

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85153592
LAW OFFICE ASSIGNED	LAW OFFICE 119
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/85153592/large
LITERAL ELEMENT	COSMOS COUNTRY
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>Examining Attorney has rejected the mark as shown under Sections 1, 2 and 45 of the Lanham Act, on the basis that the mark as shown is merely ornamental as used on the specimen submitted by Applicant in support of registration for International Class 25. Applicant states in the Office Action that the "size and location [of Applicant's mark] on the front of the shirt shows the slogan in the place where decorative elements typically appear." Applicant respectfully disagrees with the Examining Attorney's findings and submits that the mark as shown is not merely ornamental because it operates as a secondary source in this case. See TMEP § 1202.03. More specifically, the non-ornamental use of the mark as shown by Applicant in connection with services other than the Class 25 goods in issue, namely, a soccer team engaging in exhibitions and game-related services in Class 41, clearly indicate that the mark as shown COSMOS COUNTRY serves a source-identifying function. <i>Id.</i> In particular, Applicant states that this case is closely similar to that in <u>In re Paramount Pictures Corp.</u>, 213 U.S.P.Q. 1111 (TTAB 1982), in which the mark MORK & MINDY was ultimately held to be registrable for decals, after being initially refused on ornamental grounds, because applicant had a television series of that name and had previously registered MORK & MINDY for various goods and services. In that case, the Board found that the <i>primary</i> significance of the term MORK & MINDY to a prospective purchaser of decals was to indicate the television series and the principal characters of the television series, such that the mark served a source-identifying function. <i>Id.</i> at 1112. Here, Applicant submits that, similar to the <u>In re Paramount</u> case, the primary significance of the mark as shown is to refer to Applicant's soccer team, which is marketed under, and referred to by the public by, the same name, such that the mark as shown clearly has secondary meaning. Based on the non-ornamental use by Applicant of the mark as shown to market its soccer team, and by the public to refer to such team, the mark as shown indicates source or origin of Applicant as the owner of the soccer team similarly marketed under or known by the COSMOS COUNTRY name, such that this mark is registrable.</p>	

SIGNATURE SECTION	
RESPONSE SIGNATURE	/smr/
SIGNATORY'S NAME	Sarah M. Robertson
SIGNATORY'S POSITION	Attorney of record, New York bar member
SIGNATORY'S PHONE NUMBER	(212) 415-9200
DATE SIGNED	08/03/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Aug 03 16:28:37 EDT 2015
TEAS STAMP	USPTO/RFR-38.122.13.190-2 0150803162837928461-85153 592-540a036b5e16283b60299 927d841756e7847c922057771 620d24a601f72c864c-N/A-N/ A-20150803160058928532

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85153592** COSMOS COUNTRY(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/85153592/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Examining Attorney has rejected the mark as shown under Sections 1, 2 and 45 of the Lanham Act, on the basis that the mark as shown is merely ornamental as used on the specimen submitted by Applicant in support of registration for International Class 25. Applicant states in the Office Action that the "size and location [of Applicant's mark] on the front of the shirt shows the slogan in the place where decorative elements typically appear." Applicant respectfully disagrees with the Examining Attorney's findings and submits that the mark as shown is not merely ornamental because it operates as a secondary source in this case. See TMEP § 1202.03. More specifically, the non-ornamental use of the mark as shown by Applicant in connection with services other than the Class 25 goods in issue, namely, a soccer team engaging in exhibitions and game-related services in Class 41, clearly indicate that the mark as shown COSMOS COUNTRY serves a source-identifying function. Id. In particular, Applicant states that this

case is closely similar to that in In re Paramount Pictures Corp., 213 U.S.P.Q. 1111 (TTAB 1982), in which the mark MORK & MINDY was ultimately held to be registrable for decals, after being initially refused on ornamental grounds, because applicant had a television series of that name and had previously registered MORK & MINDY for various goods and services. In that case, the Board found that the *primary* significance of the term MORK & MINDY to a prospective purchaser of decals was to indicate the television series and the principal characters of the television series, such that the mark served a source-identifying function. Id. at 1112. Here, Applicant submits that, similar to the In re Paramount case, the primary significance of the mark as shown is to refer to Applicant's soccer team, which is marketed under, and referred to by the public by, the same name, such that the mark as shown clearly has secondary meaning. Based on the non-ornamental use by Applicant of the mark as shown to market its soccer team, and by the public to refer to such team, the mark as shown indicates source or origin of Applicant as the owner of the soccer team similarly marketed under or known by the COSMOS COUNTRY name, such that this mark is registrable.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /smr/ Date: 08/03/2015

Signatory's Name: Sarah M. Robertson

Signatory's Position: Attorney of record, New York bar member

Signatory's Phone Number: (212) 415-9200

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85153592

Internet Transmission Date: Mon Aug 03 16:28:37 EDT 2015

TEAS Stamp: USPTO/RFR-38.122.13.190-2015080316283792

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41756e7847c922057771620d24a601f72c864c-N

/A-N/A-20150803160058928532