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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215064
Party	Defendant Jonathan Eller
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

INTELLECTUAL RESERVE, INC.,
a Utah Corporation,

Opposer,

v.

JONATHAN ELLER, as partner of
the de facto partnership, Mormon Match,

Applicant.

In the matter of Application
Serial No. 85/949670

Mark: **MORMON MATCH
(and Design)**

Published in the *Official
Gazette* of October 29, 2013

Opposition No. 91215064

**APPLICANT'S MOTION TO DISMISS NOTICE OF OPPOSITION
AND MEMORANDUM OF LAW IN SUPPORT**

Jonathan Eller, an individual, in his capacity as partner of the *de facto* partnership Mormon Match (the "Applicant") hereby files this Motion to Dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure, seeking an order: (i) dismissing with prejudice, and without leave to amend, claims for false suggestion of a connection, priority and likelihood of confusion, and dilution in the Notice of Opposition No. 91215064 (the "Opposition"); (ii) denying Opposer's requested relief; (iii) declaring that Opposer is not and will not be damaged by registration of Applicant's mark; (iv) declaring the Opposition frivolous and otherwise improper under applicable rules; and (v) awarding Applicant any and all appropriate relief as the Trademark Trial and Appeal Board (the "Board") deems just and proper.

PROCEDURAL HISTORY

Mormons Jonathan Eller and Matthew LaPointe¹ founded Mormon Match to run a dating website for Mormons, currently at www.dateamormon.com. On June 3, 2013 Jonathan Eller filed application Serial No. 85/949,670 (the "Application") for registration of the mark "MORMON MATCH (and Design)" (the "Design Mark"). The Application as amended expressly disclaims the words "MORMON MATCH" apart from the design and published for opposition in the *Official Gazette* of October 29, 2013. On November 5, 2013, Intellectual Reserve, Inc. ("IRI") moved to extend its time to oppose. IRI eventually filed the Opposition on February 4, 2014.

The Opposition alleges IRI owns intellectual property used by the Church of Jesus Christ of Latter-day Saints (the "Church"),² including all "right, title, and interest" to the word "Mormon" for an unspecified "variety of goods and services." It cites seven registered marks, wholly dissimilar to the Design Mark, for different goods and services, but which also use the word "Mormon." The Opposition speculates that the Design Mark will cause false suggestion of connection, priority and likelihood of confusion, and dilution based on IRI's marks and recitation of 15 paragraphs of bare legal conclusions.³ The only well-pled factual allegations are that IRI owns seven marks using the word "Mormon, which word also appears in the Design Mark. These are insufficient to state any claim to oppose registration of the Design Mark. This Motion to Dismiss follows.

¹ Jonathan's family has been affiliated with the Church for at least five generations, and co-founder Matthew's family includes Mormon pioneers.

² (Opposition ¶ 2). IRI's definition of "Opposer" as inclusive of all affiliated legal entities, affiliates, and predecessors of itself and the Church is ambiguous.

³ These appear to be cut-and-paste versions of other oppositions IRI filed. *See e.g.* Notices of Opposition filed in Opposition Nos. 91191016, 91190150, and 91186461, annexed collectively as **Exhibit A** to the accompanying attorney declaration of Siddhartha Rao, Esq. dated April 5, 2014 ("Rao Decl.").

PRELIMINARY STATEMENT AND STATEMENT OF FACTS

For almost two centuries, the word “Mormon” has generally described a set of religious and cultural traditions stemming from the teachings of Joseph Smith and the adherents to these traditions, specifically Latter-day Saints. This word and related terms have been a part of public discourse and the public domain for almost as long. Yet by its Opposition, IRI now insists that nobody can accurately market goods and services with the descriptive word “Mormon.” IRI’s Opposition is plainly meritless.

Mormon Match is a business started by Mormons to operate a dating website for Mormons (See www.dateamormon.com).⁴ The website displays the Design Mark, incorporating the word “Mormon,” not as a mark, but accurately in its ordinarily accepted meaning. The Design Mark consists of “MORMON” in blue above “MATCH” in gold, with the “M” in “MORMON” showing man and woman stick figures holding hands:



IRI speculates this design displayed on an online dating website will somehow confuse and deceive Mormons into believing the Church runs a dating website.⁵

IRI bases these speculations on its ownership of seven marks, including word

⁴ The Application recites Internet-based dating, social introduction and social networking services as services for which the mark will be used.

⁵ This website contains a notice stating: “Mormon Match is not commercially affiliated with or endorsed by The Church of Jesus Christ of Latter-day Saints.” (See www.dateamormon.com.)

marks and design marks. IRI also alleges total ownership of the word “Mormon.” For ready reference, the Design Mark is displayed side by side with the word “Mormon” and specimens of IRI’s claimed registered marks below.⁶

Design Mark (Class 45)	(Alleged) Mark cited in Opposition	Type
	“MORMON”	Unregistered (“variety” of unspecified goods and services)
	“MORMON”	Word (Class 41 and 42) (Registered 5/8/2007)
	MORMON.ORG	Word/Design (Class 41) (Registered 11/24/2009)
	BOOK OF MORMON	Word/Design (Class 9 and 16) (Registered 9/14/2004)

⁶ The Board may take judicial notice of these specimens on this motion as contained in the Application and Opposition, and moreover as “capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” Fed. R. Evid. 201(b); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999).

	<p>MORMON TABERNACLE CHOIR</p>	<p>Word/Design (Class 9 and 41) (Registered 9/23/2003)</p>
		<p>Word/Design (Class 9 and 16) (Registered 12/21/2004)</p>
	<p>“MORMON HANDICRAFT”</p>	<p>Word (Class 24) (Registered 2/14/1989)</p>
	<p>“MORMON HANDICRAFT”</p>	<p>Word (Class 42) (Registered 2/28/1989)</p>

Notably, outside of the common incorporation of the word “Mormon,” none of these marks are similar in any way to the Design Mark. Moreover, none are registered for the same or similar goods and services as recited in the Application (class 45 for “Internet-based dating, social introduction, and social networking services.”)

This is unsurprising, as IRI was legally prevented from registering “MORMON” application serial number 78/161091 in class 45 of goods and services concerning “religious services.” In that proceeding, numerous office actions included findings that “MORMON” is “merely descriptive” and “appears to be generic,” (Mar. 18, 2003 Office

Action); “is incapable of serving as a source-identifier for [the Church’s] goods and/or services,” (Nov. 24, 2003 Office Action); is “refused [registration] . . . because the proposed mark is generic for applicant’s services,” (Jul. 10 2004 Office Action); and is “the common descriptor of a key ingredient, characteristic or feature of the goods[,] . . . generic and thus incapable of distinguishing source,” (Nov 1, 2005 Office Action). Because of weakness as a source-identifying term, IRI’s trademark in the word “MORMON” was narrowly restricted to a small range of services: Educational services, namely, providing classes, conferences, and institutes in the fields of history and religion, under class 41 and “genealogy services” under class 42. IRI abandoned “MORMON” for class 45 services after an appeal of the examining attorney's final refusal.⁷

Similarly, in connection with IRI’s attempt to trademark “MORMON.ORG,” serial number 77/179068, the examiner initially refused registration because the mark is “merely descriptive because it consists of the merely descriptive wording “Mormon” for the subject matter of its services . . . combined with the top-level domain (TLD) ‘.ORG.’” (August 27, 2007 Office Action); and “arguments that the proposed mark as a whole is not merely descriptive of the services in issue, fail [because] . . . [t]he proposed mark clearly describes the religion that is the subject mater of these services,” (March 16, 2008 Office Action). IRI was only able to trademark “MORMON.ORG” after representing that it sought the mark only for services “very similar” to services recited in

⁷ These office actions and notice of abandonment are together annexed as **Exhibit B** to the Rao Decl. The Board may take judicial notice of these findings and may consider them in deciding this motion. *See, e.g., Kaempe v. Myers*, 367 F.3d 958, 965 (D.C. Cir. 2004) (taking judicial notice of “documents recorded by the PTO” because “the cited documents are public records subject to judicial notice on a motion to dismiss”).

the previously registered word mark “MORMON” (May 29, 2008 Communication)⁸ Consistent with trademark practice, on granting registration, the examiner noted: “identifications of services may be amended to clarify or limit the services, adding to or broadening the scope of the services is not permitted.” (June 18, 2008 Office Action).⁹

Further, even if “Mormon” ever had a source identifying purpose, the word has long ago transcended that purpose by entering public discourse and becoming an integral part of public vocabulary.¹⁰ “Mormon” has developed a cultural significance that goes far beyond identification of goods or services produced or marketed by IRI or the Church.¹¹ This is due in no small part to the efforts of the Church. The Church’s style guide states: “‘Mormon’ is correctly used . . . as an adjective in such expressions as ‘Mormon pioneers,’” and “‘Mormons’ is acceptable” “[w]hen referring to Church

⁸ This communication was filed by attorney Dale Hulse who also filed the Opposition.

⁹ These are together annexed as **Exhibit C** to the Rao Decl.

¹⁰ In 1892 Leo Tolstoy famously remarked to the then U.S. foreign minister to Russia that Mormonism is “the American religion.” Well-known American literary critic Harold Bloom used this remark in the title of his 1992 book *THE AMERICAN RELIGION: THE EMERGENCE OF A POST-CHRISTIAN NATION* (New York: Simon and Shuster, 1992), which featured a discussion of Mormonism as the “quintessential” American religion. American writer Jon Krakauer echoes that view, writing that Mormonism “is now widely considered the quintessential American religion.” *JON KRAKAUER, UNDER THE BANNER OF HEAVEN: A STORY OF VIOLENT FAITH* 7 (First Anchor Books 2004). The Board may take judicial notice of these facts as capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. *Compagnie Gervais Danone v. Precision Formulations, LLC*, Opp’n Nos. 91179589, 91184174 (TTAB Jan. 5, 2009) (facts not subject to proof may be judicially noticed).

¹¹ Trademark examiners in numerous *ex parte* proceedings have found “Mormon” generic and unregistrable for a wide range of services *See e.g.* application serial number 85/425334 for “MORMON SAVINGS” (August 14, 2012 Office Action); application serial number 85/537316 for “MORMON IN MANHATTAN” (May 29, 2012 Office Action); application serial number 78/833327 for “BABY MORMON” (September 1, 2006 June 25, 2007 Office Actions); and application serial number 78/608815 for “MORMON MAGNETS” (November 11, 2005 Office Action), together annexed as **Exhibit D** to the Rao Decl. The Board may take judicial notice of them on this motion. *HTC Corp. v. IPCom GmbH & Co., KG*, 671 F. Supp. 2d 146, 151 n.3 (D.D.C. 2009) (holding a “court may take judicial notice of court documents and other public records”).

members”¹² Similarly, the Church also encourages the use of #Mormon as a one of a few “General Hashtags” for use in “social media discussions surrounding Mormonism.”¹³ In fact, the Church’s “I’m a Mormon” campaign on mormon.org, in which Latter-day Saints identify as “Mormon,” further propogates generic use of “Mormon” as a noun meaning Latter-day Saint.¹⁴ On the other hand, the Church does not use and discourages use of Mormon as a source-identifying name for the Church: “Mormon Church . . . is not an authorized title, and the Church discourages its use.”¹⁵

Commonly known facts and references subject to judicial notice demonstrate the impossibility, much less implausibility, of Opposer’s claims due to the generic and descriptive nature of “Mormon” in the English language. The Oxford English Dictionary defines “Mormon” first as a generic noun meaning “A member or adherent of the Church of Jesus Christ of Latter-Day Saints, a millenary Christian sect founded in 1830 at Manchester, New York, by Joseph Smith.” The dictionary also provides a descriptive adjective meaning, “That is a Mormon; of, relating to, or characteristic of Mormons.”¹⁶

An Internet search for “Mormon” reveals numerous generic, descriptive and non-source identifying uses of “Mormon.”¹⁷ These include “Cultural Mormon”; “Mormon Pioneer National Historic Trail”; “Mormon History”; “Feminist Mormon Housewives”;

¹² See Church Style Guide, *available at*: www.mormonnewsroom.org/style-guide.

¹³ See Church Hashtag Recommendations *available at*: <http://www.mormonnewsroom.org/article/mormon-hashtag-recommendations>.

¹⁴ The “I’m a Mormon” campaign does not provide any method of contacting profiled individuals or otherwise facilitate introductions, promote social networking, or provide internet-based dating. It is merely an advertising campaign for the Church.

¹⁵ See Church Style Guide, *available at*: www.mormonnewsroom.org/style-guide.

¹⁶ OXFORD ENGLISH DICTIONARY (3d ed. 2002).

¹⁷ Even if a list of search results has less weight for demonstrating public usage than printouts of pages demonstrating usage of terms, these search results do corroborate a wide range of non-source identifying uses of “Mormon.”

“Old Las Vegas Mormon Fort”; “Mormon Temple”; “The Mormons,” (a PBS program); “The Book of Mormon,” (a Broadway musical); “Mormon Infographics”; “Mormon Artist”; “The Missouri Mormon War”; “Mormon Corridor”; “Mormon Transhumanist Conference”; “Mormon Battalion Association”; “Young Mormon Feminists”; “Mormon Studies” (a subject students can minor in at the University of Utah); “Mormon Blogosphere”; “Mormon Doctrine,” (a book by Bruce McConkie, which states in the front matter: “This work is not an official publication of The Church of Jesus Christ of Latter-day Saints”); “New Order Mormons”; “Society for Humanistic Mormonism”; and “European Mormon Studies Association,” among others.

Moreover, numerous cultural references attest to the generic and descriptive public use of Mormon long before IRI registered the trademarks cited in its Opposition.¹⁸ For example, Charles Dickens published accounts of Mormons in the periodical *All the Year Round* on July 4, 1863 under the column title “*The uncommercial traveller.*” These columns were later compiled into a book of the same title, with chapter 22, titled “Bound for the Great Salt Lake,” specifically describing Dickens’ observations of “EIGHT HUNDRED MORMONS,” (capitalization in original) and his conversations with a “Mormon Agent,” and a Wiltshire laborer who states “O yes, I’m a Mormon . . . I’m a Mormon” when asked “You are of the Mormon religion, of course?”¹⁹ The term “Mormon” is also used in Jules Verne’s famous novel “*Around the World in Eighty Days,*” published in 1873, with chapter twenty-seven titled: “In which Passepartout

¹⁸ Setting aside its alleged unregistered common law mark “Mormon” for a “variety of goods and services,” “MORMON” was registered in 2007. Except for “MORMON HANDICRAFT” registered in 1989, all other marks cited in the Notice of Opposition were registered on or after 2004 (“MORMON TABERNACLE CHOIR” was registered in 2004).

¹⁹ See, <http://www.gutenberg.org/dirs/etext97/unctr10h.htm>.

Undergoes, at a Speed of Twenty Miles an Hour, a Course of Mormon History.”²⁰

Similarly in Sir Arthur Conan Doyle's *A Study in Scarlet*, published in 1887, Brigham Young and Mormon pioneers are characters and Mormon is used as a descriptive term.²¹

Other examples abound. “Mormon Culture Region” and “Mormon Corridor” are long established in the public's vocabulary.²² The American Historical Association (AHA) has an affiliate organization called “Mormon Historical Association,” (MHA) founded at a 1972 AHA meeting. The MHA is an independent organization with publications including *The Journal of Mormon History* and *Mormon History Newsletter*. The article “Mormon Stereotypes in Popular Fiction: 1979-1998” by Michael Austin of Shepherd College demonstrates generic and descriptive uses of “Mormon.”²³ These uses demonstrate that “Mormon” had long been genericized before IRI registered its marks.

The public continues its generic use and understanding of “Mormon,” consistent with the Church's own efforts to encourage use of “Mormon” as merely descriptive or generic (and to discourage and avoid its use as source-identifying). For example, “Cultural Mormon” continues to describe people who identify with Mormon cultural norms without subscribing to the doctrines of the Church. Well-known American literary critic Harold Bloom and American writer Jon Krakauer have both described Mormonism as the “quintessential” American religion.²⁴ These examples attest to the continuing generic use of the word “Mormon.”

²⁰ See, <http://etc.usf.edu/lit2go/55/around-the-world-in-80-days/>.

²¹ See, <http://www.literature.org/authors/doyle-arthur-conan/study-in-scarlet/part-02/chapter-03.html>.

²² See e.g., Meinig, D. W. *The Mormon Culture Region: Strategies and Patterns in the Geography of the American West, 1847-1964*, 55 ANNALS OF THE ASSOC. OF AM. GEOGRAPHERS 191 (Jun. 1965).

²³ Available at: http://www.adherents.com/lit/austin_lds_poplit.html.

²⁴ See, n. 10, *supra*.

ARGUMENT**POINT I****THE OPPOSITION FAILS TO MEET THE MINIMUM PLEADING STANDARD AND SHOULD BE DISMISSED**

The Opposition is legally insufficient and the claims therein should be dismissed. Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice, and the Board need not give any weight to the bare legal conclusions stated in the Opposition. Only a pleading that states a plausible claim for relief survives a motion to dismiss. *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949-50 (2009), citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 555-556 (2007).

When examined in its entirety, the Opposition fails because it does not allege plausible facts as would, if proved, establish a valid ground exists for opposing the registration of the Design Mark. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998); *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007). Simply put, the Opposition does not contain “enough facts to state a claim to relief that is plausible on its face.” *Bell Atlantic Corp.*, 550 U.S. at 570.

POINT II**OPPOSER LACKS STANDING TO PROSECUTE THIS OPPOSITION AND THE OPPOSITION SHOULD BE DISMISSED****A. IRI Does not Own All “Right, Title, and Interest” to the Mark “Mormon”**

In the Opposition, IRI contends it owns all “right, title, and interest” to the mark “MORMON,” as it and/or the Church have allegedly used “MORMON” in connection

with a “variety of goods and services” continuously since 1833.²⁵ IRI does not attempt to allege how it acquired any common-law trademark in the word “Mormon,” nor does it claim that it ever registered a supposed trademark in Mormon for a broad “variety” of goods and services. Moreover, as discussed above, IRI failed to notify the Board of numerous prior findings that IRI is not entitled to broad trademark protection for “Mormon” because it is generic and/or descriptive. Many of these findings issued in proceedings prosecuted by IRI’s current counsel. Indeed, it is well-settled that a one “simply cannot appropriate, from the public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it. This principle is fundamental to the law of trademarks.” *Christian Science Board of Directors v. Evans*, 520 A.2d 1347 (N.J. 1987); see also, *McDaniel et al. v. Mirza Ahmad Sohrab et al.*, 27 N.Y.S.2d 525 (N.Y. Sup. Ct. 1941), *aff’d* 262 A.D. 838, 29 N.Y.S.2d 509 (N.Y. App.Div. 1941) (holding plaintiffs had “no right to a monopoly of the name of a religion” and dismissing complaint).

