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Applicant	ENTIDAD DE GESTION DE DERECHOS; DE LOS P
Applied for Mark	PREMIOS PLATINO DEL CINE IBEROAMERICANO
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# Applicant’s Appeal Brief in Support of Registration

Serial No. 79143120

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## **STATEMENT OF ISSUE FOR REVIEW**

Whether a likelihood of confusion exists between Applicant's mark PREMIOS PLATINO DEL CINE IBEROAMERICANO, stylized with design, and Registrant's mark PLATINO, in typed drawing form.

### **DISCUSSION**

On September 24, 2014, the Examining Attorney issued a final refusal<sup>1</sup> for

Applicant's mark,  (Serial No. 79143120) ("Applicant's mark"), alleging a likelihood of confusion, under section 2(d) of the Trademark Act,<sup>2</sup> with Registrant's mark, PLATINO (Reg. No. 2750770) ("the '770 mark"). The Examining Attorney based the refusal on three *du Pont* factors, namely, similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the goods and/or services.<sup>3</sup>

For the following reasons, Applicant hereby appeals the decision and submits that the Examining Attorney's final refusal was improper. First, the additional terms and stylized nature of Applicant's mark give it a distinct commercial impression and cause it to be dissimilar to the '770 mark. Second, while the music industry and movie industry are part of the larger entertainment universe, they are separate and distinct industries, and the services are therefore not sufficiently related to cause consumer confusion.

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<sup>1</sup> September 24, 2014 Office Action ("Final Refusal").

<sup>2</sup> 15 U.S.C. § 1052(d) (2015).

<sup>3</sup> Final Refusal, at 2; *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973).

1. The Examining Attorney Did Not Give Sufficient Consideration to the Disclaimed Portion or the Design Aspect of Applicant's Mark

The first *du Pont* factor compares marks in their entireties, in terms of appearance, sound, meaning, and commercial impression.<sup>4</sup> To justify a refusal, the marks must be “sufficiently similar that there is a likelihood of confusion as to the source of the goods or service.”<sup>5</sup> Moreover, in conducting the comparison, the focus should be on the perception and memory of the average consumer.<sup>6</sup>

The Examining Attorney argues that “[a]n average consumer would perceive the term PLATINO as the primary element of the source indicator due to its dominance and significance.”<sup>7</sup> Applicant has disclaimed “premios del cine iberoamericano,” but those words are still a part of the mark and create a significant difference in the mark's appearance, sound, and meaning. The Examining Attorney compared the marks as if the disclaimed portion in Applicant's mark does not exist. This was improper. “The technicality of a disclaimer ... has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO.”<sup>8</sup>

Applicant's entire mark translates to “Platinum Ibero-American Film Award.”<sup>9</sup> Though the term “award” may be less important here, the phrase “Ibero-American Film”

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<sup>4</sup> *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973).

<sup>5</sup> Trademark Manual of Examining Procedure (“TMEP”) § 1207.1(b) (citing *Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 U.S.P.Q.2D (BNA) 1435 (Fed. Cir. 2012)).

<sup>6</sup> TMEP § 1207.01(b).

<sup>7</sup> Final Refusal, at 3.

<sup>8</sup> *In Re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. (BNA) 749 (Fed. Cir. 1985).

<sup>9</sup> March 9, 2014 Office Action (“Provisional Refusal”), at 4.

is important because it suggests that the mark is exclusive to *films* within the Ibero-American geographical region. Moreover, the term “platinum” is merely a descriptor for the remainder of the mark. This differs significantly from that of the ‘770 mark, which is owned by the Recording Industry Association of America.

Additional words can serve to distinguish one mark from another mark when the two have one or two terms in common if the marks convey significantly different commercial impressions or if the matter in common is descriptive or diluted.<sup>10</sup>

For example, in *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, the Trademark Trial and Appeal Board concluded that there was no likelihood of confusion between SMART ONES and SMART BALANCE.<sup>11</sup> There, both marks were used on a variety of the same kinds of frozen foods, but the Board found no likelihood of confusion, in large part, because of the differences in the marks.<sup>12</sup> The Board reasoned that, even though the two marks share a term,

The weak trademark significance of the word ‘smart’ when used on food items deemed to promote a healthy lifestyle contributes less distinctiveness to the overall commercial impression of the parties’ respective marks than would an arbitrary or fanciful term. The second word in each of the parties’ marks combines with ‘smart’ to create markedly different visual and phonetic impressions, different connotations, and different overall commercial impressions.

