

ESTTA Tracking number: **ESTTA439957**

Filing date: **11/08/2011**

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

Proceeding	85104448
Applicant	Dark Horse Distillery, LLC
Applied for Mark	DARK HORSE DISTILLERY
Correspondence Address	CHRIS A. CASEIRO VERRILL DANA, LLP 1 PORTLAND SQ PORTLAND, ME 04101-4057 UNITED STATES ccaseiro@verrilldana.com
Submission	Appeal Brief
Attachments	DHD001TM_APPEALBRF.pdf (17 pages)(176067 bytes)
Filer's Name	Chris A. Caseiro
Filer's e-mail	ccaseiro@verrilldana.com
Signature	/Chris A. Caseiro/
Date	11/08/2011

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

In re the Application of:)	
)	
Dark Horse Distillery, LLC)	
)	
Serial No. : 85/104448)	
)	
Filed : Aug. 10, 2010)	Examining Attorney: Giancarlo Castro
)	Law Office 110
Mark : DARK HORSE)	
)	
)	
Int'l Class : 040)	

BOX TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

APPEAL BRIEF OF APPLICANT

ESTTA TRACKING NUMBER ESTTA432771

I. INTRODUCTION

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board (the “Board”) on September 28, 2011, Dark Horse Distillery, LLC (“Applicant”), hereby appeals from the Examining Attorney’s final refusal to register the above identified mark (“Applicant’s Mark”) on the erroneous basis that Applicant’s Mark creates a likelihood of confusion with U.S. Registration Nos. 2919454, 2952438, 2960169, and 2921177. Applicant respectfully requests that the Board reverse the Examining Attorney’s decision based on the following remarks, establishing that Applicant’s Mark does not create a likelihood of confusion with the cited marks.

II. STATEMENT OF FACTS

On August 10, 2010, Applicant filed U.S. Application Serial No. 85/104448, seeking to register the mark DARK HORSE DISTILLERY on the Principal Register in connection with spirits distillery services in International Class 40. In the first Office Action, mailed on December 1, 2010, the Examining Attorney refused registration of Applicant’s Mark under §2(d). The Examining Attorney relied primarily on two factors set forth in *In re E. I. DuPont de Nemours & Co.*: similarity of the marks in sight, sound, meaning, and commercial impression, and similarity of the goods/services. 476 F.2d 1357 (C.C.P.A. 1973). The Examining Attorney used the doctrine of foreign equivalents in order to find similarity in meaning/connotation. Specifically, the Examining Attorney contended that KUROUMA and くらうま in U.S. Registration Nos. 2919454, 2952438, 2960169, and 2921177 is likely to be confused with

Atty. Docket No.: DHD-001TM

Applicant's Mark, based on the Registrant's suggested translation of the marks. The Examining Attorney provided no evidence proving that KUROUMA and くらうま translate into "dark horse."

Applicant filed a response to the first Office Action on March 9, 2011 and argued that the doctrine of foreign equivalents is inapplicable to this case, and no likelihood of confusion with the cited marks exists. Specifically, Applicant pointed out that KUROUMA and くらうま can be translated into numerous different things, and as such, a Japanese speaking consumer would not automatically translate the mark into "dark horse," rendering the doctrine of foreign equivalents inapplicable. With no equivalence in translation, Applicant asserted that there is no similarity in appearance, sound, connotation and commercial impression, and thus, no likelihood of confusion.

In a final Office Action mailed on March 31, 2011, the Examining Attorney issued a final refusal to register Applicant's Mark under § 2(d), although Applicant respectfully believes its arguments warrant a contrary conclusion. The Examining Attorney maintained his position and pointed out that Applicant did not provide any evidence that KUROUMA and くらうま do not or cannot translate into "dark horse," erroneously reversing the normal burden of proof. The Examiner again failed to provide any evidence that KUROUMA and くらうま translate into "dark horse." Additionally, the Examiner maintained his position that marks for services related to a particular type of goods can be confused with a mark for the goods themselves, contributing to a finding of likelihood of confusion.