IRI’s silence as to these facts does not save the Opposition from dismissal, as IRI’s bare assertion that it owns the word “Mormon” is inadequate. *Seybert v. Nat’l Ctr. for Missing & Exploited Children*, No. 09-169, 2009 U.S. Dist. LEXIS 103427, at **6–7 (E.D. Tex. Aug. 10, 2009) (holding the “legal conclusion that plaintiff owns a common law trademark” “not entitled to the assumption of truth” on a motion to dismiss). In order to acquire trademark rights, a mark must be used in the “ordinary course of trade” on goods or containers, or, if the nature of the goods makes that impractical, on documents associated with the goods or their sale.” *Brookfield Commc’ns v. West Coast Entm’t*

²⁵ (Opposition ¶¶ 3–4).

Corp., 174 F.3d 1036, 1051-52 (9th Cir. 1999) (citing 15 U.S.C. § 1127). IRI does not even attempt to allege such use.

Moreover, as a matter of law, IRI cannot show a common law trademark in “Mormon” because “Mormon” is not “inherently distinctive” nor has it acquired distinctiveness through secondary meaning, as this Board has previously found. *DeGidio v. West Grp. Corp.*, 355 F.3d 506, 509–10 (6th Cir. 2004). The issue is indistinguishable from that decided in *Gen. Conference Corp. of Seventh-Day Adventist v. Seventh-Day Adventist Kinship, Int'l, Inc.*, No. CV 87-8113, 1991 WL 11000345, at *6-7 (C.D.Cal. Oct.7, 1991). There, the court held that a company which runs a website for gay and lesbian Seventh Day Adventists, could use the trademarked term “Seventh Day Adventist” “as a matter of law” because, like “Mormon,” the trademarked “Seventh Day Adventist” also refers to adherents of a religion. *Id.* In short, the word “Mormon” cannot obtain broad legal protection because it is generic or at best merely descriptive. Neither IRI nor the Church may claim complete ownership of the generic and descriptive word “Mormon” and IRI cannot cure this defect in the Opposition.

B. IRI Lacks Standing

IRI cannot demonstrate standing because neither it nor the Church have a “real interest” and a “direct and personal stake” in the registration of the Design Mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). IRI and the Church lack exclusive rights to the mark “Mormon” and are clearly not harmed by registration of the Design Mark, which is dissimilar in appearance, meaning, and commercial connotation to IRI’s registered marks, and used for a different class of goods and services. The Board should dismiss the Opposition with prejudice for lack of standing.

POINT III

**THE OPPOSITION FAILS TO STATE A CLAIM
FOR RELIEF AND SHOULD BE DISMISSED****A. The Opposition Fails to State a Claim for False Suggestion
of a Connection Under Trademark Act Section 2(a)**

A claim for false suggestion of a connection requires that: (1) Applicant's mark is the same or a close approximation of IRI's or the Church's previously used name or identity; (2) the Design Mark would be recognized as such; (3) neither IRI nor the Church is connected with the activities performed by the Applicant under the Design Mark; and (4) IRI or the Church's name or identity is of sufficient fame or reputation that when the Design Mark is used for dating services, a connection with them would be presumed. *In Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), citing *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982).

IRI fails to plead any facts plausibly demonstrating any of these elements. Indeed, there are no such facts. First, the mark at issue is not the same or a close approximation of any of the marks identified in the Opposition. The Design Mark does not in any way (other than the mere use of "Mormon") appear similar or to be a close approximation to any mark identified by IRI. Second, the Design Mark does not point uniquely and unmistakably to IRI or the Church. The term "Mormon" is generic, descriptive, and not source identifying with respect to the Church. Third, "Mormon" in the Design Mark accurately describes the Mormon founders of Mormon Match and the Mormon consumers of its goods and services. Finally, the mere use of "Mormon" in connection with Internet-based dating, social introduction and social networking services directed at Mormons will not suggest to Mormons or the general public that IRI or the

Church is running a dating website or is commercially affiliated with one. *See, Seventh-Day Adventist Kinship, Int'l, Inc., supra.*

IRI's speculation is materially indistinguishable from claims rejected in *University of Notre Dame du Lac, supra*, in which the Federal Circuit affirmed dismissal of an opposition. The Court held "NOTRE DAME (and Design)," for cheese, did not falsely suggest a connection with the University of Notre Dame, because "'Notre Dame' is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus it cannot be said that the only 'person' which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity."

Similarly, here, "Mormon" is not a name "solely associated" with the Church (the Church itself discourages such use), but serves to identify a religious prophet and is used in the names of religious traditions and cultural movements related to those traditions. It cannot be said that the only "person" which the name possibly identifies is the Church and that the mere use of "Mormon" by another appropriates its identity. These pleading defects are incurable, and the claim should be dismissed with prejudice.

B. The Opposition Fails to State a Claim for Priority and Likelihood of Confusion

The Opposition fails to allege any facts supporting a claim for priority and likelihood of confusion under Trademark Act section 2(d). It is beyond cavil that if the common element of two marks is "weak" in that it is generic, descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed.

Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with "ASO" disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids). Here, as noted above, "MORMON" is extremely weak in that it is generic and descriptive, and its mere use as a common element cannot be the basis of a claim for likelihood of confusion.

Application of the appropriate *du Pont* factors only strengthens this conclusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973); *see, In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (discussing *du Pont* factors in likelihood of confusion analysis). These factors include:

- (1) similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) similarity or dissimilarity of established, likely-to-continue trade channels;
and
- (4) conditions under which and buyers to whom sales are made.

Id. Of these, the two key considerations are the similarities between the marks and between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*,

544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). As to similarity, marks must be considered “in their entirety as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567).

Here, the marks cited in the Opposition are wholly dissimilar to the Design Mark, considered in its entirety in appearance, sound, meaning, connotation, and commercial impression. Moreover, the “Internet-based dating, social introduction, and social networking” services described in the Application relate to online dating and are wholly unrelated to goods and services of the marks cited in the Opposition. Further, the trade channels for the Design Mark are dissimilar to those for the marks cited in the Opposition. The Design Mark will be displayed on Mormon Match’s website and trade channels related to online dating. Finally, the conditions under which sales are made to buyers using the Design Mark are dissimilar to those for the marks cited by IRI. The Design Mark will be used in conditions requiring buyers to set up an online profile for dating and social introductions, which is wholly different from the conditions under which sales are made to buyers using the marks cited in the Opposition.

In short, it strains logic to assert the registration of the Design Mark in relation dating services is likely to cause confusion, mistake, or to deceive the public that the dating services emanate from or are otherwise endorsed by IRI or the Church.

The Design Mark and the dating services it will be used with are completely unrelated to IRI’s marks for educational services, genealogical services, religious

instruction, religious books and pamphlets, pre-recorded audio and audio-video tapes and compact discs featuring musical entertainment incorporating religious, family, and educational themes, books featuring musical performances and religious, family, and educational themes, live performance by the Mormon Tabernacle Choir, fabrics, linens, bats, towels, and other textile material, and catalog mail order and telephone order services for craft items and materials, baby clothes, toys, *inter alia*.

The Opposition fails to state any facts supporting a likelihood of confusion claim, indeed no such facts exist, and this claim should be dismissed with prejudice.

C. The Notice of Opposition Fails to State a Claim for Dilution

Dilution under section 43(c) of the Trademark Act is an “extraordinary remedy” and the Board “will not resolve doubts in favor of the party claiming dilution.” *The Toro Company v. ToroHead, Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001). In deciding IRI’s dilution claim, the Board should consider whether: (1) IRI’s marks are famous; (2) IRI’s marks became famous prior to Applicant’s date of constructive use; and (3) Applicant’s Design Mark is likely to cause dilution by blurring or tarnishing the distinctiveness of IRI’s marks. *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645 (TTAB 2010). Here, IRI’s Opposition pleads no *facts* plausibly supporting any of these elements. IRI merely pleads legal conclusions.

A mark is defined as “famous for dilution purposes under 15 U.S.C. §1125(c)(2)(A) if it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” In general, the opposer has the burden of establishing that its marks have become famous,

and the requirements are “stringent” when claiming dilution. *Coach Services*, 96 USPQ2d at 1610, citing *Toro Co.*, 61 USPQ2d at 1170. “Mormon” is not famous in the sense of being widely recognized as *a designation of source* of IRI’s or the Church’s goods or services. As discussed above, “Mormon” is a word describing members of the Church and religious and cultural movements stemming from the teachings of Joseph Smith. Indeed, “Mormon” was genericized long before IRI registered any of the marks cited in the Opposition. IRI’s marks in “MORMON” and “MORMON.ORG” are not famous, and cannot satisfy the first and second factors. To the extent the remaining marks relating to Book of Mormon, Mormon Tabernacle Choir, and Mormon Handicraft *may* identify source, claims for dilution of these marks fail under the third factor.

IRI fails to satisfy the third factor because as a matter of law, the Design Mark cannot dilute IRI’s marks by the mere accurate use of the generic and descriptive word “Mormon.” It is well settled that some marks can “transcend their identifying purpose” and “enter public discourse and become an integral part of our vocabulary.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). When they do so they “assume a role outside the bounds of trademark law.” *Id.* Moreover, “[w]here a mark assumes such cultural significance, First Amendment protections come into play.” *Id.*²⁶ In these situations, “the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.” *Id.* Here “Mormon” has so transcended its identifying purpose that IRI cannot

²⁶ Indeed, IRI’s attempt to assert total ownership of “Mormon” and use this Board to proscribe speech and expression concerning “Mormon” asks this Board to impermissibly use state action to diminish or deny constitutional rights guaranteed under, *inter alia*, the First and Fourteenth Amendments. *See, Shelley v. Kraemer*, 334 U.S. 1 (1948) (holding court barred from enforcement of private contract as enforcement invokes state action to effect unconstitutional discrimination).

satisfy the third factor as a matter of law.

“Mormon” is not inherently distinctive, and has not become well and favorably known such that IRI and the Church can claim exclusive use of the word for use in internet-based dating, social introduction and social networking services. Even if the public associated the Design Mark used for dating services with IRI’s marks, no plausible facts support a showing that this would cause any impairment to IRI’s marks, and the claim would still fail. *Gap Inc. v. G.A.P. Adventures Inc.*, 100 USPQ2d 1417, 1431 (S.D.N.Y. 2011) (dismissing dilution claim despite finding of likely association of marks because of lack of any showing of impairment). Here, there is simply no plausible basis to deny the public imbues the word “Mormon” with meaning beyond a source-identifying function, and no plausible basis to claim that its accurate use to describe dating services tarnishes or blurs IRI’s other marks. This pleading defect is incurable, and IRI’s claim for dilution should be dismissed with prejudice.

POINT IV

THE OPPOSITION IS BARRED BY COLLATERAL ESTOPPEL AND SHOULD BE DISMISSED WITH PREJUDICE

Collateral estoppel bars re-litigation of an issue where a prior action presented the issue, the party litigated the issue, and a judgment in the prior action determined the issue. *Laguna Hermosa Corp. v. United States*, 671 F.3d 1284 (Fed. Cir. 2012) (affirming application of collateral estoppel to dismiss claim). Here, collateral estoppel bars IRI’s claims that “Mormon” may be registered or protected outside of a narrowly circumscribed set of goods and services.

IRI already unsuccessfully attempted to register “Mormon” in class 45 of goods

and services for “religious services” concerning application serial number 78/161091.²⁷ There, the examiner repeatedly denied registration because “MORMON” is “merely descriptive” and “appears to be generic,” (Mar. 18, 2003 Office Action); “is incapable of serving as a source-identifier for [the Church’s] goods and/or services,” (Nov. 24, 2003 Office Action); is “generic for applicant’s services,” (Jul. 10 2004 Office Action); and is “the common descriptor of a key ingredient, characteristic or feature of the goods[,] . . . generic and thus incapable of distinguishing source,” (Nov 1, 2005 Office Action).²⁸ Ultimately, IRI abandoned its application for “MORMON” for class 45 services after an appeal of the examining attorney's final refusal.

Here, the Application seeks to register the Design Mark in class 45 for Internet-dating, social introduction, and social networking services. Collateral estoppel now bars IRI from arguing that “MORMON” is source-identifying for those services. *Stephen Slesinger, Inc. v. Disney Enterprises Inc.*, No. 11-1593 (Fed. Cir. 2013); *Miller’s Ale House, Inc. v. Boynton Carolina Ale House, LLC*, Case No. 10-15140 (11th Cir. Dec. 20, 2012) (plaintiff could not re-litigate genericness of “ale house” after litigating the issue to a final decision by the 4th Circuit). The defect is incurable, and the Opposition should be dismissed in its entirety with prejudice.

POINT V

JUDICIAL ESTOPPEL BARS THE OPPOSITION AND IT SHOULD BE DISMISSED WITH PREJUDICE

Judicial estoppel prevents a party from taking inconsistent positions in judicial

²⁷ In that proceeding IRI was represented by the same firm prosecuting this Opposition.

²⁸ See Rao Decl. Ex. B. The Board may consider these findings in the context of the collateral estoppel issue. *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992).

proceedings to gain an advantage in each proceeding. *New Hampshire v. Maine*, 532 U.S. 742 (2001). Previously, IRI represented to the trademark examiner that it only sought registration within a narrowly specified category of goods and services to successfully trademark “MORMON.ORG,” after the examiner initially refused registration stating the mark was “merely descriptive” because “Mormon” is “merely descriptive wording” and because “the proposed mark clearly describes the religion that is the subject matter of these services.” IRI obtained registration only after representing that it sought registration for “very similar” services to the narrow categories for which it trademarked “Mormon.”

In short, this Board already found Mormon merely descriptive and IRI obtained registration of “MORMON.ORG” only by reassuring the Board that the registration was for narrowly circumscribed services for which it registered “MORMON.” IRI’s silence as to these facts does not save the Opposition from dismissal. IRI is now judicially estopped from asserting that “Mormon” is not generic or descriptive outside of narrowly specified goods and services.²⁹ Accordingly, the Opposition should be dismissed.

POINT VI

MISUSE OF ALLEGED MARKS AND UNCLEAN HANDS BAR THE OPPOSITION AND IT SHOULD BE DISMISSED WITH PREJUDICE

It is well settled that unclean hands bars relief where the plaintiff’s inequitable conduct directly relates to its request for equitable relief. *Aristotle Int’l, Inc. v. NGP Software, Inc.*, 714 F. Supp. 2d 1, 15 (D.D.C. 2010) (quoting *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 814 (1945)). Here, even if “Mormon” was

²⁹ Indeed, taking a contrary position now would imply prior fraud on the patent and trademark office by IRI in filing this communication.

ever a word that indicated origin of goods and services, by its own actions, the Church has encouraged the word “Mormon” to be used in a manner that strips its significance as an indicator of origin of goods or services. After misusing its alleged marks in this manner, it cannot now oppose use of “Mormon” consistent with its own instructions.

As noted above, the Church’s Style guide instructs the public to use “Mormon” generically and descriptively “as an adjective in such expressions as ‘Mormon pioneers,’” “[w]hen referring to Church members,”³⁰ and as a “General Hashtag[]” for use in “social media discussions surrounding Mormonism.”³¹ Conversely, the Church has instructed the public against the source-identifying expression “Mormon Church” stating this “is not an authorized title, and the Church discourages its use.”³² Accordingly, it cannot now claim that “Mormon” is source-identifying.

The false advertising case of *Stokely-Van Camp, Inc. v. Coca-Cola Co.*, 646 F. Supp. 2d 510 (S.D.N.Y. 2009) is instructive. There, the plaintiff complained of statements by the defendants bearing on the calcium and magnesium content of the defendants’ sports drink. Plaintiff had previously “marketed the advantage of adding calcium and magnesium” to its own sports drink. *Id.* at 533. Accordingly, the court denied plaintiff’s request for a preliminary injunction. *Id.* Here, Applicant’s use of “Mormon” is entirely consistent with the Church’s use of the word and it’s instructions to the public. Therefore, it cannot be the basis for opposition by the Church, and IRI’s Opposition should be dismissed with prejudice.

³⁰ See Church Style Guide *available at*: www.mormonnewsroom.org/style-guide.

³¹ See Church Hashtag Recommendations *available at*: <http://www.mormonnewsroom.org/article/mormon-hashtag-recommendations>.

³² See Church Style Guide *available at*: www.mormonnewsroom.org/style-guide.

CONCLUSION

By its Opposition, IRI and the Church insist that they have total ownership of the word “Mormon” such that no person can accurately use that term in a trademark to describe goods and services. This position is clearly meritless. Moreover, as shown herein, none of the facts pled in the Opposition establish any plausible claim for false suggestion of a connection, likelihood of confusion, or dilution. Indeed no facts exist to plausibly establish such claims. These pleading defects cannot be cured as the rest on the fundamentally untenable position that the Church completely owns the word “Mormon,” and require this Board to turn a blind eye to its own numerous findings to the contrary.

Accordingly, Applicant seeks an order: (i) dismissing the Opposition in its entirety with prejudice and without leave to amend; (ii) denying the Opposer’s requested relief; (iii) declaring that Opposer is not and will not be damaged by registration of the Design Mark; (iv) declaring the Opposition frivolous and otherwise improper under applicable rules; and (v) awarding Applicant any and all appropriate relief as the TTAB deems just and proper.

Dated: April 5, 2014

Respectfully submitted,

/Siddartha Rao/

Siddartha Rao, Esq. (NY License # 4753497)

Attorney for the Applicant Jonathan Eller, as partner of the de facto partnership Mormon Match

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Tel: (646) 221-1846

Email: srao@dateamormon.com

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **MOTION TO DISMISS NOTICE OF OPPOSITION AND MEMORANDUM OF LAW** is being filed electronically to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on April 5, 2014.

/Siddartha Rao/
Siddartha Rao, Esq.

