

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77564969
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2009/09/30/20090930161041127558-77564969-001_001/evi_216759226-160800436_.CASTILLO_req_for_reconsideration.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT8\IMAGEOUT8\775\649\77564969\xml1\RFR0002.JPG
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DESCRIPTION OF EVIDENCE FILE	Arguments and list of third party CASTILLO marks
SIGNATURE SECTION	
DECLARATION SIGNATURE	/lea/
SIGNATORY'S NAME	Lawrence E. Abelman
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	09/30/2009
RESPONSE SIGNATURE	/lea/
SIGNATORY'S NAME	Lawrence E. Abelman
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	09/30/2009
AUTHORIZED SIGNATORY	YES

CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Sep 30 16:10:41 EDT 2009
TEAS STAMP	USPTO/RFR-216.75.92.26-20 090930161041127558-775649 69-460f7cdbc1511ccb49b49b a71f20a9322-N/A-N/A-20090 930160800436453

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OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77564969** has been amended as follows:

EVIDENCE

Evidence in the nature of Arguments and list of third party CASTILLO marks has been attached.

Original PDF file:

http://tgate/PDF/RFR/2009/09/30/20090930161041127558-77564969-001_001/evi_216759226-160800436__CASTILLO_req_for_reconsideration.pdf

Converted PDF file(s) (3 pages)

Evidence-1

Evidence-2

Evidence-3

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 244. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark

sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /lea/ Date: 09/30/2009
Signatory's Name: Lawrence E. Abelman
Signatory's Position: Attorney of record

Request for Reconsideration Signature

Signature: /lea/ Date: 09/30/2009
Signatory's Name: Lawrence E. Abelman
Signatory's Position: Attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77564969
Internet Transmission Date: Wed Sep 30 16:10:41 EDT 2009
TEAS Stamp: USPTO/RFR-216.75.92.26-20090930161041127
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0a9322-N/A-N/A-20090930160800436453

Likelihood of Confusion

The Examiner has issued a final refusal to register the subject mark based on a likelihood of confusion with Bacardi's CASTILLO registrations for "rum." Applicant respectfully asserts that, for the reasons set forth below, as well as those set forth in its prior response filed March 20, 2009, there is no likelihood of confusion between the applied for mark and the cited registrations.

The Examiner contends that when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and is normally accorded greater weight in determining likelihood of confusion. Applicant respectfully asserts that the Examiner is overlooking the very essence of this statement, which is that normally the word portion tends to be accorded greater weight, however, *this is not always the case*. As each case involves different word portions, and different design elements, the Examiner's assertion cannot be a rule of law. Rather, the *overall commercial impression* of the marks at issue is the vital determination of whether a likelihood of confusion exists. See *New England Fish Co. v. Herwin Co.*, 184 USPQ 817 (CCPA 1975) (KITTY for cat food and BLUE MOUNTAIN KITTY O's (and design) for cat food not likely to be confused, Court holding that *each case requires a consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark*) [Emphasis added]; *Barre-National, Inc. v. Barr Laboratories, Inc.*, 21 USPQ2d 1755 (DNJ 1991) (BARRE and BARR for pharmaceutical preparations held not confusingly similar based on the differences in spelling and pronunciation). The comparison of composite marks, as involved herein, must be done on a case-by-case basis. See, e.g., *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices).

When Applicant's mark is compared to those of Registrant, it is clearly different. The different number of words, the different words themselves, and the different design elements provides Applicant with a mark that is visually and phonetically distinct from Registrant's marks. Differences in the appearance of parties' respective marks has been found sufficient in and of itself to lessen the significance of similarity in the word portions of the marks. See *M-F-G Corp. v. Emra Corp.*, 228 USPQ 568, 572 (N.D.Ill 1985) (SUPERCUT in block print for haircutting scissors and SUPERCUTS (stylized) for haircutting shops and shampoos held not confusingly similar). According to the TTAB, even a one letter difference between two marks is sufficient to change the commercial impression provided by each. See *In re Conti*, 220 USPQ 745.

