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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Borysiewicz

Serial No. 78012153

Ava K. Doppelt and Barbara Rudolph Smith of Allen, Dyer,
Doppelt, Milbrath & Gilchrist, P.A. for Jeffrey M. Borysiewicz.

Karla Perkins, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Quinn, Hohein and Drost, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Jeffrey M. Borysiewicz, a citizen of the United
States, has filed an application to register on the Principal
Register the mark "CIELO" for "cigars."¹

¹ Ser. No. 78012153, filed on June 12, 2000, which is based on an
allegation of a bona fide intention to use such mark in commerce.
Applicant states in the application that the English translation of
"CIELO" is "SKY."

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that, under the doctrine of foreign equivalents, applicant's mark, when applied to his goods, so resembles the mark "HEAVEN," which is registered for "cigars,"² as to be likely to cause confusion, or to cause mistake, or to deceive.³

Applicant has appealed. Briefs have been filed,⁴ but an oral hearing was not requested. We reverse the refusal to register.

² Reg. No. 2,252,336, issued on the Principal Register on June 15, 1999, which sets forth a date of first use of the mark anywhere and in commerce of February 1996; combined affidavit §§8 and 15.

³ Although the Examining Attorney also made final a "requirement for an acceptable translation" of applicant's mark and suggested that, "if accurate," applicant "may adopt the ... statement" that "[t]he English translation of the mark is SKY or HEAVEN," she withdrew such requirement in her brief.

⁴ The Examining Attorney, in her brief, has objected to certain evidence attached to applicant's initial and amended appeal briefs, asserting that:

The examining attorney objects to the applicant's untimely submittal of online dictionary definitions that do not otherwise appear in printed format. Specifically, the examining attorney objects to all of the definitions from the Ectaco Online Dictionaries retrieved through www.ectaco.com and www.mexicospanish.com. The examining attorney also objects to the online dictionary definitions retrieved from www.freedict.com. The applicant failed to submit these online definitions prior to appeal. Consequently, the examining attorney respectfully requests that the Board refuse to take judicial notice of this material. TBMP Sections 1208.04 and 704.12.

While applicant, in his reply brief, contends that "these definitions were provided at the invitation of the Examining Attorney and should therefore be considered by the Board," no explanation is provided as to why such evidence was not submitted prior to appeal. In view thereof, and inasmuch as on-line dictionaries which otherwise do not exist in printed format are not considered appropriate subject matter for judicial notice when submitted at the appeal stage, the Examining Attorney's objections are sustained and such evidence has been given

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 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 or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁵ Here, inasmuch as the goods at issue ("cigars") are legally identical, the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective marks.

no further consideration. See In re Total Quality Group, Inc., 51 USPQ2d 1474, 1476 (TTAB 1999); and TBMP §704.12(a) at n. 245, §1208.03 and §1208.04 (2d ed., 1st rev. March 2004).

In addition, we note that in his reply brief, applicant refers for the first time to the "results of a survey conducted as to whether consumers are likely to be confused as to the marks CIELO and HEAVEN." However, inasmuch as the evidentiary record in an application should be complete prior to the filing of an appeal, such evidence is untimely under Trademark Rule 2.142(d). See TBMP §1207.01 (2d ed., 1st rev. March 2004). Moreover, the purported results are of no probative value in any event given the absence of any information as to the methodology utilized in conducting the consumer survey. No further consideration, therefore, will be given to the summary of the survey evidence which is set forth in the reply brief. See, e.g., In re U.S. Cargo Inc., 49 USPQ2d 1702, 1702 at n. 2 (TTAB 1998).

⁵ 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 differences in the marks." 192 USPQ at 29.

The Examining Attorney, asserting in her brief that "applicant seeks to register [the mark] CIELO, [which is] the foreign equivalent of 'heaven,' for the identical goods offered by the registrant, specifically, cigars [under the mark HEAVEN]," maintains that, among other things (footnotes omitted):

According to the well-established doctrine of foreign equivalents, an applicant may not register foreign words or terms if the English-language equivalent has been previously registered for [the same or] related products or services. *In re Perez*, 21 USPQ2d 1075 (TTAB 1991); *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987); *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). TMEP §1207.01(b)(vi). The doctrine of foreign equivalents recognizes "the cosmopolitan character of the population and ... the international character of trade." Restatement (First) of Torts Section 723 cmt. a (1938). The intent of the rule is to avoid the registration of a confusingly similar foreign word recognizable to an appreciable segment of American purchasers. TMEP Section §1207.01(b)(vi). Restatement (Third) of Unfair Competition Section 21 cmt. e at 231 (1995).

