

This Opinion is not a
Precedent of the TTAB

Mailed: August 3, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re DBMG, LLC
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Serial No. 90185762
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Christopher A. DiSchino of DiSchino & Schamy, PLLC,
for DBMG, LLC.

Kelley Wells, Trademark Examining Attorney, Law Office 118,
Michael Baird, Managing Attorney.

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Before Bergsman, Goodman and Cohen,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

DBMG, LLC (“Applicant”) seeks registration on the Principal Register of the mark



(SUSHI disclaimed) for “Bar services;

Japanese restaurant services; Restaurant services featuring omakase; Sushi

restaurant services; Ramen restaurant services; Udon and soba restaurant services” in International Class 43.¹ The application includes the following description of the mark and a statement related to stippling: “The mark consists of a circle containing the words ‘SUNSET SUSHI’ stacked in an uppercase stylized font with a stylized depiction of an island to the right with three palm trees and a seagull flying overhead, all over a background gradually transitioning from being lighter at the top to darker on the bottom.” “The stippling [in the drawing] is for shading purposes only.”

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on the prior



registration of the Principal Register mark

(“SUSHI BAR” disclaimed) for “Restaurant and bar services” in International Class 43.² The cited registration contains the following description of the mark, color statement, and translation:

“The mark consists of the wording ‘BANSHOO’ and ‘SUSHI BAR’ in stylized formats incorporated within a rectangle. One of the letter ‘O’s in the word ‘BANSHOO’ is

¹ Application Serial No. 90185762 was filed on September 16, 2020, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as September 11, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Page references to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Applicant’s appeal brief is at 4 TTABVUE and the Examining Attorney brief is at 6 TTABVUE; Applicant’s supplemental brief is at 11 TTABVUE and the Examining Attorney brief to this supplement is at 13 TTABVUE.

² Registration No. 3890240, registered December 14, 2010; renewed.

designed to look like the sun. One of the letter ‘O’s in the word ‘BANSHOO’ is orange. The remaining lettering of the words ‘BANSHOO SUSHI BAR’ is white. The background behind the wording ‘BANSHOO’ is black. The background behind the wording ‘SUSHI BAR’ is blue. The white background is not a feature of the mark.”

“The colors white, black, orange and blue are claimed as a feature of the mark.”

“The English translation of ‘BANSHOO’ in the mark is ‘SUNSET.’”

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board and included attachments to its brief.³ After the Examining Attorney filed her brief, and objected to the attachments, Applicant filed a combined reply brief with a request for remand, which the Board granted.⁴

After remand, supplemental briefs were filed by Applicant and the Examining Attorney.⁵

We reverse the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive. Trademark Act 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record

³ 1 and 4 TTABVUE.

⁴ 6, 7 and 8 TTABVUE.

⁵ 11 and 13 TTABVUE.

that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors, and the others, are discussed below.

A. Similarity or Dissimilarity of the Services

The second *DuPont* factor considers “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.”⁶ *DuPont*, 177 USPQ at 567. Our comparison is based on the services as identified in Applicant’s application and the cited registration. *See Stone Lion Cap. Partners v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).

Applicant’s services are “Bar services; Japanese restaurant services; Restaurant services featuring omakase; Sushi restaurant services; Ramen restaurant services; Udon and soba restaurant services.” Registrant’s services are “Restaurant and bar services.” Applicant’s and Registrant’s “bar services” are identical; Registrant’s

⁶ Applicant did not address the relatedness of the services in its appeal brief.

“restaurant services” encompasses Applicant’s more specifically described restaurant services. *See Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007) (petitioner’s “restaurant services” encompass respondent’s “restaurant services featuring bagels as a main entrée”).

Because the services are identical or legally identical, the second *Dupont* factor weighs in favor of likelihood of confusion.

B. Similarity or Dissimilarity of the Trade Channels

The third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567. The basis for our analysis of trade channels is the identification of services set forth in the application and cited registration. *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant argues that “Applicant’s Services are for omakase style dining, which offer an intimate, small setting, chef-selected dining experience,” by a “top chef” who is “known for his unique and famous concepts,” “while the Prior Registrant’s services are for a Japanese restaurant and bar located within a convention hotel.” Applicant’s brief, 4 TTABVUE 11. Applicant submits that “the experience between walking into a sushi restaurant and an omakase restaurant are entirely different” because the registrant is operating a hotel with transient customers and traditional dining while Applicant’s omakase experience is an “intimate, small setting, chef-selected dining experience.” Applicant’s brief 4 TTABVUE 12.

