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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Manwin Licensing International Sàrl

Serial Nos. 85390145 and 85392503

Alexa L. Lewis of Mitchell, Silberberg & Knupp, LLP for
Manwin Licensing International Sàrl.

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112 (Angela Bishop Wilson, Managing Attorney).

Before Seeherman, Bucher and Mermelstein, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On August 8, 2011, Manwin Licensing International Sàrl
filed applications to register the marks XTUBE in standard
characters,¹ and XTUBE and design, as shown below,²

The logo for XTUBE features a stylized, outlined 'X' on the left, followed by the word 'TUBE' in a bold, outlined, sans-serif font.

¹ Application Serial No. 85390145.

² Application Serial No. 85392503.

for the following services:

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 Class 38; 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, in Class 41.

Both applications assert first use and first use in commerce on February 9, 2006.

The trademark examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's marks, as used in connection with the identified services, so resemble the mark XXXTUBE, in standard characters, registered for the services set forth below,³ that they are likely to cause confusion or mistake or to deceive:

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 Class 41.

Applicant has appealed the refusals in both applications, and the appeals have been fully briefed.⁴

³ Registration No. 3605311, issued April 14, 2009.

⁴ We note applicant's assertion in its reply briefs that, because the examining attorney did not address particular arguments made by applicant in its appeal briefs regarding the

Because both appeals involve common issues of law and fact, we are consolidating the appeals and issuing a single decision. See TBMP § 1214. Citations to page numbers/evidence, unless otherwise indicated, are to Serial No. 85392503.

We affirm the refusals in both appeals.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We turn first to a consideration of the services. Applicant's Class 41 services are "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

similarity of the marks, he has conceded these points. Applicant has not submitted any case law to support this position, nor do we accept it. Not discussing a particular argument on a du Pont factor in a brief is not the same as conceding that the *factor* favors the applicant. In his brief the examining attorney has clearly stated that the marks are similar, and has discussed the similarity in appearance, pronunciation, connotation and commercial impression of the marks; the fact that he has not addressed each assertion made by applicant in arguing against this position does not mean that he agrees with all of them.

services described in the cited registration are, inter alia, "entertainment services, namely, providing a web site featuring adult-themed photographs and videos." These services are legally identical. As such, they are presumed to travel in the same channels of trade and be offered to the same classes of consumers. In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994). These du Pont factors favor a finding of likelihood of confusion.

Applicant points out that its entertainment services "also contemplate the provision of images, audio, and text" (brief, p. 10). However, there is no requirement that applicant's services must be coextensive with those of the registrant in order for us to find the services legally identical. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)) (likelihood of confusion must be found with respect to the entire class of an application if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application). Both applicant's and the registrant's services include providing a website featuring adult-themed photographs and video (or, as the applicant's identification expresses it, a website featuring video and photographs in the field of adult entertainment).

As for applicant's Class 38 services, they are, although not identical to the registrant's Class 41 services, closely related to them, since they are in effect two sides to the same coin; one service involves the digital transmission of, inter alia, voice and images in the field of adult entertainment, and the other involves providing a web site featuring adult-themed photographs and videos. Further, the registrant's production of adult entertainment videos and films provides the content for the "video broadcasting and electronic, electric, and digital transmission of voice and images in the field of adult entertainment" identified in applicant's application. The complementary nature of the services is obvious.

In addition, the examining attorney has submitted evidence, in the form of third-party registrations, to show the relatedness of the services. These third-party registrations include, in their identifications, services of the type listed in applicant's Class 38 identification, e.g., video on demand transmission services, and the Class 41 services listed in the registrant's identification, e.g., providing a website featuring video and photographs. See, for example, Registration Nos. 3517534, 4250331, 3884412, 4145084, 4262305 and 4186682. Third-party registrations which individually cover a number of

different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Moreover, the fact that applicant lists these Class 38 services as well as the same entertainment services as those of the registrant in not only the subject applications but in other registrations it owns, e.g. Registration Nos. 4220491, 4244365 and 4228853, shows that these types of services may emanate from a single source under a single mark.⁵

In addition, applicant's transmission and video broadcasting services, which would encompass adult entertainment subject matter, and its electronic, electric and digital transmission of video, data and images in the field of adult entertainment, would have the same consumers as those viewing a website featuring adult-themed photographs and video.

Thus, we find that applicant's Class 38 services are closely related to the registrant's Class 41 services, and that they can be encountered by the same classes of consumers.

⁵ These registrations were made of record by the examining attorney in the Office action mailed March 31, 2013.

These du Pont factors favor a finding of likelihood of confusion.

We turn next to the du Pont factor of the similarity of the marks. First, we compare applicant's mark XTUBE in standard characters with the cited mark XXXTUBE. These marks are extremely similar in appearance, differing only by the additional XX at the beginning of the cited mark. Applicant places great weight on this difference, arguing that the XXX should be viewed as the dominant feature of that mark because it appears at the beginning of the term. On the other hand, applicant would not apply this beginning-of-the-term approach to its mark, asserting that TUBE is the dominant element because "tube" is slang for television. Brief, p. 3-4.