On September 28, 2011, Applicant filed its Notice of Appeal and paid the appeal fee.

III. ARGUMENT

The Examining Attorney's conclusion that Applicant's Mark creates a likelihood of confusion with the KUROUMA and くらうま marks should be revisited based upon the undisputed facts and well-settled law presented below. The doctrine of foreign equivalents should not be applied to bar registration of Applicant's Mark. Regardless, assuming, *arguendo*, that the Board decides that the doctrine was properly applied, a complete comparison of Applicant's Mark and the KUROUMA and くらうま marks demonstrates that nothing about their connotations, appearances, or sounds renders Applicant's Mark confusingly similar.

1. The Doctrine of Foreign Equivalents is Inapplicable.

Statement of the Law

Under the doctrine of foreign equivalents, a foreign word (from a language familiar to an appreciable segment of American consumers) and the English equivalent may be held to be confusingly similar and thus face a rejection under § 2(d). According to the Trademark Manual of Examining Procedure ("TMEP"), issues regarding the doctrine of foreign equivalents "arise early in examination, that is, at the time of conducting a search for confusingly similar marks."

TMEP § 1207.01(b)(vi)(B). The TMEP then specifically instructs:

After conducting a complete search, an examining attorney must then assess whether a refusal under §2(d) may be warranted. If so, the examining attorney should research the English translation further using available resources, such as dictionaries, the Internet, and LexisNexis®, to ascertain whether there is sufficient evidence to support applying the doctrine.

Id.

It appears the Examining Attorney failed to carry out any research to determine whether a

Atty. Docket No.: DHD-001TM

refusal under §2(d) was actually warranted in the first place, instead relying blindly on the Registrant's assertion that KUROUMA and くらうま translate into "dark horse."

This initial error led the Examining Attorney to apply the doctrine of foreign equivalents in a manner that directly contradicts case law and the procedures set forth in the TMEP.

Applicant notes that § 1207.01(b)(vi) states (emphasis added):

Whether an examining attorney should apply the doctrine of foreign equivalents turns upon the significance of the foreign mark to the relevant purchasers, which is **based on an analysis of the evidence of record, including, for example, dictionary, Internet, and LexisNexis® evidence.** If the evidence shows that the relevant English translation is literal and direct, **and no contradictory evidence of shades of meaning or other relevant meanings exists,** the doctrine generally should be applied by the examining attorney. *See, e.g., In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (holding the Italian language mark LUPPO for men's and boys' underwear, which translates to mean "wolf," likely to be confused with WOLF and design for various clothing items, because LUPPO had a literal and direct English translation such that the doctrine was applied).

In this case, there is no evidence on the record that the relevant literal and direct English translation of KUROUMA and くらうま is "dark horse." Rather, the only evidence is that provided by Applicant, showing that myriad possible translations for KUROUMA and くらうま exist, as discussed below.

Description of the Cited Marks (attached to First Office Action)

U.S. Registration Nos. 2960169 and 2921177 include four hiragana characters (くらうま), the former written horizontally, and the latter written in a downward vertical slant:

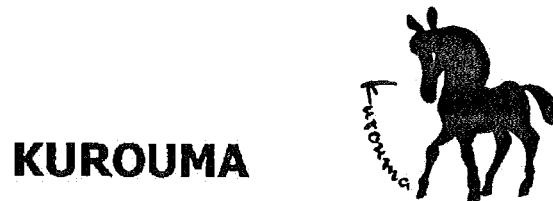


Atty. Docket No.: DHD-001TM

U.S. Registration No. 2952438 is the word KUROUMA in Roman characters, and U.S.

Registration No. 2919454 is the word KUROUMA in Roman characters together with a design.