In the case at bar, the word mark at issue is in Spanish, a language familiar to an [sic] significant segment of American consumers. The Spanish wording CIELO is the foreign equivalent of the English wording "heaven." According to *Cassell's Spanish[-English English-Spanish] Dictionary [(1982)]*, the English translation of CIELO is "sky, heaven, climate, ceiling." Conversely, the only word listed [therein] as the Spanish translation of the word

HEAVEN is "cielo." As demonstrated by excerpts from a computerized database, the purchasing public has encountered the wording CIELO and its English meanings.

In view thereof, and contending that in the case, as here, of an intent-to-use application, "it is proper for the examining attorney to assume the [subject] mark will be used to convey one of the most common meanings of the Spanish word, i.e. 'heaven,'" the Examining Attorney insists that confusion is likely to occur from the contemporaneous use in connection with cigars of the mark "CIELO" by applicant and the mark "HEAVEN" by registrant. Correctly noting, furthermore, that a mark's identity or "[s]imilarity in meaning or connotation should be weighed against dissimilarities in sound, appearance, type of goods and other factors, including the care with which the purchase is made and the strength of the mark," she insists that, because an English translation of applicant's mark is not only identical in meaning or connotation to registrant's mark, but the former "is an arbitrary and a strong mark when used with cigars," such factors, along with the identity between the respective goods, "weigh heavily towards a finding of a likelihood of confusion." Those factors, the Examining Attorney urges, in fact outweigh the dissimilarities in sound and appearance between applicant's and registrant's marks, irrespective of whether cigars are considered to be inexpensive

or relatively high-priced items and regardless of whether cigar purchasers are viewed as ordinary consumers or as sophisticated buyers.⁶ Consequently, the Examining Attorney concludes that because many consumers speak Spanish, "[a] consumer may reasonably, albeit falsely, believe [that] the registrant has directed its marketing efforts towards the Spanish-speaking population by offering the same product under the Spanish wording for the mark HEAVEN, resulting in confusion as to the source of the goods."

Moreover, to the extent that the marks "CIELO" and "HEAVEN" are not exact equivalents in meaning or connotation, the Examining Attorney, relying on dictionary definitions which are of record, maintains that (footnotes omitted):

In this case, assuming *arguendo*, that CIELO and "heaven" are not equivalents, but rather, CIELO and "sky" are Spanish-English equivalents, the wording "sky" evokes a similar commercial impression as does the word mark HEAVEN. Sky is relevantly defined as the celestial regions or the heavens. Heaven is relevantly defined as the sky or universe as seen from Earth. These definitions demonstrate that the English

⁶ In particular, the Examining Attorney points out in her brief that "[w]hile cigars are available in cigar bars and shops, they are also available in neighborhood drug stores," and accurately observes that "[t]here is no evidence of record identifying where the applicant's and registrant's cigars are sold, the costs of the cigars or to whom the cigars are sold." Furthermore, the Examining Attorney properly notes that even "if the purchasers are sophisticated or knowledgeable in a particular field[,] it does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion," citing *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983); and TMEP §1207.01(d)(vii) (3d ed. 2d rev. May 2003).

wording and the translation of the foreign wording have a similar meaning that evoke a similar overall commercial impression.

Finally, the Examining Attorney correctly points out that any doubt as to whether confusion is likely is resolved in favor of the prior registrant, citing *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

In addition to the translations of "cielo" into English and "heaven" into Spanish provided by the dictionary definitions referred to above, which the Examining Attorney admits list the most commonly used definitions first, the record upon which she relies in support of her position contains English definitions of the words "sky" and "heaven." Specifically, while partial meanings of such words were mentioned previously, the full definitions thereof, as set forth in the American Heritage Dictionary of the English Language (3d ed. 1992), are as follows: "Sky" is defined as a noun meaning "1. The expanse of air over any given point on Earth; the upper atmosphere as seen from Earth's surface. 2. Often **skies**. The appearance of the upper atmosphere, especially with reference to weather: *Threatening skies portend a storm.* 3. The celestial regions; the heavens: *stars in the southern sky.* 4. The highest level or degree: *reaching for the sky*"; and "heaven" is listed as a noun connoting "1. Often heavens. The sky or universe as seen from Earth; the firmament. 2. a. Often

Heaven. The abode of God, the angels, and the souls of those who are granted salvation. **b.** An eternal state of communion with God; everlasting bliss. **3. a. Heaven.** God: *Heaven help you!* **b. heavens.** Used in various phrases to express surprise: *Good heavens!* **4.** Often **heavens.** The celestial powers; the gods: *The heavens favored the young prince.* **5.** A condition or place of great happiness, delight, or pleasure: *The lake was heaven."*

