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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant	Romantic Tours, Inc.
Applied for Mark	BLACK BOOK
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: Romantic Tours, Inc.

Mark: BLACK BOOK

Filed: January 11, 2010

Serial No. 77/908,876

Examining Attorney: Tejbir Singh

Trademark Law Office: 106

**REPLY BRIEF OF APPLICANT**

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## I. ARGUMENT

### A. The Examiner Fails to Rebut Evidence that the Applied-For Mark and Cited Mark Have Meaningfully Different Connotations and Commercial Impressions

#### 1. The Examiner fails to distinguish other third-party marks for which the Examiner agrees there is no likelihood of confusion.

The Examiner does not dispute that in analyzing likelihood of confusion “[t]he points of comparison for a word mark are appearance, sound, meaning, and commercial impression.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689,1691 (Fed Cir. 2005), citing *E. I. du Pont de Nemours*, 476 F.2d at 1361. See TMEP 1207.01(b)(i). Contrary to focusing “on the visual differences between the marks” (Ex. Br. at 2), Applicant focuses in its initial brief on the overall commercial impression of the marks in question. This includes, most importantly, the fact that “[t]he XXX symbol is used to designate pornographic material in the U.S. and other regions around the world.” (Ex. 4). Left unrebutted is this connotation of “XXX” as well as Applicant’s evidence (Ex. 5) that .XXX is a generic top-level domain for pornographic websites. Especially in connection with BLACKBOOK’s connection to dating, the “XXX”-prefix obviously connotes pornography, thereby creating a meaningfully different commercial impression than the applied-for mark.

The Examiner effectively concedes the distinctive nature of the registered mark as compared to Applicant’s mark by admitting that “Applicant correctly noted that ‘with respect to dating services, distinctive elements differentiate marks that otherwise include “blackbook.”’” (Ex. Br. at 6). Nevertheless, the Examiner attempts to differentiate three registered third-party marks cited by Applicant that contain “BLACK BOOK” or “BLACK BOOK.” (See App. Br. at 8). With respect to BLACKBOOK27 (Reg. No. 3,926,282) and **BLACKBOOK27** (Reg. No.

4,065,116), the Examiner notes that the marks were “already cited against Applicant’s mark.” (Ex. Br. at 6). Yet, the Examiner subsequently withdrew any reliance on the BLACKBOOK27 marks, thereby demonstrating its agreement that there is no likelihood of confusion between Applicant’s mark and either BLACKBOOK27 mark. Similarly, the Examiner notes that the mark “Matt’s Little Black Book” (Reg. No. 3,476,068) has since “been cancelled.” (Ex. Br. at 6). But, this mark was not cancelled until March 6, 2015 (*See* Ex. A, attached hereto (showing cancellation due to failure to file a §8 declaration)). During the examination process, the Examiner clearly concluded there was no likelihood of confusion between the applied-for mark and “Matt’s Little Black Book.”

In trying to explain why there is allegedly a likelihood of confusion between the applied-for mark and XXXBLACKBOOK despite finding no likelihood of confusion with the other third-party marks such as BLACKBOOK27, the Examiner asserts that “[t]he [other] registrations have additional wording, letters or numbers to distinguish the marks from each other.” (Ex. Br. at 6). Yet, this distinction applies even more for XXXBLACKBOOK than it does for BLACKBOOK27. If anything, the addition of “XXX” at the beginning of “BLACKBOOK” is more distinctive than the addition of “27” at the end of “BLACKBOOK.”<sup>1</sup>

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<sup>1</sup> As a fallback argument, despite admitting that the “cited registration [XXXBLACKBOOK] includes similar services in International Class 45” as the third-party registrations, the Examiner asserts that the goods and services at issue in “four of the third-party registrations are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the pertinent services.” (Ex. Br. at 6). To the contrary, however, the goods and services listed for these third-party marks are pretty much the same as the goods and services listed for “XXXBLACKBOOK,” which the Examiner argues “are related” to the goods and services listed for Applicant’s mark. (Ex. Br. at 9-16). For example, the listed goods and services for the four third-party marks include “Dating services” and “Internet based introduction and social networking services.” (App. Br. at 8). The listed goods and services for XXXBLACKBOOK include “Online adult dating.” The Examiner fails to explain how these goods and services are in any way meaningfully different.

