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This Opinion is Not a  
Precedent of the TTAB

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Allen Batres Miranda

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Serial No. 77135681

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Edwin D. Schindler, Esq. for Allen Batres Miranda

Gina Hayes, Trademark Examining Attorney, Law Office 103  
(Michael Hamilton, Managing Attorney).

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Before Quinn, Rogers, and Wellington, Administrative  
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant seeks to register the term FUTBOLITO in standard characters, on the Principal Register, for goods ultimately identified as "Board games; Football or soccer goals; Game tables" in International Class 28.<sup>1</sup>

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of the prior registration of the mark MLS FUTBOLITO

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<sup>1</sup> Application Serial No. 77135681 is based on Section 1(b) (bona-fide intent to use the mark in commerce).

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" in International Class 41.<sup>2</sup>

The examining attorney has also refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that FUTBOLITO is descriptive of applicant's identified goods.

Applicant concurrently filed a request for reconsideration and an appeal.<sup>3</sup> Both applicant and the examining attorney filed briefs.

We first turn our attention to the refusal under Section 2(e)(1), namely that applicant's mark is merely descriptive of the identified goods. The question of whether a proposed mark is merely descriptive is not determined by asking whether one can guess, from the mark

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<sup>2</sup> Registration no. 2978074, issued July 26, 2005 to Major League Soccer, L.L.C.

<sup>3</sup> As to the request for reconsideration, it appears to be merely a cover page stating that applicant is "concurrently filing [therewith] a Notice of Appeal." There is no argument contained therein. The application was not remanded to the examining attorney by the Board and there does not appear to be any response from the examining attorney addressing the request for reconsideration. Nevertheless, the examining attorney states in her brief that the request for reconsideration was denied. Brief, (unnumbered) p. 2. Applicant does not mention the request for reconsideration in his brief. In view thereof, we consider the appeal ready for decision.

itself, what the goods or services are, but rather by asking, when the mark is seen on or in connection with the goods or services, whether it immediately conveys information about their nature. See *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). Also, the mark does not have to describe all goods that are included within applicant's identification of goods. *In re Analog Devices*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

Based on the evidence of record, we find that when applicant's mark, FUTBOLITO, is considered in relation to soccer goals or game tables, it immediately informs prospective purchasers of the purpose of the soccer goals or the type of game tables being offered by applicant.

The term "futbolito," is the combination of the Spanish word for soccer ("futbol") and the Spanish diminutive suffix "ito," which is typically used to indicate smaller size.<sup>4</sup> And under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine genericness or

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<sup>4</sup> The definition of "futbol," taken from *Merriam-Webster's Spanish-English Dictionary*, was attached to the Office Action dated January 22, 2008. We further take judicial notice that the *The University of Chicago Spanish Dictionary* (Fifth Edition, University of Chicago Press) identifies "-ito" as a common Spanish diminutive suffix.

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descriptiveness. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Further, "there is no question that Spanish is a common, modern language...the second most common language in the United States after English." *In re Peregrina Limited*, 86 USPQ2d 1645 (TTAB 2008). The doctrine is applied when it is likely that the ordinary American purchaser would "stop and translate [the word] into its English equivalent." *In Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). Because Spanish terms are so ubiquitous and the language is spoken by many people in the United States, a great deal of ordinary American purchasers will "stop and translate" applicant's mark, FUTBOLITO. In doing so, they will immediately understand that the mark describes applicant's soccer goals, i.e., they are small(er) goals for the types of soccer games in which smaller goals are used, and describes applicant's game tables as relating to soccer.

As to the soccer goals, the examining attorney has submitted internet evidence that indicates that soccer games with fewer than the regulation number of players may be called "futbolito." For example:

Futbolito

In Spanish, adding the ending -ito to word implies small size or cuteness. [For example], one teacher

calls his daughter Sara, *Sarita*...and a tiny soccer game becomes *futbolito*. Welcome to the high school lunchtime tournament...the games are 5 v 5, two halves of 10 minutes...[picture of children playing soccer in a gymnasium].

[From website [www.pannaquay.blogspot.com](http://www.pannaquay.blogspot.com), italics in original]<sup>5</sup>

As to the game tables, the examining attorney attached to her first Office Action an entry from the Wikipedia online encyclopedia for "table football (also called foosball...)," identifying it as a "table-top game that is based on association football [soccer]..." that is also known "in some other Spanish-speaking countries [as] futbolito."<sup>6</sup> The Wikipedia entry contains photographs of such games - essentially a table-top game with hand-controlled levers that move "soccer players" with the objective of striking a ball and scoring into the opponent's goal. The examining attorney also attached an internet website printout containing a picture of some men playing the same soccer-themed, table-top game under the title of "Futbolito," with the commentary "Newer bars have video games. But nothing beats the social aspects of futbolito."<sup>7</sup>

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<sup>5</sup> Attached to Office Action dated January 22, 2008.

