

ESTTA Tracking number: **ESTTA541373**

Filing date: **06/03/2013**

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

Proceeding	85390145
Applicant	Manwin Licensing International SÃ rl
Applied for Mark	XTUBE
Correspondence Address	ALEXA L LEWIS MITCHELL SILBERBERG & KNUPP LLP 11377 W OLYMPIC BLVD LOS ANGELES, CA 90064-1625 UNITED STATES all@msk.com, gxb@msk.com, kls@msk.com
Submission	Appeal Brief
Attachments	Appeal Brief (5350153).PDF(90199 bytes)
Filer's Name	Alexa L. Lewis
Filer's e-mail	all@msk.com, kls@msk.com, gxb@msk.com
Signature	/s/ Alexa L. Lewis
Date	06/03/2013

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

In re Application of:)	BRIEF FOR APPELLANT
)	
Manwin Licensing International Sàrl)	Law Office No.: 112
)	(571) 272-8276
Serial No.: 85/390,145)	
)	Trademark Examining Attorney:
Filed: August 4, 2011)	Eli J. Hellman
)	
Classes: 38, 41)	Date: June 3, 2013
)	
Trademark: XTUBE)	
)	
)	

Table of Contents

	Page
I. Introduction.....	1
II. Statement of Facts.....	1
III. Argument.	2
A. Comparison of the Marks.....	2
1. XTUBE Is Different In Appearance From the Cited Registration.	2
2. XTUBE Is Different In Sound From the Cited Registration.	4
3. Appellant’s Mark XTUBE Is Different in Meaning and Connotation From the Cited Registration.	5
IV. Appellant’s Services And the Services Offered In Connection With the Cited Mark Are Not “Identical,” As Contended In The Final Office Action.....	9
V. Conclusion.	10

Table of Authorities

Page(s)

CASES

<i>General Foods Corp. v. Ito Yokado Co.</i> , 219 U.S.P.Q 822 (T.T.A.B 1983)	2
<i>In Re Crosswalk, Inc.</i> , 2007 WL 2344684 (T.T.A.B. 2007)	6
<i>In re Farm Fresh Catfish Co.</i> , 231 U.S.P.Q. 495 (T.T.A.B. 1986)	6
<i>In re Helen Trimarchi and Michael Merr</i> , 2009 WL 4073506 (T.T.A.B. 2009)	2
<i>In re J.M. Originals Inc.</i> , 6 U.S.P.Q.2d 1393 (T.T.A.B 1987)	3
<i>In re Nat’l Data Corp.</i> , 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985)	3
<i>In re Reach Electronics, Inc.</i> , 175 U.S.P.Q. 734 (T.T.A.B. 1972)	3
<i>In re Viterra Inc.</i> , 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012).....	5
<i>J. Wiss & Sons Co. v. Gee Whiz Tool Corp.</i> , 364 F. 2d 910, 150 U.S.P.Q 583 (6th Cir. 1966)	4
<i>Lever Brothers Co. v. Barcolene Co.</i> , 463 F. 2d 1107, 174 U.S.P.Q 392 (C.C.P.A. 1972)	4
<i>Mejia & Assoc. v. International Business Machines Corp.</i> , 920 F. Supp. 540 (S.D.N.Y. 1996)	2
<i>Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.</i> , 856 F.2d 1445 (9th Cir. 1988)	9
<i>Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772</i> , 396 F.3d 1369 U.S.P.Q.2d 1689 (Fed. Cir. 2005)	2, 3
<i>Presto Products Inc. v. Nice-Pak Products, Inc.</i> , 9 U.S.P.Q.2d 1895 (T.T.A.B 1988)	3
<i>Recot, Inc. v. M.C. Becton</i> , 214 F.3d 1322 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000)	2

**Table of Authorities
(continued)**

	Page(s)
<i>Safer, Inc. v. OMS Inv., Inc.</i> , 94 U.S.P.Q.2d 1031 (T.T.A.B. 2010)	4
<i>Shen Mfg. Co. v. Ritz Hotel Ltd.</i> , 393 F.3d 1238, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004)	3
<i>Tektronix, Inc. v. Daktronics, Inc.</i> , 534 F.2d 915, 189 U.S.P.Q. 693 (C.C.P.A. 1976)	3
 STATUTES 	
15 U.S.C. §1052.....	1

I. Introduction.

Appellant, Manwin Licensing International Sàrl (hereinafter “Appellant”), hereby appeals from the Examining Attorney’s refusal to register the mark XTUBE on the grounds of likelihood of confusion. *See* Denial of Request for Reconsideration. Appellant disagrees with the Examining Attorney’s factual and legal conclusions, and respectfully requests that this Board reverse the Examining Attorney’s decision.

