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February 27, 2007  
GDH/gdh

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Kim

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Serial No. 78475526

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John G. Posa of Gifford, Krass, Groh, Sprinkle, Anderson for John Kim II.

Dahlia George, Trademark Examining Attorney, Law Office 108  
(Andrew Lawrence, Managing Attorney).

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Before Hohein, Zervas and Bergsman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

John Kim II has filed an application to register the mark "COMPASS CAFE" in standard character form on the Principal Register for the services of providing "children's entertainment and amusement centers, namely, interactive play areas" in International Class 41.<sup>1</sup>

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 applied to his services, so resembles the following marks, which are owned by the same registrant for the

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<sup>1</sup> Ser. No. 784765526, filed on August 30, 2004, which is based on an allegation of a bona fide intention to use the mark in commerce.

services indicated below, as to be likely to cause confusion, or to cause mistake, or to deceive:

(i) the mark "COMPASS KIDS' CLUB," which is registered on the Principal Register in standard character form for "entertainment services, namely, arranging and conducting recreational activities for children in the nature of arts and crafts classes, pizza parties, movies, beach and swimming parties, playground games, petting zoos, camp-outs, pony rides, and outdoor sports";<sup>2</sup> and

(ii) the mark "COMPASS CLUB," which is registered on the Principal Register in standard character form for "entertainment services, namely, arranging and conducting recreational activities in the nature of golf, tennis, table tennis, air hockey and billiards tournaments, jungle gym relays, boat outings, outdoor sports, aerobics and weight training classes, dance classes, arts and crafts classes, bingo games, movies, and birthday parties."<sup>3</sup>

Applicant has appealed and briefs have been filed. We affirm the refusal to register as to both of the cited registrations.

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

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<sup>2</sup> Reg. No. 2,570,767, issued on May 21, 2002, which sets forth a date of first use of the mark anywhere and in commerce of September 1998. The words "KIDS' CLUB" are disclaimed.

<sup>3</sup> Reg. No. 2,670,866, issued on January 7, 2003, which sets forth a date of first use of the mark anywhere and in commerce of September 1998. The word "CLUB" is disclaimed.

analysis, two key considerations are the similarity or dissimilarity in the goods or services at issue and the similarity or dissimilarity of the respective marks in their entireties.<sup>4</sup>

Applicant contends in his brief that "the Examining Attorney is engaging in inappropriate dissection in comparing the proposed mark to [those in] the registrations, and that, when the marks are considered in their entireties, a markedly different commercial impression is established, thereby defeating likelihood of confusion." In particular, applicant asserts that, "[w]ith respect to the '767 Registration, the use of 'KIDS' CLUB' cannot simply be ignored" because, "[d]espite the fact that the proposed mark and the registered mark include the term 'COMPASS,' the terms 'CAFÉ,' [sic] and 'KIDS' CLUB[,] are entirely different, creating a distinct commercial impression in each case." According to applicant, the commercial impression given by the mark "COMPASS KID'S CLUB" is one of "some sort of service directed to children," while the commercial impression engendered by his mark "COMPASS CAFE" is "that of being some sort of coffee shop." Similarly, applicant insists, as to "the '866 Registration, again, 'CAFÉ' [sic] and 'CLUB' are entirely different and deliver an entirely different commercial impression." Applicant cites in support of its contentions *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992)

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<sup>4</sup> 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 [or services] and differences in the marks." 192 USPQ at 29.

[finding no likelihood of confusion between the marks "VARGA GIRL" and "VARGAS" for calendars due to the "significant contribution" in the former of the descriptive word "GIRL"]; and *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 597 F.2d 1404, 184 USPQ 422, 425 (CCPA 1975) [holding that mark "COUNTRY VOGUES" for ladies' and misses' dresses does not so resemble "VOGUE" for a magazine as to be likely to cause confusion because such marks "do not look or sound alike"].