The design is a stylized four legged animal with large, rounded ears and a relatively small body:



Viewing the Cited Marks from a Consumer's Perspective

The Japanese written language consists of three alphabets: kanji (Chinese characters), hiragana (a syllabic alphabet that can be used to spell out kanji characters and is used together with kanji to modify verbs, etc), and katakana (a syllabic alphabet used exclusively to spell out words borrowed from other languages or to spell foreign names, etc.). The Japanese language is not written in Roman characters. With that in mind, there is nothing to suggest that the “KUROUMA” and “KUROUMA + design” marks are written in Japanese, even to a Japanese speaker. Rather, a consumer would assume that these are simply fanciful marks consisting of a made up word and the doctrine of foreign equivalents should not apply to U.S. Registration Nos. 2952438 and 2919454 at all because there is no signal to an ordinary American purchaser that he or she should stop and translate the word in the marks. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005). As such, these marks should just be compared with Applicant’s Mark to determine a likelihood of confusion based on

Atty. Docket No.: DHD-001TM

the *du Pont* factors, discussed below.¹

The four hiragana characters (くろうま, pronounced KU, RO, U, and MA, respectively) of U.S. Registration Nos. 2960169 and 2921177 are written as a single “word.” Written Japanese does not include the use of “spaces” between words as in English and there is nothing to signify how KUROUMA should be read. It could be read as KURO UMA just as easily as KUROU MA or KU RO U MA, for example. Splitting the mark into different “words” results in very different meanings because, although hiragana letters are always pronounced the same (alone or in combination), they can have various meanings depending on how the “word” is split up. The “correct” meaning is only made clear by using a specific kanji character, and there are no kanji characters used in U.S. Registration Nos. 2960169 and 2921177 to guide the consumer.

For example, the hiragana letter “ま” is always pronounced “MA,” but this word can be represented by three different kanji. Each kanji is pronounced “MA,” but has a dramatically different meaning (see Exhibit A, submitted with Applicant’s response on March 9, 2011, pertinent information summarized below):

Kanji	Pronunciation	Definition
間	ま(ma)	space; room; time; pause
魔	ま(ma)	1: demon; devil; evil spirit; evil influence; (<i>Noun suffix</i>) 2: someone who (habitually) performs some (negative) act
真	ま(ma)	just; right; due (east); pure; genuine; true

As such, if someone capable of reading Japanese saw the letter/word “ま” alone, it would

¹ If the Board considers that U.S. Registration Nos. 2952438 and 2919454 *should* be interpreted as Japanese words, the following arguments regarding the multiple translations possible for くろうま apply to the KUROUMA cited marks as well.

Atty. Docket No.: DHD-001TM

be unclear as to which of the three meanings above was implied.

With this background in place, Applicant points out that the hiragana characters of U.S. Registration Nos. 2960169 and 2921177 could be interpreted in many dramatically different ways, as shown in the following table (please refer to Exhibit B, the print outs from Japanese online dictionaries and translators submitted with Applicant’s response filed on March 9, 2011, as the source of the information below):

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

* Page 4 of Exhibit B suggests that うま may not simply refer to horse, but to any four legged mammal used for transportation, and could thus include oxen, donkeys, etc. This is particularly relevant in connection with the design element of U.S. Registration No. 2919454, which looks like a donkey rather than a horse.

There is no indication in くろうま how the letters should be split into words, and as such, it is impossible to determine what meaning is intended. Furthermore, there is nothing in any of the cited marks as used in the marketplace to suggest preference of one interpretation over another. Even the black animal silhouette design of U.S. Registration No. 2919454 does not provide sufficient guidance to compel a translation of “dark horse” because several other possible

Atty. Docket No.: DHD-001TM

translations would be equally suited to that image, such as “evil horse” or “black horse” or “troubled evil spirit” (with the horse representing one of the four horsemen of the apocalypse, perhaps). Furthermore, Page 4 of Exhibit B suggests that 馬 may not simply refer to horse, but to any four legged mammal used for transportation. This is notable because the design element of U.S. Registration No. 2919454 looks much more like a donkey than a horse. Specifically, donkeys have larger and more rounded ears than horses, and have smaller bodies.² U.S. Registration No. 2919454 itself suggests many other animals in the design search codes for this mark, including donkeys and zebras. As such, there is nothing in any of the cited marks that could guide a consumer to exclusively translate 黒馬 to mean “dark horse.”