II. Statement of Facts.

On August 4, 2011, Appellant filed an application to register XTUBE. Applicant’s associated services are “Video-on-demand transmission services; video broadcasting; electronic, electric, and digital transmission of voice, data, and images, all in the field of adult entertainment” (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” (Class 41).

On November 29, 2011, the Examining Attorney issued an Office Action refusing registration based on Lanham Act Section 2(d), 15 U.S.C. §1052. Appellant filed a response explaining why XTUBE was not barred from registration due to likelihood of confusion, but the Examining Attorney made his refusal final. Appellant requested reconsideration, citing numerous reasons why the Examining Attorney was wrong, but he denied that request.

III. Argument.

The Trademark Examining Attorney has refused registration of Appellant's mark on the grounds that Appellant's mark XTUBE is allegedly confusingly similar to the mark embodied in Reg. No. 3,605,311 for XXXTUBE. Appellant respectfully disagrees.

A. Comparison of the Marks.

In comparing marks, the Trademark Trial and Appeal Board uses the "sound, sight and meaning test" to determine if there is a likelihood of confusion between the marks. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373 U.S.P.Q.2d 1689, 1691 (Fed. Cir. 2005); *In re Helen Trimarchi and Michael Merr*, 2009 WL 4073506 at *3 (T.T.A.B. 2009). When considering the similarity of the marks, "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000). In the instant case, analysis and comparison of Appellant's mark XTUBE with the cited registration illustrates that confusion is not likely.

1. XTUBE Is Different In Appearance From the Cited Registration.

Similarity of appearance between marks is judged by a subjective test. *General Foods Corp. v. Ito Yokado Co.*, 219 U.S.P.Q. 822, 828 (T.T.A.B 1983) (overall impression must be compared "based on what must in the end come down to subjective 'eye ball' reaction.") "[M]arks are not 'similar' for purposes of assessing likelihood of confusion simply because they contain an identical or nearly identical word." *Mejia & Assoc. v. International Business*

Machines Corp., 920 F. Supp. 540 (S.D.N.Y. 1996). Here, there are three critical differences between Appellant's mark and the cited mark.

First, the cited mark contains additional letters at the beginning of the mark that are not contained in Appellant's mark. Even a one-letter difference can sufficiently distinguish two marks. *In re Reach Electronics, Inc.*, 175 U.S.P.Q. 734, 735 (T.T.A.B. 1972) (despite a one-letter difference, no likely confusion between REAC and REACH).

Second, the additional components in the cited mark are the dominant components. This is true for two reasons. As an initial matter, the additional letters are front-loaded in the cited mark. The first portion of a given mark is typically considered to be the most dominant since it is the first element seen by a prospective purchaser. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"); *see also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label). Greater weight should be given to that dominant feature – here, "XXX" – in determining whether there is a likelihood of confusion. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985); *In re J.M. Originals Inc.*, 6 U.S.P.Q.2d 1393 (T.T.A.B 1987); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 U.S.P.Q. 693, 695 (C.C.P.A. 1976).

Moreover, it is notable that the dominant element of the cited mark, "xxx," is a universal abbreviation for pornography (*see, e.g.*, Ex. 1 to Response to Office Action, a printout from www.urbandictionary.com) – whereas the dominant element of Appellant's mark is "tube,"

which is slang for “television.” (*See, e.g.* Ex. 2 to Response to Office Action, a printout from www.dictionary.reference.com.)

Third, while the cited mark contains two elements that appear in the dictionary, *see id.*, Appellant’s mark is a coined mark with no established definition. (*See* Ex. 3 to Response to Office Action.) The marks are, therefore, sufficiently visually distinct. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS are dissimilar); *Safer, Inc. v. OMS Inv., Inc.*, 94 U.S.P.Q.2d 1031, 1044 (T.T.A.B. 2010) (DEER-B-GON for animal repellant held not likely to be confused with DEER AWAY and DEER AWAY PROFESSIONAL for deer repellant).

2. XTUBE Is Different In Sound From the Cited Registration.

With respect to sound, the marks at issue are pronounced very differently. Coined words beginning with “x,” such as “xtreme,” have a common pronunciation. That is, “xtreme” is pronounced “ex-treme.” (*See* Group Ex. 4 to Response to Office Action, instructing on, respectively, the pronunciation of “Xtreme” men’s briefs, and “Xtreme” team-building exercises.) Likewise, Appellant’s mark, XTUBE, is pronounced “ex-tube.” In contrast, “xxx” is pronounced “triple-x.” (*See* Group Ex. 5 to Response to Office Action, regarding the pronunciation of the “.xxx” top level domain; an ASIA album; and a 2002 movie.) Therefore, the cited mark, XXXTUBE is pronounced “triple-x-tube.” They are, therefore, radically different in sound. *J. Wiss & Sons Co. v. Gee Whiz Tool Corp.*, 364 F. 2d 910, 911, 150 U.S.P.Q 583 (6th Cir. 1966) (the mark WIZZ was not considered to be phonetically similar to the mark GEE WHIZ); *Lever Brothers Co. v. Barcolene Co.*, 463 F. 2d 1107, 1109, 174 U.S.P.Q 392 (C.C.P.A. 1972) (the mark ALL was not considered to be confusingly similar to the mark ALL CLEAR).