Moreover, as to the respective services, applicant notes that, as to those "associated with the '767 Registration, ... the Registrant provides the services of 'arranging and conducting recreational activities for children in the nature of classes, parties, and so forth.'" Registrant, applicant insists, "provides entirely different services through entirely different means" than those rendered by applicant and thus applicant "disagrees that the [respective] services are likely to be found in the same channels of trade, namely, advertising to printed publications and electronic means." Likewise, "[w]ith respect to the '866 registration," applicant maintains that "the same arguments presented above ... apply in this case, insofar as the entertainment services provided by Registrant are identical."

The Examining Attorney, on the other hand, urges in her brief that confusion is likely, arguing that "the dominant and most significant portion of all the marks is the term COMPASS" and pointing out that such term "appears in the same sequence in all of the marks." In particular, noting that the cited registrations "contain a disclaimer of the terms 'KIDS' CLUB' and

'CLUB,' respectively," the Examining Attorney contends that (footnote omitted):<sup>5</sup>

Disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). ....

.... Here the term COMPASS is the dominant element of all of the marks. Indeed, all of the marks begin with that term. In relation to the relevant services, the term COMPASS is arbitrary for entertainment services. The Examining Attorney respectfully requests that the Board take judicial notice of the following dictionary definition of the term "COMPASS." The term COMPASS means a device used to determine geographic direction, usually consisting of a magnetic needle or needles horizontally mounted or suspended and free to pivot until aligned with the earth's magnetic field. *See in re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Canron, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §§ 712 *et seq.* (stating that the Board may take judicial notice of definitions from printed dictionaries, even if they are not made of record by the applicant or examining attorney prior to appeal).

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<sup>5</sup> Inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions, the Examining Attorney's request in her brief that the Board take judicial notice of the definition of the term "compass" from The American Heritage Dictionary of the English Language (4th ed. 2000) is approved. *See, e.g.*, *Hancock v. 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).

In consequence thereof, the Examining Attorney further argues that:

.... Here, the relevant market is the specific and narrow world of children's entertainment. Thus, the entire marks in both cited registrations give the impression of either a kids' club or a club that has the characteristic or trait of determining geographic direction or location. The Applicant's mark gives the impression of a cafe that has the characteristic or trait of determining geographic direction or location. Therefore, given the nature of the services here, the term COMPASS is completely arbitrary. Thus, upon encountering each mark, consumers must first notice this identical lead word: COMPASS. Here, the differences in the marks, .i.e., the addition of the terms CAFE, KIDS' CLUB and CLUB, respectively, in the Applicant and Registrant's marks, do not serve to distinguish them, such that consumers would assume that the marks indicate separate sources for the children's entertainment services which both Applicant and Registrant provide.

As to the respective services, the Examining Attorney asserts that such are related because "[p]eople who seek recreational activities for their children in the nature of [Registrant's] jungle gym relays, outdoor sports, pony rides, and playground games are likely to also encounter the Applicant's 'interactive play areas' for children." Contrary to applicant's contentions that the respective services are entirely different, for which the Examining Attorney points out that applicant "does not provide any evidence in support of that claim," the Examining Attorney insists that "it is reasonable that both the applicant and registrant advertise [their respective services] in the same media and employ the same trade channels in promoting and

marketing their children's entertainment services." In particular, she insists that (underlining in original):

In the instant case, both the Applicant and the Registrant's services cater to entertainment activities targeted to children. The Registrant's "recreational activities" certainly and reasonably encompass the Applicant's "interactive areas." The Examining Attorney respectfully refers the Board's attention to the supporting evidence attached by the Examining Attorney in its 11/16/2005 Office Action where it is shown that "interactive play areas" are offered as a component/aspect of recreational activities for children. .... The circumstances surrounding any marketing or advertising for "interactive play areas" and "recreational activities for children" are such that they would be likely to be encountered by the same persons under situations that would give rise to the mistaken belief that they originate from or are in some way associated with the same entity or provider.

As evidence to support her conclusion that "[e]stablishments that offer children's recreational activities commonly include interactive play areas as a desirable and attractive component to activities such as swimming, basketball courts, playground, and picnic areas for barbecues," the Examining Attorney has made of record copies of printouts from several websites which, as asserted in her final refusal, list "both 'recreational activities' and 'play areas.'" The most pertinent of such printouts include two articles from the "White Hutchinson Leisure & Learning Group" website, one of which is dated November 6, 2005<sup>6</sup> and, under the headline "Not Mere Child's Play," reports among other things that:

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<sup>6</sup> The website indicates that such article also "was published in the May 1998 issue of *Athletic Business*."

