

**To:** Jyothi Light, Prema ([premajyothilight@shimmeringly.com](mailto:premajyothilight@shimmeringly.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 76293327 - SHIMMERING RAINFOREST CHARACTER - N/A  
**Sent:** 3/9/2013 3:37:07 PM  
**Sent As:** ECOM106@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 76293327

**MARK:** SHIMMERING RAINFOREST CHARACTER

**\*76293327\***

**CORRESPONDENT ADDRESS:**

Prema Jyothi Light  
12000 E. 16th Ave. #301  
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**APPLICANT:** Jyothi Light, Prema

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

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**SUBSEQUENT FINAL OFFICE ACTION**

**ISSUE/MAILING DATE:** 3/9/2013

**This subsequent final Office action responds to applicant's communications filed on January 28, 2013, February 5, 2013 and March 4, 2013.**

**Summary of Outstanding Issues**

1. Trademark Act Sections 1, 2 and 45 Refusal – Applied-For Mark Fails to Function as a Trademark on the Specimens and the Claim of Acquired Distinctiveness is Insufficient
2. Applicant's Three Separate Requests to Amend the Drawing are Not Acceptable Because the Proposed Marks Constitute Material Alterations of the Mark Shown in the Original Drawing

**FINAL REFUSAL - Trademark Act Sections 1, 2 and 45 Refusal - Applied-For Mark Fails to Function as a Trademark on the Specimens and the Claim of Acquired Distinctiveness is Insufficient**

On June 14, 2008, registration was refused because the applied-for mark, as used on the specimens of record, does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987); TMEP §§904.07(b); 1202 *et seq.* The reasons for this outstanding refusal were fully described in the non-final Office action issued on May 26, 2012.

Applicant was previously advised that she may respond to this refusal by submitting a substitute specimen, verified with an affidavit or signed declaration under 37 C.F.R. §2.20, that shows the mark in use in commerce for the goods specified in the application. In response, applicant submitted an unverified substitute specimen on March 4, 2013, which appears to be a printer's proof of a 4-page color leaflet. The substitute specimen fails to overcome the failure to function refusal under Trademark Act Sections 1, 2 and 45 for several reasons.

First, the substitute specimen does not show use of the applied-for mark shown in the original mark drawing filed with the application, which remains the operative mark drawing. Instead, the substitute specimen shows use of applicant's proposed amended drawing of January 28, 2013, which, as explained in the next section, is a material alteration of the original drawing. Therefore, the substitute specimen fails to show use of the original applied-for mark in commerce.

Second, the substitute specimen appears to be a printer's proof of a leaflet, as shown by the printer's lines and the notation "[Center Spread (below)]." Printer's proofs generally are proofs used to preview a document and make any corrections to that document before it goes to press. As such, they are not disseminated to the public and do not show use of the mark in the ordinary course of trade on the actual goods that are sold or transported in commerce. *See In re The Signal Cos.*, 228 USPQ 956, 957-58 n.4 (TTAB 1986); TMEP §§904.04(a), 904.07(a).

Third, applicant has not verified that the substitute specimen was in use in commerce at least as early as the filing date of the application. The copyright information displayed directly on each portion of the substitute specimen indicates that the material was copyrighted as of 2004. Given that the instant application was filed on July 31, 2001, at least two and a half years prior to the copyright date, there is a question as to whether the specimen was actually in use in commerce as of the application filing date.

Finally, this amended version of the "mark" is used on the back cover of a leaflet similar to the manner in which the applied-for mark is used on other specimens already in the record. As is the case with applicant's other specimens, consumers will perceive the "mark" only as a list of fictional characters to which applicant's leaflets pertain and not as a source indicator for the leaflets themselves. The statement below the "mark" on the leaflet, which advises consumers to "Be sure to look for this unique Shimmering Rainforest Trademark, above," is of no moment. Consumers that read this statement are likely to perceive applicant's reference to the "Trademark" as referring to the actual "Shimmering Rainforest" wording that is referenced in the statement and shown in the "mark" in a larger, stylized font directly next to a "TM" symbol. However, they are unlikely to view the entire list of characters shown as being the referenced "Trademark." As explained in the May 26, 2012 Office action, the presentation of the mark in columnar form with a larger "heading" is a common manner of presenting information but is

not a common manner for displaying a trademark. In addition, the long length of the applied-for mark, at approximately 577 words, indicates that it is less likely to be perceived as a trademark than a mark comprised of significantly fewer words. *See* McCarthy on Trademarks and Unfair Competition, §6.17.50 (4th edition, 2012).

