

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

Mailed:
February 27, 2008
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

International Karate Organization Kyokushinkaikan
and Shokei Matsui

v.

Henriot Zephirin

Opposition No. 91166753
against Serial No. 76566572

Arlen L. Olsen and Autondira S. Minor of Schmeiser Olsen &
Watts, LLP for International Karate Organization
Kyokushinkaikan and Shokei Matsui.

Kathryn Jennison Shultz and John N. Jennison of Jennison &
Shultz, P.C. for Henriot Zephirin.

Before Bucher, Drost and Cataldo, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Henriot Zephirin, a U.S. citizen, seeks registration on
the Principal Register of the following mark:



for services recited in the application as "educational and entertainment services, namely clinics, camps, seminars, tournaments and classes in the field of martial arts, self-defense, kickboxing and aerobics" in International Class 41.¹

International Karate Organization Kyokushinkaikan (hereinafter "IKO Kyokushinkaikan" or "IKOK") and Shohei Matsui (hereinafter "Matsui") have opposed the application on the ground of likelihood of confusion, alleging that applicant's mark, when used in connection with the recited services, so resembles a number of opposers' previously used mark, two of which have been registered by opposer Matsui:



for "videotapes, audiocassettes, cd-roms, software featuring martial arts" in International Class 9;
"posters, books featuring martial arts instruction, instructional martial arts manuals; stationery, and calendars" in International Class 16;
"gym bags, duffel bags, wallets, umbrellas, and fanny packs" in International Class 18;
"clothing, namely, sweatshirts, t-shirts, exercise outfits, vests, hats and caps" in International Class 25;
"toys, namely, dolls, sporting goods, karate gloves and karate kick pads" in International Class 28;

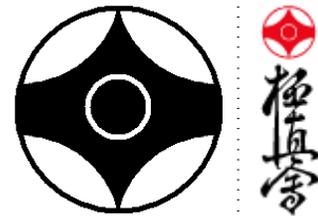
¹ Application Serial No. 76566572 was filed on December 23, 2003 based upon applicant's allegation of first use anywhere and use in commerce at least as early as September 8, 1996. No claim is made to the wording "North American Kyokushin Organization" apart from the mark as shown.

"financial sponsorship of martial arts competitions and exhibitions" in International Class 36;
"educational services, namely, martial arts instruction through classes, seminars and workshops; martial arts competitions; and conducting entertainment exhibitions in the nature of martial arts exhibitions" in International Class 41;²

**INTERNATIONAL
KARATE
ORGANIZATION**

for "posters, books featuring martial arts instruction, instructional martial arts manuals; stationery, and calendars" in International Class 16;
"financial sponsorship of martial arts competitions and exhibitions" in International Class 36; and
"educational services, namely, martial arts instruction through classes, seminars and workshops; martial arts competitions; and conducting entertainment exhibitions in the nature of marital arts exhibitions" in International Class 41,³

as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Opposers also claimed common law rights in an unregistered Kanku design mark alone



² Registration No. 2962749 issued to Shokei Matsui a.k.a. Jang Kyu Moon, a citizen of Korea, on June 21, 2005. According to the registration, the non-Latin characters in the mark transliterate to "Kyokushinkai" and this means "Ultimate Truth" in English.

³ Registration No. 2962750 issued to Shokei Matsui a.k.a. Jang Kyu Moon, a citizen of Korea, on June 21, 2005 under Section 2(f) of the Act.

[Zephirin Dep., exhibits 14, 16, 18], and the red Kanku design in conjunction with the Japanese Kyokushinkai pictogram of Reg. No. 2962749. Zephirin Dep., Exhibit 22

Applicant, in his answer, has denied all of the salient allegations in the notice of opposition. While applicant interposed several affirmative defenses, he did not file any counterclaims to cancel opposer Matsui's registrations.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. In support of their case, opposers made of record the testimony deposition of applicant, Henriot Zephirin, taken on March 27, 2007, with Exhibits 1 - 30, and under Notice of Reliance, certified status and title copies of opposer Shokei Matsui's valid and subsisting pleaded U.S. Trademark Registrations set out above.

