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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Telefonica, S.A.

Serial No.: 76/231,727 Law Office: 104

Examining Attorney: Christine Cooper

Trademark: TELEFONICA GESTION DE SERVICIOS COMPARTIDOS (Stylized)

Filed: March 28, 2001

Assistant Commissioner for Trademarks
BOX RESPONSE FEE
2900 Crystal Drive
Arlington, VA 22202-3513

12-06-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

NOTICE OF APPEAL

To the Trademark Trial and Appeal Board:

Applicant hereby appeals to the Trademark Trial and Appeal Board ("the Board") from the decision of the Examining Attorney. A copy of the Request for Reconsideration is enclosed herewith.

The appeal fee of $300.00 required by Rule 2.6 is also enclosed.

Respectfully submitted,

Perla M. Kuhn
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

on Dec 3, 2002

HUGHES HUBBARD & REED LLP

Dated: 12/3/02 By: Cecilia Cabrera

Name: CECILIA CABRERA

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REQUEST FOR RECONSIDERATION

Applicant requests reconsideration of the Examining Attorney's refusal to register of June 3, 2002. The background for this request is as follows:

1. On March 28, 2001, Applicant filed an application based on intent-to-use and foreign registration for the mark TELEFONICA GESTION DE SERVICIOS COMPARTIDOS in the United States Patent and Trademark Office ("PTO") on the Principal Register for goods in International Classes 35, 36 and 38. The application was assigned Serial No. 76/231,727.

2. In an Office Action dated July 12, 2001, the Examining Attorney initially refused registration of Applicant's mark on the grounds that (a) Applicant's mark was merely descriptive, (b) the identification of goods was indefinite, (c) the drawing was unacceptable and (d) requiring the translation of the foreign wording in the mark.

3. On January 14, 2002, Applicant filed a timely response to the Office Action, amending its identification of goods and submitted the required drawing, definitions and legal

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arguments to overcome the refusal to register based on the ground that Applicant's mark was merely descriptive.

4. On February 15, 2002, Applicant submitted a Supplemental Response with a certified copy of its foreign registration and an English translation thereof.

5. On March 8, 2002, Applicant submitted an Amendment to its Supplemental Response requesting that the intent-to-use basis for its application be deleted if the foreign registration was acceptable.

6. On March 27, 2002, the Examining Attorney suspended the application pending the receipt of the certified copy of the foreign registration. The Examining Attorney accepted the translation and drawing submitted in the January 14, 2002 Response, but maintained and continued the refusal to register because the mark was merely descriptive and the recitation of services was indefinite.

7. On June 3, 2002, the Examining Attorney accepted Applicant's foreign registration and deleted the intent-to-use basis from the application. Accordingly, the Examiner made final the refusal to register because the mark was merely descriptive and the recitation of services was indefinite.

RECITATION OF SERVICES

Please delete the current recitation of services in its entirety and substitute the following:

CLASS 035

Business management; business administration in the nature of accounting, bookkeeping for others; human resource strategy information service for others; market research export agencies; business marketing consulting services; accounting services; telephone answering service for absent subscribers; message transcription; providing statistical information; preparing

business reports; efficiency experts; conducting business and market research surveys; advertising agencies, namely promoting the services of others in the financial field through the distribution of printed and audio promotional materials and by rendering sales promotion advice.

CLASS 036

Insurance agencies; insurance brokerage; financial analysis and consultation; financial management; monetary exchange; leasing of real estate; real estate brokerage; real estate development; treasury management services for others; investment security services for others.

CLASS 038

Telecommunication services, namely, local and long distance transmission of voice, data, graphics by means of telephone, telegraphic, cable, and satellite transmissions; electronic transmission of data and documents via computer terminals; providing telecommunication connections to a global computer network.

CLASS 042

Technology consulting in the field of information systems.

Enclosed please find the required $325 fee for the addition of Class 42 to the application.

