

This is in response to the non-final Office Action dated May 10, 2019, related to Application No. 88/322,616 for the mark TWIST for “Batteries; Battery chargers” in Class 9 (“Applicant’s Mark”).

I. OBJECTION TO DESCRIPTIVENESS WITH REQUEST TO ENTER 2(F) CLAIM OF ACQUIRED DISTINCTIVENESS IN THE ALTERNATIVE

In the Office Action, the Examining Attorney has inquired about the meaning of Applicant’s Mark, to which we have responded in the Miscellaneous Statement section. While we dispute the descriptiveness of the TWIST mark, if that is the USPTO’s position in this matter, we ask that you enter our 2(f) claim of acquired distinctiveness that the mark has become distinctive of the goods, as demonstrated by the evidence set forth in this response.

II. SECTION 2(D) REFUSAL

The Examining Attorney has also issued an advisory regarding a potential for likelihood of confusion with the mark OHUI, Application No. 87/872,394, which registered on May 28, 2019 (Registration No. 5,765,150) for “Accumulators, electric; Batteries, electric; Cabinets for loudspeakers; Cases for smartphones; Chargers for electric batteries; Covers for smartphones; Electric adapter cables; Electric cables; Electric wire and cable; Electrical plugs and sockets; Electronic apparatus for the remote control of industrial operations; Headphones; Horns for loudspeakers; Identification threads for electric wires; Portable media players; Protective films adapted for smartphones; Rechargeable batteries; Telephone wires,” in class 9 (“Cited Mark”).

For the following reasons, Applicant respectfully disagrees that there is a likelihood of confusion between Applicant’s Mark and the Cited Mark and requests that the refusal be withdrawn.

A. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT’S MARK AND THE CITED MARK

A likelihood of confusion determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q.563, 567 (C.C.P.A. 1973). Trademark Act Section 2(d) requires that confusion, mistake, or deception be “likely, not merely possible.” *Sears, Roebuck & Co. v. All States Life Ins. Co.*, 246 F.2d 161 (5th Cir. 1957), *cert. denied*, 355 U.S. 894 (1957). Whether confusion, mistake, or deception are likely is determined by the standard set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q.563 (C.C.P.A. 1973).

The following analysis of the most relevant *DuPont* factors establishes why there is no likelihood of confusion, mistake, or deception between Applicant’s Mark and the Cited Mark.

1. The Doctrine Of Foreign Equivalent Is Not Appropriate In The Present Case

The doctrine of foreign equivalents is used to translate foreign words from common, modern languages into English to determine their significance. TMEP 1210.10. However, the

doctrine does not apply to obscure, rare or unusual languages. See TMEP 1207.01(b)(vi)(B) citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005); see also *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443, 54 USPQ2d 1497 (5th Cir. 2000). Foreign words from obscure languages might be so unfamiliar to any significant segment of the American buying public that they should not be translated into English for descriptive purposes. *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 2007 (While “Yosemite” may mean “the killers” in the Miwok language, no significant part of the general American beer-buying public would be familiar with that tribal language.)

In addition, the doctrine of foreign equivalents is considered a guideline, not an absolute rule, and is applied only when the “ordinary American purchaser” would “stop and translate” the foreign wording in a mark into its English equivalent. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (reversing holding of likelihood of confusion where the marks were VEUVE ROYALE (the French equivalent of “Royal Widow”) and THE WIDOW, deeming it improbable that American purchasers would stop and translate “VEUVE” into “widow”).

