

Oral Hearing:
September 30, 1997

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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JULY 8, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Fonovisa, Inc.**

Serial No. 74/241,020

Jane Shay Wald and Richard L. Gausewitz of **Oppenheimer Poms Smith**
for **Fonovisa, Inc.**

Baldev S. Sarai, Trademark Examining Attorney, Law Office 105
(**Thomas G. Howell**, Managing Attorney).

Before **Hanak, Quinn** and **Hohein**, Administrative Trademark Judges.

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

Fonovisa, Inc. has filed an application to register the
mark "MELODY" and design, as reproduced below,



for "cassette tapes, compact discs and phonograph records bearing musical sound recordings in the Spanish language" in International Class 9.¹

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 applied to its goods, so resembles the mark "МЕЛОДИЯ," which is registered in the manner shown below

МЕЛОДИЯ

for "phonograph records, audio cassettes and compact discs[,] all for musical reproductions,"² as to be likely to cause confusion, mistake or deception.³

¹ Ser. No. 74/241,020, filed on January 28, 1992, which alleges dates of first use of 1975. The application also seeks to register the mark for "posters" in International Class 16.

² Reg. No. 1,687,635, issued on May 19, 1992, which sets forth dates of first use of November 30, 1965; combined affidavit §§8 and 15. The registration states that: "The English translation of the foreign word in the mark is 'melody'."

Applicant has appealed. Briefs have been filed and an oral hearing was held.⁴ We reverse the refusal to register.

Turning first to consideration of the respective goods, we note that, as correctly pointed out by the Examining Attorney, registrant's goods encompass and are otherwise closely related to applicant's goods since, in the absence of any limitations or restrictions in the identification, the former covers all types of phonograph records, compact discs and cassette tapes, including those which, like applicant's goods, are recorded in Spanish. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Registrant's goods, therefore, would not only be sold in the same channels of trade as those in which applicant's Spanish language recordings are marketed, such as record stores and the recorded music departments of mass merchandisers and audio products

³ As indicated in the final refusal, the "refusal pertains only to [the goods in International] Class 9."

⁴ Counsel for applicant, at the oral hearing, raised for the first time the issue of whether the Examining Attorney lacked "subject matter jurisdiction" over the application, for the purpose of issuing the Office action which led to the final refusal, since a letter of protest from the registrant was received after applicant's mark had been published for opposition. While we note, in particular that applicant's mark was actually published for opposition twice (first on July 7, 1992 and again, after the lost file was reconstructed, on December 26, 1995), registrant's letter of protest was filed within 30 days of the initial publication of applicant's mark, and thus was considered timely (see TMEP §1116.03), even though it was not formally granted--and subject matter jurisdiction was restored to the Examining Attorney by the Assistant Commissioner for Trademarks--on February 8, 1996 (see TMEP §1116.02). Thereafter, on March 20, 1996, the Examining Attorney issued the Office action imposing the Section 2(d) refusal, which after receipt and consideration of applicant's timely response thereto, was made final in an Office action issued on September 19, 1996. The intervening second publication of applicant's mark (on December 26, 1995) appears, therefore, to have been erroneous and, in any event, was surplusage. Accordingly, applicant's objection on the basis of an asserted lack of subject matter jurisdiction by the Examining Attorney is not well taken.

retailers, but some of registrant's goods would even be found in the same bins or on the same racks as applicant's goods.

Consequently, if the respective products were to be sold under the same or substantially similar marks, confusion as to their source or sponsorship would be likely to occur.

Considering, then, the marks at issue, the Examining Attorney contends that "the doctrine of 'foreign equivalents' is applicable and compels a finding of likelihood of confusion."

According to the Examining Attorney:

Under this doctrine, foreign words from modern languages are translated into English to, *inter alia*, ascertain confusing similarity with English word marks. The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent. The rationale behind the rule is that a foreign word familiar to an appreciable segment of American purchasers may be confusingly similar to its English equivalent, or vice versa. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Sections 23:36 - 23:39 (4th ed. 1997). See also *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986); *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987); and *In re Perez*, 21 USPQ[2d] 1075 (TTAB 1991).