**2. The Examiner fails to rebut the fact that the “XXX-” prefix in the registered mark clearly refers to pornography.**

The Examiner attempts to minimize the self-evident conclusion that XXXBLACKBOOK distinctly connotes services connected with pornography in various ways. First, the Examiner seeks to downplay the relevance of Applicant’s evidence from Wikipedia by quoting the Board’s opinion in *In re IP Carrier Consulting Grp.*, 84 U.S.P.Q.2d 1028, 1032 (TTAB 2007). Therein, the Board stated that it “will consider evidence taken from Wikipedia as long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence *that may call into question the accuracy of the particular Wikipedia information.*” (Ex. Br. at 7(emphasis added)). The Examiner had the opportunity to rebut Applicant’s evidence that “XXX” relates to pornography, but failed to do so. Instead, the Examiner admitted in its December 19, 2004 denial of Applicant’s motion for reconsideration that “‘XXX’ could have a connotation of pornography” and agrees in its initial brief that “XXX” does connote pornography. The Examiner merely suggests that “XXX” “could also refer” to other things. (Ex. Br. at 8).

The other possible meanings suggested by the Examiner are illogical. Relying solely on an entry at Internetslang.com that relates to chat rooms and texting, the Examiner suggests that “XXX” refers to “kisses.” (Pl. Br. at 8). The Examiner’s source demonstrates, however, that this usage is more properly “XO,” “XOX,” “XOXO” or “XOXOXO” and indicates “hugs and kisses.” Even more importantly, these uses only refer to kisses (or hugs and kisses) when used alone at the end of a communication. XXX does not refer to kisses when used as a prefix added to another word as in XXXBLACKBOOK.<sup>2</sup>

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<sup>2</sup> The Examiner also seeks to rely on new evidence to suggest that “XXX” can refer to the Roman numeral for the number “thirty.” This evidence is entered for the first time in the Examiner’s appellate brief and thus is improperly before the Board. [Applicant withdraws, however, its argument appearing at fn. 1 on page 3 of its initial brief regarding evidence attached to the Examiner’s denial of Applicant’s motion for reconsideration]. Nevertheless, it strains credulity to suggest that the relevant public would understand “XXX” in XXXBLACKBOOK to refer to the Roman numeral for “thirty”. Moreover, the Examiner fails to explain its position that BLACKBOOK27 poses no

The Examiner also seeks to downplay the obvious pornographic connotation of XXXBLACKBOOK by stating that “[r]egistrant’s services in International Class 38 and 42 do not include adult or pornography type services.” (Ex. Br. at 14). Yet, as the Examiner later admits, “registrant does offer adult-related services in other classes.” (*Id.*). These services include “Online adult dating” in International Class 45, “providing a web site featuring adult-themed videos” in International Class 41, and “publication of text, audio, video and graphic works of others online featuring sexual content” in International Class 41. Once again, the evidence points clearly to the fact that the “XXX” in XXXBLACKBOOK refers to pornography.

Finally, the Examiner asserts that the connotation with pornography inherent in the cited mark makes no difference because “[A]pplicant itself has ... [allegedly] provided evidence in Exhibit 2 that pornographic materials and adult-oriented content are often associated with the term “blackbook” or “black book.” (Ex. Br. at 8-9). Not so. The evidence provided by Applicant in Exhibit 2 does not suggest, much less establish, that pornography is “often associated” with the term “blackbook” or “black book.” The exhibit merely shows the connection between the term “BLACK BOOK” and dating. The exhibit contains no pornographic materials. To the extent any entries could be considered “adult-oriented,” it is merely in the sense of dating. The mere fact that two entries make written reference to “getting laid” through dating does not make them pornographic. Such references are consistent with the commonly understood definition of “black book” in the sense of a source where men keep information regarding women who are potential dates.

If the Examiner really believed that the term “BLACK BOOK” was inherently connected with pornography, the Examiner surely would have produced its own evidence supporting this

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likelihood of confusion with Applicant’s mark while XXXBLACKBOOK with “XXX” meaning “thirty” nevertheless creates a likelihood of confusion with Applicant’s mark.

argument long ago instead of relying on isolated references in one of Applicant's exhibits for the first time on appeal. The only evidence in the record regarding the common meaning of the term "BLACK BOOK" or "BLACKBOOK" is the four dictionary definitions provided by Applicant at page 7 and Exhibit 1 of its initial brief. None define the term to connote pornography.

