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

Proceeding	88144856
Applicant	California Wineries & Vineyards LLC
Applied for Mark	VIVO
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Signature	/Kayla Jimenez/
Date	01/09/2020

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

In re Application of:
California Wineries & Vineyards LLC
Serial No.: 88144856
Filed: October 5, 2018
Trademark: VIVO

REPLY BRIEF

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Attorney for Applicant

I. INTRODUCTION

Applicant submits this brief in response to the Examining Attorney's Appeal Brief dated December 30, 2019. Applicant maintains that the Examining Attorney erred in refusing to register its mark, **vivō**, based on likelihood of confusion with the mark ROJO VIVO. First and foremost, the marks do not share a similar appearance, connotation or commercial impression. Second, dissecting the Cited Mark, ROJO VIVO, is improper because "rojo vivo" is a phrase that must be taken as a whole. The evidence that Applicant submitted demonstrates that consumers view ROJO VIVO as a phrase meaning "red hot," and therefore will not shorten or abbreviate the Cited Mark to "vivo." Registrant also specifically states in its trademark application that ROJO VIVO means "red hot." Third, the majority of Examining Attorney's argument is based on the faulty presumption that "rojo" is a generic term for a type of wine. Yet "rojo" does not mean "red" when referring to wine in Spanish ("tinto" means "red" for wine), and the evidence the Examining Attorney submits to support his argument does not prove his position. Applicant will address these arguments in detail, below.

II. ARGUMENT

A. **There is No Likelihood of Confusion Because the Marks are not Similar in Appearance, Sound, Connotation, or Commercial Impression**

The first *du Pont* factor asks whether the Applicant's Mark is similar in appearance, sound, meaning, or commercial impression to the Cited Mark.¹ In determining whether a mark is likely to be confused with another, the marks must be viewed in their entirety and not judged by their individual components.² Here, with Applicant's Mark, the use of dashes over the "I" and "O" creates the visual effect of accents. It is *not* the same as "vivo" without any dashes over the vowels. The Cited Mark is also a phrase, ROJO VIVO, rather than a single word. Applicant's Mark is not a phrase, and consists of a single term. Even if consumers dissect or abbreviate the Cited Mark, their focus will be on the first word, "rojo," rather than "vivo." This is because it is

¹ *Du Pont*, 476 F.2d 1357; *See also* TMEP §1208.01(b)-(b)(v); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321 (Fed. Cir. 2014).

² *Rodeo Collection v. West Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986); *Sears Mortgage Corp. v. Northeast Savings F.A.*, 24 U.S.P.Q.2d 1227 (T.T.A.B. 1992); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (C.C.P.A. 1981).

“often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”³

The Examining Attorney’s analysis improperly focuses on the word “vivo” in the Cited Mark, ROJO VIVO. This violates the “anti-dissection rule,” where each component of a mark must be given appropriate weight because marks tend to be perceived in their entirety by consumers.⁴ It is particularly important to view the Cited Mark in its entirety because ROJO VIVO constitutes a complete phrase that means “red hot.”⁵ ROJO VIVO, or “red hot,” is sexual and spicy, and creates an entirely different commercial impression than that of Applicant’s Mark. Consumers will not be confused between each brand when each look so different and carry such different meanings.

The Examining Attorney argues that ROJO VIVO does not mean “red hot,” insisting instead that “rojo” is “a generic term for wine.”⁶ Based on this faulty logic, the Examining Attorney dissects the Cited Mark to place emphasis on the term “vivo.” To support this theory, the Examining Attorney cites to a dictionary translation of “rojo” and four pieces of evidence purporting to prove that third-parties use the term “rojo” generically, for wine. These four examples are:

- Arizona Stronghold Playa Rojo
- Baron Philippe de Rothschild 2000 Escudo Rojo
- Carivin Rojo
- Diablo Rojo

³ See *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895 (T.T.A.B. 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369 (Fed. Cir. 2005) (In the mark VEUVE CLIQUOT, VEUVE is a “prominent feature” because it is the first word in the mark as well as the first word to appear on the wine label.); *Eveready Battery Company, Inc. v. Green Planet, Inc.*, 91 U.S.P.Q.2d 1511, 2009 WL 2176668 (T.T.A.B. 2009) (The word SLICK is first in the accused mark SLICK ULTRA PLUS is evidence that it is the dominant part.).

