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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77135681
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

***In re Application of:* ALLEN BATRES MIRANDA**

**SERIAL NO.: 77/135,681**

**FILED: MARCH 20, 2007**

**MARK: FUTBOLITO**

**INTERNATIONAL CLASS: 28**

**TRADEMARK ATTORNEY: GINA C. HAYES/LAW OFFICE 103**

**APPEAL BRIEF**

Hon. Commissioner for Trademarks  
United States Patent and Trademark Office  
P. O. Box 1451  
Alexandria, Virginia 22313-1451

*To the Trademark Trial and Appeal Board:*

**I. Introduction**

On July 22, 2008, Applicant, Allen Batres Miranda, Appellant herein, electronically-filed a *Notice of Appeal* from the Examining Attorney's final refusal-to-register, as issued in the Office Action, dated January 22, 2008. The *Notice of Appeal* has been taken from both a §2(d) likelihood-of-confusion refusal-to-register and a §2(e)(1) "merely descriptive" refusal-to-register Appellant's mark in International Class 28, and Appellant now respectfully requests that The Trademark Trial and Appeal Board reverse the Examiner's decision not to pass to publication Appellant's trademark.

## II. Appellant's Mark

Appellant's trademark is a word mark in "standard" character format for the wording "FUTBOLITO." Appellant seeks registration of his mark on the Principal Register for the goods now recited as "Board games; Football or soccer goals; Game tables," in International Class 28.

## III. The Refusal-to-Register and Pertinent Facts

Appellant filed an "intent-to-use" trademark application on March 20, 2007, to register the word mark "FULBOLITO" on the Principal Register in International Class 28 for goods originally recited as "Board games; Football or soccer goals; Game tables; Action skill games; Action target games."

On June 28, 2007, the Examining Attorney issued a first Office Action refusing registration, pursuant to §2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that a likelihood of confusion would exist between Appellant's "FUTBOLITO" trademark and "MLS FUTBOLITO" mark of U.S. Trademark Registration No. 2,978,074. As part of the first Office Action, the Examining Attorney also refused registration of Appellant's trademark, pursuant to §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the contention that Appellant's "FUTBOLITO" was "merely descriptive" of Appellant's recited goods.

On December 28, 2007, Appellant electronically filed a response to the first Office Action, in which Appellant addressed the both Examiner's §2(d) likelihood-of-

confusion refusal-to-register and the §2(e)(1) “merely descriptive” refusal-to-register. As part of Appellant’s response to the first Office Action, Appellant narrowed the recitation of goods of his application to now read: “Board games; Football or soccer goals; Game tables,” in International Class 28.

On January 22, 2008, the Examining Attorney issued a second (and final) Office Action maintaining both the §2(d) likelihood-of-confusion to register and §2(e)(1) “merely descriptive” refusal-to-register, substantially as issued in the first Office Action. No other refusals-to-register or informalities have been raised by the Examining Attorney during the application prosecution.

Accordingly, both the §2(d) likelihood-of-confusion refusal-to-register and the §2(e)(1) “merely descriptive” refusal-to-register remain outstanding and are before the Board for resolution on this Appeal.

#### IV. Issues

The following issues are presented for resolution on this Appeal:

1. Is Appellant’s trademark, “FUTBOLITO,” “merely descriptive” for goods recited as “board games; football or soccer goals; game tables,” such that registration on the Principal Register should be refused under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1)?
2. Does a likelihood of confusion exist between Appellant’s mark and the mark

of U.S. Trademark Registration No. 2,978,074 for the mark “MLS FUTBOLITO” for goods recited as entertainment services, namely organizing, conducting and staging professional soccer games and exhibitions” and for related television and radio productions?

Inasmuch as the argument for withdrawal of the §2(d) and §2(e)(1) refusals-to-register are interrelated, a “combined” argument addressing both grounds for refusal will be presented.

#### V. Argument

##### Combined Argument to §2(d) Likelihood-of-Confusion and §2(e)(1) “Merely Descriptive” Refusals-to-Register

##### *No Likelihood of Confusion Exists Between Appellant's Trademark “FUTBOLITO” and “MLS FUTBOLITO” in View of the Suggestiveness of the Marks and the Narrow Scopes of Protection to Which Such Suggestive Trademarks are Entitled*

In the final Office Action, the Examining Attorney had refused registration of Appellant’s trademark, “FUTBOLITO,” pursuant to §2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the contention that a likelihood of confusion would exist between Appellant’s mark and the mark of U.S. Trademark Registration No. 2,978,074 for the mark “MLS FUTBOLITO.” The goods in Trademark Reg. No. 2,978,074 are “entertainment services, namely organizing, conducting and staging professional soccer games and exhibitions,” as well as related television and radio productions. Appellant’s goods (as last amended on December 28, 2007), by contrast, are for “Board games, Football or soccer goals; Game tables,” which are not within the goods of the applied registration.