Many recreation and fitness centers are adding separate children's play areas to broaden their facilities' appeal, increase value to existing customers, attract new customers and increase their revenues. Facilities that can benefit from adding children's areas include community centers; fitness, health and wellness centers; recreational centers; and athletic clubs[;]

and the other article, which is dated November 7, 2005,<sup>7</sup> similarly indicates, under the headline "Adding Children's Play & Entertainment to MWR Fitness and Recreation Facilities," that:

Free standing [Children's Entertainment Centers or] CECs originally started exclusively with soft-contained-play equipment (the maze of plastic tubes, slides and ball pits), a restaurant area and birthday party rooms. ....

One example of the current generation of CECs is *Bamboola*, a CEC our company recently designed and produced for the owners of the Almaden Valley Athletic Club in San Jose, California. The entertainment center includes 23 different types of activities for children of which soft-contained-play is only one. Activities include ... interactive water play, ... interactive cooking, ... and pretend dress-up. Outdoors there is an adventure play garden with sand play areas ...[;]

and a printout from the website of the Anoka County, Minnesota, Department of Parks and Recreation which, with respect to its "Bunker Beach Water Park" facility, lists among other recreational activities both a children's "ADVENTURE POOL" with "interactive features [which] let kids play and interact [with] the water using valves, levers, handles and a water gun" and "summer birthday parties" for children "with our personal touch!"

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<sup>7</sup> Such article, according to the website, "is an unedited version of the article published in the March/April 1999 issue of *MWR Today*."

In addition, the Examining Attorney has made of record copies of various use-based third-party registrations which, she urges, show the same marks registered for the same or similar services as those of the applicant and registrant in this case. Such registrations, in particular, list such services as "providing facilities for recreation activities, including swimming and child play areas" (Reg. No. 2,625,619, issued on September 24, 2002); "entertainment services, namely, providing games and activities for children; ... [and] providing recreational areas for others in the nature of children's play areas" (Reg. No. 2,813,142, issued on February 10, 2004); and "children's entertainment and amusement centers, namely, interactive play areas," "providing fitness and exercise facilities, including swimming pools," and "golf and tennis instruction" (Reg. No. 2,975,308, issued on July 26, 2005).

Based upon the above arguments and evidence, the Examining Attorney maintains that confusion is likely. She distinguishes the two cases principally relied on by applicant by pointing out that:

The relevant marks in the *Hearst* case were VARGA GIRL and VARGAS. There, the dominant portion of the marks is not identical, as is the case here. In *Conde Nast*, the marks in dispute were COUNTRY VOGUES and VOGUE. Unlike the instant case, the dominant term of both marks was not identical and the dominant portion did not appear in the beginning of the mark.

By contrast, the Examining Attorney maintains that "[h]ere, the term COMPASS is virtually indistinguishable and the addition of such terms as 'KIDS' CLUB,' 'CLUB,' or 'CAFE' is insufficient to

distinguish between the marks as a whole and ... avoid confusion." Instead, quoting from *In re Smith & Mehaffey*, 33 USPQ2d 1531, 1533 (TTAB 1994), she concludes that (*italics in original*):

"Although consumers may well note the differences in the marks, they will assume that the differences indicate variant marks of a single source, rather than identify separate sources ..." for the recreational activities and interactive play areas. ....

