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Subject: TRADEMARK APPLICATION NO. 76293327 - SHIMMERING  
RAINFORES - N/A

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/293327

**MARK:** SHIMMERING RAINFORES



**CORRESPONDENT ADDRESS:**

PREMA JYOTHI LIGHT  
6834 SOUTH UNIVERSITY BLVD. #176  
CENTENNIAL CO 80122

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Jyothi Light, Prema

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

wintersparkle@starspath.com

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant involved herein has appealed the refusal under TMEP section 807.03 and 37 C.F.R. §2.52(a) and also from 37 C.F.R. §2.72; TMEP §§807.14, 807.14(a) and 807.14(a)(i). The examining attorney refused registration on the grounds that the applicant has presented more than one mark for registration, and because the applicant has filed a proposed material alteration of the original mark in the drawing. These are the only issues for consideration.

**FACTS**

On July 31, 2001 the applicant filed this application for the mark SHIMMERING RAINFOREST CHARACTER COLLECTION along with a surplus subordinate listing

of well over one hundred names of characters that would constitute separate marks. The application provided the following identifications reprinted below:

1. On cartoons and illustrations, in short form on the front, and full form on the back. These include text with visual art.
2. On leaflets and booklets of printed text (sometimes text-only) materials, including stories and poems.
3. On leaflets, brief booklets, storybooks and playbooks for children, which include any or all of the following: paper dolls, coloring book pages, stories, poems, illustrations, games, connect-the-dots, snow-flake-cutting patterns, suggestions for children's activities, and patterns for toys, pillows, and decals for T-shirts, pajamas, and mugs.
4. As advertising and publicity on a flyer by itself, for inclusion with other printed materials.

On June 26, 2002, the examining attorney issued a priority action requiring the applicant to limit the application to a single mark consisting of the wording SHIMMERING RAINFOREST, to disclaim the wording "RAINFOREST," and to correct the identifications. On December 5, 2002, the applicant responded only by requesting an additional two months in which to file a response. On February 14, the examining attorney indicated that the six months response time did not provide for any extensions, issued a final refusal, and invited the applicant to expedite the prosecution by using the examiner's amendment procedure.

On March 6 and 7, 2003, the applicant responded by submitting a new drawing consisting of a material alteration of the mark in the original by adding an additional design element and keeping the over 100 additional marks rather than limiting the application to a single mark; but the applicant did, however, comply with the requirements for deletion of the wording “CHARACTER COLLECTION,” and for a proper disclaimer. The applicant also filed an unacceptable amendment to the identification of goods.

The examining attorney issued a subsequent Office action on August 8, 2003 refusing to accept the proposed drawing that involved a material alteration of the mark that did not agree with the original “mark” on the drawing or on the specimens and that is not permitted under 37 C.F.R. §2.72; TMEP §807.14, 807.14(a) and 807.14(a)(i). The refusal noted the required deletion of the letters “TM” from the new mark that merely constituted a trademark notice and was not an actual portion of the mark. Other points in the refusal noted that some items remained indefinite, that addition of the term “books” to the identification was not permitted under 37 C.F.R. §2.71(a); TMEP §1402.06 and that registration as to “books” was refused as the title of a single creative work under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127; TMEP §1202.08. Lastly, registration was refused because the new drawing still had the issue present regarding the requirement that only one mark be filed per application. TMEP section 807.0:3 and 37 C.F.R. §2.52(a).

On February 7 and 9, 2004, applicant submitted essentially redundant responses in which she deleted the letters “TM” from the proposed drawing, amended the identifications of goods, argued that the term “book” was not outside the scope of the earlier identification, argued that the mark was not the title of a single work with reference to books, and argued that multiple marks were not involved. Applicant also indicated a possible willingness to amend the drawing.