CERTIFICATE OF SERVICE

I hereby certify that on April 5, 2014 a copy of the foregoing **MOTION TO DISMISS NOTICE OF OPPOSITION AND MEMORANDUM OF LAW** was served on Intellectual Reserve, Inc. by depositing said copy with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Dale E. Hulse
Counsel for Intellectual Reserve Inc.
KIRTON McCONKIE
1800 World Trade Center at
City Creek, 60 East South Temple
Salt Lake City, UT 84111

/Siddartha Rao/
Siddartha Rao, Esq.

stating “MORMON” “is incapable of serving as a source-identifier for [the Church’s] goods and/or services”; July 10, 2004, stating “MORMON” is “refused [registration] . . . because the proposed mark is generic for applicant’s services”; and November 1, 2005 (without attendant attachments), stating “MORMON” is “the common descriptor of a key ingredient, characteristic or feature of the goods[,] . . . generic and thus incapable of distinguishing source;” and notice of abandonment dated August 22, 2007.

4. Annexed hereto as **Exhibit C** are true and accurate copies of office actions (some without attendant attachments) and a communication issued and sent in connection with application serial number 77/179068 for “MORMON.ORG.” These are namely Office Actions dated August 27 2007 (without attendant attachments), stating the mark “merely descriptive because it consists of the merely descriptive wording “Mormon” for the subject matter of its services . . . combined with the top-level domain (TLD) ‘.ORG.’”; and March 16, 2008 (without attendant attachments) stating “arguments that the proposed mark as a whole is not merely descriptive of the services in issue, fail [because] . . . [t]he proposed mark clearly describes the religion that is the subject mater of these services;” a communication dated May 29, 2008 from IRI to the examiner stating IRI sought to trademark “MORMON.ORG” for “very similar” services as those recited in the previously registered word mark “MORMON”; and a June 18, 2008 Office Action.

5. Annexed hereto as **Exhibit D** are true and accurate copies of Office Actions (some without attendant attachments), namely, August 14, 2012 Office Action concerning application serial number 85/425334 for “MORMON SAVINGS” (without attendant attachments); May 29, 2012 Office Action concerning application serial number 85/537316 for “MORMON IN MANHATTAN” (without attendant

attachments); September 1, 2006 Office Action concerning application serial number 78/833327 for “BABY MORMON” (without attendant attachments); June 25, 2007 Office Action concerning application serial number 78/833327 for “BABY MORMON” (without attendant attachments); and November 11, 2005 Office Action concerning application serial number 78/608815 for “MORMON MAGNETS” (without attendant attachments).

I declare under penalties of perjury that the foregoing is true and correct.

April 5, 2014

 /Siddartha Rao/
Siddartha Rao, Esq.

Exhibit A

ESTTA Tracking number: **ESTTA294983**

Filing date: **07/13/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Intellectual Reserve, Inc.		
Entity	Corporation	Citizenship	Utah
Address	50 East North Temple Salt Lake City, UT 84150 UNITED STATES		

Attorney information	Dale E. Hulse Kirton & McConkie 60 East South Temple, Suite 1800 P.O. Box 45120 Salt Lake City, UT 84145-0120 UNITED STATES dhulse@kmclaw.com Phone:(801) 321-4815
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Applicant Information

Application No	77337325	Publication date	06/30/2009
Opposition Filing Date	07/13/2009	Opposition Period Ends	07/30/2009
Applicant	Sheets, Kendal M. 1855 MacArthur Drive McLean, VA 22101 UNITED STATES		

Goods/Services Affected by Opposition

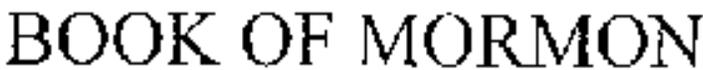
<p>Class 009. All goods and services in the class are opposed, namely: CD-ROMs, DVDs, magnetic tape cassettes, high definition digital disks featuring non-fictional content of history and religious doctrine; computer software for database management and interactive reading and research of electronically formatted books of history and religion; downloadable electronic publications and publications on recordable media, namely, books, magazines, newsletters, manuals, pamphlets, multimedia files, and magazine columns featuring non-fictional content of history and religious doctrine; audio and video recordings provided in analog and digital format featuring non-fictional content of history and religious doctrine; audio and video recordings that are downloadable to recordable media featuring books, seminars, movies, documentaries, and interviews of non-fictional content of history and religious doctrine; computer game software and DVDs, CD-ROMs, and downloadable digital media files containing such software featuring non-fictional content of history and religious doctrine</p>
<p>Class 016. All goods and services in the class are opposed, namely: Publications, namely, books, magazines, newsletters, pamphlets, guides, manuals, and syndicated newspaper columns featuring non-fictional content of history and religious doctrine; screenplays, books, guides, and manuals featuring fictional and non-fictional content of historical and religious events, persons, and activities; posters, calendars, note cards, greeting cards, stationery items, namely, pens, pencils, notebooks, notepads, stickers, binders, folders, writing paper and envelopes</p>

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Tarnishment

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3239919	Application Date	09/05/2002
Registration Date	05/08/2007	Foreign Priority Date	NONE
Word Mark	MORMON		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 1920/00/00 First Use In Commerce: 1920/00/00 Educational services, namely, providing classes, conferences, and institutes in the fields of history and religion</p> <p>Class 042. First use: First Use: 1833/06/01 First Use In Commerce: 1833/06/01 genealogy services</p>		

U.S. Registration No.	2883572	Application Date	05/10/2002
Registration Date	09/14/2004	Foreign Priority Date	NONE
Word Mark	BOOK OF MORMON		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1977/00/00 First Use In Commerce: 1977/00/00 pre-recorded audio and video cassette tapes and compact discs featuring religious content</p> <p>Class 016. First use: First Use: 1830/00/00 First Use In Commerce: 1830/00/00 Printed matter; namely religious books, religious instructional pamphlets, and brochures; photographs, artist materials, instructional and teaching material, posters, engravings, prints of paintings, books</p>		

U.S. Registration No.	2766231	Application Date	11/20/2001
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Registration Date	09/23/2003	Foreign Priority Date	NONE
Word Mark	MORMON TABERNACLE CHOIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1973/11/00 First Use In Commerce: 1973/11/00 Pre-recorded audio and audio-video cassette tapes and compact discs featuring musical entertainment incorporating religious, family, and educational themes</p> <p>Class 041. First use: First Use: 1893/08/00 First Use In Commerce: 1893/08/00 entertainment services, namely, live performances by a musical performance group</p>		

U.S. Registration No.	2913694	Application Date	04/10/2003
Registration Date	12/21/2004	Foreign Priority Date	NONE
Word Mark	MORMON TABERNACLE CHOIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2003/03/00 First Use In Commerce: 2003/03/00 prerecorded audiotapes, videotapes, compact discs, and digital video discs featuring musical entertainment incorporating religious, family, and educational themes</p> <p>Class 016. First use: First Use: 2003/06/00 First Use In Commerce: 2003/06/00 publications, namely, books featuring musical performances and featuring religious, family, and educational themes</p> <p>Class 041. First use: First Use: 2003/03/00 First Use In Commerce: 2003/03/00 entertainment services, namely, live performances by a musical performance group</p>		

U.S. Registration No.	1524555	Application Date	04/07/1986
Registration Date	02/14/1989	Foreign Priority Date	NONE
Word Mark	MORMON HANDICRAFT		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 1974/05/00 First Use In Commerce: 1974/05/00 FABRICS, LINENS, BATS, TOWELS, DISH CLOTHS, PILLOWCASES, AFGHANS, LAP ROBES, QUILTS, QUILT KITS, AND WALL HANGINGS, TABLE COVERS, SOFT GIFTS, AND HEM-STITCHED ITEMS OF TEXTILE MATERIAL

U.S. Registration No.	1527447	Application Date	04/07/1986
Registration Date	02/28/1989	Foreign Priority Date	NONE
Word Mark	MORMON HANDICRAFT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1937/10/00 First Use In Commerce: 1937/10/00 RETAIL CATALOG MAIL ORDER AND TELEPHONE ORDER SERVICES FOR CRAFT ITEMS AND MATERIALS, DOLLS, BABY CLOTHES, TOYS, YOUNG GIRLS' CLOTHING, QUILTS, PERSONAL GIFTS, NEEDLEWORK, PORCELAIN STATUES AND THE LIKE		

U.S. Application No.	77179068	Application Date	05/11/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MORMON.ORG		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: Providing information and instruction in the fields of religion, ethics, and moral and religious values; providing on-line religious instruction promoting family values; providing information in the field of parenting concerning education and entertainment of children; and providing courses of instruction in the field of marital relations		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MORMON		

Goods/Services	A wide variety of goods and services
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Attachments	76405608#TMSN.gif (1 page)(bytes) 76340212#TMSN.gif (1 page)(bytes) 76505493#TMSN.gif (1 page)(bytes) 77179068#TMSN.jpeg (1 page)(bytes) SECRET MORMON Opposition Brief.PDF (2 pages)(127356 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Dale E. Hulse/
Name	Dale E. Hulse
Date	07/13/2009

1. Intellectual Reserve, Inc. ("IRI") is a nonprofit corporation of the state of Utah having a principal place of business at 50 East North Temple, Salt Lake City, Utah 84150, IRI and its affiliates and predecessors being collectively referred to herein as "Opposer".

2. Since at least as early as 1833, Opposer has used the mark and trade name "MORMON" in connection with a variety of goods and services, and Opposer has continually used such mark up through the present time.

3. In this regard, Opposer owns all right, title, and interest in and to the mark "MORMON", as well as to the following marks and federal registrations: U.S. Registration No. 3,239,919 for the mark "MORMON", U.S. Registration No. 2,883,572 for the mark "BOOK OF MORMON", U.S. Registration No. 2,766,231 for the mark "MORMON TABERNACLE CHOIR", U.S. Registration No. 2,913,694 for the mark "MORMON TABERNACLE CHOIR (and Design)", U.S. Registration No. 1,524,555 for the mark "MORMON HANDICRAFT", and U.S. Registration No. 1,527,447 for the mark "MORMON HANDICRAFT". Opposer is also the owner of all right, title, and interest in and to the mark "MORMON.ORG" and federal application Serial No. 77/179,068 for the mark "MORMON.ORG". All of the foregoing marks, registrations, and applications are collectively referred to herein as the "MORMON marks".

4. The use of the MORMON marks by Opposer has been valid and continuous since the respective dates of first use of those marks, and such use has not been abandoned.

5. Opposer has so used the MORMON marks in connection with Opposer's goods and services such that the public has come to associate "MORMON" and the MORMON marks with Opposer and as indicating that the goods and services marketed and/or associated with the MORMON marks originate with Opposer.

6. The MORMON marks are symbolic of extensive goodwill and consumer recognition built up by Opposer through the substantial expenditure of time and resources in promotion and advertising.

7. On information and belief, Applicant, Kendal M. Sheets, is an individual with a business address at Sheets Law Office, LLC, 1855 MacArthur Drive, McLean, Virginia 22101.

8. On November 27, 2007, Applicant filed application Serial No. 77/337,325 for registration of the alleged mark "SECRET MORMON", and said application was published for opposition in the Official Gazette of the United States Patent and Trademark Office on June 30, 2009 in International Class 9 (U.S. Classes 21, 23, 26, 36, and 38) for "CD-ROMs, DVDs, magnetic tape cassettes, high definition digital disks featuring non-fictional content of history and religious doctrine; computer software for database management and interactive reading and research of electronically formatted books of history and religion; downloadable electronic publications and publications on recordable media, namely, books, magazines, newsletters, manuals, pamphlets, multimedia files, and magazine columns featuring non-fictional content of history and religious doctrine; audio and video recordings provided in analog and digital format featuring non-fictional content of history and religious doctrine; audio and video recordings that are downloadable to recordable media featuring books, seminars, movies, documentaries, and interviews of non-fictional content of history and religious doctrine; computer game software and DVDs, CD-ROMs, and downloadable digital media files containing such software featuring non-fictional content of history and religious doctrine", and International Class 16 (U.S. Classes 2, 5, 22, 23, 29, 37, 38, and 50) for "Publications, namely, books, magazines, newsletters, pamphlets, guides, manuals, and syndicated newspaper columns featuring non-fictional content of history and religious doctrine; screenplays, books, guides, and manuals featuring fictional and non-fictional content of

historical and religious events, persons, and activities; posters, calendars, note cards, greeting cards, stationery items, namely, pens, pencils, notebooks, notepads, stickers, binders, folders, writing paper and envelopes". The opposition deadline has been set for July 30, 2009.

9. Applicant's aforesaid application is based upon Applicant's alleged bona fide intent to use the proposed "SECRET MORMON" mark in connection with the above-stated goods.

10. The goods recited in Applicant's application are identical with or very similar to goods and services presently offered by Opposer, or offered in the past by Opposer, bearing the MORMON marks of Opposer.

11. The goods of Applicant bearing the alleged mark "SECRET MORMON" would pass through the same or similar channels of commerce to the same or similar classes of purchasers as the goods and services offered by Opposer in connection with its MORMON marks.

12. The alleged "SECRET MORMON" mark of Applicant, as applied to the goods of Applicant set forth in Applicant's application, so resembles the MORMON marks of Opposer, previously used in the United States by Opposer, as applied to the goods and services of Opposer, so as to be likely to cause confusion, or to cause mistake, or to deceive, so as to falsely suggest a connection with Opposer, so as to dilute the distinctive quality of Opposer's MORMON marks which are believed to be famous, and so as to tarnish Opposer's MORMON marks.

13. Based upon the foregoing, registration of the "SECRET MORMON" mark depicted in application Serial No. 77/337,325 on the Principal Register of the United States Patent and Trademark Office will cause injury and damage to Opposer.

14. Wherefore, Opposer prays that this opposition be sustained in its favor, and that registration of Applicant's alleged mark "SECRET MORMON", application Serial No. 77/337,325, be denied.

ESTTA Tracking number: **ESTTA282858**

Filing date: **05/08/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Intellectual Reserve, Inc.
Granted to Date of previous extension	05/31/2009
Address	50 East North Temple Salt Lake City, UT 84150 UNITED STATES

Attorney information	Dale E. Hulse Kirton & McConkie 60 East South Temple, Suite 1800 Salt Lake City, UT 84111 UNITED STATES dhulse@kmclaw.com Phone:(801) 321-4815
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Applicant Information

Application No	77514108	Publication date	12/02/2008
Opposition Filing Date	05/08/2009	Opposition Period Ends	05/31/2009
Applicant	Jones, Nick 7437 S. Eastern, #264 Las Vegas, NV 89123 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. All goods and services in the class are opposed, namely: Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking; Computer services, namely, interactive hosting services which allow the user to publish and share their own content and images on-line
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2703967	Application Date	11/21/2001
Registration Date	04/08/2003	Foreign Priority	NONE

		Date	
Word Mark	LDS FAMILY SERVICES		
Design Mark	LDS FAMILY SERVICES		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/06/15 First Use In Commerce: 1999/06/15 pre-recorded audio and audio-video cassette tapes and compact discs featuring educational information regarding family issues and family services</p> <p>Class 016. First use: First Use: 1999/06/15 First Use In Commerce: 1999/06/15 printed publications, namely, newsletters in the areas of adoption, parenting, child and teen development, academic and career-oriented counseling, mental health, eating disorders and body image concerns, bereavement, relationship counseling, domestic violence, personal affairs management, substance abuse, citizenship and resettlement issues for refugees and immigrants, disabilities services, homelessness, and volunteer services</p> <p>Class 042. First use: First Use: 1999/06/15 First Use In Commerce: 1999/06/15 placement and counseling services ancillary to adoptions, counseling in the fields of chemical dependency, domestic violence and family preservation, counseling of adolescents on the subjects of sex and hygiene, providing health and chemical abuse information, counseling, namely, information, support assistance, support groups and advice lines to parents and caregivers of children and teens, in the fields of parenting, child development and behavior, and family management; counseling on adoption</p>		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LDS CHURCH - Utah State Registration No. 5239773-0190		
Goods/Services	A variety of goods and services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LDS		
Goods/Services	A variety of goods and services		

Attachments	76340655#TMSN.gif (1 page)(bytes) LDSFAMILY Opposition Brief.PDF (2 pages)(96490 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Dale E. Hulse/
Name	Dale E. Hulse

Date	05/08/2009
------	------------

1. Intellectual Reserve, Inc. ("IRI") is a nonprofit corporation of the state of Utah having a principal place of business at 50 East North Temple, Salt Lake City, Utah 84150, IRI being referred to herein as "Opposer". As used herein, the term "Opposer" shall also be deemed to include any and all predecessors and affiliates of IRI.

2. Since at least as early as 1917, Opposer has used the mark and trade name "LDS" in connection with a variety of goods and services, and Opposer has continually used such mark and trade name up through the present time. Moreover, since at least as early as 1999, Opposer has used the mark and trade name "LDS FAMILY SERVICES" in connection with a variety of goods and services, and Opposer has continually used such mark and trade name up through the present time.

3. In this regard, Opposer owns all right, title, and interest in and to the marks "LDS" and "LDS FAMILY SERVICES", as well as to the following marks and registrations: U.S. Registration No. 2,703,967 for the mark "LDS FAMILY SERVICES" and Utah State Registration No. 5239773-0190 for the mark "LDS CHURCH". All of the foregoing marks and registrations are collectively referred to herein as the "LDS marks".

4. The use of the LDS marks by Opposer has been valid and continuous since the respective dates of first use of those marks and such use has not been abandoned.

5. Opposer has so used the LDS marks in connection with Opposer's goods and services such that the public has come to associate "LDS" and the LDS marks with Opposer and as indicating that the goods and services marketed and/or associated with the LDS marks originate with Opposer.

6. The LDS marks are symbolic of extensive goodwill and consumer recognition built up by Opposer through the substantial expenditure of time and resources in promotion and advertising.

7. On information and belief, Applicant, Nick Jones, is an individual having an address at 7435 S. Eastern, #5-258, Las Vegas, Nevada 89123.

8. On July 2, 2008, Applicant filed application Serial No. 77/514,108 for registration of the alleged mark "LDSFAMILY", and said application was published for opposition in the Official Gazette of the United States Patent and Trademark Office on December 2, 2008 in International Class 42 (U.S. Classes 100 and 101) for "Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking; Computer services, namely, interactive hosting services which allow the user to publish and share their own content and images on-line". Opposer has been granted two Extensions of Time to Oppose, extending the opposition deadline to May 31, 2009.

9. Applicant's aforesaid application is based upon Applicant's alleged bona fide intent to use the alleged "LDSFAMILY" mark in connection with the above-stated services.

10. The services recited in Applicant's application, and the goods and services with which Opposer has used and now uses the LDS marks, are closely associated in use and sale and are of the same class and type.

