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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

*In re Entidad De Gestion De Derechos;  
De Los Productores Audiovisuales (EGEDA)*

Serial No. 79143120

Nicholas D. Wells of Kirton McConkie,  
for Applicant

Sally Shih, Trademark Examining Attorney, Law Office 106,  
Mary Sparrow, Managing Attorney.

Before Richey, Deputy Chief Administrative Trademark Judge, and Mermelstein  
and Ritchie, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant Entidad De Gestion De Derechos; De Los Productores Audiovisuales  
(EGEDA) seeks registration of the mark depicted below for

[e]ntertainment services, namely, providing recognition  
and incentives by the way of awards to demonstrate excel-  
lence in the field of films; cultural services, namely, or-  
ganizing exhibitions in the field of film for cultural or ed-  
ucational purposes and organization of cinematographic  
events, namely, a competitive film festival

in International Class 41.<sup>1</sup>

<sup>1</sup> App. No. 79143120 is a request for extension of protection pursuant to the Madrid Proto-  
col, see Trademark Act § 66(a). The application is based on International Registration No.  
1193414, registered November 15, 2013. Applicant has declared its *bona fide* intent to use  
the mark in commerce. Applicant has disclaimed the exclusive right to use "PREMIOS DEL

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The wording in the mark is **PREMIOS PLATINO DEL CINE IBEROAMERICANO**, which is translated in the application as “PLATINUM IBERO-AMERICAN FILM AWARD.”

The Examining Attorney finally determined that applicant’s mark so resembles the registered mark **PLATINO** (in standard characters) for “conducting award programs recognizing outstanding achievement in the recording industry as evidenced by specified levels of sales,”<sup>2</sup> as to be likely to cause confusion. Trademark Act § 2(d); 15 U.S.C. § 1052(d).

We affirm the refusal to register.

### **I. Applicable Law**

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d)

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CINE IBEROAMERICANO" apart from the mark as shown.

<sup>2</sup> Registration No. 2750770, issued August 12, 2003, based on use in commerce. The registration includes the statement that “[t]he foreign wording in the mark translates into English as ‘platinum.’”

goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); see *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

## **II. Discussion**

### **A. The Similarity or Dissimilarity of the Marks in Their Entireties as to Appearance, Sound, Connotation and Commercial Impression.**

In comparing the marks at issue, we consider their appearance, sound, meaning, and commercial impression. *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). “[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). When comparing the marks, we keep in mind that “[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23

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USPQ2d 1698, 1701 (Fed. Cir. 1992); *Hunt Control Sys. Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558 (TTAB 2011), *appeal filed*, No. 11-3684 (D.N.J. July 27, 2011).

Applicant's mark comprises the stylized wording **PREMIOS PLATINO DEL CINE IBEROAMERICANO**. The word PLATINO appears in large letters across the middle of the applied-for mark with the wording PREMIOS and DEL CINE IBEROAMERICANO arranged above and below it respectively in much smaller letters in "reversed" (white on black) text. The tittle on the letter "i" in PLATINO is represented by a large circle. The translations in the cited registration and in the subject application both indicate that the word PLATINO means "platinum." According to Applicant's translation statement, its entire mark translates as "platinum Ibero-American film award."

The Examining Attorney required Applicant to disclaim "PREMIOS DEL CINE IBEROAMERICANO" on the ground that it is merely descriptive of the identified services, and Applicant complied without argument. Applicant quite correctly points out that the mere existence of its disclaimer has no legal effect on the likelihood of confusion, and that potential purchasers will no doubt be unaware of the disclaimer. *App. Br.*, 4 TTABVue 4. "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." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). A disclaimer does not remove the disclaimed matter from the mark.

But while the disclaimer itself has no bearing on our inquiry, the *reason* the Examining Attorney required the disclaimer is significant. In this case, the Examining Attorney required Applicant to disclaim “PREMIOS DEL CINE IBEROAMERICANO’ apart from the mark as shown,” because that wording is merely descriptive of Applicant’s services. *First Ofc. Action*. We agree that — consistent with the disclaimer requirement and Applicant’s compliance — this wording is descriptive or at least highly suggestive of the identified services in that it names the subject matter of Applicant’s award programs, namely an award program featuring “Ibero-American film.” It is well-settled that highly suggestive or descriptive terms are weak, having little source-indicating capacity. Thus, while the marks must be compared in their entireties, the “descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1873–74 (TTAB 2000) (“[t]hese descriptive, if not generic, words have little or no source-indicating significance”).

