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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---|---|
| Proceeding | 85390145 |
| Applicant | Manwin Licensing International SÃ rl |
| Applied for Mark | XTUBE |
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| Date | 08/29/2013 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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|---|---|---|
| In re Application of: | ) | **REPLY BRIEF FOR APPELLANT** |
| | ) | |
| Manwin Licensing International Sàrl | ) | Law Office No.: 112 |
| | ) | (571) 272-8276 |
| Serial No.: 85/390,145 | ) | |
| | ) | Trademark Examining Attorney: |
| Filed: August 4, 2011 | ) | Eli J. Hellman |
| | ) | |
| Classes: 38, 41 | ) | Date: August 29, 2013 |
| | ) | |
| Trademark: XTUBE | ) | |
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The Examining Attorney's response to Appellant Manwin Licensing International Sàrl's (hereinafter "Appellant") appeal brief is unavailing for at least three reasons. *First*, the Examiner's Statement is factually incorrect in connection with a critical aspect of the record. *Second*, the Statement fails to address several of Appellant's arguments. *Third*, in the instances in which the Statement attempts to argue against the points made in Appellant's brief, it is demonstrably wrong. Appellant respectfully requests that the Board reverse the refusal, and allow registration of XTUBE.

## I. <u>The Examiner's Statement Misstates The Record.</u>

The Examining Attorney erroneously states that: "Applicant also argues that the field is crowded, as various registered trademarks include with [sic] 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." Examiner's Statement at 9. ***Not so.*** Appellant has provided the Board with evidence of numerous marks that include such a combination, including the following:

- U.S. Registration No. 406,632 is for TUBEX in connection with "hypodermic syringes and needles therefor." It was first used in commerce in 1943, and registered on April 11, 1944.
- U.S. Registration No. 694,827 is for TUBEX in connection with "disposable injection cartridges containing pharmaceutical and diagnostic preparations." It was first used in commerce in 1943, and registered on March 22, 1960.
- U.S. Registration No. 1,600,876 is for TUBEX in connection with "plastic tree shelters, stakes, and ties in the nature of straps, all for use with saplings and trees." It was first used in commerce in 1985, and registered on June 12, 1990.

- U.S. Registration No. 2,242,920 is for TUBEX in connection with "metal building materials, namely, foundation piles." It was first used in commerce in 1971, and registered on May 4, 1999.
- U.S. Registration No. 2,782,127 is for the following mark in connection with "freight transportation through underground tunnels through electro-linear induction propulsion," first used in 1998, and registered on November 11, 2003:

- U.S. Registration No. 3,225,488 is for XTUBE in connection with "endoscopic system, consisting of endoscopes, dilators, expandable cannulae and expandable retractors, cutting apparatus, trays and application tools and instruments, including C-mount camera assembly, C-mount adapter, C-mount camera head, orientation ring, camera head, focus ring, tubular retractor lock and aspiration port, deploying and closing instrument, and component parts therefor for use in surgical procedures." It was first used in commerce in 2003, and registered on April 3, 2007.

*See* Group Ex. 5 to Req. for Reconsideration. Moreover, Applicant has provided the Board with representative examples of the actual use of "xxx" and "tube" marks. Exs. 9-12 to Response to Office Action. There is, in fact, a crowded field, one which allows for the registration of Appellant's XTUBE mark. *See, e.g.*, *In re Pure & Natural Company*, Serial No. 77/433737 at 6 (T.T.A.B. May 13, 2013) (reversing refusal to register, and stating that "We find that the frequent registration of the terms TROPICAL ***and/or*** ESCAPE for their suggestive meaning on soaps and detergents as well as on household fragrances and scented sprays together with the

evidence of third-party use of TROPICAL ESCAPE on various types of scented products suggests that consumers are able to distinguish the source of these distinctly different scented products bearing similar or even identical names." (emphasis added).); *Steve's Ice Cream, Inc. v. Steve's Famous Hotdogs*, 3 U.S.P.Q.2d 1477, at *1479 (T.T.A.B. 1987) ("[T]he numerous third-party uses demonstrate that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store fields use the term [Steve's], or something closely related to it, and that this purchasing public is able to distinguish between these businesses based on small distinctions among the marks."); *Black Entertainment Television, Inc. v. Youbet.com, Inc.,* 2001 TTAB LEXIS 130 (T.T.A.B. 2001) (in Opposition No. 112,427, denying opposer's motion for summary judgment in part because applicant's allegation of "a number of third party registrations and common law usages containing the term BET" raised a triable issue of fact as to the strength of opposer's mark).