11. The services of Applicant offered under the alleged mark "LDSFAMILY" would be offered through the same or similar channels of commerce to the same or similar classes of purchasers as the goods and services offered by Opposer in association with its LDS marks.

12. The alleged "LDSFAMILY" mark of Applicant, as applied to the services of Applicant set forth in Applicant's application, so resembles the LDS marks of Opposer, previously used in the United States by Opposer, as applied to the goods and services of Opposer, so as to be likely to cause confusion, or to cause mistake, or to deceive, so as to falsely suggest a connection with Opposer, and so as to dilute the distinctive quality of Opposer's LDS marks which are believed to be famous.

13. Based upon the foregoing, registration of the "LDSFAMILY" mark depicted in application Serial No. 77/514,108 on the Principal Register of the United States Patent and Trademark Office will cause injury and damage to Opposer.

14. Wherefore, Opposer prays that this opposition be sustained in its favor, and that registration of Applicant's alleged mark "LDSFAMILY", application Serial No. 77/514,108, be denied.

ESTTA Tracking number: **ESTTA237081**

Filing date: **09/16/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Intellectual Reserve, Inc.
Granted to Date of previous extension	09/17/2008
Address	50 East North Temple Salt Lake City, UT 84150 UNITED STATES

Name	Corporation of the President of The Church of Jesus Christ of Latter-day Saints		
Entity	Corporation sole	Citizenship	Utah
Address	50 East North Temple Salt Lake City, UT 84150 UNITED STATES		

Attorney information	Dale E. Hulse Kirton & McConkie 60 East South Temple, Suite 1800 Salt Lake City, UT 84111 UNITED STATES dhulse@kmclaw.com Phone:(801) 321-4815
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Applicant Information

Application No	76684788	Publication date	05/20/2008
Opposition Filing Date	09/16/2008	Opposition Period Ends	09/17/2008
Applicant	exclusivelyLDS, LLC 252 East 300 South Salt Lake City, UT 84111 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Marketing services, namely, providing informational web pages designed to generate sales traffic via hyperlinks to other web sites; providing a web site which features advertisements for the goods and services of others on a global computer network; promoting the goods and services of others by providing hypertext links to the web sites of others
Class 041. All goods and services in the class are opposed, namely: Providing newsletters in the field of lifestyle and religion via e-mail

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2703967	Application Date	11/21/2001
Registration Date	04/08/2003	Foreign Priority Date	NONE
Word Mark	LDS FAMILY SERVICES		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/06/15 First Use In Commerce: 1999/06/15 pre-recorded audio and audio-video cassette tapes and compact discs featuring educational information regarding family issues and family services</p> <p>Class 016. First use: First Use: 1999/06/15 First Use In Commerce: 1999/06/15 printed publications, namely, newsletters in the areas of adoption, parenting, child and teen development, academic and career-oriented counseling, mental health, eating disorders and body image concerns, bereavement, relationship counseling, domestic violence, personal affairs management, substance abuse, citizenship and resettlement issues for refugees and immigrants, disabilities services, homelessness, and volunteer services</p> <p>Class 042. First use: First Use: 1999/06/15 First Use In Commerce: 1999/06/15 placement and counseling services ancillary to adoptions, counseling in the fields of chemical dependency, domestic violence and family preservation, counseling of adolescents on the subjects of sex and hygiene, providing health and chemical abuse information, counseling, namely, information, support assistance, support groups and advice lines to parents and caregivers of children and teens, in the fields of parenting, child development and behavior, and family management; counseling on adoption</p>		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LDS CHURCH - Utah State Registration No. 5239773-0190		
Goods/Services	A variety of goods and services.		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LDS		
Goods/Services	A variety of goods and services.		

Attachments	76340655#TMSN.gif (1 page)(bytes) YOUR LDS NEIGHBORHOOD Opposition Brief.pdf (2 pages)(98905 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Dale E. Hulse/
Name	Dale E. Hulse
Date	09/16/2008

1. Intellectual Reserve, Inc. ("IRI") is a nonprofit corporation of the state of Utah having a principal place of business at 50 East North Temple, Salt Lake City, Utah 84150, and Corporation of the President of The Church of Jesus Christ of Latter-day Saints ("COP"), is a corporation sole of the state of Utah having a principal place of business at 50 East North Temple, Salt Lake City Utah 84150, IRI and COP being collectively referred to herein as "Opposer". As used herein, the term "Opposer" shall also be deemed to include any and all predecessors of IRI and COP.

2. Since at least as early as 1917, Opposer has used the mark and trade name "LDS" in connection with a variety of goods and services, and Opposer has continually used such mark and trade name up through the present time. Among other things, Opposer has used the mark and trade name "LDS" in connection with various electronic and printed publications, including internet usage.

3. In this regard, Opposer owns all right, title, and interest in and to the mark "LDS", as well as to the following marks and registrations: U.S. Registration No. 2,703,967 for the mark "LDS FAMILY SERVICES" and Utah State Registration No. 5239773-0190 for the mark "LDS CHURCH". All of the foregoing marks and registrations are collectively referred to herein as the "LDS marks".

4. The use of the LDS marks by Opposer has been valid and continuous since the respective dates of first use of those marks and such use has not been abandoned.

5. Opposer has so used the LDS marks in connection with Opposer's goods and services such that the public has come to associate "LDS" and the LDS marks with Opposer and as indicating that the goods and services marketed and/or associated with the LDS marks originate with Opposer.

6. The LDS marks are symbolic of extensive goodwill and consumer recognition built up by Opposer through the substantial expenditure of time and resources in promotion and advertising.

7. On information and belief, Applicant, exclusivelyLDS, LLC, is a Utah limited liability company having a place of business at 252 East 300 South, Salt Lake City, Utah 84111.

8. On December 10, 2007, Applicant filed application Serial No. 76/684,788 for registration of the alleged mark "YOUR LDS NEIGHBORHOOD", and said application was published for opposition in the Official Gazette of the United States Patent and Trademark Office on May 20, 2008 in International Class 35 (U.S. Classes 100, 101, and 102) for "Marketing services, namely, providing informational web pages designed to generate sales traffic via hyperlinks to other web sites; providing a web site which features advertisements for the goods and services of others on a global computer network; promoting the goods and services of others by providing hypertext links to the web sites of others" and in International Class 41 (U.S. Classes 100, 101, and 107) for "Providing newsletters in the field of lifestyle and religion via e-mail". On June 18, 2008, Opposer was granted a 90 day Extension of Time to Oppose, extending the opposition deadline to September 17, 2008.

9. Applicant's aforesaid application is based upon Applicant's alleged bona fide intent to use the alleged "YOUR LDS NEIGHBORHOOD" mark in connection with the above-stated services, and it is believed that Applicant has used that alleged mark at the website <http://www.yourldsneighborhood.com/>.

10. The services recited in Applicant's application, and the goods and services with which Opposer has used and now uses the LDS marks, are closely associated in use and sale and are of the same class and type.

11. The services of Applicant offered under the alleged mark "YOUR LDS NEIGHBORHOOD" would be offered through the same or similar channels of commerce to the same or similar classes of purchasers as the goods and services offered by Opposer in association with its LDS marks.

12. The alleged "YOUR LDS NEIGHBORHOOD" mark of Applicant, as applied to the services of Applicant set forth in Applicant's application, so resembles the LDS marks of Opposer, previously used in the United States by Opposer, as applied to the goods and services of Opposer, so as to be likely to cause confusion, or to cause mistake, or to deceive, so as to falsely suggest a connection with Opposer, and so as to dilute the distinctive quality of Opposer's LDS marks which are believed to be famous.

13. Based upon the foregoing, registration of the "YOUR LDS NEIGHBORHOOD" mark depicted in application Serial No. 76/684,788 on the Principal Register of the United States Patent and Trademark Office will cause injury and damage to Opposer.

14. Wherefore, Opposer prays that this opposition be sustained in its favor, and that registration of Applicant's alleged mark "YOUR LDS NEIGHBORHOOD", application Serial No. Serial No. 76/684,788, be denied.

Exhibit B

To: Intellectual Reserve, Inc. (mkrieger@kmclaw.com)
Subject: TRADEMARK APPLICATION NO. 78161091 - MORMON - 6925.600
Sent: 3/18/03 3:25:24 PM
Sent As: ECom114
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/161091

APPLICANT: Intellectual Reserve, Inc.

CORRESPONDENT ADDRESS:

Michael F. Krieger
Kirton & McConkie
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City UT 84111

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom114@uspto.gov

MARK: MORMON

CORRESPONDENT'S REFERENCE/DOCKET NO : 6925.600

CORRESPONDENT EMAIL ADDRESS:

mkrieger@kmclaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/161091

The assigned examining attorney has reviewed the referenced application and determined the following.

THE MARK IS A GENERIC NAME FOR THE SERVICES

The examining attorney refuses registration on the Principal Register because the proposed mark is merely descriptive of the identified services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209.01(c) *et seq.* Moreover, the proposed mark appears to be generic as applied to the services and,

therefore, incapable of identifying the applicant's services and distinguishing them from those of others. *In re Management Recruiters International, Inc.*, 1 USPQ2d 1079 (TTAB 1986). Under these circumstances, the examining attorney cannot recommend an amendment to proceed under Trademark Act Section 2(f), 15 U.S.C. §1052(f), or an amendment to the Supplemental Register.

The Court of Appeals for the Federal Circuit set forth the test to determine whether a designation is generic in *h. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987,990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test comprises two questions: 1) What is the class of goods or services at issue? 2) Does the relevant public understand the designation primarily to refer to that class of goods or services?

What is the class of services at issue?

Applicant seeks to register "MORMON" on the Principal Register for services described as "religious services, namely, operating places of assembly for worship and gatherings; ministerial services, namely, providing religious worship services and conducting church sponsored programs."

The relevant dictionary definitions of "MORMON" and "MORMON RELIGION" follow.

Mor·mon

Mor·mon (môr'men) *Mormon Church. noun*

A member of the Mormon Church. In this sense, also called *Latter-day Saint*.

adjective

Of or relating to the Mormons, their religion, or the Mormon Church.

— **Mor'mon·ism** *noun*[\[1\]](#)

Mormon Church

Mormon Church *noun*

A church founded by Joseph Smith at Palmyra in western New York in 1830 and having its headquarters since 1847 in Salt Lake City, Utah. Its doctrines are based chiefly on the Bible, the Book of Mormon, and other revelations made to church leaders. Also called *Church of Jesus Christ of Latter-day Saints*.[\[2\]](#)

The above definitions tend to show that "MORMON" is the actual name of a church or religion founded in 1830 by one Joseph Smith at Palmyra in western New York, now headquartered in Salt Lake City, Utah. A "MORMON" is a member of the Mormon Church. As an adjective the term refers to the Mormons, "their religion, or the Mormon Church." Thus "MORMON" is a word similar to "CATHOLIC" in that it instantly names a recognized formal religious organization. It is the actual name of a religious institution and is thus generic for religious services, ministerial services in the nature of providing religious worship services. What else would one expect to be provided by a recognized church? Surely, a reasonable and immediate expectation for the service mark "MORMON" would have to be the expectation of religious services somewhere in the offing. The Mormon temples in Los Angeles, California and in Maryland are veritable fortress-castles, huge with grandeur and appearing able to defend against all incursions. The Mormon schools are known for athletic prowess and never engaging in sports on Sunday. The Mormon legacy of tithing and keeping great sums assures the continuation of the Church for the foreseeable future. It's all in the newspapers. See the attached articles from the Lexis/Nexis database of United States news articles attached hereto. The term "MORMON" is well recognized in the United States as one of the

great religions.

2.Does the relevant public understand the designation primarily to refer to that class of services?

The best way to find out whether most Americans understand that “MORMON” is a church or religion is to ask them. However, this is too burdensome for ex parte trademark application prosecution and so one turns to the evidence that would tend to show that “MORMON” is understood to be a religion, a Church.

One has but to look in the newspapers of the United States to perceive that only the people who dislike the news would be uninformed as to the meaning of “MORMON.” The popularity of news programs, news broadcasts and news magazines and online news sites would indicate that news haters are few and far between. However, if one is exposed to the news, one is aware of the meaning of “MORMON” and knowing that it is a Church and a religion means that one understands that religious services will be offered by this source. The mark is the name of a religion and the services are, in the main, religious services. Most citizens will understand the reference.

Given the prohibition found in Trademark Act, Section 2(e)(1) against registration of terms which describe the goods or services of the applicant, it is difficult to see how registration may be effected in this case where the genericness is so clear just from the plain dictionary meaning of the wording in the mark and from its use in the news media.

RECITATION OF SERVICES

The wording "conducting church-sponsored programs" in the recitation of services is unacceptable as indefinite. The applicant must amend the recitation to specify the common commercial name of the services or to indicate their nature. If the programs are non-money connected, they are in Class 45. If there is a fundraising or distributing charitable element, they are in Class 36. TMEP section 1301.05. Applicant must add a “namely” and list the programs by name. Furthermore “operating places of assembly for worship and gatherings” must be said to be “for others.”

INCORRECT CLASSIFICATION

The applicant has classified some services incorrectly. The applicant must amend the application to classify all of the religious services and ministerial services in International Class 45. 37 C.F.R. Sections 2.33(a)(1)(vi) and 2.85; TMEP sections 805, 1301.06 and 1401. If any of the church programs listed are in another Class, applicant may either delete them or add a Class to the application.

If the applicant prosecutes this application as a combined, or multiple-class application, the applicant must comply with each of the following:

- (1) The applicant must specifically identify the services in each class and list the services by international class with the classes listed in ascending numerical order. TMEP section 1113.01.
- (2) The applicant must submit a filing fee for each international class of services not covered by the fee already paid. 37 C.F.R. Sections 2.6(a)(1) and 2.86(b); TMEP sections 810.01 and 1113.01. Effective January 10, 2000, the fee for filing a trademark application is \$325 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date.

(3) The applicant must submit:

(a) dates of first use and first use in commerce and one specimen for each class that includes goods or services based on use in commerce under Trademark Act Section 1(a). The dates of use must be at least as early as the filing date of this application. 37 C.F.R. Sections 2.34(a)(1) and 2.86(a), and the specimen(s) must have been in use in commerce at least as early as the filing date of the application, and/or

(b) a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class that includes goods or services based on a bona fide intention to use the mark in commerce under Trademark Act Section 1(b).

(4) The applicant must submit an affidavit or a declaration under 37 C.F.R. Section 2.20 signed by the applicant to verify (3) above. 37 C.F.R. Sections 2.59(a) and 2.71(c).

***The Office electronic Manual of Goods and Services is located on the Internet at the following address:
[www.uspto.gov/web/offices/tac/doc/gsmannual/](http://www.uspto.gov/web/offices/tac/doc/gsmmanual/)***

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP section 804.09. Therefore, the applicant may not amend to include any services that are not within the scope of the services recited in the present identification.

EXPEDITED COMMUNICATIONS

The most expeditious way to resolve goods and services descriptions and disclaimer issues is by e-mail which allows for back-and-forth discussion between applicant and examining attorney without the 6-month intervals of mail or the irritation of telephone tag. Substitute specimens and declarations are best done by fax, as are domestic representative appointments, revocations and the like. The examining attorney's personal numbers, as opposed to the official number below the signature, are:

Tel. 703-308-9114 Ext. 133

Fax: 703-746-6267

E-Mail: jill.alt@uspto.gov

If answering by E-Mail, indicate the signature as below, between two forward slashes. Thank you.

/Jill C.Alt/
Trademark Attorney, Law Office 114
703-308-9114/433
Law Office e-mail: ecom114@uspto.gov
Law Office Fax: 703-746-8114

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

*****038239*****

SEND TO: ALT, JILL
TRADEMARK LAW LIBRARY
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ARLINGTON, VIRGINIA 22202-4600

MAIL-IT REQUESTED: MARCH 18, 2003

10083K

CLIENT: JALT
LIBRARY: NEWS
FILE: US

YOUR SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:
MORMON W/15 RELIGION OR CHURCH

NUMBER OF STORIES FOUND WITH YOUR REQUEST THROUGH:
LEVEL 1... 32387

LEVEL 1 PRINTED

THE SELECTED STORY NUMBERS:
1,7,12,23,35-36,44,47,62,66,68,74-76,106

DISPLAY FORMAT: 30 VAR KWIC

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*****04373*****

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/161091

APPLICANT: Intellectual Reserve, Inc.

CORRESPONDENT ADDRESS:

Michael F. Krieger
Kirton & McConkie
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City UT 84111

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
ecom114@uspto.gov

MARK: MORMON

CORRESPONDENT'S REFERENCE/DOCKET NO : 6925.600

CORRESPONDENT EMAIL ADDRESS:

mkrieger@kmclaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/161091

This letter responds to the applicant's communication filed on 10-2-2003

Applicant's reclassification of its services has been accepted and entered in the record.

CONTINUED REQUIREMENT: AN ACCEPTABLE RECITATION OF SERVICES

The examining attorney thanks applicant for its good faith attempt to amend the recitation of services to avoid improper indefiniteness. However, anomalies remain, as follows.

1. Adult groups, youth groups, scouting services, and welfare services (which must be changed to "social welfare services"), genealogy services are not all things of the same ilk, even though they may all be sponsored by the church. "Adult groups, youth groups, boys scouts and girl scouts all fall under the rubric of "social clubs," happily remaining in Class 45. This group should be "church-sponsored social clubs, namely." "Genealogy services" doesn't exist, really. It falls under "genealogy research" and demands to be placed in Class 42. This would require an added filing fee and another specimen of use, just for genealogy research.

2. All educational programs, church-sponsored or not, belong in Class 41. Class 41 descriptions of educational services are more or less crafted in a certain way. You have start with “educational services, namely” then go on to indicate how they are provided, e.g. “providing classes, or courses, or lectures, or workshops, or conferences, or forums, or institutes, or mentoring, or seminars) in the field of religion, the Church of Latter Day Saints or whatever the topic of the educational program might be—leadership, following the ten commandments, business morality—whatever the topic. Merely mentioning “educational programs” is improperly indefinite and, moreover, incorrectly classified in Class 45.

3. “Missionary services”: are legitimate services in Class 45. “Proselytizing” is more of a promotional service in Class 35, unless it’s considered “evangelizing.”

4. “And other similar programs” is out-and-out indefinite and must be deleted or the other programs must be listed by common name.

CLASSIFICATION

The applicant has classified all of its service3s in International Class 45. The correct classification for educational services is Class 41 and for genealogy services, International Class 42. The applicant must either delete the two extra services or add International Classes 41 and 42 to the application. 37 C.F.R. Sections 2.33(a)(1)(vi) and 2.85; TMEP sections 805.03 and 1401.