The applications of the cited marks suggest that the translation of the mark is “dark horse.” Working from this basis, the Examining Attorney then concluded that, because Registrant apparently intended for the KUROUMA and 黒馬 marks to mean “dark horse,” consumers in the marketplace will necessarily translate the marks to Registrant’s intended meaning. The Examining Attorney’s focus on Registrant’s intent is misplaced. What Registrant intended has no bearing on what a consumer would do when coming across these marks in the marketplace, where no such guidance or intention would be available or known. Furthermore, the Examining Attorney has provided no evidence indicating that this is the preferred and only literal, direct translation of 黒馬.

It is apparent that there is no single literal and exact translation of “dark horse” in the cited marks, and as such, the doctrine of foreign equivalents should not be applied and there is no

² A brief search of Google Images for donkeys compared to a search for horses confirms that U.S.

Atty. Docket No.: DHD-001 TM

likelihood of confusion. The present case is very similar to *In re Sarkli*, where the Court found that the presence of several different interpretations of a French word was sufficient to prevent a finding of equivalency for a likelihood of confusion analysis. 721 F.2d 353, 354 (Fed. Cir. 1983). *See also In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987) (PALOMA, meaning both “dove” and “pigeon” was not confusingly similar to DOVE because the translation was not equivalent, and therefore the doctrine should not be applied).

2. Even if the Doctrine of Foreign Equivalents is Applied, There is No Likelihood of Confusion Between the Parties’ Marks

As set forth in *DuPont*, the similarity of the marks is evaluated “in their entireties as to appearance, sound, connotation and commercial impression.” 476 F.2d 1357, 1361 (C.C.P.A. 1973). Even if the Board somehow finds that the doctrine of foreign equivalents applies to the Applicant’s Mark, there is still no confusing similarity between Applicant’s Mark and U.S. Registration Nos. 2919454, 2952438, 2960169, and 2921177. Specifically, if the English and foreign word are considered to have a similar meaning or connotation under the doctrine, that is still only one prong of the sound, sight, and meaning trilogy of analysis. *See In re Sarkli*, 721 F.2d at 354. In order to reach a conclusion of likelihood of confusion, similarity in connotation must be measured against any dissimilarity in appearance and sound. *Id.* In other words, similarity in connotation or meaning is not enough to support a finding of likelihood of confusion under the doctrine of foreign equivalents. *See In re L’Oreal S.A.*, 222 USPQ 925, 926 (TTAB 1984) (“The similarity in connotation must be viewed as but a single factor in the overall

Registration No. 2919454 more likely depicts a donkey than a horse.

Atty. Docket No.: DHD-001TM

evaluation of likelihood of confusion.”) Thus, in this case the Examining Attorney was required to analyze whether the parties’ respective marks look alike, sound alike, and create the same commercial impression, a task largely ignored.

Appearances of the Marks

There is no similarity in appearance with respect to Applicant’s Mark and any of the cited marks. First, Applicant’s Mark is written in Roman characters. In contrast, U.S. Registration Nos. 2960169 and 2921177 are written in hiragana, one of the three Japanese alphabets. Furthermore, these marks use a highly stylized font that is intended to represent a brush stroke, such as used in traditional Japanese calligraphy. This font creates a distinct visual impression, particularly when used to write a foreign alphabet such as hiragana.

U.S. Registration No. 2919454 is the word KUROUMA written in small Roman letters next to a stylized four legged animal that resembles a donkey. Not only do the words look nothing alike as standard character marks, but, moreover, Applicant’s Mark does not contain any design elements at all. This is a dramatic difference in the appearance of the marks.