## II. The Examining Attorney Concedes Appellant's Arguments By Failing To State Otherwise In The Examiner's Statement.

The Examining Attorney also concedes numerous points in Appellant's brief by failing to challenge them in the Examiner's Statement. For example:

- Appearance of the Marks. The Statement contains only a cursory discussion of the marks' respective appearances, and completely fails to address a critical difference between the appearance the two, namely, that while the cited mark contains two elements that appear in the dictionary ("xxx" and "tube"), Appellant's mark XTUBE is a coined mark with no established definition. *See* Exs. 1-3 to Response to Office Action.

- Sound. While the Statement acknowledges that there may be no "correct" pronunciation of a trademark, *In re Viterra Inc.*, 101 U.S.P.Q.2d 1905, 1912 (Fed. Cir. 2012), it fails to recognize that a proposed pronunciation must be a *feasible* one. Accordingly, the Statement does not even address Appellant's contention that "ex tube" is *not* a realistic possible pronunciation of the mark XXXTUBE. Group Exs. 4-5 to Response to Office Action.[1] Put another way, while there may not be a single "correct" pronunciation of a mark, there are obvious *incorrect* ones.

- Meaning and Connotation. The Statement does not discuss Appellant's contention that TUBE has any number of meanings other than a website featuring videos. *See* Ex. 4 to Req. for Reconsideration.

## III. The Examining Attorney's Attempts To Rebut Appellant's Arguments Are Unavailing.

When the Examiner's Statement does address Appellant's arguments, it fails to do so successfully.

With respect to the appearance of the marks, Appellant cited *In re Reach Electronics, Inc.*, 175 U.S.P.Q. 734, 735 (T.T.A.B. 1972) for the proposition that even a one-letter difference can sufficiently distinguish two marks. The Examiner's Statement claims that *In re Reach* is

[1] The Board has previously made a determination as to how the public would pronounce a mark despite the availability of another, implausible option, and it should do so again here. In *In Re J 2 Z*, 2013 WL 3001436 at *3 (T.T.A.B. March 12, 2013), the Board stated that "in terms of sound, the marks differ to the extent that applicant's mark includes the highly descriptive matter '& MORE,' which would be pronounced 'AND MORE.'" Under the Examining Attorney's line of reasoning, the Board's statement is incorrect, because "& MORE" theoretically could be pronounced "AMPERSAND MORE." There is a reason why the Board did not advance this as a possible pronunciation: it is simply not a realistic one. Indeed, the significance of the Board's observation in *In Re J 2 Z* is even greater in this case, where the pronunciation pertains to the marks' dominant features.

irrelevant to this case because, in that case, one mark (REAC) was a coined term and the other (REACH) had a "distinct meaning." Examiner's Statement at 5-6. However, as noted above, this is precisely the situation here: Appellant's mark is the coined XTUBE, which could have multiple meanings not associated with adult entertainment, whereas the cited mark, XXXTUBE, has a distinct meaning associated with adult entertainment. *See also* Appeal Brief at 4.

The Examiner's Statement also concedes that it is true that the first part of a mark (here, the part that is different) is considered dominant. Examiner's Statement at 6. It claims, however, that X and XXX are similar in connotation. While Appellant disagrees, as set forth in greater detail below, it is not true that they are similar in appearance.

Turning to the sound of Appellant's mark versus the cited mark, Appellant contends, as set forth above, that it is not feasible that XXXTUBE would be pronounced as "ex-tube." However, even if that were not the case, any phonetic equivalence is a much less important factor when the services are, as in this case, not ordered verbally, but typed and looked at on a webpage. *See* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:22 (4th ed.).

The marks also have very different meanings and commercial impressions. Even if consumers automatically associated Appellant's mark with adult entertainment – which they would not[2] – as *admitted* by the Examining Attorney, there is a significant difference in that context between X and XXX. Examiner's Brief at 9. Moreover, the Examining Attorney focusses on a single meaning of TUBE – a website featuring videos – to the exclusion of the various other meaning cited by Appellant. *Id*.

[2] The Examining Attorney cites no law for the proposition that consumers would ignore the myriad other meanings of "X" because Appellant's services are in the adult entertainment industry.

Finally, with respect to the Appellant's services and those associated with the cited mark, Appellant maintains the arguments regarding dissimilarities as set forth in its opening brief. It also notes that, even if there were a precise identity of services, it would still be appropriate for the Board to reverse the refusal to register. *In re Gastroceuticals, LLC*, Serial No. 77/527093 at 14 (T.T.A.B. September 2, 2010) (despite similarity of goods and identity of sound, reversing refusal to register "because the dissimilarity of the marks simply outweighs the evidence as to the other factors."). *See also Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single du Pont factor may not be dispositive"); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 U.S.P.Q 563, 567 (C.C.P.A 1973) ("[E]ach [of the thirteen factors] may from case to case play a dominant role . . . .").

## IV. Conclusion.

For all of the reasons set forth above, and in the record below, Appellant respectfully requests that the Board reverse the Examining Attorney's refusal to register XTUBE.

Respectfully submitted,

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I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a) on June 3, 2013.

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