The Parties

Applicant identifies himself as the Grand Master and Chairman of North American Kyokushin Organization (NAKO) and the owner, president and CEO of Henri-Oh's Total Fitness & Karate Center. Applicant offers clinics, seminars and classes at his fitness center in Sunnyside, New York, which also doubles as his NAKO headquarters. Applicant provides seminars, holds camps and tournaments in locations from the

Canadian Rockies to Atlantic City, and from New York to Pennsylvania. Applicant has an active website (www.henrioh.com), uses audio advertisement, promotional fliers, video advertisement as well as advertisements in karate magazines. Zephirin deposition, pp. 33 - 61, Exhibits 9 - 13, 15, 19 - 21, 24 - 25

According to applicant's testimony and attached exhibits, *Kancho* Shokei Matsui is the president (or chairman) of an organization headquartered in Tokyo, Japan variously referred to as International Karate Organization Kyokushinkaikan, International Karate Organization Kyokushin-kaikan, IKO Kyokushinkaikan, IKO or IKOK. As the name suggests, it purports to be an international organization with branches all around the world, having various Branch Chiefs in cities in the United States, including New York City. Opposers appear to hold tournaments, conferences and championships all around the world, including specific events in Japan, Italy, Canada, and Chile and in California and New York. Opposers maintain a strong presence on the Internet with links to other organizations in *Budō*, the Japanese martial arts. Zephirin deposition, pp. 71 - 82, Exhibits 17 - 18, 22

As long ago as May 1995, opposer Matsui warned applicant about unfair competition with "The United States

Kyokushin Organization," his alleged "black market" sale of IKO Kyokushinkaikan videotapes, and the use of "trademarked Kyokushin logos" on his signs, written materials, etc. Accordingly, as of May 1995 applicant's previous license as a Kyokushin Branch Chief and *dojo* operator was officially terminated. Zephirin deposition, Exhibit 26

Then again, on February 21, 1996, trademark counsel for opposer Matsui sent applicant a cease and desist letter objecting to his use of the term "Kyokushin" because of alleged likelihood of confusion with the then-registered MAS OYAMA'S U.S.A. KYOKUSHIN KARATE mark. Zephirin deposition, Exhibit 27



Applicant's own website says that "Kancho Henri-oh [Henriot Zephirin] was [at that time] a 6th Degree black belt as awarded by Sosai Mas. Oyama, the founder of the Kyokuskin-kai organization." Zephirin deposition, Exhibit 9 Applicant testified that while he has met Mr. Matsui, he has never had any kind of working relationship with him. Applicant testified that he knew of International Karate Organization, an organization also called "IKO," but that until the time of his testimony, he had never heard of an

organization known as "IKOK." Zephirin deposition, pp. 94 - 96

Standing

The first issue that we must address is opposers' standing to bring this opposition. Applicant contends that neither opposer has proven standing to maintain this opposition. "[A] party opposing a registration pursuant to Section 13 of the Lanham Act [15 U.S.C. § 1063] must show that he has standing and a statutory ground which negates the applicant's entitlement to registration." *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

As to opposer Shokei Matsui, we note that establishing ownership of an allegedly confusingly similar registration is sufficient to prove standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) ["In this case, as stated earlier, Laser Golf owns two prior registrations. These registrations and the products sold under the mark they register suffice to establish Laser Golf's direct commercial interest and its standing to petition for cancellation of Cunningham's LASERSWING mark"]. In this context, opposer Matsui has introduced into evidence two recently issued registrations by submitting current status and title copies of such registrations under a notice of reliance. 37 CFR § 2.122(d).

Applicant appears to be taking the position that opposer's claimed marks are so different there is not even a colorable claim of likelihood of confusion. We disagree. The calligraphy in opposer Matsui's first claimed mark comprises Chinese characters that are used in modern Japanese, called "Kanji." According to the registration, this design mark transliterates as "Kyokushinkai." Opposer Matsui's second alleged mark consists of the wording, **INTERNATIONAL KARATE ORGANIZATION**. As discussed above, the mark in the involved application is a composite mark containing prominently the words "North American Kyokushin Organization." While this degree of commonality is clearly not determinative on the ultimate question of likelihood of confusion, the similarities in the various marks are sufficient to support opposer Matsui's claim of damages. Accordingly, inasmuch as opposer Matsui's registrations serve as evidence in support of his claim of damage, we find that Matsui has shown that he has an interest beyond that of the general public, he is not a mere intermeddler, and has standing to bring this opposition. Therefore, we deny applicant's request that we dismiss this proceeding with prejudice on this ground. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

As to opposer IKO Kyokushinkaikan, it has clearly not demonstrated ownership of any allegedly confusingly similar registered mark. In view of the express language of Section 5 of the Statute, only the registrant can rely upon the *prima facie* presumptions afforded a registration under Section 7(b) of the Trademark Act. Although we see from web pages that Kancho Shokei Matsui claims to be the chairman of the International Karate Organization ("IKO") and president of the International Karate Organization Kyokushinkaikan ("IKOK"), it is not clear that this relationship confers standing upon the International Karate Organization Kyokushinkaikan. Hence, on this rather sparse record, we conclude that IKOK has failed to demonstrate its standing to bring this opposition.