The Examining Attorney appears to base the refusal of Applicant’s Mark on the ground that the term “OHUI” is a Hawaiian term that translates into English as “twist, snatch, pull,” and therefore, the marks are confusingly similar. The Hawaiian language, however, is an extremely rare and unusual language, with only an estimated 8,000 people who can speak and understand the language. See <https://www.to-hawaii.com/hawaiian-language.php> attached **Exhibit A**. Based on our review, online translation engines appear to be unable to provide an English translation of the Hawaiian term “OHUI” with some languages excluding the Hawaiian language from their dictionaries altogether and others auto-detecting the term “OHUI” as originating from the Vietnamese language. See attached **Exhibit B**. Further review of online Hawaiian dictionaries confirms that “OHUI” is a rare Hawaiian term with multiple meanings aside from twist, including “to snatch or rescue” or “to pick or pull,” excerpts of which are attached as **Exhibit C**.

Given the uncommon nature of the Hawaiian language along with the rarity of the term “OHUI” as well as its multiple meanings, the average American consumer encountering the Cited Mark would not stop and translate the word “OHUI.” Further, even if a consumer did translate the Cited Mark, one would not necessarily come to the conclusion that “OHUI” means “twist” given various meanings of the term “OHUI.”

According to TMEP Section 1207.01(b)(vi)(B), the doctrine of foreign equivalents should not be applied when “several translation dictionaries showing variations in the English meaning constitute evidence that the foreign word or term may not have a literal and direct translation.” Where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar. See *Sarkli*, 721 F.2d at 354-55, 220 USPQ at 112-13 (holding REPECHAGE for various skin-care products, and SECOND CHANCE for face creams and other toiletries, not likely to cause confusion, where the evidence failed to show that the terms were direct foreign equivalents); see also *In re Buckner Enters.*, 6 USPQ2d 1316 (TTAB 1987) (holding DOVE (with design) for stoves and furnaces, and PALOMA for various forms of gas heating apparatus,

not likely to cause confusion, because, *inter alia*, the Spanish word “paloma” and the English word “dove” are not exact synonyms in that “paloma” can be translated into either “dove” or “pigeon”).

In *In re OpBiz, LLC*, Serial No. 77055011 (TTAB 2009), the Board found no likelihood of confusion based on the applicability of the doctrine of foreign equivalents between the applied-for mark HEART for “cocktail lounges, restaurant and bar services” and the registered marks KOKORO and KOKORO & Design for “restaurant services.” The Board stated:

The evidence of record is insufficient to establish that “kokoro” in Japanese is the foreign equivalent of “heart.” The Japanese term has multiple English translations, only one of which is “heart.” While the translations may be somewhat similar, they are not exact. Based on the dictionary evidence, we agree with applicant that “kokoro” has a broader meaning than just “heart,” thereby rendering the two words not foreign equivalents.

Id. at 15. The Board also indicated that “the marks are completely different in sound, appearance and commercial impression.” *Id.* at 16.

In sum, the application of the doctrine of foreign equivalents is not appropriate in the current case for the purposes of determining a likelihood of confusion between Applicant’s Mark and the Cited Mark. The Hawaiian language is a rare and unusual language, and the term “OHUI” is a rare Hawaiian term with multiple meanings in English, such that a consumer would not stop and translate the Cited Mark. That, combined with the overall differences in sound, appearance, and commercial impression between Applicant’s Mark and the Cited Mark (discussed further below), establishes why there is no likelihood of confusion between the marks.

2. Dissimilarity Of The Marks In Their Entireties As To Appearance, Sound, Connotation And Commercial Impression

The fact that two marks share common elements *does not* automatically lead to a finding of a likelihood of confusion. *Source Services Corp. v. Chicagoland JobSource, Inc.*, 1 U.S.P.Q.2d 1048 (N.D. Ill. 1986). “When considering the similarities of the marks ‘[a]ll relevant factors pertaining to the appearance and connotation must be considered.’” TMEP § 1207.01(b). *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000). The mere similarity or even identity between the two marks can never alone be decisive of likelihood of confusion. *McGregor-Donniger, Inc. v. Drizzle, Inc.*, 202 U.S.P.Q. 81, 89 (2nd Cir. 1979). Thus, in holding the mark “DRIZZLE” for women’s overcoats was not likely to cause confusion with “DRIZZLER” for golf jackets, the Court of Appeals for the Second Circuit stated:

First, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. “Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.” Callman § 82.1(a), at 601-02 (footnote omitted). For this reason cases involving the alteration, addition or elimination of only a single letter from the old mark to the new reach divergent results.