⁴ “It is well-established that it is improper to dissect a mark, and that marks must be viewed in their entirety. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). See also, TMEP §1207.01(c)(ii); *Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015); *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1368-69 (Fed. Cir. 2012); *Sports Auth. Mich., Inc. v. PC Auth.*, 63 U.S.P.Q.2d 1782, 1792 (TTAB 2002). See also *In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238. (both for calendars with pictures by artist Vargas; “When GIRL is given fair weight, along with VARGAS, confusion with VARGAS becomes less likely.”).

⁵ See Section II.A.3 of Applicant’s Appeal Brief and the Registrant’s own proclamation on its trademark application that the Cited Mark translates to “Red Hot.”

⁶ See Examining Attorney’s Appeal Brief at 2.

A close examination of this third-party evidence reveals that it is insufficient to prove that others view “rojo” as a generic term for red in the context of wine. Specifically, “Arizona Stronghold Playa Rojo” means “Arizona Stronghold Red Beach,” a likely reference to the red sands of Arizona.⁷ It is also noteworthy that the web printout that the Examining Attorney included for “Arizona Stronghold Playa Rojo” actually is for “Arizona Stronghold Playa Rojo Red.” This negates Examining Attorney’s argument that consumers view “rojo” as generic for red, as it makes no sense that the wine would be described as a “red red.” Likewise, Baron Philippe de Rothschild 2000 Escudo Rojo translates to “Baron Philippe de Rothschild 2000 Red Shield,” and Diablo Rojo translates to “Red Devil,” a common idiom.⁸ In short, the evidence the Examining Attorney submitted does not prove that consumers view “rojo” as a generic term for wine.

The Examining Attorney has the burden of proving that a term is generic by clear evidence.⁹ Here, the Examining Attorney has failed to meet the clear evidence-standard, especially since Applicant has put forward evidence to demonstrate that “vino tinto” or “tinto” means red wine in Spanish. The Examining Attorney objected to Applicant’s evidence that “tinto” means red wine in Spanish (as it was attached as Exhibit A to Applicant’s Appeal Brief). However, it is well established that the Board may take judicial notice of the translations and dictionary definitions and therefore consider the evidence.¹⁰ In this case, Applicant’s evidence

⁷ “Playa” translates to beach. See Exhibit 1 to this Reply. Applicant notes that such dictionary evidence is appropriate to consider, as the Board may take judicial notice of definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Foods Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff’d, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ 1066 (TTAB 2011).

⁸ “Escudo” translates to “shield” and “Diablo” translates to “devil.” See Exhibit 1 to this Reply. Applicant notes that such dictionary evidence is appropriate to consider, as the Board may take judicial notice of definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Foods Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff’d, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ 1066 (TTAB 2011).

⁹ See TMEP 1209.01; *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1344 (Fed. Cir. 2014); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987). As the Federal Circuit instructs, “On appeal, we must determine whether the... factual finding is supported by substantial evidence, taking into account the clear evidence-standard. *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302 (Fed.Cir.2009) (“When a fact is required to be found by ‘clear evidence’ and not a mere preponderance, the review for support by substantial evidence must take this heightened burden into account.”); *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085 (Fed.Cir.2000) (“The substantial evidence standard requires the reviewing court to ask whether a reasonable person might find that the evidentiary record supports the agency’s conclusion.”).

¹⁰ See TMEP 710.01; *University of Notre Dame du Lac v. J.C. Gourmet Foods Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff’d, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ 1066 (TTAB 2011); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB2016) (Noting if the definitions were taken from an online dictionary that is also available in printed form, judicial notice may be granted and the evidence may be considered).

came from Cambridge Dictionary and Collins English-Spanish dictionary, both of which are reputable and available in print form.¹¹ Therefore, the Board should consider the evidence demonstrating that “tinto” and “vino tinto” mean red wine. Even if the Board were to reject Applicant’s evidence, the Registrant itself proclaims in its trademark application that “Rojo Vivo” translates to “red hot.” Surely this evidence should be given more weight than the Examining Attorney’s four (misleading) third-party examples and a google-translate printout.¹² In any event, the Examining Attorney’s evidence does not meet the clear-evidence standard to prove “rojo” is generic for wine.