<sup>6</sup> Attached to Office Action dated June 28, 2007.

<sup>7</sup> From website [www.turingmachine.org](http://www.turingmachine.org), attached to Office Action dated June 28, 2007.

Thus, the evidence demonstrates that applicant's mark, FUTBOLITO, is merely descriptive of, if not generic for, a certain type of game table. Specifically, FUTBOLITO may be used to identify the soccer-themed game-table, also known as "foosball" in the United States.

Whether applicant's mark FUTBOLITO is understood by consumers as describing soccer goals used for a smaller-scale game of soccer (with human players) or to describe the type of table-top game, the application's identification of goods encompasses both types of goods. In other words, applicant's "soccer goals" could include smaller goals intended for games involving only a few players; likewise, applicant's "game tables" is broad enough to include the soccer-themed table-top game, which has been referred to as "futbolito."

For the aforementioned reasons, the refusal of registration under Section 2(e)(1) is affirmed.

We now turn our attention to the likelihood of confusion refusal. Here, our analysis is based on all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

"The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but 'may focus ... on dispositive factors.'" *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (citations omitted). In many cases, two dispositive considerations are the similarities of the marks and the similarities of the goods and services. See, e.g., *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). Accordingly, we have reviewed the evidence of record and the arguments concerning the import of such evidence in light of such considerations.

We begin our analysis with the first *du Pont* factor which requires us to examine the similarities and dissimilarities of the marks in their entirety in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc.*, 73 USPQ2d 1689, 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion

as to the source of the goods and/or services offered under the respective marks is likely to result.

Again, the marks are registrant's MLS FUTBOLITO and applicant's FUTBOLITO. The marks are obviously the same except that applicant does not seek to register registrant's initials. As to connotation or commercial impression, the marks are also very similar in that they both are dominated by the term "futbolito" which, as we have already noted in the descriptiveness refusal section of this decision, may be loosely translated into English as "miniature soccer." Thus, for many ordinary American purchasers who are familiar with Spanish, the marks will convey the same connotation and commercial impression, i.e., "miniature soccer." Even for those consumers unfamiliar with the translation of the term, they too may find the marks to create the same impression, e.g., that FUTBOLITO is a coined term or an unknown Spanish word, and whatever connotation such consumers would ascribe to the term, would be the same in regard to both marks.

The letters MLS in registrant's mark are evidently an initialism for registrant, Major League Soccer, L.L.C. The evidence submitted by the examining attorney showing registrant's use of its mark makes this clear. Consumers are therefore likely to attribute this portion of registrant's mark as being merely the trade name (or house



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mark) of the entity that is the source of the FUTBOLITO services. The absence of these letters in applicant's mark would therefore have little significance for purposes of distinguishing the marks. In other words, and as this Board has generally found, likelihood of confusion is not avoided between otherwise confusingly similar marks by adding or deleting a house mark. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Hewlett-Packard Co. v. Packard Press Inc.*, *supra*; *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986); and *In re Riddle*, 225 USPQ 630 (TTAB 1985).

Accordingly, we find the marks, MLS FUTBOLITO and FUTBOLITO, are highly similar in appearance, sound and connotation. This factor strongly favors finding a likelihood of confusion.

We now address the "strength of the cited mark" factor, as this is the factor that applicant emphasizes in arguing why we should not find a likelihood of confusion. Specifically, he argues that the term FUTBOLITO is suggestive of both applicant's goods and registrant's services and, therefore, the registered mark should "be afforded only a narrow scope of protection." Brief, p. 5. This weakness, applicant contends, is "recognized by the

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Examining Attorney's [descriptiveness] refusal-to-register of [applicant's] trademark." *Id.*

We agree with applicant that FUTBOLITO is suggestive of the registrant's recited services inasmuch as the recited services involve soccer (or "futbol") games. However, even though we have found applicant's intended use of the term FUTBOLITO to be merely descriptive of applicant's goods, we do not (and cannot) make such a finding as to the registrant's use of the term FUTBOLITO in its mark in connection with its services. The validity of the registration for the cited mark is not a question before us in this appeal and the registration must be accorded the full benefits to which it is entitled under Section 7(b) of the Trademark Act. *See In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Moreover, we note that there is no disclaimer of the term FUTBOLITO in the cited registration, nor is there any claim of acquired distinctiveness by registrant. And notwithstanding any suggestiveness of FUTBOLITO in the registered mark, we do not find the mark to be so weak as to prevent protection against registration by a subsequent user of the same or very similar mark for related goods and/or services. As stated by the court in

*King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d

1400, 182 USPQ 108, 109 (CCPA 1974):

Confusion is confusion. The likelihood thereof is to be avoided, as much between "weak" marks as between "strong" marks, or as between a "weak" and a "strong" mark.