Also of record are several excerpts from the "NEXIS" computerized database showing, as indicated previously, that "the purchasing public has encountered the wording CIELO and its English meanings." The following excerpts are representative (emphasis added):

"For the record, [the] original title is an untranslatable pun: '**Cielo**' means **both 'sky' and 'heaven,'** and the Spanish script has plenty of fun with the ambiguity." -- Variety, April 22, 2002 (film review headlined: "EVERY STEWARDESS GOES TO HEAVEN (TODAS LAS AZAFATAS VAN AL CIELO)");

"**Cielo means heaven or sky** in Spanish and Italian. 'I wanted it to be ethereal,' Carrier says. 'I wanted the ceilings downstairs to sort of be a halo.' Carrier had lost her father ... in the years just before the opening, and she wanted to pay ... tribute." -- Commercial Appeal, February 2, 2002 (restaurant review headlined: "UNIQUE TASTES; ARTFUL INTERIORS CAN ENHANCE THE DINING EXPERIENCE");

"Camino **Cielo, which translates to Sky** Road, isn't as epic in scale as the Angeles

Crest Highway" -- L.A. Times, June 3, 2001;

"El **Cielo** (which means 'the **sky**' or '**heaven**') has remained something of a secret, hidden high within the eastern folds of the Sierra Madres." -- Texas Monthly, June 1997; and

"The Spanish word '**cielo**' means '**sky**' or '**heavens**' in English, and [Ronald] Reagan typically used the more romantic translation. Rancho del Cielo was 'Heavenly Ranch' to him and a property in which he invested hands and heart as well as money." -- Washington Post, August 24, 1996.

Furthermore, judicial notice is taken that, as shown by the definitions attached to applicant's initial and amended appeal briefs (and not objected to by the Examining Attorney), the Spanish-English version of "Cambridge Dictionaries Online" (© Cambridge University Press 2003) in relevant part defines "cielo" as connoting "sky" and lists "heaven" as meaning "cielo." Similarly, the definitions from "WordReference.com," which cite as their source "The Collins Concise Dictionary © 2002 HarperCollins Publishers," in pertinent part set forth "cielo" as variously signifying "1 (*astronomia, meteorologia*) sky ... 2 (*religion*) heaven ... 3 (*informal*) ... sweetheart ... 4 (= *parte superior*) roof ... 5 (*arquitectura*) ceiling" and, although no corresponding definition of "heaven" was furnished, "sky" is listed as meaning "cielo."⁷

⁷ It is settled that, as a general proposition, the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v.

Applicant, on the other hand, contends that on this record confusion has not been shown to be likely. In particular, applicant observes in its amended appeal brief that it is obvious that the marks "CIELO" and "HEAVEN" "are not at all similar in sight or sound." Moreover, citing, *inter alia*, what is presently 3 J. McCarthy, McCarthy on Trademarks & Unfair Competition §23:36 (4th ed. 2004), applicant correctly points out in such brief that, with respect to the similarity or dissimilarity between the marks in terms of meaning or connotation, it is settled that "under the doctrine of "foreign equivalents," foreign words from common languages are translated into English to determine their confusing similarity to English word marks" (underlining in original). Here, as applicant additionally notes, "[t]he test for refusing a mark based on foreign equivalence is whether those American buyers familiar with the foreign language would denote the claimed English equivalent of HEAVEN from CIELO." Applicant asserts that they would not, arguing that (footnote omitted):

Clearly the primary and common translation of CIELO is sky [rather than heaven]. The Examining Attorney asserts that even if CIELO only means sky, the word "sky" has a commercial impression as

American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

"heaven", asserting that "sky" is defined as the celestial regions; the heavens, and that "heaven" is defined as the sky or universe as seen from Earth. The Examining Attorney goes on to argue that these definitions demonstrate that the English word and the translation of the foreign word evoke similar thoughts and create similar commercial impressions. Applicant respectfully submits that this is not a foreign equivalency argument, but at most, a circular line of thinking that most consumers would not engage in.

We agree with applicant that, on this record, confusion has not been demonstrated to be likely, based on the doctrine of foreign equivalents. As applicant persuasively points out in its amended appeal brief, not only are the marks "CIELO" and "HEAVEN" not exact equivalents with respect to their meaning, but:

Even assuming arguendo that CIELO and HEAVEN were foreign equivalents, that alone is not sufficient to deny ... registration of CIELO. See In re Ithaca Industries, Inc., 230 USPQ 702 (TTAB 1986) (equivalency in connotation does not, in and of itself, determine the question of likelihood of confusion). Similarity in connotation is but one factor to be considered in the overall evaluation of the likelihood of confusion. See In re L'Oreal S.A., 222 USPQ 925 (TTAB 1984). In fact, it is improper to compare a foreign word mark with an English word mark solely in terms of connotation or meaning. [See] In re Ness & Co., 18 USPQ2d 1815 (TTAB 1991). "Such similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound and all other factors, before reaching a conclusion on likelihood of confusion as to

source." In re Sarkli, Ltd., 721 F.2d 353,
220 USPQ 111 (Fed. Cir. 1983).