In sum, it is improper to break the phrase ROJO VIVO into pieces, focus on the second word (“vivo”), and use this analysis to assume consumers viewing both marks will be confused between Applicant’s Mark and the Cited Mark. In light of the foregoing, ROJO VIVO and Applicant’s Mark, **VIVŌ**, do not share the same appearance, connotation, or commercial impression. As such, the first *DuPont* factor weighs in favor of Applicant.

B. The Prior Cases Applicant Cites in its Appeal Brief Demonstrate that it is Unlikely Consumers will be Confused Between Applicant’s Mark and the Cited Mark.

In each of the cases Applicant cited in its Appeal Brief, the TTAB found no likelihood of confusion *even though* the marks were identical or nearly identical and offered identical or nearly identical goods. Here, the marks are not identical and carry very different connotations and commercial impressions. While the Examining Attorney states that, “the only cases where the goods were identical involved wording in common that was descriptive or highly suggestive,” this is simply not true. For instance, CROSS-OVER (bras) and CROSSOVER (ladies’ sportswear),¹³ SQUIRETOWN (men’s sport clothes) and TOWN SQUIRES (men’s shoes),¹⁴ and VOLTA (vodka) and TERZA VOLTA (wines)¹⁵ are not descriptive or highly suggestive. Even if the wording in common were descriptive, it does not mean that consumers cannot

¹¹ See Exhibit 2, printouts showing the online versions of Cambridge Dictionary and Collins English-Spanish Dictionary can be purchased in print form.

¹² Applicant notes that the Examiner also submitted evidence from Google Translate that “vivo rojo” translates directly to “red alive.” However, the translation algorithm sometimes does not catch the meaning of idioms in languages and breaks the words apart when compiling translations.

¹³ *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987).

¹⁴ *In re Mavest, Inc.*, 130 U.S.P.Q. 40 (TTAB 1961).

¹⁵ *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009).

distinguish between the two marks based on their significantly different connotations and commercial impressions.

Moreover, the case the Examining Attorney cited to support the position that “applicant’s mark is likely to appear to prospective purchasers as a shortened form of registrant’s mark,” *In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed Cir. 2010), is not applicable to the current case. In *In re Mighty Leaf Tea*, the Board was considering likelihood of confusion between ML and ML MARK LEES. The Board found that consumers would view ML as an abbreviation for the second portion of the mark (Mark Lees), and therefore consumers were likely to believe both tea products came from the same source. Here, Applicant’s Mark, **vivō**, is not an abbreviation of ROJO VIVO. There is also insufficient evidence to prove that the phrase ROJO VIVO (“red alive”) will be shortened by consumers to eliminate the first word of the mark, “rojo.”

III. CONCLUSION

In conclusion, there is no likelihood of confusion between Applicant’s Mark and the Cited Mark. As such, Applicant respectfully asks that the Board allow Applicant’s Mark to proceed to publication.

Respectfully submitted,

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Exhibit 1

See [playa de juegos](#)

4.

- idiom: una playa de algo (Caribbean) (informal) loads of sth (informal)

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Example sentences including **playa**

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El aparato cose a balazos la playa , alrededor de la hormiga.

Rosa Ascón et al Geografía. Vol 2. El territorio mundial: economía, cultura, poder

El solía ir todas las noches a comprar el marisco y las verduras que después vendíamos por la mañana en la playa.

El Mundo del Siglo Veintiuno (1996)

Harán falta más camareros, políglotas a poder ser, guías turísticos, vigilantes de playa , personal hotelero.

El Mundo del Siglo Veintiuno (1996)

La joven, que está descansando en la playa , pretende serle infiel con un colchonero.

El Mundo del Siglo Veintiuno (1996)

La mayor parte proceden de Centroeuropa, y son los que se acercan a la capital antes de acabar en una playa.

El Mundo del Siglo Veintiuno (1996)

La puerta que se abría a la playa estaba cubierta por una cortina de canuelas, bamboleada por la brisa.