We now consider the second *du Pont* factor, which requires us to determine the similarity or dissimilarity of the applicant's goods vis-à-vis the cited registrant's services. Again, applicant is seeking registration of his mark for "board games; football or soccer goals; game tables." The cited registered mark covers "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 settled that it is not necessary that the goods or services be identical or even competitive in order to find that they are sufficiently related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods or services themselves, but rather whether they would be confused as to the source of the goods or services. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the goods or services be related in some manner, or that the

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circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Here, applicant's goods and registrant's services are not directly competitive and they are clearly not overlapping. The examining attorney contends, however, that the respective goods and services are related because "[i]t 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." Brief, (unnumbered) p. 8. To support her position, the examining attorney made of record (with her final Office Action) copies of third-party registrations to show that various trademark owners arrange or conduct athletic competitions for entertainment purposes under the same mark as goods,

including sports equipment and board games. To the extent that these registrations are use-based (and we note that many are not)<sup>8</sup>, they have probative value because they serve to suggest that such goods and services are of a type which may emanate from a single source. See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). In particular, she relies on Registration No. 3103064 for the mark FC DALLAS which covers "entertainment services, namely organizing, conducting and staging professional soccer games..." as well as various soccer gear, computer and video games, and "board games."

Although the number of use-based registrations made of record by the examining attorney is relatively small, they suggest that applicant's soccer goals, board games and table-top games are goods that may emanate from entities, such as registrant, who organize, conduct and stage professional soccer games. Moreover, as the Board has acknowledged in prior cases, it is common knowledge that

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<sup>8</sup> Only three of the attached third-party registrations are based on use in commerce. The other attached registrations are based on foreign registrations which we find to be of little weight because, as stated in *Mucky Duck, supra* at 1470 fn.6, and as explained on numerous occasions by the Board, applications and registrations based on foreign registrations "are not even necessarily evidence of a serious intent to use the marks shown therein in the United States on all of the listed goods and services."

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the licensing of commercial trademarks on "collateral" goods has become a part of everyday life. See *DC Comics v. Pan American Grain Mfg. Co.*, 77 USPQ2d 1220, 1225 (TTAB 2005); and *Turner Entertainment v. Nelson*, 38 USPQ2d 1942, 1944 (TTAB 1996). See also *Chicago Bears Football Club, Inc. and NFL Properties LLC v. 12<sup>TH</sup> Man/Tennessee LLC*, 83 USPQ2d 1073, 1077 (TTAB 2007). Here, applicant's board games and game tables are the type of goods that may be viewed as collateral products to registrant's entertainment services in the nature of conducting and arranging professional soccer exhibitions.

With respect to the channels of trade and classes of consumers, the law is clear that when neither of the involved identifications contains limitations as to the classes of consumers or channels of trade for the identified goods and services, then the goods and services must be presumed to travel in all normal channels of trade to all customary consumers for such goods and services. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Here, we have little evidence upon which we can make conclusions. We do know that the normal trade channels for registrant's entertainment services in the nature of staging professional soccer games will be different from the normal

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trade channels of applicant's soccer goals, board games or table-top games. However, to the extent that purchasers of the respective goods and services include those with an interest in soccer (whether playing or watching), it is likely that these consumers may encounter the marks at the same establishments or trade channels. For example, any soccer enthusiast magazine could foreseeably contain advertisements for registrant's soccer entertainment services, e.g., advertising an upcoming match, as well as applicant's goods. Likewise, registrant may place posters advertising MLS FUTBOLITO soccer matches at entrances of retail stores carrying soccer-related goods, such as applicant's FUTBOLITO soccer goals or game tables. In short, consumers familiar with registrant's services, when encountering applicant's goods in a store, on a website, or in some other retail context, may conclude that the goods are licensed by registrant or otherwise affiliated with registrant and its services.

In conclusion, given that the marks, MLS FUTBOLITO and FUTBOLITO, are highly similar and the relatedness of applicant's soccer goals, board games and game tables and registrant's entertainment services featuring soccer games, we find that a likelihood of confusion exists.

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Accordingly, the refusal of registration under Section 2(d) is affirmed.

Finally, if there were any doubt on the question of likelihood of confusion, the law favors registrant. *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973) ("If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant. The rule is usually applied in *inter partes* cases but it applies equally to *ex parte* rejections." ). See also, *In re Hyper Shoppes*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988), and *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987), citing *In re Pneumatiques* (Board affirmed refusal to register applicant's marks because they were descriptive and because of likelihood of confusion with registered mark, noting it was a close case but doubt was to be resolved in favor of registrant).

**Decision:** The refusals to register, under Sections 2(d) and 2(e)(1), are affirmed.