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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85390145

MARK: XTUBE

CORRESPONDENT ADDRESS:

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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: Manwin Licensing International Sàrl

CORRESPONDENT'S REFERENCE/DOCKET NO:

43277-XTube

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Manwin Licensing International Sàrl, has appealed the Trademark Examining Attorney's refusal to register the trademark, XTUBE, in standard characters under Section 2(d) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. Section 1052(d).

Registration was refused on the Principal Register on the grounds that the applicant's mark is likely to be confused with the standard character mark, XXXTUBE in U.S. Registration No. 3,605,311. This refusal is the only issue on appeal.

FACTS

On August 4, 2011, the applicant applied to register, XTUBE, in standard character form, based on use of the mark in commerce under Section 1(a) of the Trademark Act, for, "video-on-demand transmission services; video broadcasting; transmission of voice, data, and images, all in the field of adult entertainment," in International Class 38, and "entertainment services, namely providing a website featuring video, photographs, images, audio, and text in the field of adult entertainment via a global computer network" in International Class 041.

In an office action dated November 29, 2011, the examining attorney refused registration under Section 2(d) of the Trademark Act based upon the mark, XXXTUBE, in U.S. Registration No. 3,605,311, for, "entertainment services, namely, providing a web site featuring adult-themed photographs and videos; Entertainment services, namely, providing webcasts in the field of adult entertainment; Entertainment, namely, production of adult entertainment videos and films," in International Class 041. The examining attorney also required that the applicant amend the recitation of services.

On June 4, 2012, the applicant responded to the office action and amended its recitation of services to, "video-on-demand transmission services; video broadcasting; electronic, electric, and digital transmission of voice, data, and images, all in the field of adult entertainment," in International Class 38,

"Entertainment services, namely, providing a website featuring non-downloadable video, photographs, images, audio, and text in the field of adult entertainment via a global computer network" in International Class 041, and presented arguments against the refusal under Section 2(d) of the Trademark Act.

On July 30, 2012, the examining attorney made final the refusal to register under Section 2(d) of the Trademark Act with regard to the mark in U.S. Registration No. 3,605,311, and withdrew the recitation of services requirement as satisfied.

On January 30, 2013, the applicant filed a Request for Reconsideration and a timely Notice of Appeal. The examining attorney denied the Request for Reconsideration on March 31, 2013.

On June 3, 2013, the applicant submitted an Appeal Brief presenting its arguments that the refusal under Section 2(d) of the Trademark Act should be reversed and the mark should be approved for registration on the Principal Register.

ISSUE ON APPEAL

The sole issue on appeal is whether the applicant's use of the mark, XTUBE, for, as amended, "video-on-demand transmission services; video broadcasting; electronic, electric, and digital transmission of voice, data, and images, all in the field of adult entertainment; and, entertainment services, namely, providing a website featuring non-downloadable video, photographs, images, audio, and text in the field of adult entertainment via a global computer network," creates a likelihood of

confusion with the mark, XXXTUBE, for "entertainment services, namely, providing a web site featuring adult-themed photographs and videos; entertainment services, namely, providing webcasts in the field of adult entertainment; entertainment, namely, production of adult entertainment videos and films."

ARGUMENTS

LIKELIHOOD OF CONFUSION

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 goods and/or 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 SIMILAR AND CREATE SIMILAR COMMERCIAL IMPRESSIONS

A. Similarity of the Marks

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

1. Appearance

In this case, both of the marks are formed by a combination of X or XXX and TUBE. Thus, the only difference is the number of Xs that precede the word TUBE. Accordingly, the marks are similar in appearance.

Citing *In re Reach Electronics, Inc.,* 175 U.S.P.Q. 734, 735 (T.T.A.B. 1972), the applicant argues that "a one letter difference can sufficiently distinguish two marks." *See Appellant's brief page 3.* In *In re Reach Electronics, Inc.,* the Trademark Trial and Appeal Board found no confusion between the marks REAC and REACH. Said holding is irrelevant to this case, since the word REAC is a coined term, while

REACH has a distinct meaning. In this case, as noted below, both the letter X and the letters XXX denote a rating for pornographic films. Thus, this case is distinguishable because the marks are letters X and XXX are not a coined terms versus terms with distinct meaning. Rather, the letters have similar meaning in this case.