Ana María Matute La Virgen de Antioquía y otros cuentos

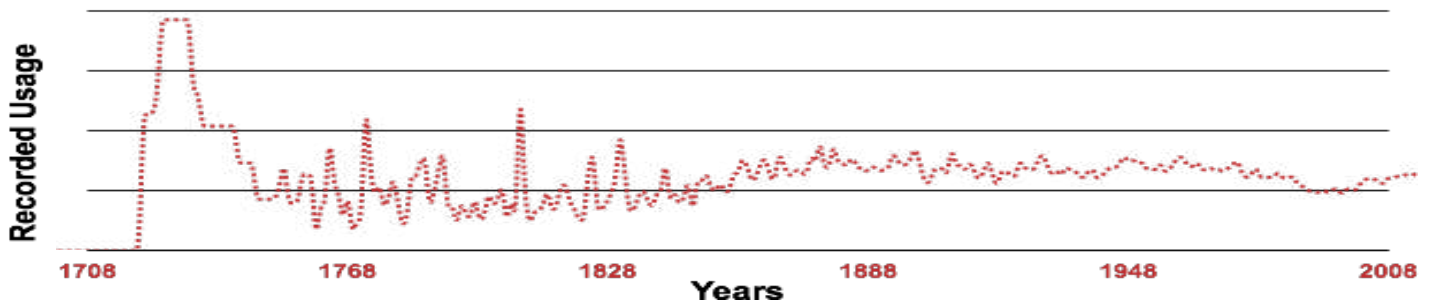
Sobre todo en el verano, cuando bajaban a banarse a la playa , dando gritos debajo del gran sol.

Ana María Matute La Virgen de Antioquía y otros cuentos

1.	ONLINE LANGUAGE TRANSLATOR	>
2.	ITALIAN LANGUAGE LESSONS	>
3.	RECENT DEATH NOTICES	>
4.	SLANG WORD DICTIONARY	>
5.	FRENCH AUDIO COURSE	

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Trends of playa

View usage for: 

In other languages

playa

British English: [beach](#) /bi:tʃ/ NOUNA *beach* is an area of sand or pebbles by the sea.

...a beautiful sandy beach.

- American English: [beach](#)
- Arabic: شاطئ
- Brazilian Portuguese: praia
- Chinese: 海滩
- Croatian: plaža
- Czech: pláž
- Danish: strand
- Dutch: strand
- European Spanish: [playa](#)
- Finnish: hiekkaranta
- French: [plage](#)
- German: [Strand](#)
- Greek: παραλία
- Italian: [spiaggia](#)
- Japanese: 浜辺
- Korean: 바닷가
- Norwegian: strand
- Polish: plaża
- European Portuguese: [praia](#)
- Romanian: plajă
- Russian: пляж
- Latin American Spanish: [playa](#)

- Swedish: strand
- Thai: ชายหาด
- Turkish: kumsal
- Ukrainian: пляж
- Vietnamese: bãi biển

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Nearby words of playa

- [plausible](#)
- [plausiblemente](#)
- [play-off](#)
- playa
- [playa de carga y descarga](#)
- [playa de estacionamiento](#)
- [playa de juegos](#)
-

[All SPANISH words that begin with 'P'](#)

Related terms of playa

- [playo](#)
- [Playa Girón](#)
- [vóley-playa](#)
- [balón de playa](#)
- [bolsa de playa](#)
-

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Source

Translation of **playa** from the [Collins Spanish to English](#)

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Quick word challenge

Quiz Review

Question: 1

-

Score: 0 / 5

me or te?

Drag the correct answer into the box.

me

te

Lola, ¿ acompañas a dar un paseo?

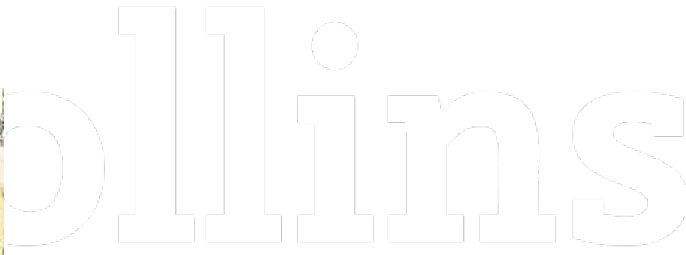
ha or he?

Which version is correct?

[Yo nunca ha vivido en Argentina.](#) [Yo nunca he vivido en Argentina.](#)

fui or iba?

Drag the correct answer into the box.