ARGUMENTS

Applicant respectfully asserts that Applicant's mark is not merely descriptive for the reason set forth below and respectfully requests that the Examining Attorney withdraw the refusal to register the Applicant's mark. The Applicant specifically avers that (1) the doctrine of foreign equivalents does not apply to the wording in Applicant's mark; and (2) the terms do not directly translate into wording that is descriptive of Applicant' services.

The Mark TELEFONICA GESTION DE SERVICIOS COMPARTIDOS is Not Merely Descriptive

1. Doctrine of Foreign Equivalents Should Not be Applied

Under the doctrine of foreign equivalents, a mark with foreign words is translated into English to determine if it is descriptive. In this case, the phrase "telefonica gestion de servicios compartidos" may be translated to mean "telephone management of shared services." However, it has been recognized by commentators and the Trademark Trial and Appeal Board (the "T.T.A.B.") that the doctrine of foreign equivalents is not absolute and should not be applied mechanically. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 11.34-35, at 11-60-62 (4th ed. 1999) ("A rigid, unthinking application of the 'doctrine' of foreign equivalents can result in a finding quite out of phase with reality."); In re Pan Tex Hotel Corp., 190 U.S.P.Q. 109 (T.T.A.B. 1976); In re Tia Maria, Inc., 188 U.S.P.Q. 524, 525-26 (T.T.A.B. 1975).

Instead, when it appears that the ordinary purchaser would not stop and translate the mark into English, but instead would simply take the mark as it is, the doctrine should not apply. See 2 McCarthy § 11.35; In re Pan Tex Hotel Corp., 190 U.S.P.Q. at 109 (finding POSADA not descriptive of hotel services even though the English equivalents include "inn"); In re Tia Maria, Inc., 188 U.S.P.Q. at 525-6 (finding no likelihood of confusion between the marks TIA MARIA and AUNT MARY'S even though the literal translations are identical).

As discussed in Applicant's Response, dated January 17, 2002, it is unlikely that an ordinary consumer would stop to translate the mark TELEFONICA GESTION DE SERVICIOS COMPARTIDOS. The wording would be encountered in a corporate setting, namely during the course of business by a company seeking business management, financial, insurance and/or

telecommunication services. Consumers who view the mark will see it as being indicative of international sophistication. When confronted with services in a context where these associations are logical, most customers will not translate the mark, but will assume that the mark is the source identifier. See, e.g., Jules Berman & Assoc., Inc. v. Consol. Distilled Prod., Inc., 202 U.S.P.Q. 67, 70 (T.T.A.B. 1979) (noting that, rather than translating the mark CHULA for liqueur, the average consumer would not attach any meaning to the term "chula" other than "as a mark with a Spanish or Mexican overtone").

In addition, when a word is not similar to the English equivalent, the application of the doctrine of foreign equivalents may not be appropriate. See 2 McCarthy § 11.35; Troy Biosciences, Inc. v. Dowelanco, Civ. No. 96-1044, 1996 U.S. Dist. LEXIS 22245, at *21 (D. Az. 1996) (finding that the mark NATURALIS was not descriptive even though the English equivalent is NATURAL, because there was no proof that "the meaning of the Latin is familiar to a sizable segment of the American buying public"). In this case, while the term "telefonica" may be suggestive of the term "telephone" and the term "servicios" may be similar the English word "services," the Spanish terms "gestion" and "compartidos" are not visually similar to the English words "shared" and "management." Cf. In re California Growers Winery, Inc., 195 U.S.P.Q. 130, 131-32 (T.T.A.B. 1977) ("blanc" is used so often to describe a type of champagne that American consumers are familiar with this term); In re Optica, 196 U.S.P.Q. 775, 777 (T.T.A.B. 1977) (noting that the similarity between the mark OPTIQUE and the English equivalent OPTIC would be apparent even to those not familiar with the French language).

While Applicant's mark may be directly translated to mean "telephone management of shared services," when a term is so obscure that it would only be recognized by a small portion of consumers, the term may function as a trademark even though it appears in a dictionary. See 2

McCarthy § 11.33; Collyrium, Inc. v. John Wyeth & Bro., Inc., 167 Misc. 231, 3 N.Y.S.2d 42 (Sup. Ct. 1938) (finding the mark COLLYRIUM for eye lotion a valid trademark even though it "is defined in some of the standard English dictionaries as meaning eye lotion or salve"); Norwich Pharm. Co. v. American Pharm. Co., Inc., 159 Misc. 818, 288 N.Y.S. 795 (Sup. Ct. 1936) (recognizing a party's right to use the word "unguent" exclusively even though it "is a word found in the dictionary").