Priority

Applicant further contends that neither opposer has demonstrated priority. However, as to opposer Matsui, priority is not an issue because opposer pleaded and later proved he is the owner of Registration Nos. 2962749 and 2962750 -- two valid and subsisting registrations of his pleaded marks. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The only way for applicant to attack this registration is with a counterclaim for cancellation. *Contour Chair-Lounge Co. v.*

The Englander Co., 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) ["[T]his is an opposition only and in an opposition, this court has always held that the validity of the opposer's registrations are not open to attack"]; *Cosmetically Yours, Inc. v. Clairol, Inc.*, 424 F.2d 1385, 165 USPQ 515, 517 (CCPA 1970) ["As long as the registration relied upon by an opposer in an opposition proceeding remains uncanceled, it is treated as valid and entitled to the statutory presumptions"]. Moreover, the earliest date on which applicant can rely is the filing date of its application, December 23, 2003.⁴ Accordingly, we find that opposer Matsui has established his priority over applicant.

Although much has been made of the ubiquitous Kanku design mark, often appearing in red, opposer Matsui has failed to lay any foundation for what this alleged mark entails. Applicant's trial deposition was the only testimony in evidence. Although applicant's mark contains elements of this design, he pleaded ignorance about whether an individual or organization has any proprietary right in this symbol. There is a single exhibit, seemingly



⁴ Applicant's vague testimony about his own first date of use of his applied-for mark more than a decade ago in connection with services listed in the subject application is irrelevant under these circumstances. Zephirin deposition, pp. 12 - 13

drawn from a Canadian website, which best explains this symbol as follows:

"The internationally recognized symbol of Kyokushin Karate, the Kanku, which originates from the kata Kanku Dai. In this form, the hands are raised to the sky with the fingers touching. The logo interprets the fingers as the points implying the peaks, representing the wrists as the wide sections, signifying power. The centre represents infinity and the circle that encloses the parts, continuity and circular motion. It is the utilization of this circular movement in the execution of techniques that distinguishes Kyokushin Karate from traditional styles of karate that rely on simple linear motion."

Zephirin dep., Exh. 30 <http://www.kyokushin.ca/index2.html>

Accordingly, while it appears from this record that this symbol has enjoyed widespread usage in connection with the Kyokushin school of Japanese martial arts, on this record, we can find no previous, common law ownership rights with the remaining opposer, Mr. Matsui.

Analysis: Likelihood of Confusion

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the

goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Services and Goods

We turn first to the *du Pont* factor focusing on the relationship of the services and goods as described in the application and in the cited registrations. We start by noting that both applicant and opposer Matsui offer educational and entertainment services related to *karate-dō*, specifically, offering classes, seminars, exhibitions or tournaments, and workshops or clinics. Not only are the parties' services legally identical, but also the record indicates that both are actually providing Japanese martial arts-related services in the same field or particular branch of the martial arts - Kyokushin Karate. This *du Pont* factor favors a finding of likelihood of confusion.

Channels of Trade

Turning to the *du Pont* factors dealing with the similarity or dissimilarity of established, likely-to-continue trade channels, we must presume that applicant's services and opposer Matsui's goods and services will move through all of the normal channels of trade to all of the usual consumers of services and goods of the type recited. *See Canadian Imperial Bank of Commerce, National Association*

v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Because applicant's recitation includes the same educational and entertainment services recited in the cited registration, the channels of trade must be deemed to be the same. Hence, this *du Pont* factor favors a finding of likelihood of confusion.

The conditions under which / buyers to whom sales are made

We find that of the prospective purchasers of these services and goods - ranging from free, introductory sessions or inexpensive items up to several hundred dollars for a course of instruction - not all participants can be deemed to be sophisticated. Undoubtedly, while some of the purchasers of martial arts services (e.g., 8th degree Black Belts winning International competitions) are sophisticated, other prospective purchasers of these services would be newbies, ordinary purchasers seeking to begin a martial arts program. We assume that these latter consumers will apply an ordinary standard of care to purchasing decisions, and hence, this *du Pont* factor too favors a finding of likelihood of confusion.