MULTI-CLASS APPLICATION

If the applicant prosecutes this application as a combined, or multipleâ€classapplication, the applicant must comply with each of the following:

(1) The applicant must specifically identify the services in each class and list the service by international class with the classes listed in ascending numerical order. TMEP section 1113.01.

(2) The applicant must submit a filing fee for each international class of services not covered by the fee already paid. 37 C.F.R. Sections 2.6(a)(1) and 2.86(b); TMEP sections 810.01 and 1113.01. Effective January 10, 2000, the fee for filing a trademark application is \$325 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date.

(3) The applicant must submit:

(a) dates of first use and first use in commerce and one specimen for each class that includes goods or services based on use in commerce under Trademark Act Section 1(a). The dates of use must be at least as early as the filing date of this application. 37 C.F.R. Sections 2.34(a)(1) and 2.86(a), and the specimen(s) must have been in use in commerce at least as early as the filing date of the application, and/or

(b) a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class that includes goods or services based on a bona fide intention to use the mark in commerce under Trademark Act Section 1(b).

(4) The applicant must submit an affidavit or a declaration under 37 C.F.R. Section 2.20 signed by the applicant to verify (3) above. 37 C.F.R. Sections 2.59(a) and 2.71(c).

CONTINUED REFUSAL: SECTION 2(E)(1) THE MARK IS GENERIC FOR THE SERVICES

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is the generic name of the identified services.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and CONTINUED.

THE MARK MAY NOT BE REGISTERED UNDER SECTION 2(F)

The proposed mark is incapable of serving as a source-identifier for applicant's goods and/or services. Therefore, the refusal of registration under Section 2(e)(1) is *continued*, notwithstanding applicant's claim of acquired distinctiveness under Section 2(f), 15 U.S.C. §1052(f).

The attached evidence from the Nexis/Lexis excerpts to the first Office action and the excerpts from the Internet Google search engine show that the proposed mark "MORMON" is incapable as used in connection with providing religious worship services and other church-related services because the word "MORMON" is a short-form or nickname for "The Church of Jesus Christ of Latter-Day Saints," the formal name for the Mormon religion. Applicant's own specimen of use shows a sign outside one of the Mormon churches or tabernacles that says the following: "The CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS (THE MORMONS). The two names mean the same thing; one is simply the dress-up term while the other is same term in jeans. One is formal, the other informal but both refer to the same group, set of beliefs, moral code, and historical background. It is specious to argue that there is only one generic name for anything. Consider "precipitation"—we call it rain, downpour, drizzle, showers, rainstorm—and that is just the water part of precipitation. There is also hail, snow, ice storm, and sleet. There are several generic nouns possible, synonyms, that convey the nature of a given product or service. The term "MORMON" is another word for "CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS." This is true unless applicant can point out some other Mormons on the globe who are not Christians, or who do not have a shared history with Mr. Smith and the old ways of polygamy. Are there "MORMONS" who are not culturally tied to the Church of Jesus Christ of Latter-day Saints? Are there Mormons who have never read the Book of Mormon?

There is no trademark or service mark for "CHRISTIANITY," "JUDAISM," "PROTESTANT," "METHODIST," "PRESBYTERIAN," or "EPISCOPALIAN" for providing religious worship services and church-related social programs and philanthropies. (See the attached printout from the Office database of registrations. Note there is not even a pending application bearing the name of a religion.) This is not for lack of gumption in applying for such a mark but rather the acknowledgement that such a mark would be unregistrable as generic for religious services. None of the widely accepted names for religions or sects of religions would be perceived as a trademark for providing worship services or church-related social services.

Applicant argues, "It is well settled that the definition of a generic term is the name of the product or services itself." This is splendid argument but the law is not quite right.

A term need not be a noun to be generic. *Miller Brewing Co. v G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978) (LITE held generic for beer); TMEP §1209.01(c)(ii).

A term that serves as the common descriptor of a key ingredient, characteristic or feature of the goods is also generic and thus incapable of distinguishing source. A term need not relate solely to the name of the goods or services in order to be held incapable of serving as an indicator of origin. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3rd Cir. 1986) (CHOCOLATE FUDGE generic for diet sodas); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977) (LITE generic for beer), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (PASTEURIZED for face cream incapable); *Roselux Chemical Co, Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (SUDSY generic for ammonia); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (ART DECO generic for flatware); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for stores that sell lingerie); *In re National Patent Development Corp.*, 231 USPQ 823 (TTAB 1986) (ULTRA PURE for interferons for medical use incapable); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of wicker furniture and accessories); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (HENNA 'N' PLACENTA generic of ingredients for hair conditioner); *In re Bee Pollen From England Ltd.*, 219 USPQ 163 (TTAB 1983) (BEE POLLEN FROM ENGLAND for bee pollen incapable).

Applicant cites a case, calling it “similar to this one.” The case is *Stocker v. General Conference Corp. of Seventh Day Adventists*. This is a case where a splinter or independent group within the Seventh Day Adventist religion is attempting to cancel the valid registration of the mother group for “SEVENTH DAY ADVENTIST” (with “ADVENTIST” disclaimed) as either descriptive or generic on grounds that the entire mark is generic and should be cancelled. The petitioner splinter group was trying to use trademark law as a sword. The splinter group considered itself, although broken off from the core group, nonetheless a Seventh Day Adventist congregation. The mother group was wont to use the trademark status of “SEVENTH DAY ADVENTIST” to prohibit splinter groups from using the phrase, indicating that such use was trademark infringement.

The Board respected the politics and the legal posture of the case to deny petitioner. This case and the cited case differ, however, quite considerably. First of all, this is an ex parte prosecution to obtain a trademark. The cited case was an inter partes attack on a presumed validly registered trademark. The petitioner in that case had to show, by a “preponderance of the evidence” that the mark was generic, and the Board found the evidence wanting. However that standard of evidence does not apply to ex parte prosecutions. The evidence required is enough evidence to make a prima facie case, and the dictionary evidence together with the United States news articles from the Lexis/Nexis database have established a prima facie case that applicant has not torn asunder.

Attached hereto are a few articles from the Internet including one that appears to be sponsored by the Mormon hierarchy, complete with the photograph of President Gordon B. Hinckley. The terms “MORMON” and “CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS” are used interchangeably in all of the articles. Another nickname for the church is “LDS,” also used frequently. The term is generic for providing worship services and for church-connected social services, services that most churches provide: the adult and youth groups, the educational component via Sunday schools and other means. The fact that the church is so well known and that the relevant public is so large makes use of “MORMON” as a service mark less, not more, likely.

EXPEDITED COMMUNICATIONS

The most expeditious way to resolve goods and services descriptions and disclaimer issues is by e-mail that allows for back-and-forth discussion between applicant and examining attorney without the 6-month intervals of mail or the irritation of telephone tag. Substitute specimens and declarations are best done by fax, as are domestic representative appointments, revocations and the like. The examining attorney's personal numbers are:

Tel. 703-308-9114 Ext. 433

Fax: 703-746-6267

E-Mail: jill.alt@uspto.gov

In order to submit formal responses by E-Mail, applicant must give written consent to be an electronic correspondent and set forth its E-Mail address. The signature, to be valid, must be typed between two forward slashes, as below.

/Jill C. Alt/
Trademark Attorney
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To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

To: Intellectual Reserve, Inc. (mkrieger@kmclaw.com)
Subject: TRADEMARK APPLICATION NO. 78161091 - MORMON - 6925.600
Sent: 7/10/04 3:33:37 PM
Sent As: ECom114
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/161091

APPLICANT: Intellectual Reserve, Inc.

CORRESPONDENT ADDRESS:

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MARK: MORMON

CORRESPONDENT'S REFERENCE/DOCKET NO : 6925.600

CORRESPONDENT EMAIL ADDRESS:

mkrieger@kmclaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/161091

This letter responds to the applicant's communication filed on 6-18-2004. The applicant's amended recitation of services has been accepted and entered in the record.

The generic refusal under Section 2(e)(1) for the mark "MORMON," has been withdrawn in Classes 41 and 42 where it has been re-determined to be merely descriptive under Section 2(e)(1). Therefore the

following refusal must issue.

PROOF OF DISTINCTIVENESS UNDER SECTION 2(f)

If applicant believes that its mark has acquired distinctiveness for educational services and for “geneology services”, that is, that it has become a distinctive source-indicator for the services, then applicant may seek registration on the Principal Register under Trademark Act Section 2(f), 15 U.S.C. §1052(f). Applicant must establish acquired distinctiveness by a preponderance of the evidence. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed.Cir. 1988). This evidence may include specific dollar sales under the mark, advertising figures, samples of advertising, consumer statements of recognition of the mark as a source identifier, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. *See In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979). This Office will decide each case on its own merits.

To determine whether the proposed mark has acquired distinctiveness, the trademark examining attorney will consider the following factors: (1) how long applicant has used the mark for the specific services; (2) the type and amount of advertising of the mark for the specific services; and (3) applicant’s efforts to associate the mark with the specific services identified in the application. *See Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 173 USPQ 820 (S.D.N.Y. 1972); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984); 37 C.F.R. §2.41; TMEP §§1212, 1212.01 and 1212.06.

Applicant will note that the term “MORMON” is to have acquired distinctiveness *as a service mark* for the particular services recited in Classes 41 and 42, not for religious services, not as a church, not as a religion, or faith. Because “MORMON” is so very descriptive of the content of the educational services and the context of the geneological services, as propounded in the the specimen entitled “MORMON GENEALOGY,” a great deal of 2(f) evidence is required.

The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985). More evidence is needed where a mark is so highly descriptive that purchasers seeing the matter in relation to the named services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984).

However, no amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot become a trademark under any circumstances. *See Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 195 USPQ 281 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978).

To be perfectly clear, the reason why the Class 41 and 42 services, educational services and genealogical services, are descriptive is because “MORMON” describes an important attribute of these services. The educational services have Mormon philosophy and theology as their subject matter and the genealogical services are “Mormon Genealogy,” the bonding of families to each other and to their ancestors who may have missed this religious bonding, according to Mormon theology, as indicated by the specimens of use. A term need not describe all of the purposes, functions, characteristics or features of the services to be merely descriptive. For the purpose of a Section 2(e)(1) analysis, it is sufficient that the term describe

only one attribute of the goods and/or services to be found merely descriptive. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973); TMEP §1209.01(b). In this case, the subject matter of the “Mormon education” and the persons whose genealogy is traced is members of the Mormon Church or Church of Latter Day Saints.

THE MARK “MORMON” IS GENERIC FOR CLASS 45 RELIGIOUS SERVICES.

Registration is refused on the Principal Register under Section 2(f) because the proposed mark is generic for applicant’s services. See *In re A La Virile Russia, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture and jewelry); *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic for computerized reservation and ticketing of transportation services); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for architectural design of buildings and retail outlets selling kits for building log homes); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS generic for consulting services to businesses seeking to establish sites on a global computer network); *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985) (CERTIFIED MORTGAGE BANKER (“MORTGAGE BANKER” disclaimed) for “educational services, namely providing qualifying examinations, testing and grading in the field of real estate finance” held so highly descriptive as to be incapable of functioning as a mark notwithstanding evidence of acquired distinctiveness); TMEP §§1209.01(c) *et seq.*

Applicant seeks to register the term “MORMON” for services described, as amended: “Religious services, namely, operating places of assembly for worship by The Church of Jesus Christ of Latter-day Saints for others; ministerial services, namely providing religious worship services.” A tour of the subject of the relationship of “MORMON” to religious worship services through the word thicket of the American Heritage Dictionary of the English Language, Third Edition indicates the following. “MORMON” is defined in the attached excerpt from *The Americans Heritage Dictionary of the English Language, Third Edition*, as follows: “A member of the Mormon Church. In this sense, also called *Latter-day Saint*.”

The trail winds forward to “Church of Jesus Christ of Latter-day Saints,” which is defined in the attached excerpt from *The Americans Heritage Dictionary of the English Language, Third Edition*, as follows: “See Mormon Church.” Two signs point to “Mormon Church,” which is defined in the attached excerpt from *The Americans Heritage Dictionary of the English Language, Third Edition*, as follows: “A church founded by Joseph Smith at Palmyra in western New York in 1830 and having its headquarters since 1847 in Salt Lake City, Utah. Its doctrines are based chiefly on the Bible, the Book of Mormon, and other revelations made to church leaders. Also called *Church of Jesus Christ of Latter-Day Saints*.”

Now it is evident that “MORMON” is a species of church. What exactly is a “church” or “Church?” “Church” is defined in the attached excerpt from *The Americans Heritage Dictionary of the English Language, Third Edition*, as follows: “A building for public, especially Christian worship.” With an initial capital letter, “Church” is defined in the attached excerpt from *The Americans Heritage Dictionary of the English Language, Third Edition*, as follows: “The company of all Christians regarded as a mystic spiritual body,” or “A specified Christian denomination: *The Presbyterian Church*.” Finally, “church” is defined in the attached excerpt from *The Americans Heritage Dictionary of the English Language, Third Edition*, as follows: “Public divine worship in a church; a religious service.”

Mormon is a specified Christian denomination, it is a church. The very dictionary definition of “church” is that of a place that provides public divine worship, a religious service. The term “MORMON” does not need the actual word “Church” after it to be generic for providing religious services. “Mormon” is another name for the “Church of Jesus Christ of Latter-day Saints,” the short name, for this particular denomination of Christianity. It is expected when the words “Roman Catholic,” “Methodist,” “Episcopalian,” are presented that these groups will provide religious services because they are all the names of various Christian denominations, as is “Mormon.”

Applicant is aware of the attachments to the Office action of 11-24-03 showing that the phrase “MORMON CHURCH” is used in the news media of the United States quite often. There were 32,387 hits in the Lexis/Nexis database of United States news articles. This is considerable coverage and tends to show that “MORMON” is a term that United States citizens have read in connection with the Mormon Church and religion. As the name of a Church or church, the term will not be perceived as a service mark. It will be perceived as the name of a Church or church.

It is a type or species of church—a place for public worship or religious services. It is generic and hence unregistrable. It is the perception of the public that finally determines what is or is not a service mark. The public perception of “MORMON” is the name of a religion or Church, an entity that would naturally provide public worship facilities and religious services. That’s what a church does, by definition. The term will not be perceived as the source of the services.

What most Churches do, the Presbyterians, Methodists et al, is to register the name combined with a logo or design, disclaim the name and go forward based upon the arbitrary and unique nature of the design. There is only one religion name that is registered without a design and that one was registered under very different circumstances, when different policies were involved, one-third of the mark is disclaimed, and the other two-thirds are registered under Section 2(f) with a mountainous amount of evidence. (See attached.)

Whether “MORMON” is used as a noun or adjective does not matter in this context. A term need not be a noun to be generic. *Miller Brewing Co. v G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978) (LITE held generic for beer); TMEP §1209.01(c)(ii).

The examining attorney includes, once again, the following list of cases where the marks were found to be generic. A term that serves as the common descriptor of a key ingredient, characteristic or feature of the goods is also generic and thus incapable of distinguishing source. A term need not relate solely to the name of the goods or services in order to be held incapable of serving as an indicator of origin. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3rd Cir. 1986) (CHOCOLATE FUDGE generic for diet sodas); *Miller Brewing Co. v G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977) (LITE generic for beer), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (PASTEURIZED for face cream incapable); *Roselux Chemical Co, Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (SUDSY generic for ammonia); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (ART DECO generic for flatware); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for stores that sell lingerie); *In re National Patent Development Corp.*, 231 USPQ 823 (TTAB 1986) (ULTRA PURE for interferons for medical use incapable); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of wicker furniture and accessories); *In re Hask*

Toiletries, 223 USPQ 1254 (TTAB 1984) (HENNA 'N' PLACENTA generic of ingredients for hair conditioner); *In re Bee Pollen From England Ltd.*, 219 USPQ 163 (TTAB 1983) (BEE POLLEN FROM ENGLAND for bee pollen incapable).

The refusal under Section 2(e)(1) based upon the generic nature of “MORMON” for public worship services and providing religious services is hereby MAINTAINED AND CONTINUED.

/Jill C. Alt/
Trademark Attorney
Law Office 114
Tel. (703) 308-9114 Ext.433
Fax: (703) 746-8114

How to respond to this Office Action:

To respond formally using the Office’s Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney’s name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office’s Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office’s web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

church

church (chûrch) *noun*

Abbr. c., C., ch., Ch.

1. A building for public, especially Christian worship.
2. Often **Church**. **a.** The company of all Christians regarded as a mystic spiritual body. **b.** A specified Christian denomination: *the Presbyterian Church*. **c.** A congregation.
3. Public divine worship in a church; a religious service: *goes to church at Christmas and Easter*.
4. The clerical profession; clergy.
5. Ecclesiastical power as distinguished from the secular: *the separation of church and state*.
6. *Christian Science*. “The structure of Truth and Love” (Mary Baker Eddy).

verb, transitive

churched, church-ing, church-es

To conduct a church service for, especially to perform a religious service for (a woman after childbirth).

adjective

Of or relating to the church; ecclesiastical.

[Middle English *chirche*, from Old English *cirice*, ultimately from Medieval Greek *kurikon*, from Late Greek *kuriakon (doma)*, the Lord's (house), from Greek *kuriakos*, of the lord, from *kurios*, lord.]^[1]

Mormon Church

Mormon Church *noun*

A church founded by Joseph Smith at Palmyra in western New York in 1830 and having its headquarters since 1847 in Salt Lake City, Utah. Its doctrines are based chiefly on the Bible, the Book of Mormon, and other revelations made to church leaders. Also called *Church of Jesus Christ of Latter-day Saints*.^[2]

Mormon

Mor·mon (môr¹men) *Mormon Church. noun*

A member of the Mormon Church. In this sense, also called *Latter-day Saint*.

adjective

Of or relating to the Mormons, their religion, or the Mormon Church.

— **Mor¹mon·ism** *noun*^[3]

Church of Jesus Christ of Latter-day Saints

Church of Jesus Christ of Lat·ter-day Saints (lat¹er-dâ´) *noun*

See Mormon Church.^[4]

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TYPED DRAWING

Serial Number

73261134

Status

REGISTERED AND RENEWED

Word Mark

SEVENTH-DAY ADVENTIST

Standard Character Mark

No

Registration Number

1177185

Date Registered

1981/11/10

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS CORPORATION
D.C. 12501 OLD COLUMBIA PIKE SILVER SPRING MARYLAND 209046600

Goods/Services

Class Status -- ACTIVE. IC 016. US 038. G & S: Religious Books, Magazines, Pamphlets, Newsletters, Brochures, Encyclopedias, Dictionaries, Commentaries, Fliers, Bulletins, Yearbooks, Booklets and Bibles. First Use: 1861/00/00. First Use In Commerce: 1861/00/00.