Accordingly, when used for services related to consultation regarding sophisticated business transactions, it is more likely that consumers will assume that the word was chosen for its international connotation than that they would stop and translate the meaning. In re Universal Package Corp., 222 U.S.P.Q. 344, 345 (T.T.A.B. 1984) (finding that the mark LE CASE for jewelry cases was suggestive and registrable); A La Carte, Inc. v. Culinary Enters., Inc., Civ. No. 97C 3958, 1997 U.S. Dist. LEXIS 12755, at *12 (N.D. Ill. 1997) (finding the mark A LA CARTE "carries an aura of associations of distinctively prepared French or continental food").

2. The Wording "Telefonica Gestion De Servicios Compartidos" Does Not Directly Translate Into A Phrase Descriptive Of Applicant's Services

In similar circumstances, where a foreign term is inclusive of a wide array of goods or has multiple connotations, the T.T.A.B. and courts have held that the mark is not descriptive. See Frehling Enter. v. Int'l Select Group, 192 F.3d 1330, 1336 (11th Cir. 1999) (affirming the lower court's determination that the mark OGGETTI, translated as "objects," was a suggestive and strong mark for home accessories and furniture); In re Atavio, 25 U.S.P.Q.2d 1362, 1363 (T.T.A.B. 1992) (finding that ATAVIO, which translates as "the dress and ornament of a person" is not descriptive of fashion jewelry because it is "an inclusive term for the overall attire of an individual rather than a reference to a particular item of attire"); In re Pan Tex Hotel Corp., 190

U.S.P.Q. at 110 (finding that POSADA is capable of functioning as a trademark for lodging services even though the translation includes "inn" among other terms). Other cases not involving foreign terms also support Applicant's position. See, e.g., Habitat Design Holdings, Ltd. v. Habitat, Inc., 196 U.S.P.Q. 425 (S.D.N.Y. 1977) (the mark HABITAT not descriptive because it "suggests a variety of goods and services" and "[o]ne could just as easily use the term for a real estate agency as for a manufacturer or retailer of home furnishings"), modified, 200 U.S.P.Q. 10 (2d Cir. 1978); BellSouth Corp., 14 U.S.P.Q.2d at 1556 (finding the mark PHONE FORWARD suggestive rather than descriptive of telephone call diverters); In re Colgate-Palmolive Co., 149 U.S.P.Q. 793 (T.T.A.B. 1966) (the mark HANDI-WIPES suggestive for dusting cloths).

While Applicant concedes that the direct translation of the wording "telefonica gestion de servisios compartidos" is "telephone management of shared services," this translation is not directly descriptive of Applicant's services. The Examining Attorney has submitted evidence in the form of articles which include the phrase "shared services." However, these articles do not indicate a precise meaning for the phrase. Accordingly, the Examining Attorney's evidence fails to show that the term "shared services" describes Applicant's services, namely, business management, insurance agencies and telecommunication services. Given the imprecise nature of the phrase and the fact that the mark TELEFONICA GESTION DE SERVISIOS COMPARTIDOS does not impart any specific information regarding Applicant's goods, the mark is suggestive, and not descriptive, of Applicant's goods.

CONCLUSION

In sum, Applicant submits that the foregoing points and authorities compel the conclusion that Applicant's mark should not be refused registration on the ground that it is merely

descriptive. Therefore, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register under Section 2(e)(1), and promptly pass its mark for publication.

Respectfully submitted,

Perla M. Kuhn
Attorney for Applicant

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CERTIFICATE OF MAILING

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on Dec. 3, 2002

HUGHES HUBBARD & REED LLP

Dated: 12/3/02 By: Cecilia Cabena

Name: CECILIA CABENA