Despite its disclaimer, Applicant argues that the wording “Ibero-American Film” (we assume that Applicant is referring here to the equivalent Spanish wording in the mark) is of particular importance in distinguishing the marks.<sup>3</sup> Although this

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<sup>3</sup> Applicant argues that the descriptive wording is important “because it suggests that the mark is exclusive to films within the Ibero-American geographical region.” *App. Br.*, 4 TTABVue 5. It is not clear what Applicant means by “the Ibero-American geographical region.” (It could be a reference to the Iberian Peninsula and all of the Americas, or to the Iberian Peninsula and the United States, but neither is what we would think of as a single

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descriptive wording does not appear in the cited registration, we disagree with Applicant's suggestion that it conceptually distinguishes the marks. The cited Registrant's services are not limited geographically or by subject matter, and there is nothing in the Registrant's mark itself that would suggest such limitations. In other words, we must assume that the subject matter of the cited registrant's award programs includes "Ibero-American" recordings.

We conclude that **PLATINO** is the dominant part of Applicant's mark, both visually and conceptually. It is centrally placed and far larger than the other elements of Applicant's mark. As noted, the additional, descriptive wording in Applicant's mark is entitled to "little weight" in our analysis.

Nonetheless, Applicant contends that

"Platinum" used for entertainment awards is a laudatory and descriptive term. . . . The term "platinum," or "gold" or "silver" or "diamond" speaks to the prestige of the award rather than its source. . . . Accordingly, the shared term "platinum" "contributes less to the overall commercial impression" of the marks.

*App. Br.* at 5.

"Additional words," Applicant argues, "can serve to distinguish one mark from another mark when the two have one or two terms in common . . . *if the matter in common is descriptive or diluted.*" *App. Br.* at 4–5 (emphasis added).

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"geographical region.") To the contrary, we think that this wording would be readily understood by Spanish-speaking customers to describe the subject matter of the films vying for Applicant's awards or the ethnicity of their actors or directors. But in either case, the wording lacks inherent distinctiveness, being either primarily geographically descriptive of Applicant's services, *see* Trademark Act § 2(e)(2), or merely descriptive of them, *see* Trademark Act § 2(e)(1).

Neither Applicant nor the Examining Attorney submitted a definition of **PLATINO** or its English equivalent, “platinum.” We nonetheless take judicial notice<sup>4</sup> of the following definition:

**noun**

1. *Chemistry.* a heavy, grayish-white, highly malleable and ductile metallic element, resistant to most chemicals, practically unoxidizable except in the presence of bases, and fusible only at extremely high temperatures: used for making chemical and scientific apparatus, as a catalyst in the oxidation of ammonia to nitric acid, and in jewelry. *Symbol:* Pt; *atomic weight:* 195.09; *atomic number:* 78; *specific gravity:* 21.5 at 20°C.

2. a light, metallic gray with very slight bluish tinge when compared with silver.

**adjective**

3. made of platinum.

4. (of a record, CD, or cassette) having sold a minimum of one million copies.

Dictionary.com Unabridged (based on the Random House Dictionary (2016)), <http://dictionary.reference.com/browse/platinum?s=t> (visited Jan. 7, 2016).

While “platinum” appears to be somewhat suggestive in both the recording and film industry, we cannot consider it laudatory or descriptive in this case. A registration on the Principal Register is presumptively valid (*i.e.*, not descriptive), Trade-mark Act § 7(b), and a collateral attack on the validity of a cited registration will

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<sup>4</sup> The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

not be heard in an *ex parte* proceeding. *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534–35 (Fed. Cir. 1997) (“It is true that a prima facie presumption of validity may be rebutted. However, the present *ex parte* proceeding is not the proper forum for such a challenge.” (citation omitted)); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007). Because the cited registration consists in its entirety of the word **PLATINO**, Applicant’s argument that the term is descriptive amounts to an impermissible attack on the validity of the registration. We thus conclude that **PLATINO** is suggestive — although still inherently distinctive — for the services recited in the application and the cited registration. And although **PLATINO** is a suggestive term for the services at issue, the cited registered mark is still entitled to protection against newcomers whose use is likely to create confusion. *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.”).

The connotation of the marks also appears to be similar. Although the cited dictionary definition specifically refers to the significance of “platinum” in the recording industry, Applicant states that the term is descriptive and laudatory as used in both marks:

Here, the term “platinum” is shared by both marks. “Platinum” used for entertainment awards is a laudatory and descriptive term. . . . 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. Ac-

cordingly, the shared term “platinum” “contributes less to the overall commercial impression” of the marks.

*App. Br.* at 5 (arguing that “platinum contributes less to the overall commercial impression of the marks” (quotation marks omitted)). Thus the mark in the cited registration implies that the Registrants’ recording industry award programs are directed to recordings that have reached high levels of sales — or that the Registrant’s awards programs are themselves prestigious. Likewise, the use of PLATINO in Applicant’s mark (along with the descriptive wording we have discussed) implies that Applicant’s Ibero-American film awards are intended to be given to films of high quality, sales, or prestige, or that applicant’s awards are prestigious.