Goods/Services

Class Status -- ACTIVE. IC 036. US 102. G & S: Establishment and Administration of Employee Health Care and Benefit Programs and Medical Insurance Programs. First Use: 1973/00/00. First Use In Commerce: 1973/00/00.

Goods/Services

Class Status -- ACTIVE. IC 041. US 107. G & S: Educational Instruction Services in Academics at Grade School, High School and College Level; Film Production and Distribution Services. First Use: 1894/00/00. First Use In Commerce: 1894/00/00.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100. G & S: Health Care Services-Namely, Hospital, Dental, Pharmaceutical, Nursing Home, and Medical Laboratory Services; Conducting Religious Observances and Missionary Services. First Use: 1860/00/00. First Use In Commerce: 1860/00/00.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ADVENTIST" APART FROM THE MARK AS SHOWN.

Section 2f Statement

IN PART AS TO CLASS 16

Filing Date

1980/05/07

Examining Attorney

UNKNOWN

Attorney of Record

VINCENT L. RAMIK

To: Intellectual Reserve, Inc. (mkrieger@kmclaw.com)
Subject: TRADEMARK APPLICATION NO. 78161091 - MORMON - 6925.600
Sent: 11/1/05 3:25:48 PM
Sent As: ECOM114@USPTO.GOV

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[Attachment - 55](#)
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[Important Email Information]

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/161091

APPLICANT: Intellectual Reserve, Inc.

CORRESPONDENT ADDRESS:

Michael F. Krieger
Kirton & McConkie
1800 Eagle Gate Tower
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Salt Lake City UT 84111

78161091

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: MORMON

CORRESPONDENT'S REFERENCE/DOCKET NO : 6925.600

CORRESPONDENT EMAIL ADDRESS:

mkrieger@kmclaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 78/161091

This letter responds to the applicant's communication filed on 3-17-05. Applicant's 2(f) evidence and declaration has been accepted and entered in the record and the refusal on the basis of mere descriptiveness has been withdrawn with respect to applicant's services in Class 41 and 42.

However, the applicant's argument against the finding that "MORMON" is generic for "religious services, namely, operating places of assembly and gathering for worship by the Church of Jesus Christ of Latter-day Saints for others; ministerial services, namely, providing religious worship services," was not found to be persuasive mandating the issuance of the following FINAL refusal.

FINAL REFUSAL: THE MARK "MORMON" IS GENERIC FOR CLASS 45 SERVICES

The proposed mark, "MORMON," is incapable of serving as a source-identifier for applicant's religious services. Therefore, the refusal of registration under Section 2(e)(1) is *continued* and made FINAL, notwithstanding applicant's claim of acquired distinctiveness under Section 2(f), 15 U.S.C. §1052(f).

Generic Terms Defined

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Generic terms are by definition incapable of indicating a particular source of the services, and cannot be registered as trademarks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Generic Term Need Not be a Noun

A term need not be a noun to be generic. *Miller Brewing Co. v G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978) (LITE held generic for beer); *In re Reckitt & Coleman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (**PERMA PRESS held generic for soil and stain removers for use on permanent press products**); TMEP §1209.01(c)(ii).

Applicant argues earnestly that the term "MORMON" is a not a religious service, but the source of religious services, thus performing the classic job of a service mark, which is to indicate the source of the applicant's goods or services.

This argument is flat-out contrary to the above axiom, bolstered by case law, that the generic term need not be a noun. There are many varied types of churches, in the sense of a church being a facility erected for the primary purpose of providing a place for assembly and gathering for worship, for providing religious worship services. Mormonism is a specific religion. The Mormon Church, also known as “The Mormon Church of Jesus Christ of Latter-day Saints” and the “Church of Jesus Christ of Latter-day Saints” is a Church in the sense of “A specified Christian denomination.

The relevant public reading the term “MORMON” immediately knows that the article or news release or whatever is before them is about the Mormon religion, one of the Christian religions. The term “MORMON” is not a source of religious services, it is the generic term for a particular religion. One expects religions to provide religious services, it is what God or the founders had in mind for them. One expects to find a religious service in a house of religion. In a Mormon house of worship, one expects to find a Mormon Church religious service. The term “MORMON” locates the type of church, the religious affiliation of a worshipper at that church, indicates a certain organized philosophy and belief system. The term “MORMON” is an adjective directly indicating a religious group whose major reason for coming together is to worship publicly in a prescribed way.

THERE ARE NO SIMILAR REGISTRATIONS ON THE PRINCIPAL OR SUPPLEMENTAL REGISTER

Applicant has argued that the mark “SEVENTH-DAY ADVENTIST” is registered. However it is not registered for religious services. It is registered in Class 16 for religious books, in Class 36 for the establishment of employee health care programs and medical insurance programs, in Class 41 for educational instruction services in academics, for film production and distribution and in Class 42 for hospital, dental, pharmaceutical, nursing home and medical laboratory services and for religious observances and missionary services. Further, the term “Adventist” is disclaimed apart from the mark, and the mark is registered under 2(f) in part as to Class 16. Since none of us are perfect, it may well be that the very small “religious observances” was overlooked by the examining attorney. “Consistency of Office practice must be secondary to correctness of Office practice.” 199 USPQ 313 (Comm Pat & Trademarks 1978).

Attached hereto are examples of other registrations including the names of various religions. None of them, nothing on the record shows a mark for Lutheran, Presbyterian, Methodist, Jewish or Judaism, Catholic or Catholicism for religious services. They are all for publications or health care or social programs and none merely employ the religion’s name as a full mark. Often the name of the religion or its adjectival equivalent is disclaimed apart from the mark.

The only way for the generic name of a religion to register for religious services is as a collective membership mark, to show membership in a religious society. One of the generic names of a religion may not register for religious services under Section 2(f), or on the Supplemental Register. Clearly this bears repeating.

From the TMEP: “ 1209.01(c) Generic Terms

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57

USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). **These terms are incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.”**

GENERIC FOR FEATURE OF THE SERVICES

A term that serves as the common descriptor of a key ingredient, characteristic or feature of the goods is also generic and thus incapable of distinguishing source. A term need not relate solely to the name of the services in order to be held incapable of serving as an indicator of origin. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3rd Cir. 1986) (CHOCOLATE FUDGE generic for diet sodas); *Miller Brewing Co. v G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977) (LITE generic for beer), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (PASTEURIZED for face cream incapable); *Roselux Chemical Co, Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (SUDSY generic for ammonia); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (ART DECO generic for flatware); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for stores that sell lingerie); *In re National Patent Development Corp.*, 231 USPQ 823 (TTAB 1986) (ULTRA PURE for interferons for medical use incapable); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of wicker furniture and accessories); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (HENNA 'N' PLACENTA generic of ingredients for hair conditioner); *In re Bee Pollen From England Ltd.*, 219 USPQ 163 (TTAB 1983) (BEE POLLEN FROM ENGLAND for bee pollen incapable).

“MORMON” is just such an indicator. It immediately informs the reader that the religious services provided will be in the style and of the belief system known as “MORMON” as well as the Church of Jesus Christ of Latter-day Saints.

The Attempted “Tide” Analogy

Applicant writes that “TIDE” is an indicator of the source of a detergent just as “MORMON” is an indicator of the source of religious services. Applicant has perhaps forgotten how trademarks become generic terms. “Cellophane” began life as a trademark for transparent package wrap. “Xerox” has come close to losing its trademark status as a copier. It is quite possible that “TIDE” may in years to come become synonymous with “detergent.” However applicant’s situation is somewhat different. Applicant wishes to register the name (or nickname) of a religious society, long known for its somewhat pioneering beliefs, out-of- mainstream practices, magnificent temples and extraordinary missionary efforts both here and abroad, the Book of Mormon and all sorts of articles in the Lexis/Nexis database and on the Internet. The word is known widely to mean a religion and is generic for religious services.

CONCLUSION

Accordingly, for the reasons stated above, the refusal under Section 2(e)(1) of the Trademark Act is hereby made FINAL.

APPROPRIATE RESPONSES TO A FINAL REFUSAL

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R.

§2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Jill C. Alt/
Trademark Attorney
Law Office 114
Tel. (571) 272-9444
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HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
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STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

Side - 1



NOTICE OF ABANDONMENT
MAILING DATE: Aug 22, 2007

The trademark application identified below was abandoned on Aug 22, 2007 after consideration of applicant's appeal to the Trademark Trial and Appeal Board.

SERIAL NUMBER: 78161091
MARK: MORMON
OWNER: Intellectual Reserve, Inc.

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

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Exhibit C

To: Intellectual Reserve, Inc. (broadbentb@ldschurch.org)
Subject: TRADEMARK APPLICATION NO. 77179068 - MORMON.ORG - N/A
Sent: 8/27/2007 3:09:33 PM
Sent As: ECOM102@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/179068

MARK: MORMON.ORG

77179068

CORRESPONDENT ADDRESS:
BERNE S. BROADBENT
THE CHURCH OF JESUS CHRIST OF
LATTER-DAY
50 E. NORTH TEMPLE, ROOM 1880
SALT LAKE CITY, UT 84150-3012

RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

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

APPLICANT: Intellectual Reserve, Inc.

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

N/A

CORRESPONDENT E-MAIL ADDRESS:
broadbentb@ldschurch.org

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 8/27/2007

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Search Results

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Section 2(e)(1) - Descriptive Refusal

Registration is refused because the proposed mark merely describes the subject matter of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*

A mark is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b). A mark that describes an intended user of a product or service is also merely descriptive within the meaning of Section 2(e)(1). *See Hunter Publ'g Co. v. Caulfield Publ'g, Ltd.*, 1 USPQ2d 1996 (TTAB 1986); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant's software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk” where relevant trade uses the denomination “concurrent” as a descriptor of this particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985); *see* TMEP §1209.01(b).

Applicant's proposed mark as a whole is merely descriptive because it consists of the merely descriptive wording “Mormon” for the subject matter of its services, namely “Providing information and instruction in the fields of religion, ethics, moral and religious values, parenting, marital and family relations”, combined with the top-level domain (TLD) “.ORG.” The TLD in the proposed mark indicates an Internet address and adds no source-identifying significance. *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1658-59 (TTAB 2005); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1441 (TTAB 2005); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1792-94 (TTAB 2002); *see* TMEP §§1209.03(m), 1215.01, 1215.05. A dictionary definition of the term “Mormon” is also attached to this office action in support of this refusal.

In *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-1177, 71 USPQ2d 1370, 1372-1374 (Fed. Cir. 2004), the court stated that, as a general rule, the addition of a TLD to otherwise unregistrable wording (i.e., merely descriptive or generic) does not add source-indicating significance except in “unique” or “exceptional” circumstances. Referring to an illustrative hypothetical mark discussed by the court during oral argument, the court gave the following explanation for possible “unique” or “exceptional” circumstances:

This hypothetical applicant's mark consists of a descriptive term – “tennis” – and a TLD – “.net.” The “net” portion alone has no source-identifying significance. The hypothetical mark as a whole, as is immediately apparent, produces a witty double entendre relating to tennis nets, the hypothetical applicant's product. Arguably, the attachment of the TLD to the other descriptive portion of the mark could enhance the prospects of registrability for the mark as a whole. This hypothetical example illustrates that, although **TLDs will most often not add any significant source-identifying function to a mark**, a bright-line rule might foreclose registration of a mark with a TLD component that can demonstrate distinctiveness.

Id. at 1373 (emphasis added).

In the present case, no such exceptional circumstances exist. The non-TLD portion of the mark is

unregistrable, and the addition of the TLD does not create a witty double entendre or add any other significance capable of identifying source or acquiring distinctiveness. When combined, the wording and the TLD retain their common meaning.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Dominic J. Ferraiuolo/
Attorney US Patent & Trademark Office
Law Office 102
tel: (571)-272-9156
fax: (571) 273-9102

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office Action should be filed using the Office's Response to Office action form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Intellectual Reserve, Inc. (broadbentb@ldschurch.org)
Subject: TRADEMARK APPLICATION NO. 77179068 - MORMON.ORG - N/A
Sent: 3/16/2008 3:09:43 PM
Sent As: ECOM102@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/179068

MARK: MORMON.ORG

77179068

CORRESPONDENT ADDRESS:
BERNE S. BROADBENT
THE CHURCH OF JESUS CHRIST OF
LATTER-DAY
50 E. NORTH TEMPLE, ROOM 1880
SALT LAKE CITY, UT 84150-3012

RESPOND TO THIS ACTION:
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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Intellectual Reserve, Inc.

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

CORRESPONDENT E-MAIL ADDRESS:
broadbentb@ldschurch.org

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 3/16/2008

THIS IS A FINAL ACTION.

This letter responds to the Applicant's communication filed on February 22, 2008.

The refusal under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), is now made FINAL for the reasons set forth below. 37 C.F.R. §2.64(a).

A mark is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic,

function, feature, purpose or use of the specified goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b). A mark that describes an intended user of a product or service is also merely descriptive within the meaning of Section 2(e)(1). See *Hunter Publ'g Co. v. Caulfield Publ'g, Ltd.*, 1 USPQ2d 1996 (TTAB 1986); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984).

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For the purpose of a Section 2(e)(1) analysis, a term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“[A] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.”) (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)).

The fact that an applicant may be the first and sole user of a merely descriptive or generic designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and/or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) (COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field); TMEP §1209.03(c).

The evidence attached to this record shows that “.ORG” identifies an Internet address and thus is not a term that serves to indicate a particular source. Applicant’s proposed mark MORMON.ORG identifies the name of a member of a particular religion and the religion as well, , as also referenced by the evidence of record attached to this office action as well as the office action dated August 27, 2007. Applicant’s arguments that the proposed mark as a whole is not merely descriptive of the services in issue, namely “Providing information and instruction in the fields of religion, ethics, moral and religious values, parenting, marital and family relations” must therefore fail. The proposed mark clearly describes the religion that is the subject matter of these services.

Applicant’s arguments center on case law that affirms the use of church names as trademarks. The fact that names of churches can and do serve as trademarks is not in dispute in this case. Rather, it is the use of the name of a religion combined with a top-level domain name to merely describe, as a whole, services that feature the particular religion named in the mark as the subject matter of the services and/or users or providers of these services. It is noted that Applicant’s claimed Registration No. 3239919 for the mark MORMON was in fact registered with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.

Therefore, refusal to register under Section 2(e)(1) is maintained and made final.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). See 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Dominic J. Ferraiuolo/
Attorney US Patent & Trademark Office
Law Office 102
tel: (571)-272-9156
fax: (571) 273-9102

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Response to Office Action

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MARK SECTION (no change)	
ARGUMENT(S)	
<p>This response is being submitted in response to the communication from the Examining Attorney dated April 30, 2008, as well as the communication from the Examining Attorney dated March 16, 2008. In this regard, in the Office Action dated April 30, 2008, the Examining Attorney withdrew the Final Office Action dated March 16, 2008, pending applicant's response to an informality, namely, the need to file a Power of Attorney in the present case.</p> <p>During a brief teleconference between Dale E. Hulse and the Examining Attorney on May 1, 2008, the Examining Attorney indicated that, after a Power of Attorney was in fact submitted in this case, applicant's prior response dated February 22, 2008 would in fact be made of record and would then be considered on the merits by the Examining Attorney. Thus, in a separate earlier submission on May 29, 2008, applicant filed electronically the requested Power of Attorney, thereby providing a complete response to the Office Action dated April 30, 2008, and applicant now incorporates by reference in this response its prior response of February 22, 2008 in response to the Office Action dated March 16, 2008.</p> <p>It is respectfully submitted that, for at least the reasons set forth in applicant's response dated February 22, 2008 which has been incorporated by reference herein, applicant's MORMON.ORG mark is not merely descriptive under the applicable legal standards, and the refusal to register under Section 2(e)(1) should be withdrawn.</p> <p>Thus, applicant firmly maintains its position that its MORMON.ORG mark is inherently distinctive and is not merely descriptive. However, pursuant to T.M.E.P. §1212.02(c), and without prejudice to applicant's position on inherent distinctiveness, applicant respectfully argues in the alternative that the subject mark has acquired distinctiveness under Section 2(f), in part.</p> <p>Thus, without prejudice, applicant makes the following assertion under Section 2(f), in part, based upon applicant's prior registration:</p> <p style="padding-left: 40px;">"MORMON has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No. 3,239,919."</p> <p>With regard to the above alternative submission under Section 2(f), in part, the Examining Attorney's attention is directed towards the fact that very similar "educational" services in International Class 41 are recited in both the present application for MORMON.ORG (providing information and instruction in the fields of religion, ethics, moral and religious values, parenting, marital and family relations) and applicant's U.S. Registration No. 3,239,919 for the mark MORMON (educational services, namely, providing classes,</p>	

conferences, and institutes in the fields of history and religion).

It is respectfully submitted that this application is now in condition for allowance and publication.

Respectfully submitted,

Dale E. Hulse
Attorney for Applicant

SIGNATURE SECTION

DECLARATION SIGNATURE	/Dale E. Hulse/
SIGNATORY'S NAME	Dale E. Hulse
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	05/29/2008
RESPONSE SIGNATURE	/Dale E. Hulse/
SIGNATORY'S NAME	Dale E. Hulse
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	05/29/2008
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Thu May 29 15:40:57 EDT 2008
TEAS STAMP	USPTO/ROA-207.225.193.114 -20080529154057902904-771 79068-420f406d58b0ae903e2 dc45f22248cde-N/A-N/A-200 80529152113350281

Response to Office Action To the Commissioner for Trademarks:

Application serial no. **77179068** has been amended as follows:

ARGUMENT(S)

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

This response is being submitted in response to the communication from the Examining Attorney

dated April 30, 2008, as well as the communication from the Examining Attorney dated March 16, 2008. In this regard, in the Office Action dated April 30, 2008, the Examining Attorney withdrew the Final Office Action dated March 16, 2008, pending applicant's response to an informality, namely, the need to file a Power of Attorney in the present case.