The Examining Attorney claims that Appellant is incorrect because “there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark The marks in question could clearly be pronounced the same – EX TUBE (three consecutive Xs could be seen as an accentuation of the letter X); such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar.”

Final Office Action at 3. While it is correct that “there is no correct pronunciation of a trademark,” *In re Viterro Inc.*, 101 U.S.P.Q.2d 1905, 1912 (Fed. Cir. 2012), it does not follow that “ex tube” is a realistic possible pronunciation of the mark XXXTUBE, any more than, say, “three-cross-tube.” That is, if the Examining Attorney is correct, and Appellant was applying for THREE CROSS TUBE, the cited mark could be construed to be pronounced in a way to prevent registration thereof. The only truly feasible pronunciations of XXXTUBE are “triple-x-tube,” as set forth in Appellant’s response to the initial Office Action, or, if the three consecutive Xs were seen as an accentuation of the letter X, as postulated in the Final Office Action, “ex-ex-ex-tube.” The latter, of course, would render the cited mark as a four-syllable, staccato word, and thus very different from Appellant’s sibilant, two-syllable mark.

3. Appellant’s Mark XTUBE Is Different in Meaning and Connotation From the Cited Registration.

The cited mark contains the element “xxx,” which as admitted by the Examining Attorney, is a reference to a certain type of pornography. Office Action at 2. On its face, therefore, the cited mark indicates that the services it brands are those associated with that type of pornography. But the Examining Attorney is incorrect that Appellant’s mark conveys a similar commercial impression. Quite the contrary: Appellant’s mark connotes any number of things other than pornography. First, it is part of a trend of recently coined words beginning with

the letter “x,” such as “xtreme” (for men’s briefs, *see* Ex. 4 to Response to Office Action), “xtranormal” (for artistic editing software, *see* Ex. 6 to Response to Office Action), and “xscape” (for a band, *see* Ex. 7 to Response to Office Action), and “xcess” (for a band, and for an insurance broker specializing in entertainment, *see* Group Ex. 8 to Response to Office Action). As such, XTUBE, with its aura of casual slang, primarily connotes that Appellant’s services are hip, exciting, and modern.

Moreover, “x” is an acronym for any number of words, ranging from “kiss” to “extreme” and “extra,” and has a long history of being used as a signifier of an unknown quantity, an abbreviation for the number “10,” and in phrases such as “x marks the spot.” (*See* Exs. 2 – 3 to Req. for Reconsideration.) Even “ex” is commonly used as a modifier, including to indicate that the word that it modifies is in the past, as in “ex-spouse.” (*See* Ex. 1 to Req. for Reconsideration.) “Tube” also has any number of meanings, ranging from a reference to a cylinder to television to a conduit. (*See* Ex. 4 to Req. for Reconsideration.) Therefore, unlike the cited XXXTUBE, Appellant’s XTUBE connotes any number of things other than pornography.

And even if Appellant’s mark conveyed an impression that the mark was being used in connection with pornography – which it does not – the Examining Attorney has admitted that “x” and “xxx” have radically different connotations in connection with pornography, which would set the respective marks apart. (*See, e.g., the L.A. Times* article Exhibit to Final Office Action.) As such, because the parties’ services have entirely different meanings and commercial impressions, Appellant is entitled to registration. *See In Re Crosswalk, Inc.*, 2007 WL 2344684 at *2-3 (T.T.A.B. 2007) (“this is a case where the connotation of the term is deemed to be clearly different as applied to the respective services”); *In re Farm Fresh Catfish Co.*, 231 U.S.P.Q. 495,

496 (T.T.A.B. 1986) (holding that CATFISH BOBBERS and BOBBER not likely to cause confusion).