Given the arbitrary nature of the term COMPASS and that the term appears in the same order in all of the marks, it is likely for consumers to mistakenly believe that the *applicant's services are associated or somehow connected to the registrant's services*. .... Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d [840], 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. [, Inc.] v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

We agree with the Examining Attorney that contemporaneous use by applicant of the mark "COMPASS CAFE" in connection with his services of providing "children's entertainment and amusement centers, namely, interactive play areas," is likely to cause confusion with registrant's use of the marks "COMPASS KIDS' CLUB" and "COMPASS CLUB" in connection with its various "entertainment services, namely, arranging and conducting recreational activities," including those specifically provided to children. As the Examining Attorney persuasively argues, registrant's marks are dominated in each instance by the arbitrary term "COMPASS," given the descriptiveness of the terms "KIDS' CLUB" and "CLUB" (as evidenced by the disclaimers thereof in the cited registrations). While, by contrast, the word "CAFE"

in applicant's mark cannot be said to be descriptive of the services for which applicant is presently seeking registration of his mark,<sup>8</sup> the term "COMPASS" in such mark is arbitrary as applied to applicant's services and, also like each of registrant's marks, such term is notably the first element thereof. Given the prominence of the term "COMPASS" in the marks at issue, it is apparent that when considered in their entirety, they are substantially similar in sound, appearance and overall commercial impression. While, nonetheless, the term "CAFE" in applicant's mark is different in meaning from the terms "KIDS' CLUB" and "CLUB" in registrant's marks, the overall difference in connotation of the marks at issue is outweighed by the substantial similarities shared by such marks in their entirety as to sound, appearance and commercial impression due to the presence of the arbitrary term "COMPASS" as the initial and principal source-indicative element of each mark. If the respective marks were therefore to be used in connection with the same or commercially related services, confusion as to the source or sponsorship of such services would be likely to occur.

In this case, we additionally concur with the Examining Attorney that the services at issue are commercially related. It is well settled, in this regard, that as the Examining Attorney has observed in her brief, goods and/or services need not be

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<sup>8</sup> As recounted by the Examining Attorney in discussing the prosecution of the application, applicant originally sought registration of his mark for services which included "restaurant services." The Examining Attorney's corresponding requirement for a disclaimer of the generic term "CAFE" was mooted by applicant's subsequent amendment of the identification of his services to delete "restaurant services."

identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient, instead, that the goods and/or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Here, both applicant and registrant provide children's recreational entertainment services in the nature of interactive play areas or other forms of play activities. As the evidence provided by the Examining Attorney helps to make clear, services like applicant's "children's entertainment and amusement centers, namely, interactive play areas" are likely to be rendered as part of other recreational entertainment services directed at children, including such playtime activities as the "arts and crafts classes, pizza parties, movies, beach and swimming parties, playground games, petting zoos, camp-outs, pony rides, and outdoor sports" offered by registrant as well as its "golf, tennis, table tennis, air hockey and billiards tournaments, jungle gym relays, boat outings, ... dance classes, ... bingo games ... and birthday parties." Plainly, parents seeking recreational activities as entertainment for their children would be likely to regard applicant's services as commercially related

to those offered by registrant, particularly when such services are rendered under substantially similar marks.

We accordingly conclude that customers and prospective consumers who are familiar or acquainted with registrant's "COMPASS KIDS" CLUB" mark and/or its "COMPASS CLUB" mark for its various "entertainment services, namely, arranging and conducting recreational activities" which are respectively provided under such marks, would be likely to believe, upon encountering applicant's substantially similar "COMPASS CAFE" mark for the services of providing "children's entertainment and amusement centers, namely, interactive play areas," that such commercially related services emanate from, or are sponsored by or associated with, the same source. In particular, notwithstanding the difference in meaning conveyed by the presence in applicant's mark of the term "CAFE" rather than the terms "KIDS' CLUB" or "CLUB" which appear in registrant's marks, the substantial overall similarities in sound, appearance and commercial impression in the marks at issue, which are imparted thereto by the arbitrary term "COMPASS" as the first element thereof, outweigh the difference in meaning and create a likelihood of confusion when respectively used in connection with applicant's and registrant's services. To the extent, however, that there is any doubt as to our conclusion in this regard, we resolve such doubt, as we must, in favor of the registrant. See, e.g., In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004); In re Hyper Shoppes (Ohio), Inc., supra at 6 USPQ2d 1026; In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d

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156, 223 USPQ 1289, 1290 (Fed. Cir. 1984; and *In re Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-Columbes*, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973).

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