To:	Multicom Entertainment Group, Inc. (tmdocketny@kenyon.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 86187999 - THE BUCCANEERS - 16071/7
Sent:	12/9/2015 4:26:55 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86187999

MARK: THE BUCCANEERS

86187999

CORRESPONDENT ADDRESS:
JAMES E. ROSINI,
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1 BROADWAY
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APPLICANT: Multicom Entertainment Group, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:
16071/7
CORRESPONDENT E-MAIL ADDRESS:
tmdocketny@kenyon.com

OFFICE ACTION

ISSUE/MAILING DATE: 12/9/2015

THIS IS A FINAL ACTION.

Introduction

This Office action is in response to applicant's communication filed on November 30, 2015. In the previous Office action, the Examining Attorney issued/maintained the following refusals and requirement:

Section 2(d) Refusal – Likelihood of Confusion

Section 2(e)(1) Refusal – Insufficient Section 2(f) Claim
Requirement for Acceptable Identification of Goods

The applicant has **obviated** the Section 2(e)(1) refusal by submitting a verified Section 2(f) claim. The applicant has also **satisfied** the identification requirement.

The applicant's response only partially overcomes the Section 2(d) refusal, which is made **final** as to specified goods as indicated below.

Summary of Issues Applicant Must Address

- Section 2(d) Refusal - Likelihood of Confusion

FINAL Section 2(d) Refusal – Likelihood of Confusion – As to Specified Goods

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No. 3799334. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.63(b). *Office action, 11/25/2014, TSDR, at 2-3.*

The applicant has applied to register THE BUCCANEERS in standard-character form for the following goods (as amended by the applicant's 11/30/2015 Office action):

> Prerecorded audio cassettes, videotapes, laser discs, DVDs, CDs, interactive discs featuring music and television programs featuring dramatic television series for adults; digital media, namely, downloadable audio-visual media files featuring entertainment content in the field of a dramatic television series for adults; computer software for streaming audio-visual media content via the Internet and to mobile digital electronic devices; pre-recorded audio discs and non-disc digital media featuring music and television programs featuring drama for adults; digital media, namely, high definition digital discs featuring music and television programs featuring drama for adults; **digital media, namely, downloadable audio and video files comprising music and television programs featuring drama**; video and audio files in the form of wave file, MP3, MP4, MOV, FLV, SWF, AVI, WMV, MPEG, MIDI, and other digital formats, available by download and recorded on CD featuring music and drama for adults; **downloadable e-books about a dramatic television series**; Motion picture films featuring fictional drama for adults, in Class 9.

The refusal is now limited to the goods highlighted above in bold.

The registered mark is BUCANEROS in standard-character form for:

> ongoing television program in the field of children's programming, in Class 41.

Registration was initially refused because the marks are similar in commercial impression and the goods and services are related. The applicant has attempted to overcome the refusal by limiting the intended audience for the applicant's goods. The services highlighted above do not contain this limitation. Therefore, the refusal is maintained and made final as to those goods.

Comparison of the Goods

With respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or 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/or registration, the identified goods and/or 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).

The goods and services are related for the following reasons.

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 goods and services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application includes downloadable audio and video featuring television programs, which is presumed to encompass the same type of television series in the registrant's more narrow identification. Additionally, because children's entertainment routinely features music, the applicant's downloadable audio and video files featuring music are also related to the registrant's services. Finally, because the same mark may be used for televisions shows, and books, the applicant's e-books are also related to the registrant's services.

Internet Evidence

The applicant was previously referred to website printouts showing the marks WIGGLES and SESAME STREET used for both a continuing television series and books. *See Office action dated 5/16/2014, TSDR at 10-12* (Sesame Street); *13-14* (The Wiggles). These marks are used for both ongoing children's television programming along with books like those in the applicant's identification.

The applicant was also previously referred to evidence from Imdb.com providing a representative sampling of television shows and movies intended for children that contain dramatic content. *See Office action dated 5/28/2015, TSDR, at 2-10.*

The applicant was also referred to a summary of the registrant's television show, which describes the show as featuring adventures "full of sword fights and Swashbuckling." *See Office action dated 5/28/2015, TSDR, at 2-11*. Thus, the registrant's programming has similar subject matter as the applicant's, and would be aptly described as featuring drama.

This evidence establishes that the relevant goods and services are provided through the same trade channels under the same mark for use by the same classes of consumers. Therefore, applicant's and registrant's goods and services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Comparison of the Marks

In the previous Office actions, the applicant's mark THE BUCCANEERS and the registrant's mark BUCANEROS, were found to be similar in commercial impression for the following reasons.

Under the doctrine of foreign equivalents, a mark that consists of or comprises a word or words from a modern foreign language will be translated into English to determine genericness. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005); *see In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1315 (TTAB 1997); TMEP §1209.03(g).

The doctrine is applied when it is likely that an ordinary American purchaser would "stop and translate" the foreign term into its English equivalent. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); *cf.* TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to "all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English." *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (citing J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §23:36 (4th ed., rev. 2006), which states "[t]he test is whether, to those American buyers familiar with the [modern] foreign language, the word would denote its English equivalent.").

Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. *See In re Oriental Daily News, Inc.*, 230 USPQ 637, 638 (TTAB 1986); *In re Zazzara*, 156 USPQ 348, 348 (TTAB 1967); TMEP §1209.03(g).

In this case, the registered mark BUCANEROS is a Spanish word that directly translates to BUCCANEERS. Thus, the marks have the same meaning, as well as sharing some similarities in appearance in sound.

Thus, based on the foregoing, the marks have the same meaning and are similar in appearance, sound, and commercial impression.

Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or 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, for the foregoing reasons, the Section 2(d) refusal is **maintained and made final** as to the goods highlighted above in bold. The applicant may overcome this refusal by limiting the audience for the audio and video files and e-books to adults.

ADVISORY – Partial Abandonment

The applicant is advised that if it fails to perfect the appeal, the following goods will be deleted from the

application:

> digital media, namely, downloadable audio and video files comprising music and television programs featuring drama; downloadable e-books about a dramatic television series, in Class 9.

The application will then proceed with the following goods:

> Prerecorded audio cassettes, videotapes, laser discs, DVDs, CDs, interactive discs featuring music and television programs featuring dramatic television series for adults; digital media, namely, downloadable audio-visual media files featuring entertainment content in the field of a dramatic television series for adults; computer software for streaming audio-visual media content via the Internet and to mobile digital electronic devices; pre-recorded audio discs and non-disc digital media featuring music and television programs featuring drama for adults; digital media, namely, high definition digital discs featuring music and television programs featuring drama for adults; video and audio files in the form of wave file, MP3, MP4, MOV, FLV, SWF, AVI, WMV, MPEG, MIDI, and other digital formats, available by download and recorded on CD featuring music and drama for adults; Motion picture films featuring fictional drama for adults, in Class 9.

See TMEP §718.02(a).

Appeal Resumed

Since the applicant previously submitted a notice of appeal, the Board will be notified to resume the appeal. TMEP §715.04(b).

/Kim Teresa Moninghoff/
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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED ON **12/9/2015** FOR U.S. APPLICATION SERIAL NO. 86187999

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this link or go to http://tsdr.uspto.gov, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

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(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

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