In reply to the overall merits of the Examiner's §2(d) likelihood-of-confusion and §2(e)(1) refusals-to-register, Appellant agrees with the Examining Attorney that the term "FUTBOLITO" is a relatively weak mark, but one which should nevertheless be considered suggestive, as opposed to "merely descriptive." In this respect, a prospective purchaser, upon viewing or hearing the term "FUTBOLITO" pronounced, would likely commence a multi-step reasoning process in order to attempt to surmise what goods or services are offered in connection with the "FUTBOLITO" mark of Appellant and the Registrant's mark which includes this term. *See, generally, No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (T.T.A.B. 1985) (Trademark Trial and Appeal Board adopts three-part test for determination of suggestiveness of mark: (1) degree of imagination; (2) competitors' use; and, (3) competitors' need.) The respective trademarks of Appellant and the owner of the applied registration are submitted to be suggestive, because of the various types of games implied by the term "FUTBOLITO," but whether those games are board games or live "on-field" soccer games, is not reasonably knowable upon hearing the term "FUTBOLITO."

Because Appellant submits that his mark and that of the cited registration are both suggestive, it is respectfully contended that each should be afforded only a narrow scope of protection, rather than being accorded the same scope of protection as would a fanciful or arbitrary trademark term. *See, e.g., Sure-Fit Products Co. v. Saltzson Drapery Co.*, CCPA 856, 254 F.2d 158, 117 USPQ 295, 297 (1958) ("It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owner of strong trademarks. Where

a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights."); *see, also, Nestles Milk Products, Inc. v. Baker Importing Co.*, 37 CCPA 1066, 182 F.2d 193, 86 USPQ 80 (1950) (the presence of a common element of allegedly conflicting marks that is a word that is "weak" reduces the likelihood of confusion); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 58 CCPA 735, 432 F.2d 1400, 167 USPQ 529 (1970); *Knapp-Monarch Co. v. Poloron Products, Inc.*, 134 USPQ 412 (T.T.A.B. 1962) (portion of a mark may be "weak" in the sense that such portion is descriptive, highly suggestive or is in common use by many other sellers in the market); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1912 (T.T.A.B. 1988); ("IMPERIAL" held to be "a relatively weak mark and we agree with applicant that the scope of protection afforded such a mark is considerably narrower than that afforded a more arbitrary designation."); *National Biscuit Co. v. Princeton Mining Co.*, 137 USPQ 250 (T.T.A.B. 1963), *aff'd*, 52 CCPA 844, 338 F.2d 1022, 143 USPQ 422 (1964) ("PREMIUM" held to be a classic weak mark). Absent the identical mark for the identical goods or services, the very narrow scopes of protection to which the respective marks of the cited registration and of the instant trademark application are entitled, no likelihood of confusion should be found to exist.

The weakness of the respective trademarks of Appellant and that of the applied registration, as recognized by the Examining Attorney's §2(e)(1) "merely descriptive" refusal-to-register of Appellant's trademark – a mark which Appellant submits should be viewed as suggestive and therefore registrable without a showing of secondary meaning – contributes to a finding that no likelihood of confusion should be found to exist as

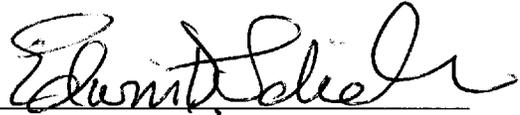
between Appellant's trademark and that of the applied registration.

VI. Conclusion

In light of the foregoing, it is respectfully contended that the Examining Attorney's refusal-to-register under §2(d) of the Trademark Act, pertaining to the Examiner's contention that Appellant's trademark "FUTBOLITO" is confusingly similar to the mark of Trademark Registration No. 2,978,074, in addition to the Examiner's §2(e)(1) "merely descriptive" refusal-to-register, should now be reversed by the Board and the trademark of the present application should be passed to publication. Such favorable action is respectfully requested and earnestly solicited.

Respectfully submitted,

ALLEN BATRES MIRANDA

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September 22, 2008

The Commissioner for Trademarks is hereby authorized to charge the Deposit Account of Applicant's Attorney, Account No. 19-0450, for any fees which may be due in connection with the prosecution of the above-identified trademark application, but which have not otherwise been provided for.