....

Given their differences visually and phonetically, the weakness of their shared term ‘smart,’ their different connotations, and their overall differing commercial impressions, we find that the parties marks are sufficiently dissimilar to weigh against a conclusion of likelihood of confusion.<sup>13</sup>

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<sup>10</sup> TMEP § 1207.01(b)(iii) (citing *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ.2d 1253 (Fed. Cir. 2011)).

<sup>11</sup> *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, Opp. Nos. 91194974 and 911966358 (T.T.A.B. March 27, 2015).

<sup>12</sup> *Id.* at \*42.

<sup>13</sup> *Id.* at \*27-28.

The Board's reasoning in *ProMark Brands* applies in the instant case. Here, the term "platinum" is shared by both marks. "Platinum" used for entertainment awards is a laudatory and descriptive term similar to "smart" used on healthy food items. The term "platinum," or "gold" or "silver" or "diamond" speaks to the prestige of the award rather than its source, just as "smart" is really about the consumers choice rather than the source of the food. Accordingly, the shared term "platinum" "contributes less to the overall commercial impression" of the marks.

Moreover, here, as in *ProMark Brands*, the two marks contain significant differences in the other wording. This difference has a significant effect on distinguishing the commercial impressions. As stated above, Applicant's mark contains several words that the '770 mark does not contain. The terms "premios del cine iberoamericano" provide context to Applicant's mark and gives it a commercial impression connected to films in the Ibero-American region. The '770 mark contains only the term "platino." As discussed above, this word possesses little distinctiveness in the context of awards, and is only entitled to a narrow scope of protection within the specific industry. In Registrant's case, that is the music industry.

Applicant's mark also contains a design with an uncommon typeface. As Applicant explained in the September 8, 2014 response, "the design portion of Applicant's mark is highly distinctive. It includes reversed text, striking lines, a large circle as the dot on the letter I, and a highly unusual typeface. All of these aspects make the design portion of Applicant's mark distinctive and likely to be remembered by consumers." These attributes serve to further distinguish Applicant's mark from the '770 mark. Applicant acknowledges that, with a trademark registration in typed drawing form,

protection is not limited to any one particular font. However, Applicant's design and font are so unique that it is highly unlikely that the '770 mark will appear with the same design and font as Applicant's mark.

In *In re Sela Products*, the Trademark Trial and Appeal Board reversed the Examining Attorneys final refusal for the mark FORZA in standard characters, despite

the cited registration for .<sup>14</sup> Deciding the case solely on the first *du Pont* factor, the Board reasoned,

Although in general words dominate over designs, in the registrant's mark the design element is large and noticeable, and it also includes literal elements. Accordingly, when the marks are compared in their entirety, we find that the differences in appearance and commercial impression ... of the marks outweigh any similarities due to the presence in both marks of the word FORZA.<sup>15</sup>

Because the application in *In re Sela Products* was in standard characters, the Board's reasoning is highly relevant here. Applicant submits that here, just as in *In re Sela Products*, the presence of the stylized font and design in one mark is sufficient to distinguish it from the other, standard character mark.

The Board reached the same conclusion in *In re White Rock Distilleries*.<sup>16</sup> There, the applicant appealed the examining attorney's refusal to register VOLTA in standard characters.<sup>17</sup> The examining attorney had refused registration, citing a likelihood of confusion between applicant's mark and the cited mark,

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<sup>14</sup> *In re Sela Products, LLC*, Serial No. 77629624 (T.T.A.B. March 26, 2013).

<sup>15</sup> *Id.* at \*23.

<sup>16</sup> *In re White Rock, Inc.*, Serial No. 77093221 (T.T.A.B. October 5, 2009).

<sup>17</sup> *Id.* at \*1.



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In the appeal, the examining attorney argued that “the respective marks are similar because applicant may display its VOLTA mark in the same lettering as the literal portion of registrant’s mark and with a similar design” and “[w]hen a word is registered in standard character format, the Board must consider all reasonable manners of display that could be represented, including the same stylized lettering as that in which a registrant’s mark appears.”<sup>19</sup>

The board disagreed, stating that “it would not be reasonable to assume that applicant’s VOLTA mark would be presented with the design element appearing in registrants mark.”<sup>20</sup> The board reversed the refusal, concluding, “when we consider the marks in their entireties, we find that they engender different commercial impressions.”<sup>21</sup>

Such is the case here. It is unreasonable to assume that the ‘770 mark will appear with a similar design or typeface as Applicant’s. The design component in Applicant’s mark is so prominent that consumers are not likely to view the term “platino” as the prominent portion. This is different from the ‘770 mark where “platino” is the dominant portion, being the only term.