During a brief teleconference between Dale E. Hulse and the Examining Attorney on May 1, 2008, the Examining Attorney indicated that, after a Power of Attorney was in fact submitted in this case, applicant's prior response dated February 22, 2008 would in fact be made of record and would then be considered on the merits by the Examining Attorney. Thus, in a separate earlier submission on May 29, 2008, applicant filed electronically the requested Power of Attorney, thereby providing a complete response to the Office Action dated April 30, 2008, and applicant now incorporates by reference in this response its prior response of February 22, 2008 in response to the Office Action dated March 16, 2008.

It is respectfully submitted that, for at least the reasons set forth in applicant's response dated February 22, 2008 which has been incorporated by reference herein, applicant's MORMON.ORG mark is not merely descriptive under the applicable legal standards, and the refusal to register under Section 2(e)(1) should be withdrawn.

Thus, applicant firmly maintains its position that its MORMON.ORG mark is inherently distinctive and is not merely descriptive. However, pursuant to T.M.E.P. §1212.02(c), and without prejudice to applicant's position on inherent distinctiveness, applicant respectfully argues in the alternative that the subject mark has acquired distinctiveness under Section 2(f), in part.

Thus, without prejudice, applicant makes the following assertion under Section 2(f), in part, based upon applicant's prior registration:

"MORMON has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No. 3,239,919."

With regard to the above alternative submission under Section 2(f), in part, the Examining Attorney's attention is directed towards the fact that very similar "educational" services in International Class 41 are recited in both the present application for MORMON.ORG (providing information and instruction in the fields of religion, ethics, moral and religious values, parenting, marital and family relations) and applicant's U.S. Registration No. 3,239,919 for the mark MORMON (educational services, namely, providing classes, conferences, and institutes in the fields of history and religion).

It is respectfully submitted that this application is now in condition for allowance and publication.

Respectfully submitted,

Dale E. Hulse
Attorney for Applicant

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so

made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Dale E. Hulse/ Date: 05/29/2008

Signatory's Name: Dale E. Hulse

Signatory's Position: Attorney of Record

Response Signature

Signature: /Dale E. Hulse/ Date: 05/29/2008

Signatory's Name: Dale E. Hulse

Signatory's Position: Attorney of Record

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 applicant'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 applicant in this matter: (1) the applicant 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 applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant'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.

Serial Number: 77179068

Internet Transmission Date: Thu May 29 15:40:57 EDT 2008

TEAS Stamp: USPTO/ROA-207.225.193.114-20080529154057

902904-77179068-420f406d58b0ae903e2dc45f

22248cde-N/A-N/A-20080529152113350281

To: Intellectual Reserve, Inc. (broadbentb@ldschurch.org)
Subject: TRADEMARK APPLICATION NO. 77179068 - MORMON.ORG - N/A
Sent: 6/18/2008 11:06:15 AM
Sent As: ECOM102@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/179068

MARK: MORMON.ORG

77179068

CORRESPONDENT ADDRESS:

Berne S. Broadbent
The Church of Jesus Christ of Latter-day
50 E. North Temple Street, Rm. 1880
Salt Lake City UT 84150-3012

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Intellectual Reserve, Inc.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

broadbentb@ldschurch.org

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 6/18/2008

This Office action is in response to applicant's communication filed on May 29, 2008.

Amendment Accepted/Refusal Withdrawn

Applicant's amendment under Section 2(f) of the Trademark Act is accepted. Accordingly, the refusal to register under Section 2(e)(1) of the Trademark Act is withdrawn.

Description Of Services Unacceptable-Wording Indefinite

The wording "Providing information and instruction in the fields of religion, ethics, moral and religious values, parenting, marital and family relations" is unacceptable as indefinite as to the wording "providing

information in the fields of parenting, marital and family relations” and must be amended to further specify the nature and/or type of these fields. *See* TMEP §1402.01. For example, the wording “providing educational instruction, namely classes and workshops in the fields of religion, ethics, moral and religious values, parenting, marital and family relations, and dissemination of printed course materials in connection therewith” is acceptable in Class 41; “Information in the field of parenting concerning education of children” is in Class 41; “Information about parenting topics, namely, drug and alcohol awareness” is in Class 44; “Information in the field of parenting concerning intrafamily relationships” is in Class 45; “information about marriage counseling” is in Class 45..

Although identifications of services may be amended 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* TMEP §§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.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

Combined Applications

The application identifies goods and/or services that are classified in at least three classes; however, the fees submitted are sufficient for only one class. In a multiple-class application, a fee for each class is required. 37 C.F.R. §2.86(a)(2); TMEP §§810.01, 1403.01.

Therefore, applicant must either (1) restrict the application to the number of class(es) covered by the fee(s) already paid, or (2) submit the fees for the additional class(es).

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the following for those goods and/or services based on an intent to use the mark in commerce under Trademark Act Section 1(b):

- (1) Applicant must list the goods and/or services by international class; and
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>).

See 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney.

/Dominic J. Ferraiuolo/
Attorney US Patent & Trademark Office
Law Office 102
tel: (571)-272-9156

fax: (571) 273-9102

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Intellectual Reserve, Inc. (broadbentb@ldschurch.org)
Subject: TRADEMARK APPLICATION NO. 77179068 - MORMON.ORG - N/A
Sent: 6/18/2008 11:06:21 AM
Sent As: ECOM102@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 6/18/2008 FOR
APPLICATION SERIAL NO. 77179068

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link
http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77179068&doc_type=OOA&
(or copy and paste this URL into the address field of your browser), or visit
<http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to access the
Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from **6/18/2008**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

1. The USPTO will NOT send a separate e-mail with the Office action attached.

2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.

Exhibit D

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

APPLICATION SERIAL NO. 85425334

MARK: MORMON SAVINGS

85425334

CORRESPONDENT ADDRESS:

PACKAGING CONSULTING SERVICES, INC.

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

PACKAGING CONSULTING SERVICES, INC.

6951 SPRING PLACE RD SE
OLD FORT, TN 37362-5370

APPLICANT: Packaging Consulting Services,
Inc.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on June 29, 2012. The refusal under Trademark Act Section 2(e)(1) is now made FINAL for the reasons set forth below. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a). The requirement to submit an acceptable identification of services is maintained and made FINAL.

SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE

Registration is refused because the applied-for mark merely describes a characteristic of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Applicant's arguments have been considered and found unpersuasive for the reason(s) set forth below.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

Applicant applied to register MORMON SAVINGS for "Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail and commercial websites of others, and discount information from websites; promoting the goods and services of others by providing hypertext links to the web sites of others; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of consumer goods and commodities; auctioneering and electronic auction services; providing an on-line searchable database featuring business information and marketing information for retail, wholesale and commercial businesses; providing an on-line directory information service featuring information regarding business; electronic classified advertising and marketing services."

The definition of the term "Mormon" is "latter-day saint; especially : a member of the Church of Jesus Christ of Latter-day Saints." See attachments. The definition of the term "savings" was provided in the last office action and means "tending to save or preserve." See attachments.

Although applicant indicates that "MORMON SAVINGS" has other meanings, the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

The attached web pages show that the term MORMON is a descriptive term and refers to members of The Church of Latter-Day Saints. See attachments. The attached web pages show that the terms Latter-Day Saints, and LDS refers to member of The Church of Latter-Day Saints. See attachments. The attached web pages show these terms are used in connection business directory services and promoting the goods and services. Here, the term Mormon indicates that directories are for Mormons and contain businesses that are owned by Mormons. See attachments. Note the following examples:

- <http://www.mormonbusiness.com/>: This web site provides a business directory of Mormon businesses.
- <http://www.mormonbusinessdirectory.com/benefits.asp>: This web site provides a business directory of Mormon businesses.
- <http://www.ldslinkup.com/introfaq.asp>: The web site provides Mormon business information.
- <http://www.ldsphonebook.com/>: This website provides a directory of Mormon businesses.

The attached web pages show information about savings that are geared towards Mormons. Note the following examples:

- <http://latterdaycents.com/home-3/deborah-naves/>: This web site provides information for Latter-Day Saints to save money.
- <http://www.retailmenot.com/coupons/latterdaysaints>: This web page states “Listed below you'll find some of the best latter day saints coupons, discounts and promotion codes as ranked by the users of RetailMeNot.com.”
- <http://www.tjoos.com/Coupon/187721/Lds-gifts.com>: This web site provides coupons and gifts directed towards Latter-Day Saints.

The trademark examining attorney refers to the excerpted articles from the LexisNexis® computerized database in which a number of articles show the term “savings” used in connection with coupons and additional articles show that savings are commonly advertised. See attachments. The attached evidence from the Internet show that auctions provide savings to consumers. See attachments. Thus, the wording SAVINGS is commonly used in connection with the applicant’s services and indicates that consumers may save money.

The applicant’s mark MORMON SAVINGS is merely descriptive of the services because it indicates that the services are provided for Mormons or provided by Mormons to help with saving money. Specifically, the applicant’s “Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail and commercial websites of others, and discount information from websites; promoting the goods and services of others by providing hypertext links to the web sites of others; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of consumer goods and commodities; auctioneering and electronic auction services; providing an on-line searchable database featuring business information and marketing information for retail, wholesale and commercial businesses; providing an on-line directory information service featuring information regarding business; electronic classified advertising and marketing services” are for Mormons or provided by Mormons to save money.

The disclaimer of the wording SAVINGS does not overcome the refusal under Trademark Act Section 2(e)(1). Registration is refused because the proposed mark MORMON SAVINGS is merely describes a characteristic of the applicant’s services.

SUPPLEMENTAL REGISTER

Applicant may respond the refusal by amending the application to seek registration on the Supplemental Register. **A mark in an application under Trademark Act Section 1(b) is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been filed. 37 C.F.R. §§2.47(d), 2.75(b); TMEP §§815.02, 1102.03.** When a Section 1(b) application is successfully amended to the Supplemental Register, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(e) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03.

Although registration on the Supplemental Register does not afford all the benefits of registration on the

Principal Register, it does provide the following advantages:

- The registrant may use the registration symbol ®;
- The registration is protected against registration of a confusingly similar mark under Trademark Act Section 2(d);
- The registrant may bring suit for infringement in federal court; and
- The registration may serve as the basis for a filing in a foreign country under the Paris Convention and other international agreements.

See 15 U.S.C. §§1052(d), 1091, 1094; TMEP §815.

IDENTIFICATION OF SERVICES

THIS REQUIREMENT APPLIES ONLY TO THE SERVICES SPECIFIED THEREIN

The wording “the bringing together, for the benefit of others, of a variety of goods; enabling customers to conveniently view and purchase those goods in the field of consumer goods and commodities” in the identification of services is indefinite and must be clarified. Applicant should further specify the “field of consumer goods and commodities” with greater specificity. *See* TMEP §1402.01. Applicant may substitute the following wording, if accurate:

Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail and commercial websites of others, and discount information from websites; promoting the goods and services of others by providing hypertext links to the web sites of others; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of **[further specify the type or field of consumer goods and commodities]**; auctioneering and electronic auction services; providing an online searchable database featuring business information, advertising information and marketing information for retail, wholesale and commercial businesses; providing an on-line directory information service featuring information regarding business; electronic classified advertising and marketing services, in class 35.

An applicant may amend an identification of services 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* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or 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/netathtml/tidm.html>. *See* TMEP §1402.04.

RESPONSE TO FINAL OFFICE ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per

class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to 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).

/Ramona Ortiga Palmer/
Trademark Examining Attorney
ramona.ortiga-palmer@uspto.gov
Law Office 117
571-272-9715

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail 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 Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, 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/teas/eTEASpageE.htm>.

108B8C

Time of Request: Monday, August 13, 2012 21:29:49 EST
Client ID/Project Name:
Number of Lines: 414
Job Number: 1826:365005301

Research Information

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

APPLICATION SERIAL NO. 85537316

MARK: MORMON IN MANHATTAN

85537316

CORRESPONDENT ADDRESS:

RICHARD L. HILL
4844 N 300 W STE 300
PROVO, UT 84604-5670

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Natalie Hill

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

Search of Office's Database of Marks

The Office records have been searched and there are no similar registered or pending marks that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

However, registration must be refused for the following reason.

Section 2(e)(1) Refusal

Registration is refused because the applied-for mark merely describes a feature or characteristic of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP

§§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); *see In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

In this case, the applicant has applied to register the mark “MORMON IN MANHATTAN” for “On-line journals, namely, blogs featuring information about New York City and about living in and visiting New York City; Entertainment services, namely, an on-going series of programs and/or documentaries provided through television, webcasts, and/or radio broadcasts; Entertainment services, namely, continuing programs, segments, movies and/or shows.”

The mark consists of wording which is not arbitrary, but bears a logical relationship to the services. The term MORMON is defined as “A member of the Mormon Church. Also called Latter-day Saint; Of or relating to the Mormons, their religion, or the Mormon Church.” See the attached online definition. The applicant’s specimen indicates that she is Mormon. See attached copy of specimen. The term MANHATTAN is defined as “A borough of New York City in southeast New York, mainly on Manhattan Island at the north end of New York Bay.” See attached online dictionary definition. The applicant is located in New York City, as evidenced by the application, and is providing information about Manhattan. The attached copy of the applicant’s specimen indicates that the applicant is Mormon and is providing information about Manhattan. MORMON IN MANHATTAN is merely descriptive of a feature or characteristic of the relevant services because the writer of the blog/creator of the entertainment services is writing and providing information about Manhattan, a borough of New York City.

In light of the above, the proposed mark, MORMON IN MANHATTAN merely describes a feature or characteristic of the services and has no separate, nondescriptive meaning. Accordingly, registration must be refused under Section 2(e)(1) of the Trademark Act.

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by

submitting evidence and arguments in support of registration.

The applicant should note the following.

Supplemental Register Suggested

The applied-for mark has been refused registration on the Principal Register. Applicant may respond to the refusal by submitting evidence and arguments in support of registration and/or by amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. Amending to the Supplemental Register does not preclude applicant from submitting evidence and arguments against the refusal(s). TMEP §816.04.

Although registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register, it does provide the following advantages:

- The registrant may use the registration symbol ®;
- The registration is protected against registration of a confusingly similar mark under Trademark Act Section 2(d);
- The registrant may bring suit for infringement in federal court; and
- The registration may serve as the basis for a filing in a foreign country under the Paris Convention and other international agreements.

See 15 U.S.C. §§1052(d), 1091, 1094; TMEP §815.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

U.S. Patent and Trademark Office
/Amy Alfieri/
Amy Alfieri
Examining Attorney, Law Office 109
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Email: amy.alfieri@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail 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 Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, 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/teas/eTEASpageE.htm>.

To: Maher, Timothy R. (pudall@BoothUdall.com)
Subject: TRADEMARK APPLICATION NO. 78833327 - BABY MORMON - 1099.002
Sent: 9/1/2006 9:23:15 AM
Sent As: ECOM116@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/833327

APPLICANT: Maher, Timothy R.

CORRESPONDENT ADDRESS:
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MARK: BABY MORMON

CORRESPONDENT'S REFERENCE/DOCKET NO : 1099.002

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78833327

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P.O. Box 1451
Alexandria, VA 22313-1451

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/833327

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

No Conflicting Marks Noted

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Mark is Merely Descriptive

Registration is refused because the proposed mark merely describes feature, function, purpose or use of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re BrightCrest, Ltd* 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b). A mark that describes an intended user of a product or service is also merely descriptive within the meaning of Section 2(e)(1). *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984); *In re Gentex Corp.*, 151 USPQ 435 (TTAB 1966).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (Board found that DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of "computer programs recorded on disk;" it is unnecessary that programs actually run "concurrently," as long as relevant trade clearly uses the denomination "concurrent" as a descriptor of this particular type of operating system); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) ("Whether consumers could guess what the product is from consideration of the mark alone is not the test"); TMEP §1209.01(b).

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. However, if each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of "facsimile terminals employing electrophoretic displays"); *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts).

The applicant applied to register the mark BABY MORMON for "Audio, visual, and audiovisual recordings in all media featuring entertainment, instruction, music, stories, natural sounds, spoken words,

photographic images, graphic images and/or animation,” and “Books, activity books, picture books, coloring books, workbooks, comic books, composition books, music books, booklets, manuals, pamphlets, newsletters, brochures, note cards, sketch pads, memo pads, note pads, flash cards, calendars, caricatures, pictures, color prints, greeting cards, lunch bags, note paper, pencils, pens, photo albums, scrapbook albums, posters, sheet music, temporary tattoos, and trivia cards; Pants, shorts, shortalls, dresses, skirts, jumpers, rompers, jumpsuits, overalls, coveralls, onesies, sleepers, shirts, blouses, sweaters, jackets, socks, slippers, shoes, hats, caps, and cloth bibs; Bed sheets, bed linens, bed blankets, bed spreads, pillow cases, comforters, and baby blankets, hooded towels and washcloths.”

The term BABY is defined as, “Of or having to do with a baby.” *The American Heritage Dictionary of the English Language, Fourth Edition*. Copyright 2000 by Houghton Mifflin Company. (See attachments).

The term MORMON is defined as, “Of or relating to the Mormons, their religion, or the Mormon Church.” *The American Heritage Dictionary of the English Language, Fourth Edition*. Copyright 2000 by Houghton Mifflin Company. (See attachments).

In this case, the mark BABY MORMON merely combines descriptive terms without creating a new non-descriptive meaning. The mark would be immediately understood as describing a feature, function, purpose of use of the goods including, among other things, audio, visual, and audiovisual recordings featuring entertainment, instruction, music, stories, spoken words, photographic images, graphic images and/or animation and/or books, activity books, picture books, coloring books, workbooks, comic books, composition books, music books, booklets, manuals, pamphlets, newsletters, brochures, note cards, flash cards, calendars, caricatures, pictures, color prints, greeting cards of/for children concerning Mormonism, and/or clothing, blankets, linen towels and washcloths intended for use by Mormon infants.

Applicant should note the following additional ground for refusal.

Mark is Deceptively Misdescriptive

Alternatively, to the extent that the proposed mark does not describe any aspect of the goods, then the idea that it conveys would be false because, given the nature of the goods, it is plausible that the proposed mark would immediately be understood as describing some aspect of the goods.

The test for deceptive misdescriptiveness has two parts: (1) whether the mark misdescribes a characteristic, quality, function, composition or use of the goods or services; and if so, (2) would consumers be likely to believe the misrepresentation. *See In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993); *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987); *In re Quady Winery, Inc.*, 221 USPQ 1213 (TTAB 1984).

Therefore, to the extent that the proposed mark does not describe any aspect of the goods, as indicated above, the examining attorney concludes that the proposed mark would be deceptively misdescriptive and, therefore, in the alternative, registration is refused on that basis as well.