Further, the applicant argues the first portion of a mark is the dominant element. While this has been held to be true, the X and XXX are similar in that they are ratings for pornographic films. Accordingly, even if the letters X and XXX are deemed to be the dominant features of the mark, they are similar in sight, sound, and more importantly, connotation. *See below analysis regarding the meanings of X and XXX in the adult entertainment industry.*

Thus, the marks are similar in appearance because they are both comprised of the letter(s) X (which has been shown to have meaning in relation to the specified services) as a prefix to the term TUBE.

2. <u>Sound</u>

Here, the marks can both be pronounced as EXTUBE, as the only letters preceding the term tube are the letters X.

The applicant argues that the marks are different in sound and appearance, as the applicant's mark sounds like EX TUBE, while the registered mark sounds like TRIPLE X TUBE. However, there is no

correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

The applicant argues that the only "feasible pronunciations of XXXTUBE are "triple-x-tube" or "ex-ex-ex-tube." *See Appellant's brief page 5.* However, the applicant's own postulation that there could be multiple pronunciations of the registered mark proves there is no definite pronunciation, and the consuming public could possibly pronounce the mark as EXTUBE with an accentuation of the X like ECKS.

Thus, the marks are similar because the marks may be similar in pronunciation.

3. <u>Meaning and Commercial Impression</u>

When the marks are considered in their entireties, the meaning of, and commercial impressions created by the marks are very similar. The marks share the identical term TUBE. The marks are differing in that the applicant's mark contains a single X as the prefix to tube, whereas the registered mark contains XXX as the prefix to tube. However, a single X compared to XXX does not distinguish the overall commercial impressions created by the marks.

In this case, both marks are a combination of the X or XXX rating for pornographic films used in association with the term TUBE. "Single-X-rated movies feature nudity, long-range or panoramic and medium-range camera shots, simulated sex and sex between women. Double-X-rated movies show intercourse, oral sex and close-up shots. Triple-X-rated movies feature anal sex and visible ejaculation." *See the Los Angeles Times article "Adelphia's Explicit Porn," pages 4-8 of the Office action dated November 29, 2011.*

The term TUBE suggests a website featuring videos. *See U.S. Reg. Nos. 3350922, 3385174, 3543597, 3547966, 3635840, 3687250, 3682090, 3685335, 3690953, 3702501, 3724921, 3767086, 3771383, 3825919, 3835466, 3866253, 3936197, 4022953, 4150368, all containing the terms TUBE for websites featuring videos and streaming of videos, see pages 2-54 of the Office action dated July 30, 2012.* Here, both marks are for use with websites featuring videos and streaming of videos.

Thus, the marks have a similar commercial impression, since they both connote a pornographic film rating in combination with the term TUBE – especially when used in association with services featuring adult themed videos, which include pornographic films.

The applicant argues that the X in its mark "connotes any number of things other than pornography." *See Appellant's brief, page 5.* However, when combined with the term TUBE, and associated with services featuring adult themed movies, the mark suggests the X is adult theme related.

The applicant argues that the X in its mark "primarily connotes the Appellant's services are hip, exciting, and modern." *See Appellant's brief, page 5.* Further, the applicant argues that the letter X is an acronym for a number of words. However, the term X has significance in the relevant industry, namely, that the something is pornographic in nature. Thus, the additional meanings are of little consequence, since the X has a distinctive meaning when combined with the term TUBE and associated with the applicant's adult themed services.

Applicant also argues that the field is crowded, as various registered trademarks include with the term XXX or TUBE. However, the applicant's and registrant's marks are the only two marks that include a combination of the letters X or XXX and TUBE. The marks have the same commercial impression because the X and XXX are the dominant features of the marks, and the addition of TUBE merely connoted that the marks are for use with video related websites.

Accordingly, the marks are similar.

APPLICANT'S SERVICES ARE SUFFICIENTLY RELATED TO REGISTRANT'S SERVICES THAT CONFUSION IS LIKELY

A. The Services are Commercially 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 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)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

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, e.g.*, *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *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/or 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 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).