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<sup>18</sup> *Id.* at \*2.

<sup>19</sup> *Id.* at \*4.

<sup>20</sup> *Id.* at \*5.

<sup>21</sup> *Id.* at \*5, 9.

When the additional words and design portions of Applicant’s mark are fully acknowledged, the dissimilarities in the marks far outweigh any similarity that the term “platino” creates. Because the Examining Attorney gave insufficient weight to these additional attributes in Applicant’s mark, an improper conclusion was reached. Applicant asserts that, when properly applied, the first *du Pont* factor weighs heavily against a finding of likelihood of confusion.

2. The Music Industry and Movie Industry are Not Sufficiently Related to Cause Confusion as to the Source of Applicant’s Services

The second *du Pont* factor compares the goods and services associated with each mark.<sup>22</sup> Applicant’s mark is for “Entertainment services, namely, providing recognition and incentives by the way of awards to demonstrate excellence in the field of films; cultural services, namely, organizing exhibitions in the field of film for cultural or educational purposes and organization of cinematographic events, namely, a competitive film festival.” In contrast, the ‘770 mark is for “conducting award programs recognizing outstanding achievement in the recording industry as evidenced by specified levels of sales.” Every aspect of the two services, aside from being in the entertainment universe, is different.

In the provisional refusal, the Examining Attorney stated, “the application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant’s more narrow identification.”<sup>23</sup> This is incorrect as the identification currently exists. The term “namely” narrows the identification to the specific services that follow. Taking this into

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<sup>22</sup> *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973).

<sup>23</sup> Provision Refusal, at 3.

account, Applicant’s identification only includes “providing recognition and incentives by the way of awards to demonstrate excellence in the field of films” and “organizing exhibitions in the field of film for ... a competitive film festival.” This proper interpretation of Applicant’s identification clearly restricts the services to those directly related to films.

In the final refusal, the Examining Attorney argued that “[t]he film and recording industries are often referred to as simply the entertainment industry,” and provided examples of companies that provide awards in both areas.<sup>24</sup> These examples, however, are insufficient to support a close relationship.

For example, in *In re Princeton Tectonics, Inc.*, the Trademark Trial and Appeal Board concluded that there was no likelihood of confusion between EPIC, in standard characters, for “personal headlamps” and EPIC, in standard characters, for “electric lighting fixtures” despite the examining attorney’s proffered evidence that in some instances personal headlamps and electric lighting fixtures come from the same source.<sup>25</sup>

Additionally, in *In re Thor Tech, Inc.*, the Board determined that there was no likelihood of confusion between TERRAIN, in standard characters, for “recreational vehicles, namely, towable trailers” and TERRAIN, in standard characters, for “motor land vehicles, namely, trucks,” even though the examining attorney offered multiple examples of companies that sell both types of goods.<sup>26</sup>

Similarly, here, the fact that a few entities offer the services of both Applicant and Registrant does not outweigh the fact that music awards and film awards are separate and

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<sup>24</sup> *Id.*

<sup>25</sup> *In re Princeton Tectonics, Inc.*, Serial No. 77436425 (T.T.A.B. June 16, 2010).

<sup>26</sup> *In re Thor Tech, Inc.*, Serial No. 85667188 (T.T.A.B. January 26, 2015).

distinct. No one will receive a film award at the Grammys, or a music award at the Emmys. Applicant further submits that, in terms of awards, consumers view the two industries in general as separate and distinct. To borrow the common idiom, it is like comparing apples to oranges.

The music industry and the film industry are both part of the entertainment industry, just as are sports, and even news broadcasting. Still, the differences in these industries make any alleged relationship attenuated at most. As a result, the Examining Attorney's conclusion as to the second *du Pont* factor was incorrect, and Applicant's services are not sufficiently related to support a finding of likelihood of confusion.

## **CONCLUSION**

Applicant's mark contains important additional wording and a highly distinctive design, which makes it dissimilar to the '770 mark. Moreover, the film services of Applicant are categorically different from the music services associated with the '770 mark. As a result, the Examining Attorney's finding of likelihood of confusion was improper. Based on the foregoing, Applicant respectfully requests that this Board reverse the Examining Attorney's refusal.