In the present case, the Examining Attorney asserts that the respective marks are similar in sound, meaning and commercial impression. In particular, while stating that "[I]t is conceded that the marks are very different in appearance given that one is in English while the other is a Russian word shown in the Cyrillic alphabet," the Examining Attorney maintains that "the difference in appearance is outweighed by the similarities between the marks as to meaning, pronunciation and commercial

impression." As to the meanings of the respective marks, the Examining Attorney notes that, not only does the cited registration contain the statement that the foreign word which forms the mark "МЕЛОДИЯ" translates into English as "melody," but the dictionary definitions from both The Oxford Russian-English Dictionary (2d ed. 1984) at 341 and the Hippocrene Standard Dictionary Russian-English English-Russian (1993) at 84 and 112 show that the registrant's mark "МЕЛОДИЯ" means "melody" or "tune" in English.⁵ Thus, the Examining Attorney argues, the respective "marks have the same meaning with respect to their literal portions and can be considered to be synonymous."

With respect to the pronunciation of the registrant's "МЕЛОДИЯ" mark, the Examining Attorney also observes that the Hippocrene Standard Dictionary Russian-English English-Russian (1993) at 84 indicates that "the cited mark's transliteration is 'melodiia'" and that such dictionary at 112 "demonstrates that the English word 'melody' translates exactly to the registrant's Russian word mark." The Examining Attorney, in light thereof,

⁵ Although such definitions are attached to the Examining Attorney's brief and were not previously made of record, the Examining Attorney in his brief has "requested that the Board take judicial notice of the dictionary definitions appended". Applicant's objection thereto, raised in its reply brief and again at the oral hearing, is utterly without merit inasmuch as it is well settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *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).

insists that, not only is it the case that "[t]he marks are clearly phonetically similar," but that:

Use of term "MELODY" or its Russian equivalent in connection with musical sound recordings creates the same commercial impression, i.e., they both suggest music, which is likely to be impressed upon the minds of the many consumers of musical recordings who speak and read modern Russian.

In view thereof, the Examining Attorney concludes that:

Given the fact that the registrant's mark is in non-Latin script, it is not likely to be accepted as it is but rather [will be] translated by potential purchasers of musical sound recordings. In making the translation, readers and speakers of Russian are bound to note its similarity to the applicant's mark and wrongly assume that some connection exists between the two labels. Even if the foreign mark is not translated by purchasers, the potential consumer cannot avoid the phonetic similarity between the marks "melody" versus "melodiia".

With respect to the design portion of the applicant's mark, it has often been remarked that the literal portions of marks are to be accorded greater weight in making likelihood of confusion determinations because purchasers use only the literal elements of marks in calling for the branded goods or services. This axiom is no less true in the instant case where the design element resembles a musical note which refers back to or suggests the literal term "MELODY" and thereby serves to emphasize it. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Americo, Inc.*, 192 USPQ 729 (TTAB 1976).

Applicant, on the other hand, contends that even if the doctrine of foreign equivalents is deemed to be applicable, confusion of an appreciable number of persons interested in purchasing musical sound recordings is unlikely. Specifically, applicant urges that:

[I]f there were ever to be any confusion, it would be relative to a person having all of the following characteristics:

- (a) is present in the United States,
- (b) reads and understands Russian Cyrillic writing,
- (c) wants to purchase a tape, disc or phonograph record bearing a musical sound recording in the Spanish language, and
- (d) ignores the prominent design portion of Applicant's mark.

It is submitted that it is not a matter of how many persons in the United States read the Cyrillic alphabet and understand what the words mean. Nor is it a matter of how many persons in the United States want to buy Spanish-language musical sound recordings. It is, instead, a matter of the likelihood of there being a significant number of persons who can and want to do both, and (also) who disregard the design portion of Applicant's mark. It is submitted that there is no likelihood of there being any such significant number of persons, and consequently that there is no likelihood of confusion.

Applicant further contends, however, that because registrant's "МЕЛОДИЯ" mark is "written in the Russian Cyrillic alphabet," the doctrine of foreign equivalents should not be applicable, notwithstanding that such mark is "translatable into the word portion of the composite [MELODY and design] mark." According to applicant:

Reference is made to McCarthy on Trademarks and Unfair Competition, J. Thomas McCarthy, Fourth Edition, Volume 3, at § 23:36 (starting at page 23-83):

The Doctrine of Foreign Equivalents should not be transformed into a

mechanical and rigid doctrine. The purchaser of the goods does not, of course, see the English "equivalent" compared to the English language word mark alleged to be confusingly similar. He sees only a foreign word mark compared to an English word mark. When it is unlikely that the American buyer will translate the foreign mark and will take it as it is, then use of the foreign equivalent gives a skewed view of the marketplace.