1. **Comparison of Class 041 Services**

Applicant's class 041 services are identified as "entertainment services, namely, providing a website featuring non-downloadable video, photographs, images, audio, and text in the field of adult entertainment via a global computer network. The identification of services listed in U.S. Registration No. 3,605,311 has no restrictions as to nature, type, channels of trade, and are available to the same class of purchasers. Therefore, it is presumed that these services travel in all the normal channels of trade, and are available to the same class of purchasers. Because the recitation of services in the application uses broad language to describe the services, this language is presumed to encompass all services of the type describes, including those in the more narrow recitation of services in U.S. Registration No. 3,605,311. Therefore, the applicant's class 041 services and the services in U.S. Registration No. 3,605,311 are legally identical and are therefore, closely related.

Applicant argues that its services also include the provision of images in the field of adult entertainment. The registrant's mark is currently used with websites featuring adult themed photographs. Photographs are a type of image. Thus, the applicant's service featuring images encompasses the more narrow recitation of the applicant, i.e., a website featuring adult themed photographs.

Thus, the class 041 services are similar because they are both comprised of websites featuring adult entertainment.

2. **<u>Comparison of the Applicant's Class 038 Services and the Registrant's Class 041 Services</u>**

The services listed in the applicant's class 038 recitation of services are "Video-on-demand transmission services; video broadcasting; electronic, electric, and digital transmission of voice, data, and images, all in the field of adult entertainment." Said services commonly emanate from a single source as web providers featuring non-downloadable images and videos. *See registrations featuring both video on-demand and streaming services, and websites featuring non-downloadable images and videos on pages 6-40 in the Denial of the Request for Reconsideration dated 3/31/2013.*

The following registrations are used with video-on-demand transmission; video broadcasting; electronic, electric, digital transmission of data; and websites featuring videos and images in the field of adult entertainment:

- FYRETV (U.S. Reg. No. 3517534) for use in association with "Broadcasting services and provision of telecommunication access to video and audio content provided via a video-on-demand service via the Internet; communications services, namely, transmitting streamed sound and audio-visual recordings via the Internet; streaming of video material on the Internet; and, Entertainment services, namely, providing a website featuring, photographic, audio, video and prose presentations featuring adult entertainment;"

- INNOCENT SKIN (U.S. Reg. No. 4250331) for use in association with "Transmission and distribution of audio visual images via a global computer network or the Internet, and video on demand transmission services via the Internet; and, Entertainment services, namely, providing a web site featuring adult-themed photographs and videos, adult-themed performances, related film clips, photographs and other multimedia materials."

- TLA (U.S. Reg. No. 3748782) for use in association with "video on demand transmission services; entertainment services, namely, distribution of motion pictures, adult entertainment, comedy, musical and dramatic series, and documentaries for others available via a global communications network;"

- REDTUBE (U.S. Reg. No. 3884412) for use in association with "Streaming of video content on the internet in the field of adult entertainment; broadcasting services and provision of telecommunication access to video and audio content via video-on-demand service via the internet; broadcasting programs via the internet; providing online discussion forums, bulletin boards and chat rooms concerning audiovisual content on the internet in the fields of general interest entertainment and adult entertainment; telecommunications services, namely, broadcasting and delivery of text, electronic documents, databases, graphic, audio and visual data by means of the internet; Entertainment services, namely, providing a website featuring videos, film clips, photographs, multimedia materials, magazines, and television programs in the field of adult entertainment; production of videos and photographs in the field of adult entertainment; electronic publishing services, namely, publication of text and graphic works, video and photographs of others featuring adult entertainment;" and,