Advisory Concerning Supplemental Register

A mark in an application under Trademark Act Section 1(b) is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been filed. 37 C.F.R. §§2.47(d) and 2.75(b); TMEP §1102.03. When a Section 1(b) application is amended to the Supplemental Register, the effective filing date of the application is the date of filing of the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§206.01 and 1102.03.

Requirements

Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If applicant chooses to respond to the refusal(s) to register, then applicant must also respond to the following requirement(s).

Identification of Goods

The current wording used to describe the goods needs clarification because it does not identify all of the goods by the common commercial name, and/or it does not identify the subject matter of all of the printed and/or recorded goods, and/or it does not identify the types of media that the recorded goods are recorded on, and/or it misclassifies some of the goods, and/or it combines together goods from several different classes. Applicant must amend the identification of goods to specify the common commercial or generic name, and correct classification, for all of the goods. If there is no common commercial or generic name for the product, then applicant must describe the product and intended consumer as well as its main purpose and intended uses. TMEP §1402.01. Applicant may adopt the following identification of goods, if accurate:

International Class 9

A series of audio, visual, and audiovisual recordings on (identify the types of “media” by the common commercial name, e.g., audio cassette tapes, video cassette tapes, CD’s and DVD’s) featuring (identify the specific type of “entertainment,” e.g., children’s stories), instruction in the field of (indicate the specific field of instruction, e.g., the Mormon religion), music, (specify the types of “stories,” e.g., children’s stories and religious stories), natural sounds, spoken words concerning (identify the subject matter of the spoken messages), photographic images, graphic images and/or animation.

International Class 16

Books in the field of (identify the subject matter of the books), children’s activity books, picture books, coloring books, workbooks directed to (indicate the subject matter), comic books, composition books, printed music books, booklets in the field of (indicate subject matter), manuals in the field of (indicate area of use), pamphlets in the field of (indicate subject matter), newsletters in the field of (indicate subject matter), brochures in the field of (indicate subject matter), note cards, sketch pads, memo pads, note pads, flash cards, calendars, caricatures, pictures, color prints, greeting cards, lunch bags, note paper, pencils, pens, photo albums, scrapbook albums, posters, sheet music, temporary tattoos, and trivia cards.

International Class 24

Bed sheets, bed linens, bed blankets, bed spreads, pillow cases, comforters, and baby blankets, hooded towels and washcloths.

International Class 25

Pants, shorts, shortalls, dresses, skirts, jumpers, rompers, jumpsuits, overalls, coveralls, infant and toddler one piece clothing, infant sleepers, shirts, blouses, sweaters, jackets, socks, slippers, shoes, hats, caps, and cloth bibs.

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see

the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>.

Requirements for Combined Applications

Applicant must clarify the number of classes for which registration is sought. The submitted filing fees are insufficient to cover all the classes in the application. Specifically, the application identifies goods that are classified in at least four international classes, however applicant paid the fee for only two classes.

Applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. §2.86(a)(2); TMEP §§810.01, 1401.04, 1401.04(b) and 1403.01.

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the following for those goods based on an intent to use the mark in commerce under Trademark Act Section 1(b):

- (1) Applicant must list the goods by international class with the classes listed in ascending numerical order. TMEP § 1403.01; and
- (2) Applicant must submit a filing fee for each international class of goods not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>). 37 C.F.R. §2.86(a)(2); TMEP §§810 and 1403.01.

Requirement for Advertising or Information Concerning the Goods

Applicant must submit samples of advertisements or promotional materials and a photograph of the identified goods because the nature of the goods on which applicant intends to use its mark is not clear from the present record. If such materials are not available, then applicant must submit samples of advertisements or promotional materials and a photograph of *similar* goods. In addition, applicant must describe in some detail the nature, purpose and channels of trade of the goods listed in the application. 37 C.F.R. §2.61(b); TMEP §§814 and 1402.01(e).

/John Dwyer/
Examining Attorney
Law Office 116
Telephone 571-272-9155
Facsimile 571-273-9116

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of receipt in the Office.**

not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

To: Maher, Timothy R. (trademark@boothudall.com)

Subject: TRADEMARK APPLICATION NO. 78833327 - BABY MORMON - 1099.002

Sent: 6/25/2007 12:36:00 PM

Sent As: ECOM116@USPTO.GOV

Attachments: [Attachment - 1](#)
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/833327

MARK: BABY MORMON

78833327

CORRESPONDENT ADDRESS:

Pacer K. Udall
Booth Udall PLC
1155 W. Rio Salado Pkwy., Ste. 101
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RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Maher, Timothy R.

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

1099.002

CORRESPONDENT E-MAIL ADDRESS:

trademark@boothudall.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 6/25/2007

This letter responds to the applicant's correspondence dated May 30, 2007.

The applicant (1) argued against the refusal to register the mark under Section 2(e)(1) as merely descriptive; (2) argued against the refusal to register the mark under Section 2(e)(1) as deceptively misdescriptive; (3) amended the identification of goods; and, (4) submitted information concerning the goods. Nos. 3 and 4 are accepted and made part of the record.

The refusal to register the mark under Section 2(e)(1) as merely descriptive, and the refusal to register the mark under Section 2(e)(1) as deceptively misdescriptive, are maintained and made final.

Mark is Merely Descriptive

The refusal under Trademark Act Section 2(e)(1) as merely descriptive, 15 U.S.C. §1052(e)(1), is now made FINAL for the reasons set forth below. 37 C.F.R. §2.64(a).

A mark is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b). A mark that describes an intended user of a product or service is also merely

descriptive within the meaning of Section 2(e)(1). See *Hunter Publ'g Co. v. Caulfield Publ'g, Ltd.*, 1 USPQ2d 1996 (TTAB 1986); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); see, e.g., *In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk” where relevant trade uses the denomination “concurrent” as a descriptor of this particular type of operating system); see TMEP §1209.01(b).

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (holding SUGAR & SPICE not to be merely descriptive of bakery products). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. E.g., *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (finding GROUP SALES BOX OFFICE descriptive for theater ticket sales services). The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark so created imparts an incongruous meaning as used in connection with the goods and/or services. Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive. E.g., *In re Copytele Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *Associated Theatre Clubs*, 9 USPQ2d at 1662.

The applicant applied to register the mark BABY MORMON for “Audio, visual, and audiovisual recordings designed to stimulate the learning capabilities of infants and young children, namely, pre-recorded videotapes, videodiscs, DVDS, CD-ROMS, audio cassettes and audio CDs, all featuring music, natural sounds, spoken words, photographic images, graphic images and/or animation” and “Children's books, children's activity books, picture books, coloring books, comic books, composition books, music books, note cards, sketch pads, memo pads, note pads, flash cards, calendars, caricatures, pictures, color prints, greeting cards, lunch bags, note paper, pencils, pens, photo albums, scrapbook albums, posters, sheet music, temporary tattoos, and trivia cards.”

The term BABY is defined as “A very young child; an infant.” *The American Heritage Dictionary of the English Language, Fourth Edition*. Copyright 2000 by Houghton Mifflin Company. (See attachments).

The term MORMON is defined as “*Same as Latter-Day Saint*,” “relating to the Church of Jesus Christ of Latter-Day Saints” and “a member of the Church of Jesus Christ of Latter-Day Saints, founded by Joseph Smith in 1830 and centered in Salt Lake City, Utah.” *Encarta World English Dictionary [North American Edition]*. Copyright 2007 by Microsoft Corporation. (See attachments).

The examining attorney searched the Internet using the Google® search engine for the term “Mormon” in relation to “teaching aids,” “children,” “CD-ROM” and “DVD.” Attached for the applicant’s reference are copies of representative webpages demonstrating the descriptive significance of the term MORMON in relation to recorded and/or printed goods which feature information concerning Mormons, Mormonism, and/or are for use by Mormons. (See attachments).

The examining attorney searched the Patent and Trademark Office computerized database for registered third party marks which disclaim the term BABY in relation to the same or similar goods as the

applicant's identified goods. Attached for the applicant's reference are copies of representative third party registrations which demonstrate that the term BABY has previously been disclaimed as descriptive in relation to the same or similar goods as the applicant's identified goods. (See attachments).

The examining attorney searched the Patent and Trademark Office computerized database for registered third party marks which disclaim the term MORMON, or which are registered under Section 2(f) or on the Supplemental Register, in relation to the subject matter and/or intended users of goods and services. Attached for the applicant's reference are copies of representative third party registrations which demonstrate that the term MORMON has previously been treated as descriptive. (See attachments).

The applicant's own website clearly indicates that the goods are for babies and the subject matter is religious-based wherein it provides, in part, "Our goal with the Baby Mormon video series is to provide a true learning environment for your small child ..."; "Through extensive research, Kelley found there was indeed a demand for Gospel-based developmental videos – helping parents connect Heaven and Earth for their children. Hence the Baby Mormon video series was born," "Our goal with the Baby Mormon video series is to provide a true learning environment for your small child - connecting Heaven and Earth. As LDS parents, we constantly strive to familiarize our small children with the World around them. We believe that it is even more important to teach them the Gospel of Jesus Christ. Through the use of Primary music and gospel themes, we reiterate the very message you are aiming to teach each day in your home" and "Baby Mormon is the perfect mix of gospel, education & entertainment!" (See attachments).

In this case, the mark BABY MORMON immediately identifies the intended users or the goods, namely, Mormon children, and/or the intended users and subject matter of the goods, namely, small children and the Mormonism. Accordingly, the mark is refused registration on the Principal Register under Section 2(e)(1) as merely descriptive of the goods.

The applicant argues that the term BABY MORMON is not found in a dictionary, the term MORMON has additional meaning, and that the examining attorney has improperly dissected the mark.

The fact that a term is not found in the dictionary is not controlling on the question of registrability. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b).

Descriptiveness is considered in relation to the relevant goods and/or services. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974); TMEP §1209.03(e).

Examining the component terms of a mark is not the same thing as dissecting a mark, so long as the determination of descriptiveness is made with regard to the mark as a whole. Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive. *E.g., In re Copytele Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *Associated Theatre Clubs*, 9 USPQ2d at 1662.

Applicant should note the following additional ground for refusal.

Mark is Deceptively Misdescriptive

In the alternative, the refusal to register the mark Trademark Act Section 2(e)(1) as deceptively misdescriptive, 15 U.S.C. §1052(e)(1), is now made FINAL for the reasons set forth below. 37 C.F.R.

§2.64(a).

The applicant applied to register the mark BABY MORMON for “Audio, visual, and audiovisual recordings designed to stimulate the learning capabilities of infants and young children, namely, pre-recorded videotapes, videodiscs, DVDS, CD-ROMS, audio cassettes and audio CDs, all featuring music, natural sounds, spoken words, photographic images, graphic images and/or animation” and “Children's books, children's activity books, picture books, coloring books, comic books, composition books, music books, note cards, sketch pads, memo pads, note pads, flash cards, calendars, caricatures, pictures, color prints, greeting cards, lunch bags, note paper, pencils, pens, photo albums, scrapbook albums, posters, sheet music, temporary tattoos, and trivia cards.”

The term BABY is defined as “A very young child; an infant.” *The American Heritage Dictionary of the English Language, Fourth Edition*. Copyright 2000 by Houghton Mifflin Company. (See attachments).

The term MORMON is defined as “*Same as Latter-Day Saint*,” “relating to the Church of Jesus Christ of Latter-Day Saints” and “a member of the Church of Jesus Christ of Latter-Day Saints, founded by Joseph Smith in 1830 and centered in Salt Lake City, Utah.” *Encarta World English Dictionary [North American Edition]*. Copyright 2007 by Microsoft Corporation. (See attachments).

In this case, potential purchasers of the goods would reasonably believe that the goods are for Mormon children and/or are for children and the subject matter relates to Mormonism. Since potential purchasers would reasonably believe that the applicant’s BABY MORMON products are for Mormon children and/or are for children and the subject matter relates to Mormonism, then to the extent that the mark does not describe the goods, the mark is deceptively misdescriptive.

Accordingly, the refusal to register the mark under Section 2(e)(1) as deceptively misdescriptive is maintained and made final.

--Advisory Regarding Supplemental Register

A mark in an application under Trademark Act Section 1(b) is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been filed. 37 C.F.R. §§2.47(d) and 2.75(b); TMEP §1102.03. When a Section 1(b) application is amended to the Supplemental Register, the effective filing date of the application is the date of filing of the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§206.01 and 1102.03.

Options

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/John Dwyer/
Examining Attorney
Law Office 116
Telephone 571-272-9155
Facsimile 571-273-9116

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office Action should be filed using the Office's Response to Office action form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: S N D Enterprises Corporation (gmh@pwlaw.com)
Subject: TRADEMARK APPLICATION NO. 78608815 - MORMON MAGNETS - N/A
Sent: 11/11/2005 6:44:46 PM
Sent As: ECOM106@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/608815

APPLICANT: S N D Enterprises Corporation

CORRESPONDENT ADDRESS:

GREGORY M. HESS
PARR WADDOUPS BROWN GEE & LOVELESS, P.C.
185 S STATE ST STE 1300
SALT LAKE CITY, UT 84111-1537

78608815

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: MORMON MAGNETS

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

CORRESPONDENT EMAIL ADDRESS:

gmh@pwlaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-

MAILING DATE.

Serial Number 78/608815

The assigned trademark examining attorney has reviewed the referenced application and determined the following.

Search Results.

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). *Trademark Manual of Examining Procedure Section 704.01.*

The applicant should note the following ground for refusal.

STATUTORY REFUSAL: THE MARK IS MERELY DESCRIPTIVE.

The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the goods. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); *Trademark Manual of Examining Procedure Section 1209*, (3rd Edition January 2002).

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re BrightCrest, Ltd.* 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

The applicant's mark is MORMON MAGNETS for magnets.

The term MORMON is defined in pertinent part as follows:

Mor·mon

Mor·mon (môr¹men) *Mormon Church. noun*

A member of the Mormon Church. In this sense, also called *Latter-day Saint*.

adjective

Of or relating to the Mormons, their religion, or the Mormon Church.

— **Mor¹mon·ism** *noun* [1]

The goods are magnets. It is presumed that the goods feature or have some relation to the Mormon Church. Historically, when the term MORMON is used in combination with the generic wording for goods, Office practice requires that the mark be found merely descriptive since they feature or have some relation to the Mormon Church. Such marks are registered either on the Supplemental Register or on the Principal Register but only after the applicant shows that the mark has acquired distinctiveness under Section 2(f). See the attached registrations. This examining attorney finds the entire mark merely descriptive and registration is therefore refused.

The examining attorney can not now recommend an amendment to the Supplemental Register because the application was filed under Trademark Act Section 1(b). A mark in an application under Trademark Act Section 1(b) is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 or statement of use under 37 C.F.R. §2.88 has been filed. 37 C.F.R. §§2.47(d) and 2.75(b); TMEP §1102.03. When a Section 1(b) application is amended to the Supplemental Register, the effective filing date of the application is the date of filing of the allegation of use. 37 C.F.R. §2.75(b); TMEP §§206.01 and 1102.03.

Regarding a possible claim of acquired distinctiveness under Section 2(f), an intent-to-use applicant who has used the mark on related goods or services may file a claim of acquired distinctiveness under Trademark Act Section 2(f) before filing an amendment to allege use or a statement of use if applicant can establish that, as a result of applicant's use of the mark on *other* goods or services, the mark has become distinctive of the goods or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and services in the intent-to-use application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); TMEP §1212.09(a). The Trademark Trial and Appeal Board has set forth the requirements for showing that a mark in an intent-to-use application has acquired distinctiveness:

- (1) Applicant must establish that the same mark has acquired distinctiveness as to the other goods and/or services, by submitting evidence such as ownership of a prior registration for the same mark for related goods and/or services, a *prima facie* showing of acquired distinctiveness based on five years' use of the same mark with related goods and/or services, or actual evidence of acquired distinctiveness for the same mark with respect to the other goods and/or services; *and*
- (2) Applicant must submit evidence to establish a sufficient relationship between the goods and/or services in connection with which the mark has acquired distinctiveness and the goods and/or services recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods and/or services in the application upon use.

In re Rogers, 53 USPQ2d 1741 (TTAB 1999).

Applicant may not amend an application filed under Section 1(b) (intent to use in commerce) to assert a Section 1(a) (use in commerce) basis unless applicant also files an allegation of use under Trademark Act Sections 1(c) or 1(d), 15 U.S.C. §§1051(c) or (d). 37 C.F.R. §2.35(b)(8).

In order to avoid abandonment, the applicant must respond to the refusal to register and may do so by submitting evidence and arguments in support of registration.

Responding to this Office Action.

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office

action, and the applicant's telephone number.

If the applicant has any questions or needs assistance in responding to this Office Action, please telephone the assigned examining attorney. However, you may be able to receive a response faster by sending me an email at john.dalier@uspto.gov with any questions regarding this Office Action. Note that this email address is not for responses to Office Actions, just questions about Office Actions.

Copies of Documents

The applicant may view and download any or all documents contained in the electronic file wrapper of all pending trademark applications, as well as many registrations via the Trademark Document Retrieval (TDR) system available online at: <http://portal.uspto.gov/external/portal/tow>. Currently, you can access all pending applications and all Madrid Protocol filings, and also many registrations, via TDR. The USPTO is in the process of converting all remaining registrations into a digital format, to permit future TDR access. This conversion process is expected to take several years.

Downloads are converted into PDF format and may be viewed with any PDF viewer, including the free Adobe Reader.

/John D. Dalier/
Trademark Examining Attorney
Law Office 106; 571 272 9150
Fax (571) 273-9106

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **DECLARATION OF SIDDARTHA RAO IN SUPPORT OF APPLICANT'S MOTION TO DISMISS OPPOSITION** is being filed electronically to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on April 5, 2014.

/Siddartha Rao/
Siddartha Rao, Esq.

CERTIFICATE OF SERVICE

I hereby certify that on April 5, 2014 a copy of the foregoing **DECLARATION OF SIDDARTHA RAO IN SUPPORT OF APPLICANT'S MOTION TO DISMISS OPPOSITION** was served on Intellectual Reserve, Inc. by depositing said copy with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Dale E. Hulse
Counsel for Intellectual Reserve Inc.
KIRTON MCCONKIE
1800 World Trade Center at
City Creek, 60 East South Temple
Salt Lake City, UT 84111

/Siddartha Rao/
Siddartha Rao, Esq.