Here, it is submitted to be ... unlikely that an American buyer will translate the Russian Cyrillic word. It is much more unlikely that an American buyer who wants to buy compact discs, etc., "bearing musical sound recordings in the Spanish language" will translate the Russian Cyrillic word. It is unlikely that any such purchaser will disregard the design portion of Applicant's composite mark.

As to the applicability of the doctrine of foreign equivalents, we note that while such doctrine has been applied most commonly, as here, in cases in which the literal elements of the marks involved are a foreign term and its English equivalent,⁶ the Board has expressed a reluctance to apply the doctrine where the respective marks consist of terms from different foreign languages.⁷ A justification for this latter point of view is that the universe of potential customers in the United States who are sufficiently fluent in three languages, and

⁶ See, e.g., cases cited in 3 J. McCarthy, McCarthy on Trademarks & Unfair Competition (4th ed. 1998) §23:39.

⁷ See Safeway Stores Inc. v. Bel Canto Fancy Foods Ltd., 5 USPQ2d 1980, 1982 (TTAB 1987), stating that "this Board does not think it proper to take the French expression 'bel air' and the Italian expression 'bel aria' and then convert both into English and compare the English translations to determine whether there is similarity as to connotation, especially in this case."

thus would be able to translate two different foreign language terms or expressions into their corresponding English equivalents, is undoubtedly very small. This case, while it involves a mark with an English term and a mark appearing in the Russian Cyrillic alphabet, nevertheless involves basically the same general principle given the additional fact that applicant's goods are musical sound recordings in the Spanish language. Clearly, in the United States, the prospect of an appreciable number of prospective purchasers of applicant's and registrant's Spanish language musical sound recordings who, in addition to knowing Spanish, are familiar with the Russian language and are also fluent in English, so as to be able both to translate registrant's "МЕЛОДИЯ" mark from Russian into English and understand Spanish musical recordings, seems extremely remote.⁸

As our principal reviewing court has cautioned, in general, with respect to determinations of likelihood of confusion:

We are not concerned with mere theoretical confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), *citing* Witco Chemical Co. v. Whitfield Chemical Co., Inc., 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

⁸ While, of course, those who understand both English and Russian but not Spanish could nonetheless wish to listen to Spanish songs or other sound recordings in the Spanish language, the number of such persons would likewise be exceedingly small.

Moreover, as the Board observed in *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975):

[T]here are foreign expressions that even those familiar with the language will not translate, accepting the term as it is, and situations arise in the marketplace which make it feasible or even unlikely that purchasers will translate the brand names or labels appearing on canned foods and other like products.

Keeping the foregoing in mind, we think that with respect to registrant's "МЕЛОДИЯ" mark, a substantial portion of the American purchasing public would regard such term, in light of the Cyrillic lettering in which it is shown, as simply an abstract design or designation (recognizable possibly by some as of Russian origin) and would not, especially in the absence of an accompanying prominent depiction of a stylized musical note, as in applicant's "MELODY" and design mark, be inclined to translate such term into its English equivalent of "MELODY" and/or be able to vocalize the term as "melodiia" upon encountering the term on Spanish language or other recordings of music. In addition (and we believe such a situation to be remote), even if those customers or prospective purchasers of Spanish music and other musical sound recordings, who are also conversant with both English as well as Spanish, were to regard or recognize registrant's "МЕЛОДИЯ" mark, despite a lack of knowledge or understanding of Russian, as a cognate for the English word "MELODY" in applicant's mark, we nevertheless find that the identity in connotation of the respective marks is

outweighed by their striking differences in appearance and a concomitant inability to pronounce registrant's mark. As our principal reviewing court point out in *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983):

[S]uch 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.

Consequently, even among those few who might regard registrant's "МЕЛОДИЯ" mark as having the meaning of the English word "MELODY," when the respective marks are considered in their entirety, the glaring visual differences therein, due to the Cyrillic lettering in registrant's mark and the large stylized musical note prominently displayed as part of applicant's mark, are sufficient, given the inability to pronounce registrant's mark, to render the marks distinguishable and thereby avoid a likelihood of confusion.

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

E. W. Hanak

T. J. Quinn

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board