- PRIVATE MEDIA GROUP, INC. (U.S. Reg. No. 4027800) for use in association with "television broadcasting, video broadcasting, audio broadcasting; broadcasting services and provision of telecommunications access to video and audio content via video on demand via the internet; ***video broadcasting and transmission services via the Internet featuring films and movies***; electronic delivery of digital music, digital images and digital photographs all via electronic transmission; satellite, cable and network transmission of sounds, images and data; providing multiple user access to proprietary collections of information by means of global information networks; streaming of audio, visual and audiovisual material via a global computer network; wireless electronic transmission of audio signals, data, images and informations; transmission of sounds, images and data all via satellite to mobile phones, mobile devices, wireless devices and wired devices; communications by telephone, mobile media services in the nature of electronic transmission of entertainment media content; transmission of sounds, video and information from web cams, video camera or mobile phones all featuring live or recorded materials; provision of access to electronic sites; providing on-line chat rooms for social networking; entertainment services, namely, multimedia production services; entertainment media production services for motion pictures, television and the Internet; entertainment services in the nature of the creation, production and distribution of films, motion pictures and television and radio programs; entertainment services in the nature of the creation, production and distribution of videos and DVDs all featuring adult entertainment content; internet services, namely, displaying a series of films; internet services, namely, displaying a series of videos featuring adult entertainment content; cable television programming; multimedia publishing of magazines, games, music and electronic publications; publication of e-zines; provision of non-downloadable films, movies and television programs via video on demand services; rental of film, videotapes and motion pictures; entertainment services, namely, providing on line electronic games; entertainment services in the nature of providing continuing programs, movies and shows featuring adult entertainment delivered by television, satellite and Internet;

entertainment services, namely, providing web sites featuring non-downloadable adult themed films, videos and photographs; entertainment services in the nature of on-going IPTV (Internet Protocol Television) television programming segments in the field of adult entertainment; entertainment services, namely, providing web casts and pod casts in the field of adult entertainment."

Thus, consumers are accustomed to seeing a single mark used with both video transmission and broadcasting services and websites featuring adult entertainment based on third party registrations. In *In Re Anderson,* 101 USPQ2d 1912, 1919, the Trademark Trial and Appeal Board acknowledged that "use-based, third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source."

Moreover, the USA Today article "Purveyors of porn scramble to keep up with the Internet: DVDs are dying; Web is what's hot," discusses how the adult entertainment industry is trying to keep up with technology by streaming movies and creating websites featuring exclusive video content. *See pages 64-66 of the Denial of the Request for Reconsideration dated March 31, 2013.*

In addition, the applicant is one of the leading providers of online adult entertainment. *See Wikipedia printout, press releases from XBIZ NEWSWIRE, article from American LiveWire, and Internet rankings from www.alexa.com on pages 2, 51-63, and 67-82 of the Denial of the Request for Reconsideration dated March 31, 2013.* The Wikipedia entry for the applicant indicates the applicant is the owner of many major pornographic websites, including XTUBE, "which between them generate some 16 billion visitors per month and consequently are believed to be among the most popular websites on the planet. *See Wikipedia entry of for MANWIN.* WWW.AMERICANLIVEWIRE.COM ranks the

applicant's YOUPORN number 2 among the Internet's most visited porn sites, while www.alexa.com ranks it number 3 among all adult entertainment websites *See page 67 and 71 of the Denial of the Request for Reconsideration dated March 31, 2013.*

The fact that the applicant's websites are the some of the most visited adult entertainment websites on the Internet, and that those websites feature video on demand, video broadcasting, and transmission of voice, data, and images, all in the field of adult entertainment, along with websites featuring images and videos in the field of adult entertainment, is evidence that consumers of adult online entertainment are likely to be accustomed to seeing all of those services originating from a single source. Accordingly, it would be reasonable for the registrant to expand its trade to use its mark with the class 038 services, since one of the leading providers of online adult entertainment is using a single mark with all of said services.

In this case, the services are similar because they commonly emanate from a single source as evidenced by prior registrations. Moreover, the adult entertainment industry is utilizing new technologies to release adult themed entertainment. Thus, the consuming public is becoming accustomed to seeing single marks with both broadcasting and video transmission services used with the same mark that identifies a website featuring adult themed videos. Accordingly, the services are similar.

CONCLUSION

The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Thus, it can be said that the applicant has a legal duty to select a mark that is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner Lambert Co*., 203 USPQ 191 (TTAB 1979). In light of that duty, and for the foregoing reasons, the examining attorney respectfully requests that the Board resolve the likelihood of confusion issue in favor of the registrant and affirm the refusal to register on the basis of Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. Section 1052(d).

Respectfully submitted,

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