. Enjoy your favorite classic pasta, light and crispy calamari or a seasonal risotto. Buon appetito!

## Restaurant Information

Return to Top

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**Exhibit F**

# Trademark/Service Mark Application, Principal Register

## TEAS Plus Application

**Serial Number: 85450247**

**Filing Date: 10/18/2011**

***NOTE: Data fields with the \* are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.***

**The table below presents the data as entered.**

Input Field	Entered
TEAS Plus	YES
<b>MARK INFORMATION</b>	
*MARK	<u>BACIO</u>
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BACIO
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
<b>REGISTER</b>	Principal
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	TROPICANA LAS VEGAS, INC.
*STREET	3801 LAS VEGAS BLVD., SOUTH
*CITY	LAS VEGAS
*STATE (Required for U.S. applicants)	Nevada
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	89109
<b>LEGAL ENTITY INFORMATION</b>	
*TYPE	CORPORATION

* STATE/COUNTRY OF INCORPORATION	Nevada
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
* INTERNATIONAL CLASS	043
IDENTIFICATION	Bar and restaurant services; Cafe and restaurant services; Hotel, bar and restaurant services
* FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 05/11/2011
FIRST USE IN COMMERCE DATE	At least as early as 05/11/2011
SPECIMEN FILE NAME(S)	<u>\\TICRS\EXPORT11\IMAGEOUT11\854\502\85450247\xml1\FTK0003.JPG</u>
SPECIMEN DESCRIPTION	A scanned image of applicant's web site, advertising applicant's services.
<b>ADDITIONAL STATEMENTS SECTION</b>	
*TRANSLATION (if applicable)	The English translation of bacio in the mark is kiss.
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
<b>ATTORNEY INFORMATION</b>	
NAME	JONATHAN BLINDERMAN
ATTORNEY DOCKET NUMBER	T-4
FIRM NAME	GLASER WEIL FINK JACOBS HOWARD AVCHEN & SHAPIRO, LLC
INTERNAL ADDRESS	19TH FLOOR
STREET	10250 CONSTELLATION BLVD.,
CITY	LOS ANGELES
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	90067

<b>PHONE</b>	310 553 3000
<b>FAX</b>	310 843 2681
<b>EMAIL ADDRESS</b>	jblinderman@glaserweil.com
<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>OTHER APPOINTED ATTORNEY</b>	MARVIN H KLEINBERG MARY ANN T. NGUYEN
<b>CORRESPONDENCE INFORMATION</b>	
<b>*NAME</b>	JONATHAN BLINDERMAN
<b>FIRM NAME</b>	GLASER WEIL FINK JACOBS HOWARD AVCHEN & SHAPIRO, LLC
<b>INTERNAL ADDRESS</b>	19TH FLOOR
<b>*STREET</b>	10250 CONSTELLATION BLVD.,
<b>*CITY</b>	LOS ANGELES
<b>*STATE (Required for U.S. applicants)</b>	California
<b>*COUNTRY</b>	United States
<b>*ZIP/POSTAL CODE</b>	90067
<b>PHONE</b>	310 553 3000
<b>FAX</b>	310 843 2681
<b>*EMAIL ADDRESS</b>	jblinderman@glaserweil.com
<b>*AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>FEE INFORMATION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>FEE PER CLASS</b>	275
<b>*TOTAL FEE PAID</b>	275
<b>SIGNATURE INFORMATION</b>	
<b>* SIGNATURE</b>	/marvin h. kleinberg/
<b>* SIGNATORY'S NAME</b>	MARVIN H. KLEINBERG
<b>* SIGNATORY'S POSITION</b>	Attorney of record, CA bar member
<b>* DATE SIGNED</b>	10/18/2011

## Trademark/Service Mark Application, Principal Register

### TEAS Plus Application

**Serial Number: 85450247**

**Filing Date: 10/18/2011**

#### To the Commissioner for Trademarks:

**MARK:** BACIO (Standard Characters, see [mark](#))

The literal element of the mark consists of BACIO.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, TROPICANA LAS VEGAS, INC., a corporation of Nevada, having an address of  
3801 LAS VEGAS BLVD., SOUTH  
LAS VEGAS, Nevada 89109  
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

**For specific filing basis information for each item, you must view the display within the Input Table.**

International Class 043: Bar and restaurant services; Cafe and restaurant services; Hotel, bar and restaurant services

In International Class 043, the mark was first used at least as early as 05/11/2011, and first used in commerce at least as early as 05/11/2011, and is now in use in such commerce. The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) A scanned image of applicant's web site, advertising applicant's services..

[Specimen File 1](#)

The English translation of bacio in the mark is kiss.

