

Attention : Rockelle Ricks

Re 75-880796

1-14-02

Rochelle,

Judge Botorff suggested that the best course of action here would be for me to return the case to the Board for action on the request for remand contained at pages 5 and 6 of the Applicant's Appeal Brief. The request includes only one of the third party registrations referred to by applicant, and thus does not even include all of the evidence that the applicant wishes to have considered. Further it contains no reasons why the evidence was not available during prosecution. Although it seems that the request thus does not satisfy TBMP 1207.02, it really doesn't seem proper for the examiner to rule on the request for remand. This seems to be something a Board member should rule on. If the request for remand is denied, then the case could be returned to me for my Appeal Brief. Thanks.


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whether a likelihood of confusion exists. *Id at 1360-61.*

Applicant respectfully disagrees with the Examiner's request to exclude the third party registration for LA VIDA LOCA in class 25 mentioned in the Applicant's Office Action response of December 19, 2000. *As Du Pont* stated that every case with an issue related to likelihood of confusion turns on the facts, not on conjecture, the court held that it was the examiner's and the board's duty to consider all the evidence as to whether a likelihood of confusion exists, *Id at 1362.* Additionally, Applicant argues that U.S.P.T.O. TESS (United States Patent and Trademark Office Trademark Electronic Search System) records that evidence third party registrations relevant to the likelihood of confusion issue should be acceptable as official records which are not themselves in question (TESS records are certainly available to the Examiner and used by examiners to support refusals of registration) and because the overall policy of trademark examination, developing from even prior to the passage of the Lanham Act in 1946 through creation of the TMEP and the many TTAB decisions issued, has been a striving for consistency in the trademark examination procedure. Relevant prior registrations should be allowed when it supports an Applicant's arguments for registration as they are U.S.P.T.O. public records and freely used by examiners to support refusals of registrations. Examiners should not be allowed to excluded U.S.P.T.O. records as a means of turning a blind eye to records which do not support them.

Alternatively, Applicant respectfully requests the Board to remand the application to examination so that information containing relevant facts, including official records

such as third party TESS registration records, may be added to the application record.

Finally, Applicant respectfully believes that if its mark is not dissected for comparison with Registrant's mark and all relevant aspects of the 13 *Du Pont* factors are applied to all the relevant facts, no likelihood of confusion results between Applicant's and Registrant's marks.

MARKS ARE NOT CONFUSINGLY SIMILAR

THE MARKS MUST BE VIEWED IN THEIR ENTIRETIES

Applicant respectfully disagrees with the Examining Attorney's contention that the VIVA LA VIDA word mark of the Applicant is highly similar to the LA VIDA and design mark of the Registrant. According to *Du Pont*, the similarity of marks is determined by comparison of the marks in their entireties as to appearance, sound, connotation and commercial impression. However, the examiner has argued the similarity of the marks by dissecting the Applicant's mark for comparison.

DOMINANCE OF WORD OR DESIGN

The examining attorney argued in that dissection of marks to compare the similar portion because the "design element is not controlling" was allowed by *In re Appetito Provisions Co.*, 3 USPQ 2d 1553 (TTAB 1987). However, *Appetito* did not say that the