To the extent that one element of the marks would be considered dominant, we cannot agree with applicant that the dominant element is different in the two marks. In both marks, X or XXX describes the nature of the content of the subject matter of the services, while TUBE is highly suggestive of the manner in which the subject matter can be watched. When used in connection with adult-themed services, the X or XXX portion of the marks conveys the same meaning, that of pornography, albeit "X" connotes a less extreme degree of pornographic content than "XXX"

does.⁶ See February 2, 2005 Los Angeles Times article, www.latimes.com, submitted with November 29, 2011 Office action, describing the features of single-X, double-X and triple-X rated movies. Although consumers will recognize the difference between XTUBE and XXXTUBE, and indeed may pay particular attention to this portion of the mark to identify the degree of pornography they are seeking, they are not likely to view the number of X's in the marks as indicating separate sources for the services, but only the nature of the content of the material transmitted or provided. As a result, the differences between the marks do not distinguish them as indicators of source. For similar reasons, the differences in pronunciation of the marks do not distinguish them either. Even if we assume

⁶ We are not persuaded by applicant's argument that consumers would see XTUBE as "part of a trend of recently coined words beginning with the letter 'x,' such as 'xtreme,' [and] 'xtrnormal'.... Brief, pp. 5-6 (citations to exhibits omitted). First, as the examining attorney points out, in these examples the letter "X" is merely substituted for "ex" in an actual word. More importantly, the meaning that a mark conveys, or in this case the letter X in the mark, must be assessed in connection with the goods or services with which it is used. Cf. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (although "doc" is defined as both "doctor" and "document" the relevant meaning will be understood as document by the purchasing public in relation to document management software). It is because the meaning of the mark will depend on the goods or services with which the mark is used that in some cases identical word marks have been found not confusingly similar. See *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (COACH when applied to educational materials brings to mind someone who instructs students, while COACH when used in connection with luxury leather goods, brings to mind traveling by carriage).

that consumers will pronounce the registrant's mark as "Triple X Tube," and applicant's mark as "X Tube," as applicant contends, the difference will only signal to consumers information about the nature of the content of the services, and not that they emanate from separate sources.

Overall, the marks are similar in appearance, connotation and commercial impression, and the differences in pronunciation are not sufficient to distinguish them.

As for applicant's word and design mark,



the "X" portion is highlighted because it is depicted in a larger size and in a different font from TUBE, further emphasizing that the mark consists of two elements, X and TUBE. However, this does not serve to distinguish it from the registrant's mark XXXTUBE. XXXTUBE would also be viewed as consisting of the two elements, XXX and TUBE. As previously discussed, consumers will understand the element X and XXX in the respective marks as describing the nature of the content of the material that is the subject of the services, rather than understanding the different prefixes X or XXX as identifying separate sources of the services.

We also point out that, because the cited registration is for a standard character mark, the registrant would be entitled to depict it in any form, including in the fonts which applicant uses for the elements X and TUBE, and with the XXX in larger size. In re Viterra Inc., 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012) (a standard character mark is not limited to any particular font, size, style, or color. As for the sound, meaning and commercial impression of the marks, our analysis with respect to applicant's standard character mark and the cited mark applies to applicant's stylized mark.

We find that applicant's marks and the cited mark are similar, and that this du Pont factor favors a finding of likelihood of confusion.

In reaching this conclusion, we have considered the evidence and argument regarding the strength of the cited registration, and the du Pont factor of the number and nature of similar marks in use for similar services. Applicant has shown that various marks containing the elements XXX and TUBE have been registered in connection with "adult goods and services." Brief, p. 8. Third-party registrations can be used in the manner of dictionary definitions to show that a particular term has a meaning or significance in a particular industry. See Tektronix, Inc.

v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). We have no doubt that XXX has a significance in the adult entertainment industry. Both applicant and the examining attorney are in agreement on this point: ("xxx" is a universal abbreviation for pornography," applicant's brief, p. 4; February 5, 2005 Los Angeles Times article submitted by examining attorney, reporting the ratings system developed by adult entertainment industry). And, as we have already found, TUBE has a suggestive significance for the manner in which the services are delivered. Because the cited mark is composed of a descriptive and a suggestive element, we agree that the scope of protection to which it is entitled is not as great as would be due an arbitrary mark. However, even weak marks are entitled to protection. See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute, 101 USPQ2d 1022, 1028 (TTAB 2011); In re Max Capital Group Ltd., 93 USPQ2d 1243, 1246 (TTAB 2010); In re Chica Inc., 84 USPQ2d 1845, 1850 (TTAB 2007). In this case, where the marks are so similar and the services are in part identical and otherwise closely related, the scope of protection due to the cited registration extends to prevent the registration of applicant's marks for its identified services.

As for the third-party registrations for TUBEX and XTUBE relied on by applicant, they have no probative value. They are for goods and services far removed from the services at issue, i.e., medical devices, apparatus for use with saplings and trees, and freight transportation services, and therefore cannot show any significance of the terms in connection with the involved services. Further, they are not evidence of use of the marks; even if they were, they do not show that XXXTUBE is part of a crowded field of similar marks for the services at issue herein.

Neither applicant nor the examining attorney have discussed or submitted evidence on any other du Pont factors. To the extent that any factors are relevant, we treat them as neutral.

In view of our analysis of the evidence pertaining to the du Pont factors, we find that applicant's use of its marks for its identified services is likely to cause confusion with the registered mark.

Decision: The refusals of registration are affirmed with respect to both applications.