Urging that the marks are distinguishable, Applicant points out that its mark uses “an uncommon” and “highly unusual” typeface. *App. Br.* at 5–7. We note, however, that the cited registration is for **PLATINO** in standard characters. A registration for a standard-character mark covers the wording of the mark as it may appear in *any* stylization. Trademark Rule 2.52(a) (standard-character marks are “words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color”); *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) (“registrant is entitled to depictions of the standard character mark regardless of font style, size, or color”). Thus, while we agree that the wording in Applicant’s mark is highly stylized, we must consider that the mark in the cited registration could be used in a similar or even the same stylization, regardless of how unusual it is. *Id.* (Board erred in limiting consideration of special-character marks to “reasonable manners” of display). Thus the Registrant’s mark could visually appear highly similar or identical to the prominent word

**PLATINO** in applicant's mark.

Applicant refers to its mark as a “design,” or featuring a “design portion.” *App. Br.* 4 TTABVue at 6–7. Applicant's mark displays the words PREMIOS and DEL CINE INTERAMERICANO in reversed lettering (light on dark) on two quadrilateral dark areas and depicts the tittle on the letter “i” in PLATINO as a circle relatively large in comparison to the rest of that word. While we think the mark is more appropriately described as consisting of stylized words, it is arguable that the quadrilateral dark areas and the large circle are design elements.<sup>5</sup> But even if we consider some parts of Applicant's mark to comprise design elements — *i.e.* features which go beyond stylized lettering — the effect of such elements adds very little to the impression of the mark as a whole.

Simple background shapes (sometimes called “carriers”) typically add little to the overall impression of the mark, and we find that to be the case with the quadrilateral dark areas in Applicant's mark. While the outlines of the dark areas do not exactly follow the text, the difference is slight, and unlikely to be noticed or remem-

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<sup>5</sup> While we consider applicant's mark as a whole, the characterization of these elements as either parts of Applicant's stylized wording or design elements is potentially relevant. As already noted, we must consider a standard-character registration to cover the words in the registration without limitation to any stylization. *Citigroup*, 98 USPQ2d at 1259. But the standard-character doctrine does not extend to any design elements included in a junior party's mark. In other words, a registration in standard characters would not be considered legally *identical* to a junior party's application for the exact same wording plus a design. In such a case, the junior party's word-and-design mark may still be found similar enough to the senior party's standard-character mark to support a finding that confusion is likely, but unlike the stylization of the words, the design elements must be taken into account in the comparison. In other words, there is at least a possibility that the design elements — alone or in combination with any differences in the wording of the marks — may distinguish the marks to the degree that confusion is not found likely under the *du Pont* analysis.

bered, let alone considered as a source-identifying feature by the relevant public. While Applicant's circular tittle is slightly more distinctive, it is no more than an unadorned simple geometric shape which, in the context of Applicant's mark as a whole, adds little to the highly-stylized wording. As with the quadrilateral areas, it is unlikely that the public will focus on the circular tittle as a source-identifier. Thus while we may not ignore them if these features are considered designs (as opposed to parts of Applicant's stylized text) their effect on the overall impression of Applicant's mark is minimal, and does very little to distinguish it from the mark in the cited registration.

Finally, we find that the marks are similar in pronunciation in that they both share the word **PLATINO**, although we also recognize that Applicant's mark comprises additional wording which (if the mark is verbalized in its entirety) will make them sound different to some extent.

While we have discussed the weight to be given to different features of applicant's mark, *see In re Nat'l Data Corp.*, 224 USPQ at 751, the ultimate decision on the question of similarity must rest on consideration of the respective marks in their entirety, and without ignoring any part of them. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015). While the marks at issue in this case share the identical word **PLATINO**, they differ in that Applicant's mark includes additional wording not present in the cited registration. Nonetheless, we find that when considered in their entireties, the similarities of the marks clearly outweigh their differences. Although Applicant's mark includes addi-

tional wording not present in the cited registration, that wording is descriptive, and is not likely to be impressed upon potential purchasers as a significant distinguishing feature. *Cunningham*, 55 USPQ2d at 1846 (the “descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”). When the marks are considered *as a whole*, Applicant’s mark bears a strong visual, aural, and conceptual resemblance to that of the cited Registrant.

This factor favors a finding that confusion is likely.

**B. The Similarity or Dissimilarity and Nature of the Services as Described in an Application or Registration**

In comparing the parties’ services, “[t]he issue to be determined . . . is not whether the [services] . . . are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.” *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). It is not necessary that the parties’ services be the same or even competitive to support a finding of likelihood of confusion. It is sufficient if the services are related in some manner or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that the services come from or are associated with the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Applicant seeks registration of its mark for use in connection with the following services:

Entertainment services, namely, providing recognition and incentives by the way of awards to demonstrate excel-

lence 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.