#### Applicant's Claim of Acquired Distinctiveness under Trademark Act Section 2(f)

Applicant argues, in the alternative, that applicant's mark has acquired distinctiveness based upon her verified claim that the mark has been in "substantially exclusive and continuous use in commerce, for several years preceding her original application in 2001, through to the present day." Applicant's January 28, 2013 response at pages 8-9. This verified statement is noted. However, as explained in the May 26, 2012 Office action, length of use alone does not demonstrate that the applied-for mark, which is merely an informational list of characters, has come to be perceived as a trademark. Because the failure to function refusal is predicated on the manner in which the applied-for mark is used on the specimens, concrete evidence that the proposed mark is perceived as a mark for the relevant goods is required to establish distinctiveness. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). This evidence must demonstrate that the purchasing public has come to identify the applied-for mark with the source of the goods.

In this case, applicant's substitute specimen does not demonstrate that the applied-for mark is used in commerce as a trademark, for the reasons described above. Applicant has not submitted any other evidence demonstrating that the applied-for mark is perceived as a source indicator for the goods. Therefore, applicant's claim of acquired distinctiveness is insufficient and fails to obviate the refusal under Trademark Act Sections 1, 2 and 45.

Accordingly, the refusal to register because the applied-for mark, as used on the specimens of record, does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods is **FINAL**. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; 37 C.F.R. §2.64(a).

#### **FINAL REFUSAL - Applicant's Three Separate Requests to Amend the Drawing are Not Acceptable Because the Proposed Marks Constitute Material Alterations of the Mark Shown in the Original Drawing**

In the Office action issued on May 26, 2012, applicant was advised that two separate requests by applicant to amend the drawing, one on March 6, 2003 and one on December 16, 2008, were not acceptable because they constituted material alterations of the original mark drawing filed with the application. An amendment to a mark will not be accepted if the change would materially alter the mark in the initial application. 37 C.F.R. §2.72; *In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211 (TTAB 2000) (holding proposed amendment of TACILESENSE to TACTILESENSE to be material alteration); *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999) (holding proposed amendment of TURBO and design to typed word TURBO to be material alteration); TMEP §807.14. Therefore, applicant was required to either (a) argue in favor of one of the proposed amended drawings or (b) request that the proposed amended drawings be withdrawn. *See* TMEP §§714.05(a), 807.17.

In response to this requirement, applicant instead chose to submit a third amended drawing (shown on page 6 of applicant's January 28, 2013 response at TICRS page 12). This third amended drawing is unacceptable and fails to resolve the outstanding issue concerning the mark drawing because it is also a

material alteration of the original drawing filed with the application.

Specifically, this newly proposed amended drawing contains design elements not present in the original drawing filed with the application. These design elements include numerous white stars and yellow rays of light. These elements would have required a search of additional design codes, such as 01.01.12 (more than one star with four points) and 01.15.25 (light rays). In addition, applicant has changed many of literal elements in the mark<sup>[1]</sup>, including

(a) changing the spelling of fanciful terms (*e.g.*, changing QUIZZLE-KOOS to QUIZZLE-QUOOS), and

(b) the deletion of wording and the addition of new wording (*e.g.*, deleting an entry for GLORIOUS GLORIETTA GLISSANDO and replacing it with a new entry for ADORIOUS ADORIETTA GLISSANDO), and

Such changes significantly alter the appearance, sound and connotation of the mark. In addition, these proposed changes would require an additional search because applicant has added new terms and/or changed the spelling of old terms. As a general rule, the addition of any element that would require a further search will constitute a material alteration. *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986); TMEP §807.14. Deletion of matter from the mark can also result in a material alteration. *See In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm'r Pats. 1993); TMEP §807.14(a).

Accordingly, the proposed amended drawing submitted on January 28, 2013 has not been entered and thus, the previously acceptable drawing of the mark (the Original Columnar Drawing filed with the application) will remain operative. TMEP §807.17.

