

6/20/02

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 10
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **KAST, Inc.**

Serial No. 75/**579,579**

Erik W. Ibele of Neider & Boucher, S.C. for **KAST, Inc.**

Scott M. Oslick, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before **Hohein, Walters** and **Wendel**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

KAST, Inc. has filed an application to register the
mark "KARATE AMERICA" and design, as reproduced below,



for the services of "karate instruction, and the organization and conduction of karate competitions and demonstrations."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its services, so resembles the mark "KARATE AMERICA, WHERE EVERY



FAMILY IS SPECIAL" and design, as illustrated below, which is registered for the services of "karate instruction,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a

¹ Ser. No. 75/579,579, filed on October 30, 1999, which alleges a date of first use anywhere and in commerce of September 1992. The words "KARATE AMERICA" are disclaimed.

² Reg. No. 2,105,391, issued on October 14, 1997, which sets forth a date of first use anywhere and first use in commerce of August 1, 1996. The words "KARATE AMERICA" are disclaimed.

likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and/or services and the similarity of the marks.³ Here, inasmuch as applicant's services are identical ("karate instruction) in part and are otherwise closely related ("the organization and conduction of karate competitions and demonstrations") to registrant's services ("karate instruction"),⁴ the focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entireties. However, as pointed out in Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), ["[w]hen marks would appear on virtually identical ... services,

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks."

⁴ Applicant, we note, does not take issue with the Examining Attorney's contention in his brief that "because karate students commonly participate in demonstrations and competitions arranged by the karate studios at which they receive such instruction, the Applicant's services of organizing and conducting karate competitions and demonstrations are ... highly related to the Registrant's services of providing karate instruction."

the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."]

Applicant argues that confusion is not likely because, when considered in their entirety, the respective marks are sufficiently different, particularly in terms of appearance:

The applicant's mark comprises an equilateral triangle enclosing a 5-pointed star which in turn encloses three human figures in martial arts dress. Underneath the design are the words "KARATE AMERICA." The registered mark comprises a stylized ... United States Flag over a stylized depiction of a black-belt. Over the black-belt appear the words "KARATE AMERICA," and underneath the belt the phrase "WHERE EVERY FAMILY IS SPECIAL." The words "KARATE AMERICA" constitute the sole similarity between the marks. The wording "KARATE AMERICA" constitutes the largest physical element in the registered mark.

Although the applicant's mark also uses the wording "KARATE AMERICA," the wording is not the largest, or central feature of the mark. The stylized triangle, star and human figure design is larger in area than the space occupied by the wording, and constitutes an element of at least equal, if not greater visual significance. The triangular configuration of the applicant's mark also distinguishes it from the rectilinear orientation of the registered mark. The applicant therefore maintains that its mark is clearly distinguishable from the registered mark, and that this ... reduces the likelihood of confusion.

While we agree with applicant that the marks at issue are distinguishable on the basis of a side-by-side comparison, such is not the proper test to be used in determining the issue

of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); Envirotech Corp. v. Solaron Corp., 211 USPQ 724, 733 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

We concur, in view thereof, with the Examining Attorney that, notwithstanding the disclaimer in both of the respective marks of the words "KARATE AMERICA," such words, rather than the design elements, constitute the dominant and distinguishing feature thereof, when the respective marks are considered in their entireties, inasmuch as they are the feature which would be utilized by customers and potential consumers when calling for or referring to applicant's and registrant's services. See, e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987) [where a mark consists of both a word portion and a design portion, it is generally the word

portion which is more likely to be impressed upon a consumer's memory and to be used in calling for and/or asking about the goods and/or services]. Plainly, in both marks, the words "KARATE AMERICA," due to their prominent display, function as the name under which applicant and registrant provide their services to the purchasing public⁵ and the other design elements merely play off of and are subordinate to such name in each mark.

Specifically, the star in applicant's mark, which is so positioned as to create a portion of a stylized letter "A," and the American flag design in registrant's mark, all serve to underscore that the name under which applicant and registrant provide their karate instruction services is "KARATE AMERICA." Similarly, the figures in martial arts dress in applicant's mark and the black belt in registrant's mark are design elements which simply reflect various apparel involved in karate instruction and thus are essentially without source indicative significance. Overall, and given both the fact that, as applicant admits, "the wording 'KARATE AMERICA' constitutes the largest physical element in the registered mark" and the fact that it forms a significant part of applicant's mark, we find

⁵ As the Examining Attorney tellingly observes in his brief, "it would be difficult to imagine potential users utilizing any other element of the [Applicant's or the] Registrant's mark when calling for the ... services."

that the marks at issue are substantially similar in sound, appearance, connotation and commercial impression. Moreover, while registrant's mark, unlike applicant's mark, contains the slogan "WHERE EVERY FAMILY IS SPECIAL," we agree with the Examining Attorney that such is insufficient to distinguish the respective marks because, as pointed out in his brief:

[W]hen the size and display of this wording is compared to the size and display of the wording KARATE AMERICA, it is clear that the wording WHERE EVERY FAMILY IS SPECIAL is not a dominant portion of the Registrant's mark. Nor is this phrase likely to be considered the name under which the Registrant provides its services. Rather, this wording is likely to be perceived as a "tag line" used by the Registrant to describe its business philosophy.

Accordingly, we conclude that customers and potential consumers, who are familiar or acquainted with registrant's "KARATE AMERICA WHERE EVERY FAMILY IS SPECIAL" and design mark for its karate instruction services, would be likely to believe, upon encountering applicant's substantially similar "KARATE AMERICA" and design mark for its karate instruction services and its services of organizing and conducting karate competitions and demonstrations and articles of clothing, that such identical in part and otherwise closely related services emanate from, or are sponsored by or associated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.