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Subject: U.S. TRADEMARK APPLICATION NO. 78095659 - SQRAT - N/A - SU - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 5

Files: merchandis-1.jpg, merchandis-2.jpg, merchandis-3.jpg, merchandis-4.jpg, 78095659.doc

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

**U.S. APPLICATION SERIAL NO.** 78095659

**MARK:** SQRAT



**CORRESPONDENT ADDRESS:**

DAVID A EINHORN

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NEW YORK, NY 10111-0230

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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**APPLICANT:** Silberstein, Ivy

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

bhipdocket@bakerlaw.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 10/15/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated March

26, 2015 are maintained and continue to be final: failure to function as a mark and requirement for a new specimen. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

#### **REFUSAL – FAILURE TO FUNCTION AS A MARK**

Registration is refused because the applied-for mark, as used on the substitute specimen of record, does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; see *In re Moody's Investors Serv., Inc.*, 13 USPQ2d 2043 (TTAB 1989); *In re The Signal Cos.*, 228 USPQ 956 (TTAB 1986); *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984); TMEP §§904.07(b), 1301.02 *et seq.*

Applicant has applied to register the mark SQRAT for “merchandising of movies and television programs.” “Merchandising” is defined as “the activity of trying to sell goods or services by advertising them or displaying them attractively” and “the activity of selling products that are related to something (such as a television show, movie, or sports team) in order to make more money.” See attached dictionary evidence.

The applied-for mark, as shown on the substitute specimen, does not function as a service mark because it does not function as a source identifier or service mark. Here, the mark merely appears in the upper right corner of the specimen without any reference to applicant's merchandising of television programs and movies services. There is no promotion of, or nexus with, applicant's merchandising of television programs and movies; thus consumers would not perceive the mark as a source identifier for the applicant or for the services applicant provides.

The previous specimen submitted in applicant's May 5, 2014 correspondence consists of a jingle. Here, the mark is used as a character in the jingle and not as a source identifier, or advertising for, applicant's merchandising services.

The specimen of record, along with any other relevant evidence of record, is reviewed to determine whether an applied-for mark is being used as a service mark. *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998). Not every word, design, symbol or slogan used in the advertising or performance of services functions as a mark, even though it may have been adopted with the intent to do so. See TMEP §1301.02. A designation cannot be registered unless purchasers would be likely to regard it as a source-indicator for the services. *Id.*; see *In re Moody's Investors Serv. Inc.*, 13 USPQ2d 2043, 2047-49 (TTAB 1989).

Based on the foregoing, the final refusal for failure to function as a mark is maintained.

#### **SUBSTITUTE SPECIMEN UNACCEPTABLE**

The refusal to register the mark is maintained because the substitute specimen in International Class 35 does not show a direct association between the applied-for mark and the identified services; thus the specimen fails to show the applied-for mark in use in commerce for each international class. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(f)(ii), (g)(i).

In response to the final action, applicant submitted a substitute specimen showing the intended mark SQRAT in the upper right corner of a webpage. The substitute specimen is unacceptable because it does not show use of the mark in connection with applicant's services. Specifically, no nexus is shown between the mark and applicant's services. The term SQRAT is merely shown adjacent to the wording "IVY SUPERSONIC" and "READ ABOUT SUPERSONIC vs 20<sup>th</sup> CENTURY FOX" and is not used in relation applicant's merchandising of television program and movie services.

While the exact nature of the services does not need to be specified in the specimen, there must be something which creates in the mind of the purchaser an association between the mark and the service. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)); see *In re Osmotica Holdings, Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

Based on the foregoing, the final requirement with respect to the specimen is maintained.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Michele-Lynn Swain/

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merchandising

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the activity of trying to sell goods or services by advertising them or displaying them attractively

the activity of selling products that are related to something (such as a television show, movie, or sports team) in order to make more money

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**Full Definition of MERCHANDISING**  
 : sales promotion as a comprehensive function including market research, development of new products, coordination of manufacture and marketing, and effective advertising and selling

See merchandising defined for English-language learners

**Variants of MERCHANDISING**  
merchandising also merchandizing ↔

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OCTOBER 14, 2015

affluent ↔

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Examples of MERCHANDISING

- She is the company's director of merchandising.
- The film made a lot of money thanks to strong merchandising.
- Most of the movie's earnings came from merchandising and not ticket sales.

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First Known Use of MERCHANDISING

1917

Other Business Terms

amortize, caveat emptor, clearinghouse, divest, due diligence, emolument, green-collar, marquee, overhead, perquisite

Rhymes with MERCHANDISING

advertising, agonizing, appetizing, enterprising, unsurprising

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**merchandise**

Next Word in the Dictionary: merchant  
(noun)  
Previous Word in the Dictionary: merchandise  
All Words Near: merchandising

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What made you want to look up merchandising? Please tell us where you read or heard it (including the quote, if possible).

17 Comments Sort by **Newest**



 **Sunday Fredrick Ayo Ibazebo** - Founder at Places and Faces Africa Magazine  
Yea being old as man itself, the forbidden fruit was merchandised by devil to eve and you see how fast it was bought and still selling. God have mercy  
Like · Reply · Jul 11, 2014 9:50am

 **Zaid Shahin** - Amman, Jordan  
Market doesn't Sleep So does Retail (Merchandising)  
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 **Raven Aloro** - University of Calococan City - UCC  
Add a comment....  
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 **Shaikat Chowdhury** - Production Staff at Beximco Textile Ltd  
I am a textile student and wants to know about merchandising for my Research paper.  
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 **Jalal Alshaibani** - Jeddah, Saudi Arabia  
Merchandising is  
is the art of displaying the product at the...  
·DWHI time

-Right time  
-Right place  
-Right quantities  
-Right price  
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