**3. Other factors support the conclusion that the marks are sufficiently dissimilar to avoid any likelihood of confusion.**

The Examiner does not dispute that the "XXX" portion of the cited mark is the dominant part of the mark or at least an equally distinctive part of the mark. For this reason, the Examiner's argument that "[d]eletion of wording from a registered mark is often not sufficient to overcome a likelihood of confusion" (Ex. Br. at 7) is misplaced. In *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 U.S.P.Q.2d 1257 (Fed. Cir. 2010), the first case cited by the Examiner, the Federal Circuit determined that removal of the "MARK LEES" portion of the following registered design mark was insufficient to avoid a likelihood of confusion with the Applicant's word mark "ML":



Clearly, the dominant portion of the registered mark was identical to the applicant's mark. *Cf.* TMEP §1207.01(b)(iii) ("if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences"). In the instant case, the dominant portion of the applied-for mark and the registered mark are completely different.

In the second case cited by the Examiner, *In re Optica Int'l*, 196 U.S.P.Q. 775, 778 (TTAB 1977), the Board refused registration of the mark "OPTIQUE" for "eyeglass frames"

both because the mark was generic and because of prior registration on the supplemental register of the mark “OPTIQUE BOUTIQUE”. The removal of BOUTIQUE from the registered mark was insufficient to avoid a likelihood of confusion because the word BOUTIQUE was generic for “a small shop.” Cf. TMEP §1207.01(b)(iii)(“Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by ... deleting ... a term that is descriptive”). In the instant case, the applied-for mark is not identical to the registered mark save for the removal of a generic word. Instead, the distinctive “XXX” is removed.

The marks are also unlikely to be confused because of the differences in the way the marks are pronounced. “XXX” is likely to be pronounced “Triple X” or “X X X.” (*See* Ex. 5). The registered mark starts with three syllables that are non-existent in Applicant’s mark. This further differentiates the commercial impression of the registered mark and Applicant’s mark.

**B. The Examiner Does Not Rebut Applicant’s Evidence Regarding the Different Nature of the Goods and Services Offered Under Applicant’s Mark and the Registered Mark**

In its initial brief, Applicant argued that the “applied-for mark is further distinguished because it is not for dating services *per se* but for “[p]roviding on-line non-downloadable software for keeping track of online companions and organizing online communications, correspondence history, events, profiles and preferences in the field of online relationships and dating” while the cited mark “is for services such as ‘Online adult dating,’ ‘Hosting online websites for others for organizing and conducting online meetings, gatherings and interactive discussions’ and ‘Chat room services for social networking; telecommunication services ...” (App. Br. at 10 (emphasis in original)). As Applicant summarized, “the applied-for mark is for providing non-downloadable software for maintaining specified records. The cited mark is for dating services and actual communications seemingly related to online adult dating, sex and/or pornography.” *Id.*

In its brief, the Examiner does not demonstrate that such services as those offered by Applicant and registrant emanate from the same source. The Examiner relies on evidence that Match.com, OKCupid.com, Zoosk and PlentyofFish offer software through which users can narrow their dating search results and meet others. (Ex. Br. at 12-14). Other software offered by these companies matches users with other users and/or allows communications. (*Id.*). Yet none of these companies offer software such as that offered by Applicant, *i.e.*, “software for keeping track of online companions and organizing online communications, correspondence history, events, profiles and preferences.” Instead, the evidence submitted by the Examiner merely shows that some entities offer software permitting the type of services offered by registrant. This type of evidence is insufficient to show similarity between goods and services of Applicant and registrant.

Perhaps for this reason, the Examiner argues that “Applicant’s software services are related to registrant’s [services].” (Ex. Br. at 11). The Examiner even goes so far as to claim that “the field of the registrant’s services is *identical* to and encompasses the field of the [A]pplicant’s services” despite the fact that registrant’s services make no mention of software. (Ex. Br. at 11 (emphasis added)). Yet, the mere fact that both services relate in some way to dating does not mean that both are likely to be believed to emanate from the same source.

## II. CONCLUSION

For these additional reasons, Applicant respectfully requests that the Board overturn the decision of the Examiner and allow the applied-for mark to proceed towards registration.

Respectfully submitted,

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**Mark:** MATT'S LITTLE BLACK BOOK

MATT'S LITTLE BLACK BOOK

**US Serial Number:** 77355194

**Application Filing Date:** Dec. 18, 2007

**US Registration Number:** 3476068

**Registration Date:** Jul. 29, 2008

**Filed as TEAS Plus:** Yes

**Currently TEAS Plus:** Yes

**Register:** Principal

**Mark Type:** Service Mark

**Status:** Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

**Status Date:** Mar. 06, 2015

**Publication Date:** May 13, 2008

**Date Cancelled:** Mar. 06, 2015

Mark Information

Goods and Services

Basis Information (Case Level)

Current Owner(s) Information

Attorney/Correspondence Information

Prosecution History

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

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