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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79143120

MARK: PREMIOS PLATINO DEL CINE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: ENTIDAD DE GESTION DE DERECHOS; DE LOS P
ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1193414

I. STATEMENT OF THE CASE

Applicant has appealed the final refusal to register the proposed mark, PREMIOS PLATINO DEL CINE IBEROAMERICANO and design, in special form, for use on or in connection with “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.” Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the proposed mark is likely to be confused with the mark in U.S. Registration No. 2750770, PLATINO, in typed form, for use on or in connection with “conducting award programs recognizing outstanding achievement in the recording industry as evidenced by specified levels of sales.” It is respectfully requested that the Trademark Act Section 2(d) refusal be affirmed.

II. FACTS

On November 15, 2013, applicant filed the instant application seeking registration on the Principal Register of the proposed mark, PREMIOS PLATINO DEL CINE IBEROAMERICANO and design, in special form, for use on or in connection with “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 International Class 41. In the first Office action, mailed March 10, 2014, registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that the proposed mark was likely to cause confusion with the mark depicted in U.S. Registration No. 2750770, PLATINO, in typed form, for use on or in connection with

“conducting award programs recognizing outstanding achievement in the recording industry as evidenced by specified levels of sales,” in International Class 41.

Applicant filed a response to the refusal on September 8, 2014, submitting arguments against a likelihood of confusion with the cited mark. In an Office action mailed September 24, 2014, the Section 2(d) refusal citing U.S. Registration No. 2750770 as a bar to registration was maintained and made final.

Applicant responded to the final refusal with a notice of appeal and filed an appeal brief on March 23, 2015.

III. ARGUMENT

THE PROPOSED MARK IS NOT ENTITLED TO REGISTRATION BECAUSE A LIKELIHOOD OF CONFUSION EXISTS WITH THE CITED REGISTERED MARK

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011)

(citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

The Marks Are Confusingly Similar

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterro Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

In the present case, applicant's mark PREMIOS PLATINO DEL CINE IBEROAMERICANO in which the wording "PREMIOS DEL CINE IBEROAMERICANO" has been disclaimed. The registrant's mark is PLATINO.

Here, the common term “PLATINO” is in the largest font and prominently appears in the center of the proposed mark. The term “PLATINO” dominates the appearance of the proposed mark.

Applicant conceded the insignificance of the term “award” by stating “the term “award” may be less important here.” However, applicant argued that “the phrase “Ibero-American Film” is important because it suggest that the mark is exclusive to films within the Ibero-American geographic region.”

Contrary to applicant’s argument, said wording is merely descriptive of a feature of the services identified. Applicant has conceded the descriptiveness of the wording by disclaiming the said wording.

Applicant then argued that the proposed mark “contains a design with an uncommon typeface.” A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterro Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).

Accordingly, the proposed mark and the registered mark are confusingly similar.

The Services Are Related

The services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Applicant is offering “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,” while registrant is offering “conducting award programs recognizing outstanding achievement in the recording industry as evidenced by specified levels of sales.”

Applicant argued that “music awards and film awards are separate and distinct.” Contrary to applicant’s assertion, the music and film industries are closely related. By way of example, the examining attorney refers to U.S. Registration No. 3479926, for the mark NEW HOLLYWOOD AWARDS, registered for providing recognition and incentives by the way of awards and contests to demonstrate excellence in the fields of music, Internet, television, radio and films; and U.S. Registration No. 2331475, for the mark THE SOURCE, registered for award ceremonies in the fields of music, video, sports and education; music and video production. This evidence shows that the services listed therein, namely, award service for music and films, are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *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).

Moreover, both parties are providing awards. While the registrant’s awards specifically pertain to sales, the applicant’s services are not limited to any particular type of excellence and could also pertain to sales achievements. With respect to applicant’s and registrant’s services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and registration, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261,

1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, 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.

Accordingly, applicant's services and registrant's services are related.

IV. CONCLUSION

Consumers encountering the proposed mark, PREMIOS PLATINO DEL CINE IBEROAMERICANO and design, in special form, for use on or in connection with "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," used concurrently with the mark in U.S. Registration No. 2750770, PLATINO, in typed form, for use on or in connection with "conducting award programs recognizing outstanding achievement in the recording industry as

evidenced by specified levels of sales” are likely to mistakenly conclude that the services are related and originate from a common source. Accordingly, it is respectfully requested that the refusal to register under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

/Sally Shih/

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