The Marks

We turn then to the critical *du Pont* factor involving the similarities or dissimilarities in the appearance,

sound, connotation and commercial impression of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). We note, in discussing this factor that the Court of Appeals for the Federal Circuit has held that when marks appear, as is the case herein, on “virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

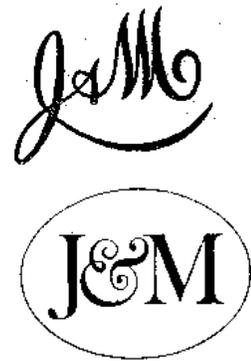
Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather, the decision must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

Nonetheless, applicant contends that there are such significant dissimilarities between its mark and opposer Matsui’s registered marks that this is a case where a single *du Pont* factor may be dispositive in a likelihood of confusion analysis. Indeed, there are cases where it is

proper for the Board to rely solely upon the dissimilarity of the marks in dismissing an opposition. For example, in *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998), the Court of Appeals for the Federal Circuit did not find clear error in the Board's finding that CRYSTAL CREEK for wine was not likely to cause confusion with CRISTAL for champagne, primarily because of the difference in the marks. See also



Genesco Inc. v. Martz, 66 USPQ2d 1260 (TTAB 2003) [despite overlapping goods and trade channels, the difference between the parties marks is "pivotal"].



“Kyokushin” and “Kyokushinkai”

Turning then to the registered marks, the record shows several distinct variations on the “Kyokushin-” root. All of the references are to a system of karate developed in Japan by Sosai Masutatsu (‘Mas’) Oyama (1923 - 1994), a style that he dubbed “Ultimate Truth.” In the absence of any clear dictionary definitions in the record, we find that the information contained in the overall record only hints at the subtle differences in connotation created by adding

the suffixes, "-kai" (and "-kaikan") to the "Kyokushin-" root.

We begin by focusing on opposer Matsui's Japanese pictogram. According to the registration, this Japanese pictogram is transliterated as "Kyokushinkai."

It is clear from the record that for years applicant has been embroidering this

"Kyokushinkai" calligraphy on all its karate uniforms, or *dogi*, distributed throughout North America. Zephirin deposition, p. 80, exhibits 19 - 21

In fact, it is also clear that opposers and other regional and national organizations do likewise all around the globe. Zephirin deposition, p. 82, exhibit 23 This transliterated term shares the "Kyokushin" meaning of "Ultimate Truth" but in this context seems to refer more to the organization or society. Zephirin deposition, pp. 78, 87 - 88



Hence, opposer Matsui's transliteration is very similar in connotation to the word "Kyokushin," shown in Western characters within applicant's mark (with the added suffix "-kai" not found in applicant's composite mark). According to the record, the term "Kyokushin" is comprised of two Japanese words, "Kyoku" (ultimate, utmost, extreme) and "Shin" (reality, truthfulness or truth from within).

Zephirin deposition, Exhibit 30 Hence, this term too translates into the English language as "the true way" or "the ultimate truth." This form of the word appears to be used in connection with the philosophy, the technique, and the specific history brought to this system of martial arts by its founder, Masutatsu ('Mas') Oyama, who chose the "Kyokushin" designation as a source indicator.

In the caption of this proceeding, the final letter "K" in opposer IKOK's name is "Kyokushinkaikan". Like "Kyokushinkai," "Kyokushinkaikan" seems to focus more on the organizational structure than the underlying philosophy ("Kyokushin"). Zephirin deposition, p. 78

In any case, the adverse parties herein make quite different arguments about the meaning of the term "Kyokushin" and/or "Kyokushinkai" to members of the relevant public. While opposer claims "Kyokushinkai" is a strong source-indicator, applicant contends that this is a term that simply refers to what is basically a style of karate-dō having a history and philosophy, techniques, instruction or curriculum and patterns of movement (*kata*) that differ from other, related strands of Japanese martial arts.

From the entire record, we can surmise that applicant has concluded that the Kyokushin-related terms at dispute herein have become generic when used in connection with a

defined school of Japanese martial arts, that the Kyokushin logos have all been used indiscriminately and licensed worldwide without sufficient quality controls, or that the plethora of users shown in the record reflects a confused and splintered state of ownership of these marks, beginning in Japan. While any or all of these theories may be gleaned from the record, applicant, as noted, has not filed a counterclaim to cancel this registration on any of these bases. Accordingly, we must accord opposer Matsui's Kyokushinkai registration all of the statutory presumptions of Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b).