Additionally, as applicant correctly notes in its reply brief, "[w]here the only similarity between marks is in connotation, and here the two words do not even have the same connotation, the Federal Circuit requires a 'much closer approximation' between the marks to justify a refusal where the marks otherwise are totally dissimilar," citing In re Sarkli, Ltd., supra at 220 USPQ 113.

In the present case, it is obvious that the respective marks are totally dissimilar in appearance and pronunciation. In addition, while the Examining Attorney has noted that the English word "heaven" has been shown to be translated into Spanish solely as "cielo," the relevant inquiry for purposes of applying the doctrine of foreign equivalents is the translation of the Spanish term "cielo" into English, which according to the record can variously mean not only "heaven" but also "sky," "climate," "ceiling" "roof" and "sweetheart." None of the latter alternatives, however, has been demonstrated to be obscure or little used and, of the various Spanish translations, the record shows that "cielo" is just as likely--if not most likely--to be translated into English as "sky" rather than "heaven," inasmuch as "sky" is the translation of "cielo" which the dictionary definitions thereof either list as the first or

sole entry therefor. Thus, not only is there no exact equivalency in English meaning or connotation between the marks "CIELO" and "HEAVEN," but contrary to the Examining Attorney's alternative contention, the meaning of the mark "CIELO" as "sky," that is, "the celestial regions or the heavens," does not closely approximate that of the mark "HEAVEN," given the wide variety of meanings of both the word "sky" and the word "heaven."

The Examining Attorney, however, insists in her brief that:

This case is analogous to *In re Perez*, 21 USPQ2d 1075 (TTAB 1991) wherein the Board found that confusion was likely. The registered mark was ROOSTER for use with fresh citrus fruits. The applicant sought to register the wording EL GALLO for use with fresh vegetables. The term "gallo" is Spanish meaning rooster. The Board determined that although "gallo" may have other English translations, there was no evidence of record that purchasers would assign any of the other meanings to the mark. Similar to the present case, "gallo" has other meanings, however, only one Spanish word was given to define rooster, namely, "gallo."

We disagree. In *Perez*, a decisive factor leading to a finding of likelihood of confusion was the fact that:

Undercutting applicant's argument that the Spanish word "gallo" has meanings other than "rooster", and, thus, is not the foreign equivalent of registrant's mark, is the usage of applicant's mark[s] in the commercial marketplace, as evidenced by the

specimens of record. The specimens depict applicant's marks with a prominent representation of a rooster. While the rooster design is not a feature of the marks sought to be registered and, of course, cannot be considered when comparing the marks, the design would certainly reinforce to consumers in the marketplace the "rooster" translation of "gallo" as opposed to the other English meanings of "gallo."

21 USPQ2d at 1076-77. Here, by contrast, the application is based on an allegation of a bona fide intention to use the mark "CIELO" for cigars and an amendment to allege use, with an accompanying specimen, has not been submitted.⁸ Thus, while a different result could indeed be the case if, once applicant submits either an amendment to allege use or a statement of use, the specimen of use were to illustrate a heavenly motif, and/or if the advertising and promotional materials for applicant's goods were to utilize such a theme, at present there is nothing to suggest that applicant seeks to reinforce a particular English connotation with respect to its "CIELO" mark or otherwise trade upon the goodwill in registrant's "HEAVEN" mark for its cigars.

Accordingly, notwithstanding the legal identity of the goods at issue, we find that because the marks "CIELO" and "HEAVEN" are totally dissimilar in sound and appearance and are

⁸ We note, however, applicant's statement in its amended appeal brief that it assertedly "has been using the CIELO mark for over two years and no one has ever asked if CIELO means heaven, or confused the CIELO cigars with the HEAVEN cigars."

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neither exact synonyms nor a close approximation in meaning or connotation, there is no likelihood of confusion from the contemporaneous use thereof in connection with cigars. See, e.g., In re Sarkli, Ltd., supra at 113; In re Ness & Co., supra at 1816; and In re Buckner Enterprises Corp., 6 USPQ2d 1316, 1317 (TTAB 1987).

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