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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/135681

MARK: FUTBOLITO

CORRESPONDENT ADDRESS:
MICHAEL I. KROLL
MICHAEL I. KROLL
171 STILLWELL LN
SYOSSET, NY 11791-1913

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: Miranda, Allen Batres

CORRESPONDENT'S REFERENCE/DOCKET NO:
AM-2-019sd
CORRESPONDENT E-MAIL ADDRESS:
patent@invention.net

EXAMINING ATTORNEY'S APPEAL BRIEF

The application was refused on the ground that there is a likelihood of confusion between the proposed mark, FUTBOLITO and U.S. Registration No. 2978074, MLS FUTBOLITO within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d). In addition, the application was refused on the ground that the proposed mark is merely descriptive of the applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act. The trademark examining attorney respectfully requests that the Board affirm the refusal on both grounds.

STATEMENT OF FACTS

On March 20, 2007, Applicant filed an Intent to Use application to register FUTBOLITO on the Principal Register for "board games; football or soccer goals; game tables; action skill games; action target games." On June 28, 2007, the examiner issued the first Office Action rejecting the proposed mark on two grounds, (1) likelihood of

confusion with Registration No. 2978074 for FUTBOLITO under Section 2(d) of the Trademark Act and (2) that the mark is merely descriptive of the goods under Section 2(e)(1) of the Trademark Act. The Applicant filed a response on December 28, 2007 in support of registration. The applicant also revised the identification of goods to delete action skill and action target games. On January 22, 2008, the examiner issued the final refusal under Sections 2(d) and 2(e)(1). Applicant filed a Request for Reconsideration and Notice of Appeal on July 22, 2008. The Request for Reconsideration was denied. Applicant filed its brief on September 22, 2008. Jurisdiction was thereafter restored to the examining attorney.

ISSUES ON APPEAL

(1) Whether Applicant's proposed mark, FUTBOLITO for "board games; football or soccer goals; game tables" is likely to cause confusion with the registrant's mark, MLS FUTBOLITO for "entertainment services, namely organizing, conducting and staging professional soccer games and exhibitions; production for television and radio presentations of professional soccer games and exhibitions."

(2) Whether the proposed mark FUTBOLITO is merely descriptive of the goods, namely, board games; football or soccer goals; game tables.

ARGUMENTS

A. FUTBOLITO IS MERELY DESCRIPTIVE OF THE GOODS

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *Id*. *See also In re Bed & Breakfast Registry,* 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 U.S.P.Q. 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (TTAB 1979);

TMEP section 1209.01(b). The applicant's football and soccer goals will be used in the game of soccer. In addition, the applicant's board games and table games will feature the game of soccer. Fubolito is a form of soccer; therefore, futbolito is merely descriptive of the subject matter of applicant's goods.

The origin of the term futbolito is the Spanish word "futbol," which is defined by the Merriam Webster Dictionary as "soccer" (see the definition attached to the final office action). Futbolito is a common term of art used to describe field soccer or the game table version of the same. The examiner attached several articles to her first and final office actions that demonstrated common usage of the term futbolito in reference to soccer. For example, an article from the Internet dated September 17, 2007, (attached to the final office action), entitled Teaching History, Playing Soccer, and Stumbling Over Spanish explains the origin of the term futbolito: "In Spanish, adding the ending 'ito' to a word implies small size or cuteness…and a tiny soccer game becomes futbolito" http://paraguay.bolgspot.com/2007/09/fubolito.html. Further, a Major League Soccer's (hereinafter referred to as "MLS") MLS Futbolito Press Release dated April 11, 2007, (attached to the first office action) entitled MLS Futbolito Celebrates its Fifth Year states: "Major League Soccer today announces the return of one of the league's most successful grassroots initiatives, MLS-Futbolito, the leagues' official 4-v-4 soccer tournament co-presented by Burger King, Panasonic and Sierra Mist." Another article entitled Futbolito: A Journey Through Central America (attached to the first office action) describes futbolito as a baby soccer game. The article states: "While volunteering in Guatemala with Peace Brigades International during 1987, Social Worker Daniel Botkin discovered

that footbag (nicknamed 'el futbolito' or 'baby soccer ball' by several Spanish speaking enthusiasts)…"

In addition, the examiner attached photos from an article dated April 23, 2007, depicting men playing the table game of foosball (the table version of field soccer). The quote beneath the pictures states "nothing beats the social aspects of futbolito." To prove the point that table soccer is also called "futbolito," the examiner attached an excerpt from Wikipedia.com to the first office action, which included "futbolito" in its definition of "table football," it states: "Table football is also known in the U.S. as foosball, from fuБball, the German word for football (although foosball is generally known as 'kicker' in German), and is alternatively known as table soccer. In Spain it is known as futbolito, in Chile it is known as taca-taca, in some other Spanish-speaking countries being futbol de mesa or futbolito." Material obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (Internet evidence accepted by the Board to show false connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (Internet evidence accepted by the Board to show geographic significance); *Fram Trak Indus. v. WireTracks LLC*, 77 USPQ2d 2000, 2006 (TTAB 2006) (Internet evidence accepted by the Board to show relatedness of goods); *In re Consol. Specialty Rest. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (Internet evidence accepted by the Board to show that geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (Internet evidence accepted by the Board to show surname significance); *In re Fitch IBCA Inc.*, 64

USPQ2d 1058, 1060 (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

By applicant's own admission, the term "futbolito" is weak (Applicant's Brief page 5). However, Applicant argues the word is suggestive and that therefore a multi-step reasoning process is required to surmise what goods are offered in connection with the proposed futbolito mark. *Id.* On the contrary, futbolito is descriptive, not suggestive. A suggestive term differs from a descriptive term, which immediately and directly conveys some information about the goods. *In re Aid Laboratories, Inc.*, 223 USPQ 357 (TTAB 1984). A suggestive mark is registrable on the Principal Register. (TMEP §1209.01(a)). The crucial determination as to the registrability of a mark in this context is whether the proposed mark is suggestive as applied to a particular set of goods. Moreover, the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g.*, *In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). When consumers encounter the term FUTBOLITO in light of the applicant's goods, there is no

question that the consumers will immediate conclude that the game board or the table game features soccer. There is no imagination, thought or perception required to determine the nature of the applicant's goods from the term futbolito.

