

**To:** Silberstein, Ivy ([bhipdocket@bakerlaw.com](mailto:bhipdocket@bakerlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 78095659 - SQRAT - N/A  
**Sent:** 11/4/2015 1:26:00 PM  
**Sent As:** ECOM116@USPTO.GOV  
**Attachments:**

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

U.S. APPLICATION SERIAL NO. 78095659

MARK: SQRAT

**\*78095659\***

**CORRESPONDENT ADDRESS:**

DAVID A EINHORN  
BAKER HOSTETLER  
45 ROCKEFELLER PLZ FL 11  
NEW YORK, NY 10111-0230

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<http://www.uspto.gov/trademarks/teas/response>

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**APPLICANT:** Silberstein, Ivy

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[bhipdocket@bakerlaw.com](mailto:bhipdocket@bakerlaw.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 30 DAYS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 11/4/2015**

**STRICT DEADLINE TO RESPOND TO THIS LETTER:** To avoid abandonment of applicant's trademark application, the USPTO must receive a complete response within (1) thirty (30) days of the date of issuance of this letter.

Applicant filed a timely request for reconsideration on September 24, 2015, responding to the final Office action that issued on March 26, 2015. Although the request does not resolve all outstanding issues, applicant's response was filed within the six-month response period and otherwise complies with 37 C.F.R. §2.65(a)(2). Thus, applicant is being granted thirty (30) days from the date of issuance of this

letter or the remainder of the sixth-month response period, whichever is longer, to resolve all outstanding issues. *See* 37 C.F.R. §2.65(a)(2); TMEP §§715.03(a)(ii)(C), 718.03(b).

A Motion for Remand was filed and granted to provide a complete explanation for the specimen deficiency and allow applicant an opportunity to address the deficiency of the substitute specimen to overcome the failure to function refusal and specimen requirement. The Board then suspended the appeal and remanded the application to the trademark examining attorney to issue an Examiner's Action Continuing a Final Refusal – 30 day Letter.

A response to this Office action should be filed with the trademark examining attorney, and not with the Board. Applicant should not respond by filing another appeal. TMEP §715.04(b). The appeal will remain suspended while the application is on remand. TMEP §715.04. If applicant's response does not resolve all issues, the Board will be notified to resume the appeal. *Id.*

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

Registration is refused because the applied-for mark, as used on the substitute specimen, 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.” As indicated in the previous action, “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 definition in previous action.)

On May 5, 2014, applicant filed a Statement of Use with a specimen that consists of a jingle. Registration was refused because the mark, as shown on the specimen, fails to function as a service mark because the mark merely identifies a character and is being used to promote a character, and not being used to advertise or promote applicant's merchandising services. Thus, the specimen appears to show use of the mark for applicant's benefit and not for the benefit of others.

On September 24, 2015, in response to the final action, applicant provided substitute specimen that consists of a webpage in which the mark is displayed in the upper right corner. The applied-for mark, as shown on the substitute specimen, does not function as a service mark because it does not function as an indicator of source for the services. The mark merely appears in the upper right corner of the webpage without any reference to applicant's merchandising of movies and television shows. Thus, consumers would not perceive the mark as a source identifier for the applicant or for the services applicant provides.

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).

Applicant may respond to the refusal by submitting a substitute specimen for each applicable international class that shows the applied-for mark used in commerce as a service mark for the services in the statement of use, and the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20:

**“The substitute specimen was in use in commerce prior to the expiration of the deadline for filing a statement of use.”** 37 C.F.R. §2.59(b)(2); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C).

To submit a verified substitute specimen online using the Trademark Electronic Application System (TEAS), applicant should (1) answer “yes” to the TEAS response form wizard question to “submit a new or substitute specimen,” and then do the following for each relevant class for which a substitute specimen is being submitted: (2) attach a jpg or pdf file of the substitute specimen, (3) describe what the specimen consists of, and (4) select the statement that “The substitute specimen(s) was in use in commerce prior to the expiration of the deadline for filing the statement of use.”

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).

On May 5, 2014, applicant filed a Statement of Use with a specimen that consists of a jingle. The jingle is unacceptable as a specimen because it fails to show use of the mark SQRAT in connection with applicant’s merchandising of movies and television programs. There is no reference to applicant’s merchandising services and the mark is not being used to promote applicant’s merchandising services. Rather, the mark is being used to identify a character in the jingle.

On September 24, 2015, in response to the final action, applicant provided a substitute specimen showing the intended mark SQRAT in the upper right corner of a webpage. The substitute specimen is unacceptable because there is no association between the mark and the merchandising of movies and television programs. To show use of the mark in commerce there must be an association or nexus between the mark and the identified services. On the webpage, the term SQRAT is shown adjacent to the wording “IVY SUPERSONIC” and “READ ABOUT SUPERSONIC vs 20<sup>th</sup> CENTURY FOX” without any reference to 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).

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of services identified in the statement of use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. See TMEP §1301.04(a), (h)(iv)(C).

Applicant may respond to this refusal by submitting, for each applicable international class, a different specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce prior to the expiration of the deadline for filing the statement of use and (b) shows the mark in actual use in commerce for the services identified in the statement of use.

Applicant, however, may not withdraw the statement of use. See 37 C.F.R. §2.88(f); TMEP §1109.17.

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

/Michele-Lynn Swain/  
Michele-Lynn Swain  
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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**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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**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

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

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON **11/4/2015** FOR U.S. APPLICATION SERIAL NO. 78095659

Please follow the instructions below:

(1) **TO READ THE LETTER:** Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click 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) **TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **11/4/2015** (or sooner if specified in the Office action). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.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. Instead, the USPTO recommends that you respond online 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).

(3) **QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail [TSDR@uspto.gov](mailto:TSDR@uspto.gov).

**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.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see [http://www.uspto.gov/trademarks/solicitation\\_warnings.jsp](http://www.uspto.gov/trademarks/solicitation_warnings.jsp).