Applicant’s Mark is three words, DARK HORSE DISTILLERY, and each of the cited marks (KUROUMA and くろま) is only one word. The average American consumer is used to reading based on interpreting the spaces between words. Thus, there is a significant visual distinction between a one-word mark and a three-word mark. Furthermore, Applicant’s Mark consists of nineteen letters, whereas KUROUMA in the cited marks is only seven letters. The letters that start and end each mark (D, Y and K, A), arguably the most visually important letters, are extremely different in shape. Thus, even though U.S. Registration Nos. 2919454 and

Atty. Docket No.: DHD-001TM

2952438 are written in Roman letters, as is Applicant's Mark, there are no visual similarities with respect to the marks. Each of the points regarding the appearances of the marks weighs heavily in favor of Applicant, suggesting that there can be no likelihood of confusion between Applicant's Mark and any of U.S. Registration Nos. 2919454, 2952438, 2960169, and 2921177.

Sounds of the Marks

In the Final Office Action the Examining Attorney makes reference to "pronunciation" and thus appears to have considered similarity of sound. However, the Examining Attorney has conflated the concepts of translation and pronunciation, and there is no similarity in sound with respect to Applicant's Mark and any of the cited marks.

As the Examining Attorney points out, there is no correct pronunciation of a mark because it can be impossible to predict how the public will pronounce a particular mark. However, this notion can only be applied to situations with fanciful marks or words with altered spellings, as evident from the cases cited by the Examining Attorney in the Final Office Action. *See In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (CAYNA (stylized) for soft drinks held likely to be confused with CANA for, *inter alia*, canned and frozen fruit and vegetable juices); *In re Energy Telecommunications & Electrical Ass'n*, 222 USPQ 350 (TTAB 1983) (ENTELEC and design for association services in the telecommunication and energy industries held likely to be confused with INTELECT for conducting expositions for the electrical industry).

Applicant's Mark, DARK HORSE DISTILLERY, is capable of only one pronunciation, the two syllable reading of these two short words that would be used by all English speakers. If

Atty. Docket No.: DHD-001TM

interpreted as a fanciful mark, it is obvious that KUROUMA could be pronounced in several ways. Examples include “KU-RO-U-MA” (matching the pronunciation of the hiragana marks), “KU-ROW-MA,” “CUE-ROOM-A,” or “CURE-O-UMA.” Regardless of the pronunciation used by a consumer, there is simply no way that KUROUMA could be considered to sound like DARK HORSE DISTILLERY.

U.S. Registration Nos. 2960169 and 2921177, containing the hiragana letters くらうま, could also not be pronounced in any manner that sounds like DARK HORSE. Letters of the hiragana alphabet have only one pronunciation each, and letters are not ever read together as they occasionally are in the English language. The four hiragana characters くらうま are pronounced KU, RO, U, and MA, respectively. No pronunciation of these four syllables, even with different cadence or accent, sounds anything like DARK HORSE DISTILLERY.

The Examining Attorney states in the Final Office Action that “the marks in question could clearly be pronounced the same by people familiar with the Japanese language and such similarity in sound alone may be sufficient to support a finding of likelihood of confusion.” When translating a foreign word or phrase, the translation process is an internal, mental process and has no bearing whatsoever on the sound of the marks as they would be spoken aloud. Thus, the Examining Attorney’s remark indicates his failure to differentiate the concepts of pronunciation and translation. くらうま can only be pronounced as KU, RO, U, and MA, as would be evident to people familiar with the Japanese language. There is no “similarity in sound,” although one of the many possible *translations* of くらうま is “dark animal/horse,” as discussed above.

Atty. Docket No.: DHD-001 TM

Based on the above, each of the points regarding the sounds of the marks weighs heavily in favor of Applicant, suggesting that there can be no likelihood of confusion between Applicant's Mark and any of U.S. Registration Nos. 2919454, 2952438, 2960169, and 2921177.

Commercial Impression/Nature of Goods or Services

The next *DuPont* factor considered relevant by the Examining Attorney is "the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." *DuPont*, 476 F.2d at 1361.