On July 31, 2004, after an extended telephone call fully discussing the issues with the examining attorney regarding this application and applicant’s two companion files with the same issues, the applicant agreed to resolve the remaining issues by examiner’s amendment that the examining attorney issued on that date. The examiner’s amendment involved changing the identifications of goods to comply with Trademark Office requirements and creating a new drawing limiting the mark to the wording SHIMMERING RAINFOREST in its original script format.

On October 1, 2004, applicant filed a change of correspondence address and a response objecting to the examiner’s amendment in application serial numbers 76293326 and 76293327 regarding the drawing issued but agreed to the amended identifications of goods. Applicant did agree to maintain the examiner’s amendment as written, however, for the remaining companion filed, application serial number 76293325, which has now matured to registration.

On January 19, 2005, the examining attorney issued a final refusal because applicant had added a design element that is considered to be a material alteration of the mark in the drawing that is not permitted under 37 C.F.R. §2.72; TMEP §§807.14, 807.14(a) and 807.14(a)(i). The examining attorney also refused registration under TMEP section 807.03 and to 37 C.F.R. §2.52(a) because applicant had submitted more than one mark for registration.

On August 12, 2005, the applicant filed an appeal before the Trademark Trial and Appeal Board. In its letter of August 18, 2005, the Trademark Trial and Appeal Board declined to institute the appeal because it was not timely filed and it also indicated the application stood abandoned. The applicant filed a petition to revive the application on September 23, 2005. On December 29, 2005, the Trademark Office issued a Notice of Deficiency in the petition to revive. On January 26, 2006 the applicant re-filed the appeal. On February 9, 2006, the Trademark Office issued a further Notice of Deficiency and a failure to file the appeal fee. On March 8, 2006, applicant filed the required fees, and the application was revived on March 9, 2006.

On March 24, 2006, the Board instituted the appeal, and the applicant filed her brief on May 30, 2006. On June 13, 2006, the Board required an explanation from the applicant why the brief was filed late, failure of which would result in dismissal of the appeal. On June 28, 2006, the applicant filed a response that the Board accepted. The Trademark Trial and Appeal Board forwarded the appeal to the examining attorney for his brief on August 9, 2006. On August 21, 2006, the applicant filed a request for time to

file various exhibits that the Board granted on August 28, 2006. Applicant filed a further request for time to file various exhibits on February 6, 2007 that the Board granted on February 16, 2007. Applicant filed a further request for time to file various exhibits on February 26, 2007 that the Board granted on February 28, 2007. Applicant filed a further request for time to file various exhibits on April 13, 2007 that the Board granted on April 13, 2007. Applicant filed a further request for time to file various exhibits on May 31, 2007 that the Board granted on June 7, 2007. Applicant filed a change of correspondence address on August 9, 2007. Applicant filed a further request for time to file various exhibits on August 9, 2007 that the Board granted on August 13, 2007. Applicant filed a further request for time to file various exhibits on November 15, 2007 that the Board denied on November 16, 2007; on that date, the Board also forwarded the appeal to the examining attorney. Applicant filed a request for consideration of the Board's denial on November 26, 2007; the Board denied reconsideration on November 28, 2007.

## ARGUMENT

First, before proceeding further, the examining attorney formally objects to any evidence the applicant has either submitted or indicated she intended to submit during the appeal, which may or may not have ever been placed in the file. It is noted that applicant has referenced sending additional specimens that she wished to be accepted on page 9 of her appeal. The examining attorney found no such evidence appearing in the electronic files. However, the examining attorney objects to this and any other evidence the applicant would attempt to introduce after the filing of the appeal whether it be something

she says is already of record, something she would attempt to submit with any reply brief, or which she would attempt to introduce at any oral hearing that she may request, or at any time thereafter.