The services set out in the cited registration are “conducting award programs recognizing outstanding achievement in the recording industry as evidenced by specified levels of sales.” Under its services, Applicant intends to issue “awards to demonstrate excellence in the field of films,” and to “organiz[e] . . . a competitive film festival.” Opposer “conduct[s] award programs . . . in the recording industry.” Applicant’s and Opposer’s services thus include the provision of awards to recognize excellence in the film and recording industry, respectively.

Applicant argues that its

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.

App. Br. at 9, 4 TTABVue 10. Applicant notes its disagreement with the Examining Attorney’s statement that “[t]he film and recording industries are often referred to as simply the entertainment industry.” *Id.* Applicant argues that the film industry and the music industry are “separate and distinct.” *Id.* at 10. Accordingly, “[n]o one will receive a film award at the Grammys, or a music award at the Emmys.” *Id.*

The fact that music industry awards programs (like the Grammys) and film industry awards programs (like the Emmys) are actually different programs and that people would not likely mistake one for the other is beside the point. The issue is not whether consumers would confuse the goods themselves, but rather whether

they would be confused as to the source of the goods. “[T]he law has long protected the legitimate interests of trademark owners and consumers from confusion among noncompetitive, but related, products bearing” similar marks. *Safety-Kleen Corp. v. Dresser Indus. Inc.*, 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); *Miss Universe L.P. v. Community Marketing Inc.*, 82 USPQ2d 1562, 1568 (TTAB 2007).

Applicant’s services are not *per se* related to those of the cited registrant merely because they are both part of something called the “entertainment industry.” But it is obvious that they are similar in that they both include programs to recognize and award achievement in the popular arts, namely, the music and film industry. While such programs are not necessarily similar in rules or format, they might indeed be similar or virtually identical in many respects. Neither the application nor the cited registration are limited to any particular type of awards program. Participants in the industry and members of the public would likely assume that such similar awards programs provided under similar marks originate from a common source, or that one is affiliated or sponsored by the other.

In support of her argument that Applicant’s services are related to those of the cited Registrant, the Examining Attorney made of record six<sup>6</sup> use-based trademark registrations including similar services directed to *both* the music and film industry.

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<sup>6</sup> The Examining Attorney submitted ten third-party registrations, but we have disregarded several which arguably do not include both Applicant’s and the Registrant’s services. For instance, Reg. No. 3206496, recites “conducting award ceremonies to promote excellence in the entertainment industry.” Although music and film are both part of the entertainment industry and for other purposes must be considered as covered by the ’96 Registration, the registration does not specifically indicate that the registrant’s services include both music and film award ceremonies.

Although third-party registrations are not evidence of the use of the registered marks, registrations which individually cover a number of different items and which are based on use in commerce may serve to suggest that the listed goods are of a type that may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* No. 88-1444 (Fed. Cir. Nov. 14, 1988) (not precedential).

Applicant argues that “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.” *App. Br.* at 9–10, 4 TTABVue 10–11. Applicant cites two Board cases, *In re Princeton Tectonics Inc.*, 95 USPQ2d 1509 (TTAB 2010), and *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015). In *Princeton Tectonics*, the Board found that a single third-party registration was not sufficient to show that the parties’ goods were related. And in *Thor Tech*, the Examining Attorney had submitted only two third-party registrations covering both the applicant’s and the cited registrant’s goods. Moreover, the applicant in *Thor Tech* submitted “fifty . . . sets of third-party registrations for the same or similar marks registered for [the cited registrant’s goods] on the one hand and [applicant’s goods] on the other, which are owned by *different* entities.” *Thor Tech*, 95 USPQ2d at 1548 (emphasis added). The Board found that this and other evidence outweighed the Examining Attorney’s two registrations suggesting that the goods were related under the facts of the case. Neither case refutes the principle that multiple third-party registrations *can* be

probative of a relationship of the parties' goods or services.

Registrant argues that the Examining Attorney's evidence is insufficient, and we agree that six third-party registrations is not an overwhelming number. Nonetheless, it is enough to indicate that the services at issue are related. The evidence is stronger than that offered in *Princeton Tectonics*, and Applicant offers no countervailing evidence, such as that offered in *Thor Tech*. We conclude that Applicant's services and those of the cited Registrant are related.

This *du Pont* factor supports a finding of likelihood of confusion.

### **III. Conclusion**

Because we find that Applicant's mark is similar to that of the cited Registrant, and that Applicant's film-related services and the Registrant's music-related services are related, we find that confusion is likely.

**Decision:** The refusal to register Applicant's mark **PREMIOS PLATINO DEL CINE IBEROAMERICANO**, is affirmed.