Applicant notes that this factor has no relevance when there is no similarity in the marks, as is the case here (*see supra*). Nevertheless, Applicant respectfully submits that the services/goods are dissimilar. The present Application is directed to a mark for *distillery services*, whereas the cited marks identify the source of *Japanese distilled spirits of barley soju*. That is, one is a service and the other is a good. The relevant consumers of the Applicant's services are those who wish to sell spirits to others and need a manufacturer. On the other hand, the relevant consumers of Registrant's distilled spirits of barley soju goods are those who consume those particular spirits. The descriptions of the two marks make this clear. Manufacturers or distributors would generally be the customer base for the distillery services of Applicant's mark, whereas individual consumers are likely to be the customers for distilled spirits of barley soju in the market place related to the cited marks.

Additionally, Applicant notes that the Examining Attorney may have tried to lump Applicant's distillery services and Registrant's distilled spirits of barley soju into a single broad class, such as "general alcohol related goods and services," and argues that these are all so related

Atty. Docket No.: DHD-001TM

that they are encountered by the same consumers and thus likely to cause confusion. If this is an argument the Examining Attorney intimated, the subject application can be considered to be very similar to the situation in the *Harlem Wizards* case, where, although the services of each party could be lumped under one group, the court found no likelihood of confusion:

Plaintiff would have this Court simply lump the services of plaintiff and defendants under the heading of basketball or entertainment and, on that basis alone, find that the parties engage in confusingly similar services. Numerous cases, however, illustrate that even when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion. Meaningful differences between the products and services are often cited as a factor tending to negate reverse confusion, even when the products are superficially within the same category.

Harlem Wizards Entm't Basketball, Inc. v. NBA Properties, Inc., 952 F. Supp. 1084, 1095 (D.N.J. 1997).

The substantial differences between distillery services and distilled spirits of barley soju have been noted above, and Applicant respectfully suggests that these are “meaningful differences” sufficient to negate any likelihood of confusion, even if, *arguendo*, the goods are considered to be in the same broad category.

Even if one were to argue successfully that the services and goods should be lumped together, Applicant respectfully contends that any goods resulting from the services provided under the Applicant’s mark when compared to the particular goods offered under the cited marks are sufficiently dissimilar to relevant consumers as to render this factor also favorable to Applicant. The goods identified in the registrations of the cited marks are expressly limited to *distilled spirits of barley soju*. That specificity as to the origin of the spirits was clearly intended by Registrant to make clear to consumers who wish to drink barley soju-based spirits that

Atty. Docket No.: DHD-001TM

KUROUMA or くろうま was the identifier of the source of such particular goods. That is, not only are the particular goods so limited by the Registrant, but so is the target consumer of those goods. The target consumer seeking to consume a barley soju-based spirit would take greater care to confirm the acquisition of such a product to the extent that the consumer would likely *not* be confused as to the source of such goods. Had the Registrant of the cited marks wished to offer its spirits to a wide audience of consumers, it would have not limited the description of the goods as indicated. Applicant notes that the goods resulting from the service it intends to provide are more generally identified as distilled spirits not limited to those particular consumers seeking a particular grain as the basis of the spirits they consume.

In light of the specificity of goods definition established by the Registrant for the cited marks, Applicant submits that the service and goods offered under the respective marks are dissimilar and, further, that the relevant consumers are also dissimilar. There is, therefore, no likelihood of confusion regarding this *DuPont* factors.

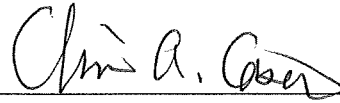
IV. CONCLUSION

Applicant has established that the doctrine of foreign equivalents does not apply to Applicant's Mark and U.S. Registration Nos. 2919454, 2952438, 2960169, and 2921177. Even if the doctrine is applied and the Board finds similarity in meaning between Applicant's Mark and the cited marks, there is no similarity in sight or sound of the marks, nor in the overall commercial impression. As such, there is no likelihood of confusion and Applicant respectfully requests that the Board reverse the Examining Attorney's decision.

Atty. Docket No.: DHD-001TM

Respectfully submitted,

Dated: November 8, 2011



Chris A. Caseiro
VERRILL DANA LLP
One Portland Square
Portland, Maine 04112-0586
(207) 774-4000
Attorney for Applicant