

TTAB

June 8, 2005

VIA EXPRESS MAIL

United States Patent and Trademark Office
Madison West Building
600 Dulany St.
Alexandria, VA 22313

Re: *Petition to Cancel*

76098947
76099449

Dear Sir or Ma'am,

Enclosed for filing please find the Petition to Cancel the marks for FUNKY MUNKY, Registration Nos. 2,863,952 and 2,865,908 and a check for \$600.00 for filing of the same. If you have any questions or need further information, please contact me at your convenience.

Very truly yours,

Megan M. Auchincloss

Enclosures

1620 Market Street, Suite 3W
Denver, Colorado 80202

720.974.4000 phone 720.974.4050 fax
www.mastlaw.com

Of Counsel, Arthur H. Travers



06-09-2005

U.S. Patent & TMOtc/TM Mail Rpt Dt. #64

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

In the matter of trademark Registration Nos. 2,865,908 and 2,863,952
For the marks FUNKY MUNKY
Registered on July 27, 2004 and July 20, 2004, respectively

Johnny Ray Company, Inc.,

v.

Jodi Galle,

Cancellation No. _____

06/13/2005 THCCANTS 00000042 2865908

01 FC:6401

300.00 OP

PETITION TO CANCEL

Petitioner's name and address:

Johnny Ray Company, Inc.
1129 Pearl St.
Boulder, Colorado 80302

Notification should be sent to:

David Mastbaum
Megan M. Auchincloss
Mastbaum & Moffat LLP
P.O. Box 806
Boulder, Colorado 80306

To the best of Petitioner's knowledge, the name and address of the current owner
of the two registered marks at issue are:

Jodi Galle
1586 Spring Hill Mall
West Dundee, Illinois 60118

06/13/2005 THCCANTS 00000039 76099449

01 FC:6401

300.00 OP

Void date: 06/13/2005 THCCANTS

06/13/2005 THCCANTS 00000039 76099449

01 FC:6401

-300.00 OP

The above-identified Petitioner believes that it will be damaged by the above-identified registrations because Petitioner has been utilizing the mark FUNKY MONKEY since October 1994 to identify and promote its retail stores featuring apparel and other merchandise. Therefore, Petitioner hereby petitions to cancel the two FUNKY MUNKY marks identified above.

The grounds for cancellation are as follows:

1. Petitioner has used the mark FUNKY MONKEY to identify and promote its retail stores featuring apparel and other merchandise. The mark was first used by the Petitioner in October 1994 and also was first used in interstate commerce by the Petitioner in October 1994. The mark has since and continues to be so used in interstate commerce. An invoice reflecting Petitioner's use of the mark dated December 3, 1994 is attached as Exhibit A.

2. On January 28, 2004, Petitioner filed an application with the United States Patent and Trademark Office to register its mark for "[r]etail variety stores; retail stores featuring miscellaneous general merchandise." A copy of the application is attached hereto as Exhibit B.

3. An Office Action dated September 3, 2004 was apparently transmitted to Petitioner's counsel on that date, but it was never received. Petitioner and Petitioner's counsel learned of the Office Action through an Abandonment Notice transmitted April 12, 2005. The Office Action notified Petitioner that its application for registration had been rejected under Trademark Act section 2(d), 15 U.S.C. section 1052(d), "because the applicant's mark, when used on or in connection with the identified services, so

resembles the marks in U.S. Registration No. 2865908 and 2863952 as to be likely to cause confusion, to cause mistake, or to deceive.” A copy of the Office Action is attached hereto as Exhibit C.

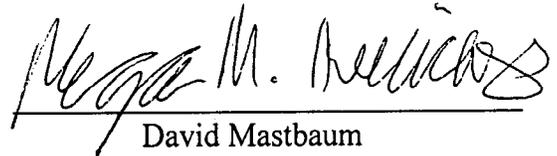
4. Petitioner first used the mark FUNKY MONKEY in October 1994 and has used the mark continuously in interstate commerce since that date. Registrant, according to its applications for registration, first used the mark Registration No. 2865908 in January 1995 and first used the mark Registration No. 2863952 in December 1996. Accordingly, Petitioner’s rights in its mark are superior to Registrant’s rights.

PRAYER FOR RELIEF

WHEREFORE, for the reasons set forth above, Petitioner requests that the two cited registrations be cancelled and for such other and further relief as is deemed just and proper.

Dated: June 8, 2005

By:



David Mastbaum
Megan M. Auchincloss

Attorneys for Petitioner

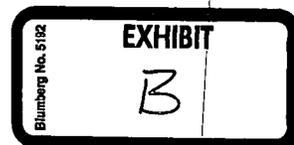
Trademark/Service Mark Application, Principal Register

Serial Number: 78358635

Filing Date: 01/28/2004

The table below presents the data as entered.