Appellant's position that there is no likelihood of confusion between its mark and the cited XXXTUBE mark is reinforced by the fact that there is a crowded field. There exist numerous other websites using "xxx" and/or "tube." To illustrate that self-evident point, web searches result in over 26,000 hits for domain names containing "xxx", and over 41,000 hits for domain names containing "tube." (Exs. 9-10 to Response to Office Action.) Representative examples of websites using "tube" (YouTube, GodTube, SchoolTube, MathATube, and TeacherTube) are attached as Exhibit 11 to Response to Office Action; redacted representative examples of those including "xxx" (XXXF*ckerz, FreeXXXVideos, and XXXVideosTube) are attached as Exhibit 12 to Response to Office Action.

Additionally, the United States Patent and Trademark Office has registered the following "xxx" and "tube" marks in connection with adult goods and services:

ULTRAXXPASSWORDS.COM (Reg. No. 2706915); THEXXXSPACE.COM (Reg. No. 3539414); XXX IRON CROSS FTW & Design (Reg. No. 3645878); XXXBLACKBOOK.COM (Reg. No. 4051248); MUSCLEMENXXX (Reg. No. 3144946); ALLREALITYXXXPASS (Reg. No. 3251219); SPYTUBE (Reg. No. 3767086); REDTUBE (Reg. No. 3884412); MOVIE TUBE (Reg. No. 3771383); PORNTUBE (Reg. No. 3936197); SEXTUBE (Reg. No. 3350922); GAYTUBE (Reg. No. 3690953); SMUTTUBE.COM (Reg. No. 3543597); and TUBE4FREE (Reg. No. 3543508.). (Group Ex. 13 to Response to Office Action.)

Indeed, there are numerous registrations for marks that include a combination of the letters X or XXX *and* TUBE. For example:

- U.S. Registration No. 406,632 is for TUBEX in connection with “hypodermic syringes and needles therefor.” It was first used in commerce in 1943, and registered on April 11, 1944.
- U.S. Registration No. 694,827 is for TUBEX in connection with “disposable injection cartridges containing pharmaceutical and diagnostic preparations.” It was first used in commerce in 1943, and registered on March 22, 1960.
- U.S. Registration No. 1,600,876 is for TUBEX in connection with “plastic tree shelters, stakes, and ties in the nature of straps, all for use with saplings and trees.” It was first used in commerce in 1985, and registered on June 12, 1990.
- U.S. Registration No. 2,242,920 is for TUBEX in connection with “metal building materials, namely, foundation piles.” It was first used in commerce in 1971, and registered on May 4, 1999.
- U.S. Registration No. 2,782,127 is for the following mark in connection with “freight transportation through underground tunnels through electro-linear induction propulsion,” first used in 1998, and registered on November 11, 2003:

TUBEX

- U.S. Registration No. 3,225,488 is for XTUBE in connection with “endoscopic system, consisting of endoscopes, dilators, expandable cannulae and expandable retractors, cutting apparatus, trays and application tools and instruments, including C-mount camera assembly, C-mount adapter, C-mount camera head, orientation ring, camera head, focus ring, tubular retractor lock and aspiration

port, deploying and closing instrument, and component parts therefor for use in surgical procedures.” It was first used in commerce in 2003, and registered on April 3, 2007.

(See Group Ex. 5 to Req. for Reconsideration.) All of these uses preceded the cited mark, creating a crowded field.

Accordingly, the owner of the cited mark does not have exclusive rights in the phrase “XXXTUBE.” To the extent that it has any rights, its rights are weak. As the Ninth Circuit has explained:

In a crowded field of similar marks, each member of the crowd is relatively weak in its ability to prevent use by others in the crowd. Simply put, a mark which is hemmed in on all sides by similar marks on similar goods cannot be very distinctive. . . . In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.

Miss World (UK) Ltd. v. Mrs. America Pageants, Inc., 856 F.2d 1445, 1449 (9th Cir. 1988).

IV. Appellant’s Services And the Services Offered In Connection With the Cited Mark Are Not “Identical,” As Contended In The Final Office Action.

The Examining Attorney also errs in his conclusion that the services associated with Appellant’s mark and the cited mark are “identical,” and “the fact that the services are identical further bolsters the argument that consumers will be confused as to the source of the services.” For example, the services associated with the cited mark are “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 contrast, Appellant’s services include

Class 38 video transmission services, which are not encompassed by the cited mark, and its entertainment services also contemplate the provision of images, audio, and text.

V. Conclusion.

For all of the reasons set forth above, and in the record below, Appellant respectfully requests that the Board reverse the Examining Attorney's refusal to register XTUBE.

Respectfully submitted,

/s/ Alexa L. Lewis

Alexa L. Lewis, Esq.
Mitchell, Silberberg & Knupp, LLP
11377 W. Olympic Boulevard
Los Angeles, CA 90064
310-312-2000
Attorneys for Appellant

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a) on June 3, 2013.

/s/ Alexa L. Lewis

Alexa L. Lewis