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escudo Example sentences Trends In other languages

English translation of 'escudo'



Word Frequency

Share

x

escudo

masculine noun

1. [de protección] shield

See [escudo humano](#)

See [escudo térmico](#)

2. (Heraldry)

See [escudo de armas](#)

3. (= moneda) escudo

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Example sentences including escudo

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En el escudo de esa monarquía universal, a lo Carlomagno, sobre campo sinople, la bola de la ruleta y el sable del faraón.

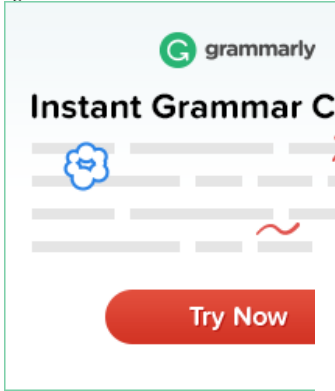
Manuel Azaña Plumas y palabras

P. -- Dígame, por último, qué nombre recibe la corona que remata el escudo de la República Española.

El Mundo del Siglo Veintiuno (1996)

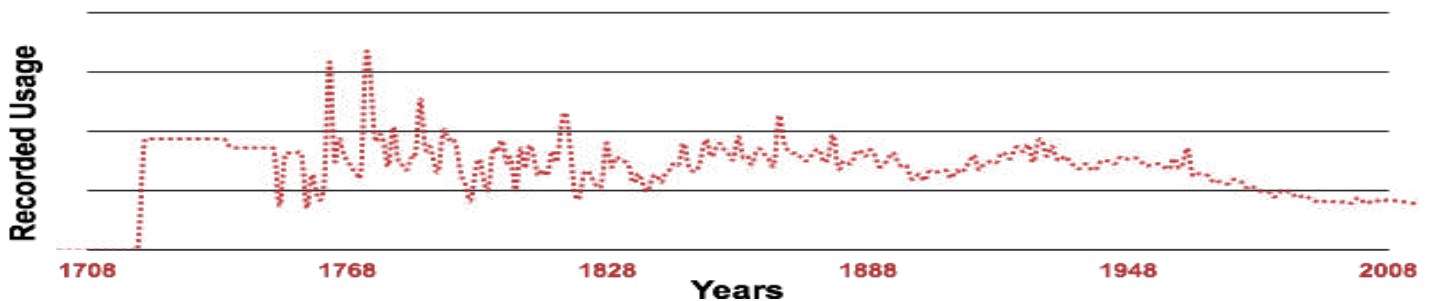
Su Excelencia ocupó una butaca que le habían traído con el escudo de España en el respaldo.

Ignacio Carrión Hernández El milagro



Trends of escudo

View usage for:



In other languages escudo

British English: [shield](#) /ʃi:ld/ NOUN

A *shield* is a large piece of metal or leather which soldiers carried in the past to protect their bodies.

- American English: [shield](#)
- Arabic: نُؤس
- Brazilian Portuguese: escudo

- Chinese: 盾
- Croatian: štít
- Czech: štít
- Danish: skjold
- Dutch: schild
- European Spanish: [escudo](#)
- Finnish: kilpi
- French: [bouclier](#)
- German: [Schild](#)
- Greek: ασπίδα
- Italian: [scudo](#)
- Japanese: 盾
- Korean: 방패
- Norwegian: skjold
- Polish: tarcza
- European Portuguese: [escudo](#)
- Romanian: scut
- Russian: щит
- Latin American Spanish: [escudo](#)
- Swedish: sköld
- Thai: โล่
- Turkish: kalkan
- Ukrainian: щит
- Vietnamese: cái khiên

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Nearby words of escudo

- [escudero](#)
- [escudete](#)
- [escudilla](#)
- escudo
- [escudo de armas](#)
- [escudo humano](#)
- [escudo térmico](#)
-

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Related terms of escudo

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- [escudo humano](#)
- [escudo térmico](#)
- [escudo de armas](#)

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Question: 1

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English translation of 'diablo'



Word Frequency

Share



diablo

masculine noun

1. (= demonio) devil

el diablo tentó a Jesús the Devil tempted Jesus

no le hagas caso, es un pobre diablo don't pay any attention to him, the poor devil

▪ idiom: como un diablo (informal)

esta mesa pesa como un diablo this table weighs a ton (informal)

▪ idiom: del diablo or de mil diablos (informal)

hace un frío del diablo or de mil diablos it's hellishly cold (informal) ♦ it's absolutely freezing