Input Field	Entered
MARK SECTION	
MARK	FUNKY MONKEY
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	FUNKY MONKEY
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
OWNER SECTION	
NAME	Johnny Ray Company, Inc.
STREET	1129 Pearl St.
CITY	Boulder
STATE	CO
ZIP/POSTAL CODE	80302
COUNTRY	USA
PHONE	303-402-9636
EMAIL	lara@thefunkymonkey.com
AUTHORIZED EMAIL COMMUNICATION	No
LEGAL ENTITY SECTION	
TYPE	CORPORATION
STATE/COUNTRY OF INCORPORATION	CO
GOODS AND/OR SERVICES SECTION	
DESCRIPTION	Retail variety stores; retail stores featuring miscellaneous general merchandise.
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	00/00/1992
FIRST USE IN COMMERCE DATE	00/00/1992



SPECIMEN FILE NAME(S)	\\ticters\EXPORT9\IMAGEOUT9\783\586\78358635\xml1\AP P0003.JPG
SPECIMEN DESCRIPTION	JPEG file containing Service Mark as used in commerce.
SIGNATURE SECTION	
SIGNATURE	/viva r moffat/
SIGNATORY NAME	Viva R. Moffat
SIGNATORY DATE	01/28/2004
SIGNATORY POSITION	Attorney
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	335
TOTAL AMOUNT	335.00
ATTORNEY	
NAME	Viva R. Moffat
FIRM NAME	Mastbaum & Moffat, LLP
STREET	1620 Market St., Ste. 3W
CITY	Denver
STATE	CO
ZIP/POSTAL CODE	80202
COUNTRY	USA
PHONE	720-974-4000
FAX	720-974-4050
EMAIL	viva@mastlaw.com
AUTHORIZED EMAIL COMMUNICATION	Yes
CORRESPONDENCE SECTION	
NAME	Viva R. Moffat
FIRM NAME	Mastbaum & Moffat, LLP
STREET	1620 Market St., Ste. 3W
CITY	Denver
STATE	CO
ZIP/POSTAL CODE	80202
COUNTRY	USA

PHONE	720-974-4000
FAX	720-974-4050
EMAIL	viva@mastlaw.com
AUTHORIZED EMAIL COMMUNICATION	Yes
FILING INFORMATION	
SUBMIT DATE	Wed Jan 28 12:54:48 EST 2004
TEAS STAMP	USPTO/BAS-20717415162-200 40128125448556165-7835863 5-2009e87cd3f7b21f01695e7 eb6c5b5a4bab-CC-1024-2004 0128125311731239

PTO Form 1478 (Rev. 4/98)
OMB Control #0651-0092 (Exp. 06-30-2005)

Trademark/Service Mark Application, Principal Register

Serial Number: 78358635

Filing Date: 01/28/2004

To the Commissioner for Trademarks:

MARK: (Standard Characters, see mark)

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The literal element of the mark consists of FUNKY MONKEY.

The applicant, Johnny Ray Company, Inc., a corporation of CO, residing at 1129 Pearl St., Boulder, CO, USA, 80302, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

The applicant, or the applicant's related company or licensee, is using the mark in commerce, and lists below the dates of use by the applicant, or the applicant's related company, licensee, or predecessor in interest, of the mark on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.

International Class _____: Retail variety stores; retail stores featuring miscellaneous general merchandise.

In International Class _____, the mark was first used at least as early as 00/00/1992, and first used in commerce at least as early as 00/00/1992, and is now in use in such commerce. The applicant is submitting or will submit one specimen for *each class* showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) JPEG file containing Service Mark as used in commerce..

Specimen - 1

The applicant hereby appoints Viva R. Moffat of Mastbaum & Moffat, LLP 1620 Market St., Ste. 3W, Denver, CO, USA, 80202 to submit this application on behalf of the applicant.

The USPTO is authorized to communicate with the applicant or its representative at the following email address: viva@mastlaw.com.

A fee payment in the amount of \$335.00 will be submitted with the application, representing payment for 1 class(es).

Declaration

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. Section 1001, and that such willful false statements, and the like, 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. Section 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; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /viva r moffat/ Date: 01/28/2004

Signatory's Name: Viva R. Moffat

Signatory's Position: Attorney

Mailing Address:

Viva R. Moffat

1620 Market St., Ste. 3W

Denver, CO 80202

RAM Sale Number: 1024

RAM Accounting Date: 01/28/2004

Serial Number: 78358635

Internet Transmission Date: Wed Jan 28 12:54:48 EST 2004

TEAS Stamp: USPTO/BAS-20717415162-200401281254485561

65-78358635-2009e87cd3f7b21f01695e7eb6c5

b5a4bab-CC-1024-20040128125311731239

FUNKY MONKEY



1129 Pearl St. Boulder Colorado 303-402-9636

To: Johnny Ray Company, Inc. (viva@mastlaw.com)
Subject: TRADEMARK APPLICATION NO. 78358635 - FUNKY MONKEY - N/A
Sent: 9/3/04 1:56:45 PM
Sent As: ECOM111@USPTO.GOV
Attachments: Attachment - 1
Attachment - 2
Attachment - 3
Attachment - 4
Attachment - 5
Attachment - 6
Attachment - 7
Attachment - 8

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/358635

APPLICANT: Johnny Ray Company, Inc.

