

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nikken, Inc.

Serial No. 76573402

Jeffrey A. Babener of Babener and Associates for Nikken,
Inc.

Barney L. Charlon, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Bucher, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Nikken, Inc. seeks registration on the Principal
Register of the mark **KENZEN WELLNESS** for goods identified
in the application as "dietary supplements" in
International Class 5.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register this designation under Section 2(e)(1) of the

¹ Application Serial No. 76573402 was filed on January 28,
2004 based upon Applicant's allegation of a *bona fide* intention
to use the mark in commerce.

Trademark Act based upon the ground that the mark is merely descriptive when considered in relation to Applicant's identified goods, i.e., that the term "Kenzen Wellness" immediately informs potential purchasers about the nature and quality of Applicant's dietary supplements.

Applicant and the Trademark Examining Attorney have fully briefed the issues involved in this appeal.

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of a significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is used or is intended to be used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978)

[GASBADGE merely descriptive of a "gas monitoring badge"]. *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services." The Court found that a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service."]. The foreign equivalent of a merely descriptive

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English word is not registrable under Section 2(e)(1) because it too is considered merely descriptive. *In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986) [the transliteration of these Chinese characters is a merely descriptive ORIENTAL DAILY NEWS. Hence, the ultimate question before us is whether the term **KENZEN WELLNESS** conveys information about a significant feature or characteristic of Applicant's goods with the immediacy and particularity required by the Trademark Act.

We turn then to the various dictionary entries that have been made part of this record:

Results for 'kenzen'	
Japanese	English
kenzen	health (an), soundness, wholesome ²

kenkō, n. health

kenzen (na), adj. 1. healthy. 2. active

healthy, adj. 1. kenkō (na) (vigorous)

wholesome, adj. 1. kenzen (na) (morally good) ³

kenzen na sound

health, n. kenkō; **healthful** kenkō ni yoi; **healthy** kenkō na⁴

² <http://www.freedict.com/onldict/onldict.php> as attached to First Office Action of September 3, 2004.

³ RANDOM HOUSE JAPANESE-ENGLISH, ENGLISH-JAPANESE DICTIONARY.

⁴ WEBSTER'S NEW WORLD JAPANESE DICTIONARY, POCKET EDITION.

In arguing for registrability, Applicant contends that the word "kenzen" has multiple translations from the Japanese language. Applicant argues from the record that the word "kenzen" is an adjective meaning "wholesome, sound" that is applied to much broader concepts than the human body and its state of physical health or well-being.

Part of the concept of wholesomeness or soundness includes healthiness, and this is not in dispute, but there are many other concepts and connotations attached to this Japanese word. That there are many different meanings attached to "KENZEN" is borne out by the definition attached to the Examining Attorney's Brief. This entry sets out multiple meanings and variations including:

"health of (Japanese) economy ... sound finance; a balanced budget ... healthy, sound; wholesome ... healthy literature ..., healthy (wholesome) reading ... a clean wholesome story ... wholesome ideas ..., sturdy (hard) common sense ... a wholesome moving picture for children ... sound development ... sound judgment ... a sound investment ..., be sound minded ..., a man of sound body and mind."

Applicant's reply brief at 1 - 2. Thus, Applicant argues, there is a measure of vagueness and ambiguity to this broad conceptual term, such that the composite mark suggests a wholesome and safe product used to maintain health and wellness, but does not merely describe a dietary supplement

product. Applicant points out that any resulting doubt about this issue should be resolved in its favor.

In any case involving issues of foreign equivalents, whether in the context of making a determination of likelihood of confusion⁵ or mere descriptiveness,⁶ the exactness of the translation equivalency is a key question.

Reviewing all of the definitions in the record, including those put into the record by the Trademark Examining Attorney, it seems as if the Japanese term "kenkō na" is quite close to the translation for "healthy" in the physical sense, while "kenzen" or "kenzen na" have a broader sense of "soundness," "wholesomeness," "morally good," etc. Hence, accepting that a correct translation of the Japanese language word "kenzen" is best captured by the combination of the English-language terms "healthy," "sound" and "wholesome," on this record, we find that our doubts about the exactness of the translation equivalency for the term "Kenzen" into "physically healthy" must be resolved in Applicant's favor.

⁵ *In re Sarkli*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983) [REPECHAGE is not the equivalent of "second chance"].

⁶ *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992) [Spanish term ATAVIO is highly suggestive for fashion jewelry given that it is an inclusive word referring to individual's overall attire; however, it is not merely descriptive of particular goods involved in this case].

Furthermore, even if we found ourselves in agreement with the Trademark Examining Attorney that the precise translation of the Japanese word "kenzen" were quite clearly "physically healthy," it is not clear to us that the involved composite mark would necessarily be found to be merely descriptive. "Kenzen" is a Japanese word immediately preceding "Wellness," an English language word:

This situation is different from that where we are presented with a mark consisting entirely of foreign word components. Here 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.

A crucial aspect of our analysis of this case is consideration of the needs of applicant's competitors to use the term sought to be registered. As stated in *In re Abcor Development Corp.*, 577 F.2d 811, 200 USPQ 215 (CCPA 1978), the major reasons for not protecting marks which are merely descriptive of the goods with which they are used are "to prevent the owner of a mark from inhibiting competition in the sale of particular goods" and "to maintain freedom of the public to use the language involved, thus avoiding the possibility of harrassing [sic] infringement suits by the registrant against others who use the mark when advertising or describing their own products." Competitors in applicant's field of goods have every right to use the generic name for their goods. They have no need, other than to trade on the good will of applicant, to use the complete trademark adopted and used by applicant. There is nothing in the record which even remotely

suggests that competitors have used or would need to use the term "LE CASE" to describe their goods.

In re Universal Package Corporation, 222 USPQ 344, 347 (TTAB 1984) [LE CASE (with the word "Case" disclaimed) is not merely descriptive for "jewelry boxes and gift boxes not made of precious metal"]; *see also In re Sweet Victory, Inc.* 228 USPQ 959 (TTAB 1986) [*Glacé Lite* not merely descriptive for ice creams, sherbets, frozen yogurts and nondairy frozen desserts, namely, fruit ices, yogurt substitute and tofu]; and *French Transit Ltd. v. Modern Coupon Systems Inc.*, 818 F.Supp 635, 29 USPQ2d 1626 (S.D.N.Y. 1993) [finding that the doctrine of foreign equivalents is inapplicable inasmuch as plaintiff's mark, LE CRYSTAL NATUREL, is a combination of foreign and English language words, and citing to 1 J. Thomas McCarthy, *TRADEMARKS AND UNFAIR COMPETITION*, § 11.14 at 464-66 (2d ed. 1984) as well as *Universal Package Corporation*, 222 USPQ at 347].

For all these reasons, we find that the applied-for matter is not merely descriptive of Applicant's dietary supplements.

Decision: We do not find the mark as a whole to be merely descriptive. However, inasmuch as the word "Wellness" has been shown to be merely descriptive, and

stands as a separate component in the mark as a whole, the mark is not registrable without a disclaimer of the word "Wellness" under Section 6(a) of the Act. *See Universal Package Corporation*, 222 USPQ at 347. Accordingly, applicant is allowed thirty days from the date of this decision in which to submit a disclaimer, failing which the refusal to register will be *affirmed*. *Cf.* 37 C.F.R. § 2.142(g). If applicant submits an appropriately worded disclaimer, namely: "No claim is made to the exclusive right to use the word 'Wellness' apart from the mark as shown," the refusal to register will be *reversed* and the application will be forwarded to the Trademark Examining Attorney to place in condition for publication for opposition under Section 12(a) of the Act.