However, our consideration of trade channels is not based on alleged “real-world conditions” but based on the identifications which have no trade channel restrictions as identified. *See Stone Lion*, 110 USPQ2d at 1162 (“It was proper, however, for the Board to focus on the application and registrations rather than on real-world conditions, because ‘the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application.’” (quoting *Octocom Sys.*, 16 USPQ2d 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”))).

Because Applicant’s and Registrant’s services are in part identical and legally identical, we presume that these services are offered in the same trade channels to the same classes of purchasers, namely ordinary consumers who are dining out. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff’d mem.* (No. 18-2236) (Fed. Cir. September 13, 2019) (“Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.”).

The third *DuPont* factor weighs in favor of likelihood of confusion.

C. Conditions of Sale

The fourth *DuPont* factor considers the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs careful, sophisticated purchasing,” *DuPont*, 177 USPQ at 567. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005).

Applicant argues that the purchasers of its services are highly sophisticated because Applicant’s omakase services are expensive, available to a limited number of customers with “refined palates” who must “actively seek out Applicant” and make a reservation in advance.⁷ Applicant’s brief, 4 TTABVUE 13. During examination, Applicant provided evidence relating to Applicant’s take out menu pricing (omakase boxes for \$125 and sushi box for \$60) and about omakase restaurant services generally. The article relating to omakase restaurant services explains that this type of Japanese dining experience involves a sophisticated customer, is expensive, and is “menuless.” June 18, 2021 Response to office action at TSDR 37-38. Additionally, the seatings and number of guests for this type of omakase dining experience are limited. *Id.* For example, at one Washington D.C. restaurant, the chef provides 3 seatings for omakase and a maximum of 8 to 10 guests per seating. *Id.* at 38.

⁷ Although there is evidence in the record relating to Applicant’s take-out menu, there is no evidence in the record regarding the price of Applicant’s in-person omakase services. This appears to be merely attorney argument.

However, Applicant also is offering “Japanese restaurant services, Sushi restaurant services; Ramen restaurant services, Udon and soba restaurant services,” and “Bar services,” and we may assume that these services are offered at all price points and to all potential consumers. Registrant’s sushi menu also is in the record and shows most items priced between \$10 and \$12, with one item at \$14 and another at \$18. February 4, 2021 Office action at TSDR 28-29.

Although omakase by its nature appears to be a more costly dining experience, neither Applicant’s identification nor Registrant’s registration includes a limitation as to price point. Therefore, we must consider that Applicant’s and Registrant’s services are offered at all price points and to the full range of consumers. Therefore, while Applicant’s omakase restaurant services may be more expensive and offered to more sophisticated consumers, we must presume also that Applicant is offering more moderately-priced restaurant services for ramen, sushi, soba, and udon and Japanese food to a full range of consumers, not just sophisticated ones. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“because neither Applicant nor Registrant has limited its products to any particular style, type of consumer, or price point, we must assume that both identifications include “residential and commercial furniture” of all types, styles, and price levels offered to the full range of usual consumers for such goods.”); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). *See also Stone Lion*, 110 USPQ2d at

1163-64 (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”).

We find the fourth *DuPont* factor neutral.

D. Similarity or Dissimilarity of the Marks

The first *DuPont* factor requires us to determine the similarity or dissimilarity of the marks in terms of appearance, sound, connotation, and overall commercial impression. *Palm Bay Imps.*, 73 USPQ2d at 1691. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The test under the first *DuPont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

Our analysis cannot be predicated on dissecting the marks into their various components; the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of

confusion.”). It is nevertheless appropriate, for rational reasons, to regard certain features of the marks as being more dominant or otherwise significant, and therefore to give those features greater weight in the analysis. *See In re Nat’l Data Corp.*, 224 USPQ at 751-52.

Descriptive or generic matter in a mark is typically less significant or less dominant when comparing marks. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)). Design elements of a mark are generally given less weight to the wording, because the wording would be used by consumers to request the goods. *In re Viterra*, 101 USPQ2d at 1908 (“In the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed” (internal quotation marks omitted)); *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999).



