

From: DelGizzi, Ronald

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To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85904828 - PARLEY - cfa/tm/1.4 - Request for
Reconsideration Denied - Return to TTAB

Attachment Information:

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

U.S. APPLICATION SERIAL NO. 85904828 MARK: PARLEY	
CORRESPONDENT ADDRESS: OLIVER PLATZ PLATZ-IP LAW OFFICE OF OLIVER PLATZ 187 LAFAYETTE ST5TH FLOOR NEW YORK, NY 10013	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp VIEW YOUR APPLICATION FILE
APPLICANT: Strange Matter Ventures, LLC	
CORRESPONDENT'S REFERENCE/DOCKET NO: cfa/tm/1.4 CORRESPONDENT E-MAIL ADDRESS: mail@platz-ip.com	

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 11/6/2014

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. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated March 13, 2014 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 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.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

The acronym "TMEP" used in official USPTO letters and notices refers to the USPTO's *Trademark Manual of Examining Procedure*, a manual written by USPTO staff attorneys that explains the laws and procedures governing the trademark application, registration, and post-registration processes. The USPTO updates the TMEP periodically to reflect changes in law, policy, and procedure and notes each new version by the month and year it issues. The current version of the TMEP is available online at <http://www.uspto.gov/trademarks/resources/index.jsp>.

NEW SPECIMEN REQUIRED - MAINTAINED AND CONTINUES TO BE FINAL

As to Class 36 Services Only

The specimens do not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 36, and therefore are not acceptable. Specifically, the specimen for this class as described by the applicant fails to associate the mark with the identified services.

The applicant's Class 36 services recite the following services:

Charitable fundraising services by means of organizing and conducting special events; charitable fundraising services for the conservation of oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, support of eco-friendly projects, products, and services; global projects that create awareness of specific topics that relate to the protection and conservation of planet earth and its inhabitants, resources and values, collaboration and co-creation projects, namely, art, film, music, fashion, design, namely, sustainable product and urban design, innovation, technology, activism, and science to raise awareness for environmental protection and conservation of the ocean; Financial sponsorship of events, non-profit organizations, concerts, cultural activities, entertainment, projects, media and marketing campaigns, and activists, concerning oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, support of eco-friendly projects, products, and services that create awareness of specific topics that relate to the protection and conservation of planet earth and its inhabitants, resources and values

Registration is refused because the specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 36 in the application or amendment to allege use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Chengdu AOBI Info. Tech. Co.*, ___ USPQ2d ___, Ser. No. 77723547, 2011 TTAB LEXIS 188, at *3-6 (May 31, 2011) (redesignated precedential Sept. 5, 2014); TMEP §§904, 904.07(a), 1301.04(d), (g)(i).

Specifically, the applicant's specimens continue to fail to associate the proposed trademark with ANY of the services shown in its Class 36 list of services.

For example, the first specimen shows the term "PARLEY" superimposed upon the graphic representation of an underwater scene replete with the silhouettes of a whale and/or shark. Nowhere on this specimen are any of the services listed.

Also, the second specimen shows an image of a whale with the following words located to the left of the image, "For the oceans. Parley is an ongoing series of events where creator, thinkers and leaders come together to raise awareness for the beauty and fragility of our oceans and to collaborate on projects that conserve and protect them."

The third specimen and the remaining 48 specimens also fail to state any of the charitable fundraising services or financial sponsorship services.

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 goods and/or services identified in the application or amendment to allege 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 goods include tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, and displays associated with the actual goods at their point of sale. See TMEP §§904.03 *et seq.* Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. TMEP §904.03(i). 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 satisfying one of the following for each applicable international class:

- (1) Submit a different specimen (a verified ["substitute" specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark in actual use in commerce for the goods and/or services identified in the application or amendment to allege use.

- (2) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

DECLARATION FOR SUBSTITUTE SPECIMEN - TEAS - USE APPLICATION

To submit a verified 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 specimen is being submitted: (2) attach a jpg or pdf file of the specimen, (3) describe what the specimen consists of, and (4) select the statement that “The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application.”

IDENTIFICATION OF GOODS and SERVICES - MAINTAINED AND CONTINUES TO BE FINAL

The identification of goods is indefinite and must be clarified. See TMEP §1402.01. Applicant must specify the common commercial or generic name for the goods. If there is no common commercial or generic name, applicant must describe the product and intended consumer as well as its main purpose and intended uses. The identification of services is indefinite and must be clarified. See TMEP §1402.01. Applicant must specify the common commercial or generic name for the services. If the services have no common commercial or generic name, applicant must describe the nature of the services as well as their main purpose, channels of trade, and the intended consumer(s).

For the applicant’s convenience, the Examining Attorney has highlighted suggested amendments and problem areas in **bold** type below.