▪ idiom: ¡diablos! or ¡por todos los diablos! (informal) damn it! (very informal) ♦ oh hell! (very informal)

▪ idiom: donde el diablo perdió el poncho (Southern Cone) (informal) in some godforsaken spot (informal) ♦ in the back of beyond (informal)

▪ idiom: irse al diablo (informal)

el proyecto se fue al diablo the project was a miserable failure ♦ the project failed miserably

¡vete al diablo! get lost! (informal)

▪ idiom: mandar al diablo (informal)

no podía arreglarlo y lo mandé al diablo I couldn't fix it so I chucked it the hell away (informal)

se enfadó y nos mandó al diablo he got mad and told us to go to hell (informal)

▪ proverb: más sabe el diablo por viejo que por diablo there's no substitute for experience

See [diablos azules](#)see also [demonio](#)

2. (informal) (como intensificador)

¿cómo diablos se le ocurrió hacer tal cosa? what on earth or what the hell made him do such a thing? (informal)

¿quién diablos te crees que eres? who on earth or who the hell do you think you are?

¡qué diablos! ¡yo también quiero ser rico! damn it, I want to be rich too! (informal)

3. (Southern Cone) (= carro) heavy oxcart

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Example sentences including diablo

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La cuestión es, más bien, cómo prescindir del gas del diablo.

Europarl Parallel Corpus

Para mí, la cuestión no es saber si podemos comprar gas al diablo.

Europarl Parallel Corpus

Pero como el diablo enreda las cosas, es esencial que las condiciones de retorno de los niños sean efectivamente respetadas.

Europarl Parallel Corpus

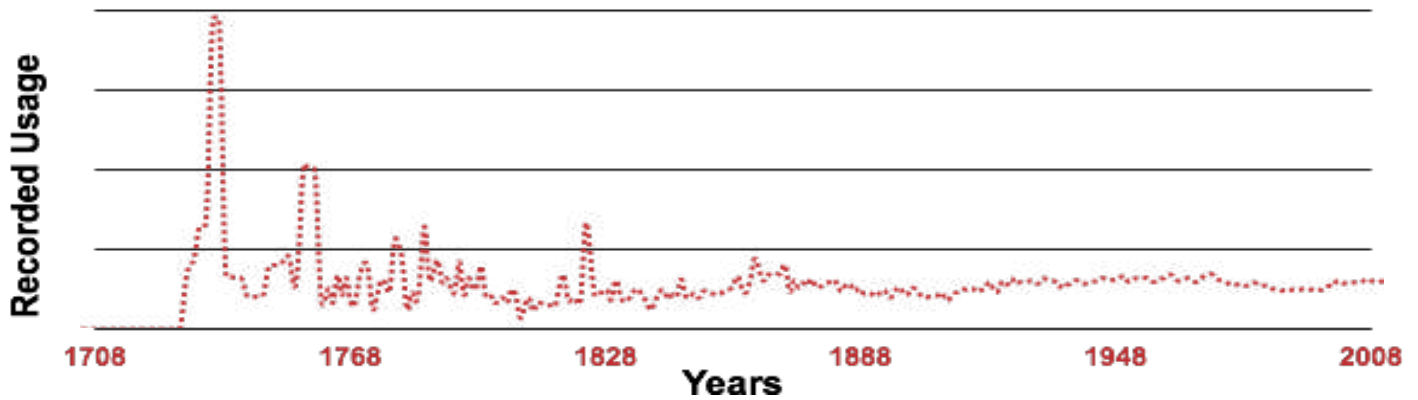
También creo que, en lo que respecta a las granjas, a veces se considera a los inspectores como encarnaciones del diablo que visitan sus granjas.