Applicant’s mark is

and Registrant’s mark is



The Examining Attorney argues that the doctrine of foreign equivalent applies because BANSHOO translates as “sunset” from Japanese, and the average purchaser would stop and translate. Examining Attorney’s brief 6 TTABVUE 5. In support, the

Examining Attorney relies on Japanese-words.org, a printout from Registrant's website, and printouts from third-party websites advertising Registrant's restaurant, which indicate BANSHOO is translated from Japanese to English as "sunset."⁸ Examining Attorney's brief, 6 TTABVUE 5, 6. February 4, 2021 Office action at TSDR 28, 33; July 28, 2021 Office action at TSDR 3, 26, 28, 36, 42, 46.

Applicant, on the other hand, argues that the doctrine of foreign equivalents should not be applied because there is no literal and direct translation of BANSHOO. Applicant's brief, 4 TTABVUE 6. Applicant relies on additional translation entries for BANSHOO from Japanese-words.org that precede the definition the Examining Attorney relies on,⁹ GOOGLE translate showing "nichibotsu" as the Japanese transliteration for "sunset," the English translation for "banshoo" on Google translate,¹⁰ and the declaration of Andy Matsuda, a native Japanese speaker, who indicates that the modern term for "sunset" is "nichibotsu," not "banshoo."¹¹ June 18, 2021 Response to office action at TSDR 13-14, 18, 21; May 12, 2022 Request for remand, 7 TTABVUE 9-10.

⁸ It is unclear what actual dictionary source is being used to provide these definitions on the website Japanese-words.org, relied on by both the Examining Attorney and Applicant.

⁹ The translations for "banshoo" that precede "sunset" are "all obstacles," "evening bell; curfew," "capsicum" (and "chili pepper," "cayenne" and "red pepper," "shichimi pepper"), "all creation, all nature, all universe." June 18, 2021 Response to office action at TSDR 13-14.

¹⁰ Google translate shows "board chasing tail" as the translation for "banshoo." June 18, 2021 Response to office action at TSDR 18. The Examining Attorney criticizes this translation as a "search engine" and "not a reference source." Examining Attorney's brief 6 TTABVUE 6.

¹¹ Mr. Matsuda also indicates that an archaic term for sunset, "banshō," is translated in Japanese as "lightening of the night," is a term not found in modern Kanji dictionaries, books or magazines, and "when transcribed in English" "is not written as" "banshoo" but "banshō." Matsuda declaration paragraphs 11, 12 and 13. May 12, 2022 Request for remand, 7 TTABVUE 9-10.

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English word marks. *See Palm Bay Imps.*, 73 USPQ2d at 1696. The doctrine of foreign equivalents is a “guideline and not an absolute rule.” *Id.* The doctrine is applied when it is likely that “the ordinary American purchaser would ‘stop and translate [the term] into its English equivalent.’” *Id.*, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)).

With respect to likelihood of confusion determinations, the doctrine of foreign equivalents generally has been applied when the wording in one mark is entirely in English and the wording in the other mark(s) is entirely in a foreign language. *See, e.g. In re Perez*, 21 USPQ2d 1075, 1076 (TTAB 1991) (ROOSTER vs. EL GALLO); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987) (GOOD MORNING and design vs. BUENOS DIAS); *In re Ithaca Indus., Inc.*, 230 USPQ 702, 704 (TTAB 1986) (LUPO vs WOLF and design); *In re Hub Distrib., Inc.*, 218 USPQ 284, 284 (TTAB 1983) (SUN and design vs. EL SOL).

In this case, the literal portion of the cited registration is a combination of a Japanese transliteration BANSHOO and the English words SUSHI BAR.¹²

¹² We take judicial notice that “sushi” is an English word and means “cold rice dressed with vinegar, formed into any of various shapes, and garnished especially with bits of raw seafood or vegetables. MERRIAM-WEBSTER DICTIONARY, (<https://www.merriam-webster.com/dictionary/sushi> accessed July 31, 2023). The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format or that have regular fixed editions. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions).