Applicant may adopt the following identification, ***if accurate:***

Class 16: (NO CHANGE) General feature magazines and magazine supplements for newspapers in the fields of oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, and support of eco-friendly projects, products, services and organizations; General feature magazines and magazine supplements for newspapers featuring global projects that create awareness of specific topics that relate to the protection and conservation of planet earth and its inhabitants, resources and values, collaboration and co-creation projects in art, film, music, fashion, design, namely, product design, innovation, technology, activism, science; Posters, printed invitations, printed pamphlets, brochures, manuals, books, booklets, leaflets, flyers, informational sheets and newsletters, adhesive backed stickers, and kits comprising one or more of the foregoing materials, namely, posters, stickers, manuals, books, booklets, flyers, informational sheets, and newsletters in the field of oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, support of eco-friendly projects, products, services and organizations, global projects that create awareness for of specific topics that relate to the protection and conservation of planet earth and its inhabitants, resources and values, collaboration and co-creation projects, namely, in art, film, music, fashion, design, namely, product design innovation, technology, activism, science

Class 35: Advertising services, namely, promoting and marketing the goods and services of others in the fields of oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, support of eco-friendly projects, products, services and organizations, global projects that create awareness of specific topics that relate to the protection and conservation of planet earth and its inhabitants, resources and values, collaboration and co-creation projects, namely, in art, film, music, fashion, design, namely, product design, innovation, technology, activism, and science via print and electronic media; arranging and conducting marketing promotional events for others; organization of events, exhibitions, fairs and shows for others for commercial, promotional and advertising purposes; Promoting the parties and special events of others; Promotional advertising and sponsorship of products and services of third parties through sponsoring arrangements and license agreements for non-profit organizations for ocean and marine wildlife conservation, for individuals, namely, artists, scientists, activists, musicians, fashion designers, film-makers, designers, and for companies; Promotional advertising **and sponsorship of events, conferences, content [expands scope of original ID]** in the fields of oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, **products, services and organizations, [expands scope of original ID]** and global projects that **create promote** awareness of specific topics that relate to the protection and conservation of planet Earth and its inhabitants, resources and values, projects, services, **namely, {applicant must specify the services contemplated}**, individuals, organizations, namely, the bringing together for the benefit of others

Class 36: Charitable fundraising services by means of organizing and conducting special events; charitable fundraising services for the conservation of oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, support of eco-friendly projects, products, and services ~~(-)~~ **in the nature of** global projects that create awareness of specific topics that relate to the protection and conservation of planet earth and its inhabitants, resources and values, collaboration and co-creation projects, namely, art, film, music, fashion, design, namely, sustainable product and urban design, innovation, technology, activism, and science to raise awareness for environmental protection and conservation of the ocean; Financial sponsorship of events, non-profit organizations, concerts, cultural activities, entertainment, projects, media and marketing campaigns, and activists, concerning oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, support of eco-friendly projects, products, and services that create awareness of specific topics that relate to the protection and conservation of planet earth and its inhabitants, resources and values

Class 41: Entertainment services in the nature of exhibitions, namely, entertainment exhibitions in the fields of education, art, film, music, design, architecture, technology, activism, all of the aforementioned concerning oceans, water, nature, wildlife, environmental protection and conservation, sustainable living, support of eco-friendly projects, products, and services that create awareness of specific topics that relate to the protection and conservation of planet earth and its inhabitants and resources; Entertainment in the nature of concerts, art, performances, namely, dance, music, singing, live performances by a vocal and instrumental groups, panel discussions between individuals, companies, and organizations on topics in art, music, fashion, film, design, on sustainable product and urban design, science, technology, activism and environmental protection, talk shows, debates ~~(-)~~ to benefit conservation of the oceans and environmental protection, **and** collaboration workshops to foster collaboration between individuals, companies and organizations to benefit conservation of the oceans and environmental protection; Entertainment services, namely, the provision of continuing tv shows, documentaries, movies, podcasts featuring individuals in the fields of art, music, fashion, film, technology, science and activism discussing conservation of the oceans and environmental protection and collaborations therefor; magazine publishing; multimedia publishing of books, magazines, journals, software, games, music and electronic publications; organization of events for cultural purposes; organizing cultural and arts events; providing on-line non-downloadable general feature magazines; publication of books, magazines, almanacs, and journals; publication of electronic magazines

Class 42: (NO CHANGE) Creating an on-line community for individuals, companies and organizations for the purpose of fostering and managing collaboration projects, namely, creating an

online community and forum to allow participants to discuss sustainability and environmental protection causes and form collaborations to benefit conservation of the oceans and environmental protection

An applicant may only amend an identification to clarify or limit the goods and/or services, but not to add to or broaden the scope of the goods and/or services. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04.

RESPONSE GUIDELINES

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; see 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/trademarks/teas/index.jsp>. If applicant has technical questions about the TEAS

response to Office action form, applicant can review the electronic filing tips available online at http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp and email technical questions to TEAS@uspto.gov.

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