The applicant's current Attorney Information:

JONATHAN BLINDERMAN and MARVIN H KLEINBERG MARY ANN T. NGUYEN of GLASER  
WEIL FINK JACOBS HOWARD AVCHEN & SHAPIRO, LLC

19TH FLOOR  
10250 CONSTELLATION BLVD.,  
LOS ANGELES, California 90067  
United States

The attorney docket/reference number is T-4.

The docket/reference number is T-4.

The applicant's current Correspondence Information:

JONATHAN BLINDERMAN

GLASER WEIL FINK JACOBS HOWARD AVCHEN & SHAPIRO, LLC

19TH FLOOR

10250 CONSTELLATION BLVD.,

LOS ANGELES, California 90067

310 553 3000(phone)

310 843 2681(fax)

jblinderman@glaserweil.com (authorized)

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1 class(es).

#### **Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /marvin h. kleinberg/ Date Signed: 10/18/2011

Signatory's Name: MARVIN H. KLEINBERG

Signatory's Position: Attorney of record, CA bar member

RAM Sale Number: 4414

RAM Accounting Date: 10/19/2011

Serial Number: 85450247

Internet Transmission Date: Tue Oct 18 17:55:12 EDT 2011

TEAS Stamp: USPTO/FTK-12.198.27.100-2011101817551278

2883-85450247-48092be9698c36a33ed703262e

d64474c53-CC-4414-20111018174029826088

# BACIO

CHECK AVAILABILITY

I'm Looking For:

- Rooms & Suites
- Shows & Events
- Dinner Reservations

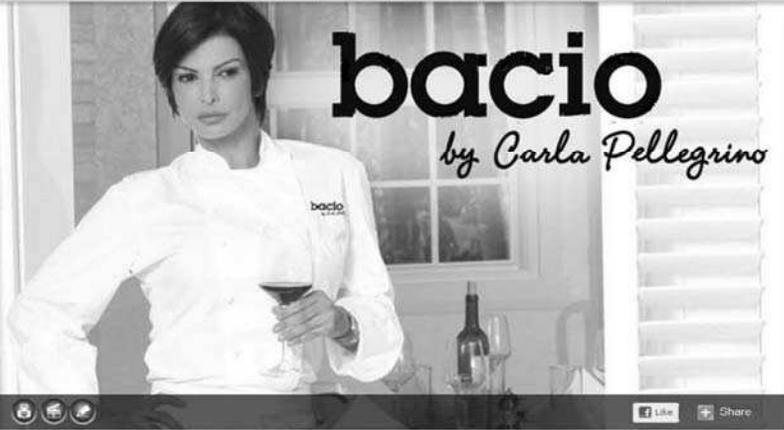
GO

DINING

- Biscayne
- Bacio
- Café Nikki
- Dining Special Offers

Sign Up For  
Exclusive Offers

GO



RECYCLED PERCUSSION



Bacio By Carla Pellegrino

Reservations

**Cuisine Type:** Italian  
**Hours:** 5pm - 10:30pm  
*Open 7 days a week*  
**Reservations:** Make a [Reservation Online](#) or call  
[800.462.8267](tel:800.462.8267)  
**Average Price:** \$\$  
[Dinner Menu](#) | [Happy Prefix Menu](#)

A Taste of Italy Just Steps from The Las Vegas Strip

Bacio By Carla Pellegrino is a charming trattoria specializing in authentic Italian fare. Using only the freshest and most choice ingredients, we prepare signature salads, pastas, pizzas, and more.

At this Las Vegas Restaurant, we do it old-world style, favoring simplicity over complexity and letting the true flavors of the food shine through. Enjoy your favorite **classic pasta**, **light and crispy calamari** or a **seasonal risotto**. And don't forget to check the wine list, our selection is carefully crafted to bring out the best in our signature dishes.

*Buon appetito!*

72 HOUR SALE!

**72 HOUR SALE!**  
UP TO 20% OFF

TROPICABANA HOTEL EXPERIENCE

**Tropicabana**

GLADYS KNIGHT PERFORMING LIVE



Las Vegas Mob Experience



## **Exhibit G**

**To:** TROPICANA LAS VEGAS, INC. ([jblinderman@glaserweil.com](mailto:jblinderman@glaserweil.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85450247 - BACIO - T-4  
**Sent:** 2/5/2012 11:48:51 AM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 85450247

**MARK:** BACIO

**\*85450247\***

**CORRESPONDENT ADDRESS:**

JONATHAN BLINDERMAN  
GLASER WEIL FINK JACOBS HOWARD  
AVCHEN &  
10250 CONSTELLATION BLVD FL 19  
LOS ANGELES, CA 90067-6219

**CLICK HERE TO RESPOND TO THIS LETTER:**  
[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

**APPLICANT:** TROPICANA LAS VEGAS,  
INC.

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:**

T-4

**CORRESPONDENT E-MAIL ADDRESS:**

[jblinderman@glaserweil.com](mailto:jblinderman@glaserweil.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 2/5/2012

**TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT**

**FEE:** Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

### **SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3307901. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re Ist USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In the present instance, the proposed mark is BACIO for bar and restaurant services; cafe and restaurant services; and hotel, bar and restaurant services. The registered mark is KISS for restaurant services, cafes, coffee bars, and coffee house services; carry-out restaurant and food preparation. The proposed mark and the registered mark are foreign equivalents. Furthermore, the services offered by the registrant and applicant are closely related, even identical.