Secondly, the examining attorney requests that the Trademark Trial and Appeal Board adhere to 37 CFR § 2.142(b)(2) that limits the applicant's brief to twenty-five pages and that states in part: "If an applicant files a brief that exceeds the twenty-five page limit without prior leave of the Board, the brief will not be considered, although the failure to file a conforming brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal". Applicant's brief extends beyond the twenty-five pages prescribed, and the record does not indicate that the applicant has petitioned the Board's prior leave to exceed the limit. As such, the Board is requested to disregard the applicant's brief as required by 37 CFR § 2.142(b)(2).

Concerning the substantive matters under appeal, the actual issues are straightforward notwithstanding applicant's contrary contentions. First, the original drawing showed the wording SHIMMERING RAINFOREST in a very large calligraphy type script with the informational wording CHARACTER COLLECTION below in a much smaller script. This highlighted wording appears in the upper left hand portion of a square and also appears in a sequestered rectangular background. The remaining portion of the square below and to the right of the large wording appears with a list of well over 100 separate characters in a much smaller uppercase type font.

TMEP section 807.03 and 37 C.F.R. §2.52(a) require that the application be limited to a single mark. However, applicant is attempting to obtain protection the proposed “mark” so that she does not have to register each character separately. The arguments that she presents that the individual elements are part of a unitary design similar to the stripes in a flag is specious. The individual names in the list appear in columns not as stripes. They are separated by indentations and display each character name beginning on a separate line. The intent is clear; applicant wants to register well over 100 different names in a single application. One must conclude that the presentation of the matter submitted encompasses a laundry list of names that applicant wishes to register in one fell swoop. The clear intent of TMEP section 807.03 and 37 C.F.R. §2.52(a) is to prevent this. Applicant has taken the situation to one extreme. If her argument were to be granted, the question arises: How many names can someone put on one page? If someone wanted to use a large poster sheet, would it be any less logical to anticipate someone would decide to add another 900 names or so? Clearly the public would not perceive these individual marks without reading through the entire list. Applicant’s argument, if accepted, would be an open invitation for any applicant so inclined simply to list its entire list of trademarks on a single page and seek registration for all at once. This simply makes no sense; everyone intuitively knows it; the statute reflects it. The requirement that one mark be filed per application makes the limit very clear. Anything over one mark per application is at least one too many. However many marks above one mark someone may present in its application makes no difference. One is the limit.

Applicant has also submitted a proposed change in the marks that involves a material alteration. Addition of a radiating design element in the form of a sun, star, or flower is considered to be a material alteration of the mark that is not permitted under 37 C.F.R. §2.72; TMEP §§807.14, 807.14(a) and 807.14(a)(i). The change from a square to the proposed design requires an additional search for references. As such, the change in the mark would require republication if it had been published in the original format. This proposed change was applicant's attempt to move laterally when direct forward movement toward publication was refused. Applicant's argument that a design with a spider's legs, or any similar radiating appendage for that matter, would all be needed as an integral part of the design is without merit because of the material change that is not permitted. This is not a situation where deletion of one of a spider's legs would lead to an incongruous drawing. This is an attempt to transition the character names in the square format referenced with the original proposed "mark" into a radiating design. The purpose of the Trademark Office is to provide parties the opportunity to register marks that they have already used or have a bona fide intent to use in commerce at the time of filing and requires public notice as to what mark is being presented as of the filing date. The purpose of the Office is not to serve as an intellectual property cafeteria for individuals to sample which marks they like best before taking one or more home.

## CONCLUSION

Because the applicant has presented more than one mark for registration, and because the applicant has filed a proposed material alteration of the mark, the Trademark Trial and Appeal Board is requested to affirm the refusal to allow registration under

TMEP section 807.03 and 37 C.F.R. §2.52(a) and also under 37 C.F.R. §2.72; TMEP §§807.14, 807.14(a) and 807.14(a)(i).

Respectfully submitted,

/Paul F. Gast/  
Paul F. Gast  
Trademark Attorney, Law Office 106  
Phone: (571) 272-9163  
Fax: (571) 273- 9106  
Mary I. Sparrow  
Managing Attorney  
Law Office - 106