For the purposes of a Section 2(e)(1) analysis, it is sufficient that the term describe only one attribute of the goods and/or services to be found merely descriptive. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973); TMEP §1209.01(b). In this case, clearly the applicant's board games, football or soccer goals and board tables will feature the game of futbolito. Fubolito is synonymous with a form of soccer. Therefore, the applicant's mark must be refused as merely descriptive under Section 2(e)(1) of the Trademark Act.

B THE APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH U.S. REGISTRATION NUMBER 2978074 UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Marks are Confusingly Similar

Applicant's mark, FUTBOLITO is confusingly similar to the registrant's mark MLS FUTBOLITO because the marks are identical in part and highly similar. The applicant's proposed mark consists solely of the term FUBOLITO. The registration is composed of FUTBOLITO plus the acronym MLS. Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the services, to cause confusion, or to cause mistake or to deceive. The Court in *In re E. I. DuPont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether there is a likelihood of

confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the services.

Applicant does not argue that the marks are not likely to be confused; instead, Applicant argues the term futbolito is weak and thus not entitled to protection in this case (Applicant's brief, page 5). The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. This protection even extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). The registrant's registration is valid and is entitled to protection, despite the fact that futbolito is descriptive. Applicant ignores the fact that the registrant's mark is not comprised solely of futbolito. The registrant has combined MLS with its mark while the applicant's proposed mark is solely the descriptive term FUTBOLITO.

The overriding concern in the likelihood of confusion analysis is to prevent buyer confusion as to the source of the goods and services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.,* 209 USPQ 698 (N.D. Ga. 1980). It is more likely that purchasers will assume that there is a source or other connection between the goods and services sold under the respective marks, based on the fact that the applicant's mark is comprised entirely of a word taken from the Registrant's mark. In fact, the applicant's mark is presented in Standard Character without claim to any particular font, style, size or color. Likewise, the registrant's mark is not stylized; therefore, the marks bear the exact

connotation. But, the real question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b). In this case, the average purchaser will recall the word FUTBOLITO and will not distinguish MLS FUTBOLITO from FUTBOLITO due to the fact that the marks share the same overall impression.

Goods and Services are Confusingly Similar

The applicant's goods and the registrant's services are related. The Applicant's goods are board games; football or soccer goals. The Registrant's services are entertainment services, namely organizing, conducting and staging professional soccer games and exhibitions; production for television and radio presentations of professional soccer games and exhibitions. It is likely that consumers will be confused by the use of highly similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837

F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

The examiner attached copies of printouts from the USPTO X-Search database with her Final Office Action, which showed third-party registrations of marks used in connection with the same or similar goods and services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely board games and entertainment in the nature of soccer games are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck*

Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). See: U.S. Registration Nos. 2644998; 2653133 (MBA) for board games and entertainment in the nature of soccer games. These registrations serve as evidence that confusion is likely in this case.

The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods or services, but it also protects against "reverse confusion," that is, that the junior user is the source of the senior user's goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Banff Ltd., v. Federated Department Stores*, 6 USPQ2d 1187 (2d Cir. 1988); *Fisons Horticulture v. Vigoror Industries,* 31 USPQ2d 1592 (3rd Cir. 1994). Consumers familiar with the Registrant's professional soccer games upon encountering Applicant's board games and other Class 28 goods sold under a highly similar mark are likely to conclude that the goods and services emanate from a single source. It is not uncommon for the same owner to apply an identical trademark to its major league soccer team and its goods associated with that team, such as board games and other goods in International Class 28. For example, FC Dallas, a professional soccer team that plays in the MLS has a federal trademark registration (Registration No. 3103064) for FC DALLAS, which includes board games and other goods in International Class 28 in addition to professional soccer games (see Registration No. 3103064 FC DALLAS attached to the final office action). This suggests that MLS sports fans are familiar with the use of the same trademark on MLS teams and goods like board games connected with the team; therefore, upon encountering the applicant's FUTBOLITO board games featuring soccer,

MLS FUTBOLITO fans are likely to conclude that the Applicant's board games emanate from, are sponsored by or associated with the owner of MLS FUTBOLITO.

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes* (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i). Since the marks in this case are identical in part and highly similar overall, there is no doubt that the marks are confusingly similar. Finally, to the extent that there is any doubt on the question of the likelihood of confusion, doubt must be resolved against the newcomer who files an Intent to Use application and in favor of the established longtime user. *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470. This principle applies here where the applicant has filed an Intent to Use application.

CONCLUSION

For the foregoing reasons, refusal on the grounds that the proposed mark is descriptive within the meaning of Section 2(e)(1) and likely to be confused with U.S. Registration No. 2978074 within the meaning of Section 2(d) of the Trademark Act should be upheld. The trademark examining attorney respectfully requests that the Board affirm the refusal on both grounds.

Respectfully submitted,

Gina Hayes, Esq.
/GH/
Trademark Examining Attorney
U.S. Patent and Trademark Office
Law Office 103
571-272-9407

Michael Hamilton
Managing Attorney
Law Office - 103