The question is not whether people will confuse the marks, but whether the marks will confuse people into

believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Under the doctrine of foreign equivalents, a mark in a foreign language and a mark that is its English equivalent may be held to be confusingly similar. TMEP §1207.01(b)(vi); *see, e.g., In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983). Therefore, marks comprised of foreign words are translated into English to determine similarity in meaning and connotation with English word marks. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Equivalence in meaning and connotation can be sufficient to find such marks confusingly similar. *See In re Thomas*, 79 USPQ2d at 1025.

The doctrine is applicable when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696; TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d at 1024 (citing J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:26 (4th ed. 2006), which states “[t]he test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.”).

Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. *See In re Thomas*, 79 USPQ2d at 1021 (holding MARCHE NOIR for jewelry likely to be confused with the cited mark BLACK MARKET MINERALS for retail jewelry and mineral store services where evidence showed that MARCHE NOIR is the exact French equivalent of the English idiom “Black Market,” and the addition of MINERALS did not serve to distinguish the marks); *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (holding applicant’s mark LUPO for men’s and boys’ underwear likely to be confused with the cited registration for WOLF and design for various clothing items, where LUPO is the Italian equivalent of the English word “wolf”); *In re Hub Distrib., Inc.*, 218 USPQ at 284 (holding the Spanish wording EL SOL for clothing likely to be confused with its English language equivalent SUN for footwear where it was determined that EL SOL was the “direct foreign language equivalent” of the term SUN).

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

Accordingly, the registration is refused under Section 2(d).

Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

### **Section 2(d) Advisory - Prior Pending Application**

Information regarding pending Application Serial No. 85412901 is enclosed. The filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

/Sally Shih/  
Sally Shih  
Trademark Examining Attorney  
Law Office 106  
USPTO  
(tel) 571-272-9712  
(fax) 571-273-9106  
sally.shih@uspto.gov

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does

not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

**DESIGN MARK**

**Serial Number**  
76660733

**Status**  
REGISTERED

**Word Mark**  
KISS

**Standard Character Mark**  
No

**Registration Number**  
3307901

**Date Registered**  
2007/10/09

**Type of Mark**  
SERVICE MARK

**Register**  
PRINCIPAL

**Mark Drawing Code**  
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**  
Kiss Catalog, Ltd. CORPORATION NEW YORK c/o Joseph Young Associates,  
Ltd. 18 Hook Mountain Road Pine Brook NEW JERSEY 07058

**Goods/Services**  
Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services, cafes, coffee bars, and coffee house services; carry-out  
restaurant and food preparation. First Use: 2006/07/04. First Use In  
Commerce: 2006/07/04.

**Prior Registration(s)**  
1055765;1153088;1155932;1894876;2800903;AND OTHERS

**Colors Claimed**  
Color is not claimed as a feature of the mark.

**Filing Date**  
2006/05/30

**Examining Attorney**  
BAKER, JORDAN

**Print: Feb 5, 2012**

**76660733**

**Attorney of Record**  
William H. Cox



**DESIGN MARK**

**Serial Number**

85412901

**Status**

NON-FINAL ACTION - MAILED

**Word Mark**

KISS

**Standard Character Mark**

Yes

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Boba Tea Company, Inc. CORPORATION NEW MEXICO 8216 Montgomery Blvd NE  
Albuquerque NEW MEXICO 87109

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services featuring tea based beverages containing ingredients made  
with various fruit flavor tapioca. First Use: 2007/01/10. First Use  
In Commerce: 2007/01/10.

**Filing Date**

2011/09/01

**Examining Attorney**

CLARKE, NANCY

**Attorney of Record**

Joanna Y. Tsai

**KISS**

**To:** TROPICANA LAS VEGAS, INC. ([jblinderman@glaserweil.com](mailto:jblinderman@glaserweil.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85450247 - BACIO - T-4  
**Sent:** 2/5/2012 11:48:53 AM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 2/5/2012 FOR  
SERIAL NO. 85450247**

Please follow the instructions below to continue the prosecution of your application:

**TO READ OFFICE ACTION:** Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

**RESPONSE IS REQUIRED:** You should carefully review the Office action to determine (1) how to respond; and (2) the applicable response time period. Your response deadline will be calculated from 2/5/2012 (or sooner if specified in the office action).

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System Response Form.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

**Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.**