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14009.1

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77595225

MARK: BIG EFFIN GARAGE



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: BIG EFFIN GARAGE, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

14009.1

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EXAMINING ATTORNEY'S APPEAL BRIEF

BIG EFFIN GARAGE, LLC (hereinafter referred to as "Applicant") has appealed the examining attorney's final refusal to register the proposed mark, BIG EFFIN GARAGE. The application was refused on the grounds that the proposed mark is scandalous within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. Section 1052(a). The trademark examining attorney respectfully requests that the Board affirm this refusal.

STATEMENT OF FACTS

On October 17, 2008, Applicant applied to register the mark BIG EFFIN GARAGE for services identified as "entertainment services, namely, providing a website where registered visitors can listen to music and find out information about musicians and musical groups, including demo materials, and reviews and recommendations generated by an online community of musicians and music fans" and "hosting an online

community for musicians and music fans featuring information about music, musicians and musical groups; Computer services, namely, creating an online community for registered musicians and music fans to upload, download, or mix music tracks, showcase their skills, get feedback from peers, form virtual groups, play music together, and engage in social and professional networking.” It also disclaimed the wording BIG EFFIN. In the first Office Action dated January 26, 2009, the Examining Attorney refused registration under Section 2(a) of the Trademark Act arguing that the mark is scandalous and immoral, required applicant to withdraw the disclaimer and amend the identification of services.

In its response filed May 7, 2009, Applicant presented arguments that the mark is not scandalous because it is the euphemism of the cuss word fucking, amended its identification of services, withdrew the voluntary disclaimer and amended the identification of services. On June 23, 2009, the Examining Attorney issued a final refusal under Section 2(a) and of the identification requirement.

On January 20, 2010, upon failing to respond to the final refusal, a notice of abandonment was mailed, abandoning Applicant’s application. On February 22, 2010, applicant filed a Petition to Revive together with a notice of appeal. The Board acknowledged the appeal and applicant filed its brief on April 21, 2010. The appeal brief addressed the Section 2(a) refusal but failed to address the identification requirement. On April 21, 2010, jurisdiction was restored to the Examining Attorney.

ISSUES ON APPEAL

First, whether applicant's mark, BIG EFFIN GARAGE for "entertainment services, namely, providing a website where registered visitors can listen to music and find out information about musicians and musical groups, including demo materials, and reviews and recommendations generated by an online community of musicians and music fans" and "hosting an online community for musicians and music fans featuring information about music, musicians and musical groups; Computer services, namely, creating an online community for registered musicians and music fans to upload, download, or mix music tracks, showcase their skills, get feedback from peers, form virtual groups, play music together, and engage in social and professional networking" is scandalous and immoral. Second, whether the applicant's identification as amended is beyond the scope as originally filed.

ARGUMENTS

A. THE APPLICANT'S MARK IS SCANDALOUS AND IMMORAL UNDER SECTION 2(a) OF THE TRADEMARK ACT

The applicant's proposed mark BIG EFFIN GARAGE is scandalous and immoral under Section 2(a) of the Trademark Act. A substantial composite of the American public considers the term "EFFIN" vulgar. The term "effin" is the vulgar-equivalent of "fucking" and limited to nothing else but its vulgar meaning and is used to denote the same meaning.

Section 2(a) of the Trademark Act, 15 U.S.C. §1052 (a) states:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its

nature unless it--consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;

The Federal Circuit has determined that showing a word is vulgar is sufficient to meet the scandalous and immoral requirements under Section 2(a). In *In re Boulevard Entertainment, Inc.*,

334 F.3d at 1336, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003), the Federal Circuit determined:

that to justify refusing to register a Trademark under the first clause of section 1052(a), the PTO must show that the mark consists of or comprises “immoral, deceptive, or scandalous matter.” *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). A showing that a mark is vulgar is sufficient to establish that it “consists of or comprises immoral ... or scandalous matter” within the meaning of section 1052(a). *See id.* At 1371-74 (analyzing a mark in terms of “vulgarity”); *In re McGinley*, 660 F. 2d 481, 485 (CCPA 1981) (quoting with approval *In re Runsdorf*, 171 USPQ 443, 443-44 (TTAB 1971), which refused registration of a mark on grounds of vulgarity). In meeting its burden, the PTO must consider the mark in the context of the marketplace as applied to the goods described in the application for registration. *McGinley*, 660 F.2d at 485. In addition, whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes, *id.*, keeping in mind changes in social mores and sensitivities. *Mavety*, 33 F.3d at 1371.

Although the words “immoral” and “scandalous” may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter. *See In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 672 n.6 (C.C.P.A. 1981), *aff’g* 206 USPQ 753 (TTAB 1979) (“Because of our holding, *infra*, that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”) TMEP §1203.01. The statutory language “scandalous” has also been considered to encompass matter that is “vulgar,” defined as

“lacking in taste, indelicate, morally crude.” *In re Runsdorf*, 171 USPQ 443, 444 (TTAB 1971) see also TMEP §1203.01.

Under Section 2(a), to be considered “scandalous,” a mark must be “shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; ... giving offense to the conscience or moral feelings; ... [or] calling out for condemnation.” See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). Whether a term is scandalous is determined from the standpoint of “*not necessarily a majority, but a substantial composite of the general public, and in the context of contemporary attitudes.*” *Id.*

In support of this refusal, the Examiner’s first Office Action included a definition of “effin” from the UrbanDictionary.com to prove that the term is vulgar and is commonly used in place of “fucking.” The UrbanDictionary.com defined the term as “a derivative of fucking.” (See pages 3 to 4 of the Urban Dictionary excerpts submitted with the initial Office action on January 26, 2009.) According to Applicant, the term “effin” as defined by the UrbanDictionary.com on its own is not vulgar. However, the same dictionary refers to the term as “the new cuss word that begins with an e” and “the edited version of the word “fucking.” Taken as a whole, the applied-for mark EFFIN means “fucking” and is thus scandalous because the term is the equivalent of the scandalous term “fucking.”

Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, **where multiple dictionaries**, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant’s use of

the word is limited to the vulgar meaning of the word. *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (1-800-JACK-OFF and JACK OFF held scandalous, where all dictionary definitions of “jack-off” were considered vulgar); *Red Bull, supra* (multiple dictionary definitions indicating BULLSHIT is “obscene,” “vulgar,” “usually vulgar,” “vulgar slang,” or “rude slang” constitute a prime facie showing that the term is offensive to the conscience of a substantial composite of the general public).

In addition, the examiner’s Final refusal included excerpts from various websites showing that use of the wording “effin” generally refers to the vulgar wording “fucking.” Therefore, contrary to applicant’s argument, there is no evidence that the term “effin” is considered polite by the American public. The substitution of the term “effin” in place of “fucking” does not change the vulgar connotation. Although it may be a different way of saying “fucking,” it has the same connotation and meaning. The applicant submitted a definition from the online dictionary Dictionary.com which defined the wording “effin” as “euphemism for fucking.” (See page 5 of Applicant’s brief, May 7, 2009.) However, the same dictionary, defines the term as follows:

“effing” definition and F-ing mod.

fucking. (Usually objectionable.) : What an effing stupid idea!, Who is that F-ing idiot.” (See attached dictionary definition from the online Dictionary.com).

The online Urban Dictionary evidence attached, defines the term as follows:

“How to say the word “fucking” in front of young children, so they don't echo your potty mouth.”

“A common way of spelling the term “[fuck](#)” on a web page, message board, etc. with a obscenity-[censor](#)ing program.”

See also evidence showing use of the wording “effin” in a vulgar manner. Specifically, (see evidence from the Internet Slang Dictionary definition of the term (on Page 25 of the June 23, 2009 Final Office action as well as the articles on Pages 6 through 24 of the June 23, 2009 Final Office action.)

There is, therefore, no alternative non-scandalous meaning for the term “effin.” It means “fucking” which is vulgar.

The more egregious the allegedly scandalous nature of a mark, the less evidence is required to support a conclusion that a substantial composite of the general public would find the mark scandalous. See *In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996) (finding that “the inclusion in a mark of a readily recognizable representation of genitalia certainly pushes the mark a substantial distance along the continuum from marks that are relatively innocuous to those that are most egregious”); TMEP §1203.01.

For example, in, *Boston Red Sox Baseball Club Limited Partnership v. Brad Francis Sherman*, Opposition No. 91172268 (September 9, 2008) [precedent], sustaining the Red Sox Club's opposition to proposed mark SEX ROD in the stylized form for clothing items (including infant wear, baby bibs, and girdles), the Board found that the mark was both scandalous and disparaging under Section 2(a). The Opposer, the Club, submitted that the slang usage of the term “rod” was vulgar because it referred to the male “penis.” Brad Francis Sherman argued that the mark “represented the at once clever yet sophomoric sense of humor that prevails in those venues in which apparel bearing the SEX ROD stylized mark would likely be worn, e.g., ball parks, sports bars and university

campuses.” Id. The TTAB determined “even assuming for the sake of argument that ‘SEX ROD’ is a parody of the opposer’s ‘RED SOX’ marks, as applicant asserts - there is nothing in the parody itself which changes or detracts from the vulgar meaning inherent in the term. In other words, the parody, to the extent there is one, is itself vulgar.” Id. Here, as in the SEX ROD case, there is nothing in the context of the Applicant’s use of the term “effin” which changes or detracts from the vulgar meaning inherent in the term. The slang version of the term “fucking” or its euphemism is no less vulgar than the term “fucking” itself. The very need to use its watered down version confirms that the term is vulgar and the American public perceives it as such.

CONCLUSION

For the foregoing reasons, refusal on the grounds that the proposed mark is scandalous and immoral within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. Section 1052(a) should be upheld. The trademark examining attorney respectfully requests that the Board affirm this refusal.

IDENTIFICATION OF SERVICES

The services in Class 42 is accepted and made of record. Applicant failed to address the identification of services in the brief. As indicated in the Final Office action, the proposed amendment to the identification of services in class 41 is beyond the scope as originally filed. In the application as originally filed, applicant identified the services as “entertainment services, namely offering an online community for musicians and music fans, allowing registered users to upload, download, or mix music tracks, showcase their skills, get feedback from peers, form virtual groups, play

music together, and engage in social and professional networking.” the current identification now identifies the services as “entertainment services, namely, providing a website where registered visitors can listen to music and find out information about musicians and musical groups, including demo materials, and reviews and recommendations generated by an online community of musicians and music fans.” The services are different; therefore, the amendment is unacceptable. See TMEP §1402.01.

Applicant may adopt the following identification, if accurate: “Hosting an online community for musicians and music fans featuring _____ [indicate subject matter or purpose]; Computer services, namely creating an online community for registered musicians and music fans to upload, download, or mix music tracks, showcase their skills, get feedback from peers, form virtual groups, play music together, and engage in social and professional networking,” in International Class 42.

Identifications of services can be amended only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 c.f.r. §2.71(a); see tmepp §§1402.06 et seq., 1402.07. Therefore, applicant may not amend the identification to include services that are not within the scope of the services set forth in the present identification.

Respectfully submitted,

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