Finally, applicant is advised that the proposed amended drawing submitted on January 28, 2013 does *not* create a new issue because the acceptability of proposed amendments to the drawing was already at issue. *See* TMEP §714.05(a). Please also see the August 8, 2011 Remand Order of the Trademark Trial and Appeal Board at page 3, which states, in relevant part, “the acceptability of the drawing has been an issue throughout prosecution of the application and, indeed, was an issue in the original appeal. Subsequently filed proposed amendments to the drawing in such a circumstance do not raise a new issue.”

Therefore, the refusal to register because applicant’s proposed amendments to the mark drawing consist of material alterations of the mark drawing set forth in the original application is **FINAL**. 37 C.F.R. §§2.64(a), 2.72; TMEP §807.14.

#### **ADVISORY – Correction of USPTO’s Typographical Errors**

The applicant’s response at pages 13-17 contains a list of typographical errors that appeared in the “literal element” field of the USPTO’s electronic record concerning the original mark drawing. The examining attorney thanks the applicant for bringing these typographical errors to the Office’s attention. The examining attorney has made corrections pursuant to the list of “USPTO Typographical Errors” supplied by applicant, after comparing applicant’s proposed corrections with the literal elements shown in the original mark drawing.

Applicant also observes that in the literal element field “the character names are all run together” and requests that “[e]ach character name should be shown flush left, which is as these appear in the

Trademark.” Unfortunately, applicant’s request cannot be accommodated. Applicant is advised that the purpose of the literal element field is merely to set forth the literal elements featured in the mark, without regard to the manner of the display on the mark drawing. Moreover, due to the excessive number of characters in the mark, it is simply not possible to display each character name on a separate line in the “literal element” field. Finally, applicant is advised that the original mark drawing, not the literal element field, controls for purposes of determining what constitutes the applied-for mark. *See* TMEP §807.01.

### **Application Will be Returned to the TTAB**

As noted in the Board’s August 8, 2011 Remand Order, this application will now be returned to the Board for resumption of action on the appeal. <sup>[2]</sup>

**If applicant has any questions about this subsequent final Office action, please contact the undersigned examining attorney.**

/Linda Lavache/  
Trademark Examining Attorney  
Law Office 106  
p. 571.272.7187  
f. 571.273.9106

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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<sup>[1]</sup> Applicant indicates on page 17 of her January 28, 2013 response that these changes are now requested as a result of “typographical errors by typists for Applicant Light.” It is incumbent upon the applicant to ensure the accuracy the mark drawing at the time the application is filed because the matter shown on the drawing controls for purposes of determining the mark. *See* TMEP §807.01. The fact that applicant is characterizing the proposed changes to literal elements on the original drawing as “corrections of typographical errors” by persons applicant employed to create the drawing does not obviate the fact that the proposed amendments materially change the commercial impression of the original drawing that was filed with the application. *See, e.g., In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211 (TTAB 2000) (holding proposed amendment of TACILESENSE to TACTILESENSE to be material alteration).

<sup>[2]</sup> Page 5 of the Order indicates that if applicant’s response to the examining attorney’s non-final Office action “is not found persuasive, the examining attorney should issue a final Office action which omits the six-month-response clause,

and return the file to the Board, which will then resume proceedings in the consolidated appeal.”

**To:** Jyothi Light, Prema ([premajyothilight@shimmeringly.com](mailto:premajyothilight@shimmeringly.com))  
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON **3/9/2013** FOR U.S. APPLICATION SERIAL NO. 76293327

Your trademark application has been reviewed. The trademark examining attorney assigned by the USPTO to your application has written an official letter to which you must respond. Please follow these steps:

(1) **READ THE LETTER** by clicking on this [link](#) or going to <http://tsdr.uspto.gov/>, entering your U.S. application serial number, and clicking on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) **RESPOND WITHIN 6 MONTHS** (*or sooner if specified in the Office action*), calculated from **3/9/2013**, using the Trademark Electronic Application System (TEAS) response form located at [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp).

**Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response** because the USPTO does NOT accept e-mails as responses to Office actions.

(3) **QUESTIONS** about the contents of the Office action itself should be directed to the trademark examining attorney who reviewed your application, identified below.

/Linda Lavache/  
Trademark Examining Attorney  
Law Office 106  
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## **WARNING**

**Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application.** For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

**PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION:** Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

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