Europarl Parallel Corpus

1.	ONLINE LANGUAGE TRANSLATOR	>
2.	SYMPTOMS OF LUNG CANCER	>
3.	CHOCOLATE PRETZELS RECIPE	>
4.	KITCHEN CABINET COLORS OF 2020	>
5.	FRENCH AUDIO COURSE	

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Trends of diablo

View usage for: 

Nearby words of diablo

- [diabético](#)
- [diabla](#)
- [diablillo](#)
- diablo
- [diablos azules](#)
- [¡diablos! or ¡por todos los diablos!](#)
- [diablura](#)

• [All SPANISH words that begin with 'D'](#)

Related terms of diablo

- [como un diablo](#)
- [irse al diablo](#)
- [abogado del diablo](#)
- [mandar al diablo](#)
- [caballito del diablo](#)

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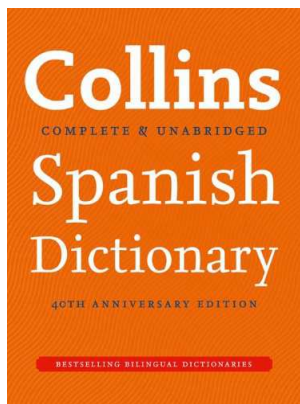
Quick word challenge

Exhibit 2

Items related to Collins Spanish Dictionary

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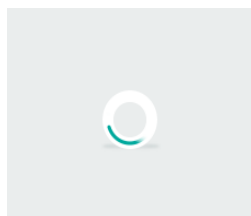
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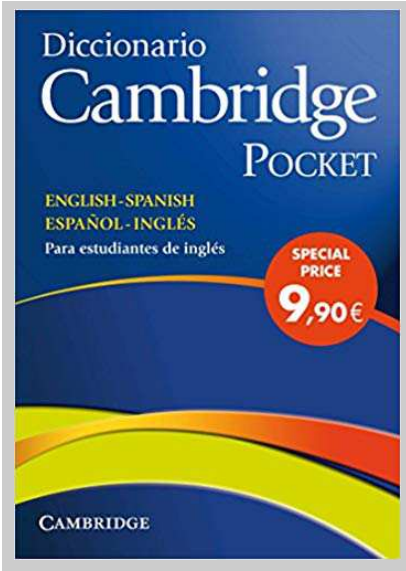
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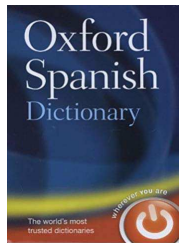
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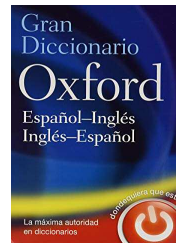
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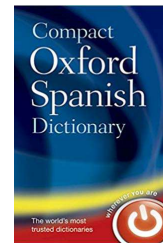
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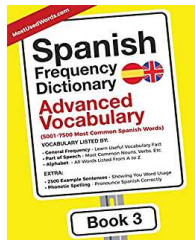


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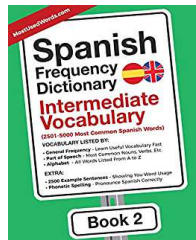
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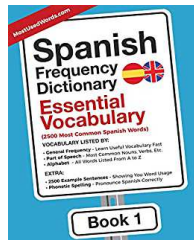
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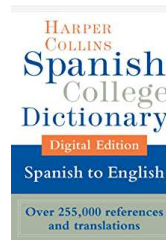
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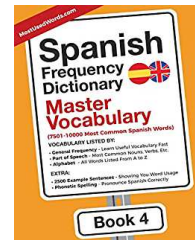
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- Misc. Supplies:** 798 pages
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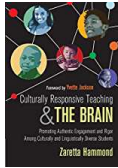


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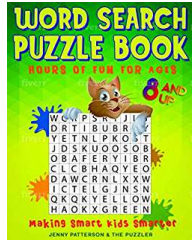


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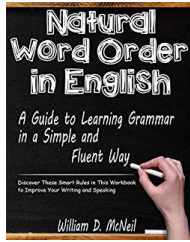
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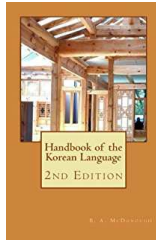
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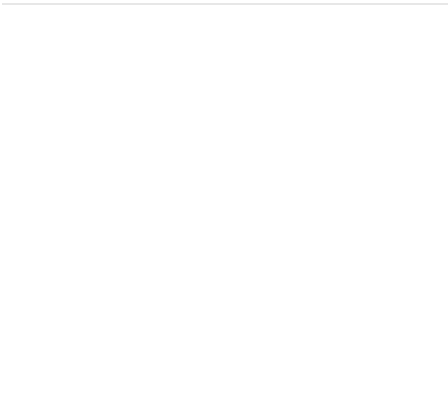
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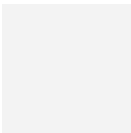
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