Moreover, the Examiner points out that the upper half of Applicant's mark is dominated by the word CASTILLO. Applicant does not contend this, but rather upholds it as support for the fact that *bottom portion of the mark* is dominated by the design element. If half the mark is dominated by the word, and half is dominated by a design, it does not follow that the word portion would be the most dominant element, and therefore, entitled to greater weight. At most, the elements should each be accorded equal weight. In any event, this factor favors Applicant because it points to two equally dominant elements of its mark, as compared to Registrant's mark which is clearly not dominated by the overly simplistic design.

The Examiner expands on the "dominant word" rule, and asserts that a word portion of a mark is more likely to be impressed upon a purchaser's memory. The Court of Appeals for the Federal Circuit has cautioned that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." See TMEP §1207.01(c)(ii); *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement). As stated above, the Examiner himself stated that "normally" a word may be considered more dominant, however normally does not mean "in every instance." Applicant asserts that the Examiner is overlooking the dominance of its design element. This element is especially significant here where numerous third parties use the term CASTILLO in connection with alcoholic beverages. Because of this widespread use, consumers are conditioned to look to other elements to distinguish the marks. Accordingly, the design element of Applicant's mark, which is much more detailed than Registrant's design, will be impressed on the minds of consumers. Since the design element is clearly a dominant portion of Applicant's mark, consumers are likely to notice and remember this feature, thus minimizing any possibility of confusion.

Finally, in response to Applicant's claim that CASTILLO is commonly used in the marketplace in connection with alcoholic beverages, the Examiner maintains that even marks which have been deemed "weak" are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods/services. While this may be true in some cases, it is not the rule here where there are so many differences between the marks which override the common use of CASTILLO. In *In re Broadway Chicken Inc.*, 38 USPQ2d 1565-66 (TTAB 1996), citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), the Board stated:

Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.

See also, Victory Pipe Craftsmen, Inc. v. Faberge, Inc., 223 USPQ 258, 262 (N.D. Ill 1984) (trademarks are also considered weak if they are used on a variety of other products by other companies). Based on this rationale, the fact that both parties' goods include "rum" is not determinative on the likelihood of confusion issue. Applicant conducted a search of the Trademark Office database and found 15 active CASTILLO marks, owned by various parties, for wines (see attached). How is it that these marks, which all contain the identical term CASTILLO, and all cover the identical goods, wines, may co-exist, yet the applied for mark is not allowed to co-exist with the cited registrations? The only answer is that those Examiners accorded less weight to the term CASTILLO, and placed greater weight on the *differing elements* between the respective marks. Likewise, Applicant requests that the Examiner give proper weight to Applicant's design element, as well as the additional word elements, and withdraw the refusal to register.



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Current Search: S3: castillo[bi] and live[ld] and wines[gs] docs: 15 occ: 48

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	79072294		CASTILLO DE VALMADRID	TARR	LIVE
2	79068005		GRAN CASTILLO CABERNET SAUVIGNON MEDIUM SWEET RED WINE	TARR	LIVE
3	79053936		CASTILLO DE GORMAZ	TARR	LIVE
4	79038304	3392174	CASTILLO DE ANNA	TARR	LIVE
5	79006792	3090454	CASTILLO VAREZ	TARR	LIVE
6	78818963	3082531	CASA CASTILLO	TARR	LIVE
7	78722412	3308917	CASTILLO YGAY	TARR	LIVE
8	78604788	3161780	CASTILLO LA BASTIDA	TARR	LIVE
9	78327569	2993249	CASTILLO DE GREDOS	TARR	LIVE
10	78425532	3051735	CASTILLO DE LIRIA	TARR	LIVE
11	78269404	2866786	CASTILLO DE CUZCURRITA	TARR	LIVE
12	77166051	3417140	CASTILLO REAL	TARR	LIVE
13	76088981	2783536	CASTILLO DE LUZON	TARR	LIVE
14	74240690	1745998	CASTILLO DE MOLINA	TARR	LIVE
15	73466409	1349884	CASTILLO DE PERELADA	TARR	LIVE

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