When terms in a mark are a combination of multiple or different languages, “[c]ourt[s] and the Board frequently have found that consumers would not ‘stop and translate’ marks comprised of [such] terms ... often finding that the marks combine the different languages for suggestive purposes to create a certain commercial impression.” *In re Taverna Izakaya LLC*, 2021 USPQ2d 1134, at *10 (TTAB 2021) (finding the doctrine of foreign equivalents did not apply to the mark TAVERNA COSTERA — which combined the English word “Taverna” (found in the English dictionary) with the Spanish word “Costera”). *Cf.*, *In re Sweet Victory, Inc.* 228 USPQ 959, 960-61 (TTAB 1986) (“the combination of a foreign word ‘GLACÉ’ and the English word ‘LITE’ is not merely descriptive under Section 2(e)(1)” because “the juxtaposition of the French word ‘GLACÉ’ with the English word ‘LITE’ changes the commercial impression of the mark.”).

Because the literal portion of Registrant’s mark combines English terms with a Japanese transliteration, we find that the doctrine of foreign equivalents does not apply in this case. Consumers will not stop and translate the portion of Registrant’s mark that contains a Japanese transliteration, but will take the literal portion of Registrant’s mark BANSHOO SUSHI BAR in its entirety as it is.¹³ *See e.g.*, *In re Universal Package Corp.*, 222 USPQ 344, 347 (TTAB 1984) (in declining to apply the doctrine of foreign equivalents under a Section 2(e)(1) refusal, the Board held that

¹³ We further note that Applicant’s submissions show that there are other relevant connotations and variations in meaning for BANSHOO making the English translation of “sunset” submitted by the Examining Attorney neither unambiguously literal nor direct, which also results in the inapplicability of the doctrine of foreign equivalents. *In re Sarkli, Ltd.*, 721 F.2d 353, 354, 20 USPQ 111, 112-113 (Fed. Cir. 1983).

the mark LE CASE for jewelry boxes was not merely descriptive as a whole, noting “[h]ere only one of the two components is foreign. Translation of an entire compound word mark is more likely to take place in the marketplace than is the translation of only part of the mark.”).

We now turn to comparison of the marks. The dominant literal term in Applicant’s mark is SUNSET given that SUSHI is disclaimed; the dominant literal term in Registrant’s mark is BANSHOO, given that SUSHI BAR is disclaimed.

The dominant literal portions of Applicant’s and Registrant’s marks are dissimilar in sound, appearance, connotation and commercial impression. BANSHOO, when not translated, appears coined, giving Asian flair to Registrant’s mark, while SUNSET in Applicant’s mark is arbitrary in connection with restaurant and bar services. When considering the literal portions of Applicant’s and Registrant’s marks, we find that the dissimilarities outweigh any similarities resulting from the shared disclaimed term SUSHI, and find the literal portions SUNSET SUSHI and BANSHOO SUSHI BAR are different in sound, appearance, connotation, and commercial impression. *See In re Code Consultants Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

As to the design elements in the marks, Applicant’s design is an island design consisting of water, an island, palm trees, a seagull, and a lined sky that represents a sunset. The impression is one of an island sunset, which reinforces the term SUNSET in Applicant’s mark. As to Registrant’s mark, the colors are claimed as a feature, and the black and blue rectangular design element acts as a carrier for the

wording BANSHOO SUSHI BAR. The design element incorporated into the word BANSHOO is an orange circle which is incomplete and could be viewed simply as a representation of the sun, either rising or setting. The sun could be considered as a reference to Japan which is known as the land of the rising sun,¹⁴ and the cuisine of the restaurant which is a sushi bar serving Japanese sushi. The additional design elements in Applicant's and Registrant's mark add to the different connotation and commercial impressions of the marks.

When we consider Applicant's and Registrant's word and design marks in their entirety, we find they are dissimilar.

The first *DuPont* factor weighs against likelihood of confusion.

II. Conclusion

Balancing all of the relevant *DuPont* factors, we conclude that confusion is unlikely. Although the services are identical in part and legally identical and the trade channels overlap, the marks are dissimilar.

The first *DuPont* factor is dispositive in this case and outweighs the other applicable *DuPont* factors that weigh in favor of likely confusion. *See Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“a single DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”) (quoting *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d

¹⁴ We take judicial notice that “Land of the Rising Sun” is a reference to Japan. RANDOM HOUSE UNABRIDGED DICTIONARY, (dictionary.com accessed July 31, 2023).

2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were considered in [opposer’s] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”)).



Decision: The refusal to register Applicant’s mark is
reversed.