McGregor-Donniger, Inc. v. Drizzle, Inc., 202 U.S.P.Q. 81, 89 (2nd Cir. 1979), citing *E.I. DuPont de Nemours & Co. v. Yoshida Internat'l, Inc.*, supra, 393 F.Supp. at 511-12, 185 USPQ at 604-605.

In comparing the relevant factors in the present case, it is evident that when Applicant's Mark and the Cited Mark are viewed in their entirety, they are very dissimilar in appearance, sensory impression, connotation, and commercial impression and not likely to result in confusion. The Applicant's Mark is TWIST while the Cited Mark is OHUI (pronounced "ō-hu'i"). In fact, the Cited Mark is so similar in appearance to the French word "OUI" that consumers may be more inclined to believe that the Cited Mark translates to "yes" in English rather than "twist." Without the additional step of attempting to translate the wording in the Cited Mark from Hawaiian to English (which as discussed above, has multiple meanings/translations and translation is unlikely to occur), there are simply no similarities between Applicant's Mark and the Cited Mark.

Any similarities between Applicant's Mark and the Cited Mark due to the fact that OHUI may translate to TWIST is greatly outweighed by the overall differences between the marks when taken as a whole. Applicant's Mark and the Cited Mark "evoke a very different image in the minds of relevant consumers" from one another. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 4714 U.S.P.Q.59 (Fed. Cir. 1998).

When taken as a whole, Applicant's Mark and the Cited Mark convey very different and distinct commercial impressions apart from one another. The visual and phonetic distinctions between Applicant's Mark and the Cited Mark create unquestionably different commercial impressions, thereby precluding a finding of likelihood of confusion and favoring the registration of Applicant's Mark. See *Odom's Tennessee Pride Sausage Inc. v. FF Acquisition LLC*, 93 USPQ2d 2030 (Fed. Cir. 2010).

3. Conclusion

Under the Lanham Act, a refusal to register under likelihood of confusion requires that such confusion as to the source of the goods/services must not be merely possible, but likely. A mere possibility of confusion is an insufficient basis for refusal under Section 2(d). See *In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. 367, 368 (TTAB 1983). In the case at hand, there is no evidence to support a finding that confusion is likely. Further, the TTAB specifically stated in *In re Massey-Ferguson*: "We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with practicalities of the commercial world, with which trademark deals." *Id.* at 368, quoting *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969).

The application of the doctrine of foreign equivalents is not appropriate in the current case, as the Hawaiian language is an uncommon language. The term "OHUI" in the Cited Mark is a rare term within the Hawaiian language such that an average American consumer would not stop and translate the mark and confuse it with Applicant's Mark. Further, even when translated, "OHUI" has meanings other than "twist."

The overall dissimilarities in the marks, the distinct commercial impression conveyed by the Applicant's Mark and the Cited Mark illustrate that there is less than a mere possibility of confusion in this case. As illustrated above, the mere similarity or even identity between Applicant's Mark and the Cited Mark is not likely to cause confusion. It would be plainly improper to maintain the refusal.

In conclusion, Applicant's Mark and the Cited Mark must be considered in their entireties, and further consideration of the visual and phonetic differences as well as the overall commercial impression imparted by Applicant's Mark, as compared to the meaning and overall commercial impression of the Cited Mark, suggests that Applicant's Mark is readily distinguishable and not similar to the Cited Mark. In total, the *DuPont* factors weigh against a finding of likelihood of confusion between Applicant's Mark and the Cited Mark.

Therefore, the Section 2(d) Likelihood of Confusion Refusal related to the Cited Mark should be withdrawn, and the mark should be allowed to proceed to publication.