While applicant has disclaimed the wording, "North American Kyokushin Organization," that does not obviate a bar of likelihood of confusion, and the word Kyokushin, still forms a significant portion of applicant's mark for purposes of our likelihood of confusion analysis.

For while we must consider the marks in their entirety, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). When viewed through the eyes of someone having an interest in Japanese martial arts who

is also somewhat knowledgeable about the modern Japanese language, the sole portion of registrant's mark is "Kyokushinkai" while the term one would use to call for applicant's services contains as its most distinctive term "Kyokushin."

There are obvious differences between these marks in overall appearance - applicant's mark has descriptive words like "North American" and "Organization," the organization's initials, "N.A.K.O.," the silhouetted image of a martial artist in action, and all of this against the Kanku background. However, we conclude that the most distinctive single element in applicant's composite mark is the word "Kyokushin." Similarly, as to sound, the transliterated sound of the Japanese pictogram sounds quite similar to the word "Kyokushin" within applicant's mark. Again, when compared in their entireties, we cannot ignore the fact that applicant's spoken mark would also include "North American," "Organization," and the organization's initials, "N.A.K.O." On the other hand, "[w]hile the marks are concededly distinguishable in their appearance and sound, it is our view that the equivalency in meaning or connotation is sufficient, in this case, to find likelihood of confusion." *Cf. In re Perez*, 21 USPQ2d 1075, 1077 [EL GALLO v. ROOSTER].

Applicant seems to take the position that we need not deal with the similarities in the connotations of these marks created by this transliteration because " ... Asian languages such as Japanese, Korean and Chinese are not 'common languages'" We disagree. Clearly, a sizable number of consumers in the United States are familiar with both the Chinese and English languages. *In re Oriental Daily News, Inc.*, 230 USPQ 637, 638 (TTAB 1986). The Chinese language is spoken by more than one billion people, and hence is the number one spoken language in the world. Arguably, kanji characters, having both Chinese- and Japanese-language origins, qualify as one of the most "common" written languages on the planet. We find that this would include ordinary purchasers in the United States of America who are knowledgeable in the languages of Chinese and Japanese, and would be able to transliterate registrant's mark to "Kyokushinkai." *Cf. In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006). We take judicial notice of information obtained from the United States Census Bureau, Census 2000, that Chinese and Japanese have been heavily represented in the U.S. for several generations, and according to the latest decennial census, there are almost

one million people of Japanese descent in the United States.⁵

As noted earlier, while the marks have obvious differences when compared in their entireties as to appearance and sound, we find that the identity in connotation is sufficient to support a finding of likelihood of confusion, especially as used in connection with identical educational and entertainment services. The fact that the marks have the same connotation, resulting in a similar overall commercial impression, is sufficient for us to conclude that confusion is likely, despite the differences in their appearance and sound. *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987).

We conclude that consumers familiar with opposer



Matsui's services offered under the calligraphy mark, upon encountering applicant's applied-for composite mark



used in connection with legally-identical educational and entertainment services, would be likely to believe that the services originated with or are somehow associated with or sponsored by the same entity.

⁵ <<http://www.census.gov/prod/2004pubs/censr-17.pdf>> See *U.S. v. Bailey*, 97 F.3d 982, 985 (7th Cir. 1996) [judicial notice taken of facts from Census Bureaus Statistical Abstract of the United States]; *Knox v. Butler*, 884 F.2d 849, 852 n. 7 (5th Cir. 1989) [judicial notice appropriately taken of census data]; *Citizens Financial Group Inc. v. Citizens National Bank of Evans City*, 383 F.3d 110, 72 USPQ2d 1389 (3d Cir. 2004). See also *In re*

Lastly, to the extent that any of the points raised by applicant raise a doubt about our finding of likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

INTERNATIONAL KARATE ORGANIZATION

In their notice of opposition, opposers pleaded a second registration, Reg. No. 2962750, for the mark **INTERNATIONAL KARATE ORGANIZATION**. During their testimony period, a certified status and title copy of the registration was submitted. However, in his brief, *Kancho Shokei Matsui*, failed to address this claim at all. Therefore, we agree with applicant that the sole remaining opposer has waived this claim.

Decision: As to opposer IKO Kyokushinkaikan, the opposition is dismissed. As to opposer *Kancho Shokei Matsui*, his opposition based upon Registration No. 2962749 is sustained on the basis of likelihood of confusion under Section 2(d) of the Lanham Act, and registration to applicant is hereby refused.

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