78358635

CORRESPONDENT ADDRESS:

Viva R. Moffat
Mastbaum & Moffat, LLP
1620 Market St., Ste. 3W
Denver, CO 80202

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: FUNKY MONKEY

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

viva@mastlaw.com

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 78/358635

MARK: FUNKY MONKEY

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

LIKELIHOOD OF CONFUSION

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 2865908 and 2863952 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the enclosed registrations.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The applicant has applied to register the mark "FUNKY MONKEY. Registered mark No. 2865908 and 2863952 are both for the wording "FUNKY MUNKY". Registered mark 2863952 also has a design element. Both marks are owned by the same entity. The applicant's mark and the registered mark are phonetically equivalent. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side#by#side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is controlling in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii).

Registered mark Nos. 2865908 and 2863952 are both used in connection with "retail stores in the field of jewelry, non-edible gift items and collectibles." The applicant intends to use the mark in connection with "retail variety stores; retail stores featuring miscellaneous general merchandise." The services of the parties are highly related because they involve retail store services. Accordingly, it is reasonable to conclude that potential consumers exposed to the services identified with the marks may be confused as to the source of the services.

Overall the similarities between the marks and the services are so great as to create a likelihood of confusion. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

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 chooses to respond to the refusal(s) to register, then applicant must also respond to the following requirement(s).

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.

The applicant should also note the following additional ground for refusal.

THE SPECIMENS DO NOT SUPPORT SERVICES MARK USE

The specimen does not show use of the mark for any services, retail services." The applicant must submit a specimen showing use of the mark for the services specified. 37 C.F.R. Sections 2.56 and 2.88(b)(2). The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimen was in use in commerce prior to the expiration of the time allowed to the applicant for filing a statement of use. 37 C.F.R. Section 2.59(b); TMEP section 905.10.

If an amendment of the dates-of-use clause is necessary in order to state the correct dates of first use, the applicant must verify the amendment with an affidavit or a declaration in accordance with 37 C.F.R. Section 2.20. 37 C.F.R. Section 2.71(c); TMEP section 904.05.

A specimen is unacceptable if it does not show use of the service mark in relation to the identified service. *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977). The specimen must show use of the mark "in the sale or advertising of services." Trademark Act Section 45, 15 U.S.C. Section 1127; *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); TMEP section 1301.02. Therefore, the specimen must show the mark in reference to the particular services identified.

The applicant must submit a specimen that shows how the applicant uses the mark in commerce with the services. A mark is deemed to be used in commerce "on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...." Trademark Act Section 45, 15 U.S.C. Section 1127. The applicant must demonstrate how the mark is used with the services by submitting an acceptable specimen. *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975); 37 C.F.R. Section 2.56

CONDITIONAL REFUSAL – NO USE OF SERVICE MARK

Pending an adequate response to the above, the examining attorney refuses registration under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. Sections 1051, 1052, 1053 and 1127, because the record does not show use of the proposed mark as a service mark.

The examining attorney will reconsider this refusal if the applicant submits a specimen showing use of the mark in the sale or advertising of the services. If the specimen differs from the specimen submitted with the amendment to allege use, the applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimen is in use in commerce. 37 C.F.R. Section 2.59(b); TMEP section 905.10.

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.

NOTICE: TRADEMARK OPERATION RELOCATING OCTOBER AND NOVEMBER 2004

The Trademark Operation is relocating to Alexandria, Virginia, in October and November 2004. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

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

Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.

Georgia Ann Carty Ellis

/Georgia Ann Carty Ellis/

Trademark Attorney

Law Office 111

(703) 308-9111, Ext. 150

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

Print: Aug 21, 2004

76099449

DESIGN MARK

Serial Number

76099449

Status

REGISTERED

Word Mark

FUNKY MUNKY

Standard Character Mark

No

Registration Number

2865908

Date Registered

2004/07/27

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

GALLE, Jodi INDIVIDUAL UNITED STATES 1586 Spring Hill Mall West Dundee
ILLINOIS 60118

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Retail
stores in the field of jewelry, non-edible gift items and
collectibles, excluding toys. First Use: 1995/01/00. First Use In
Commerce: 1995/01/00.

Filing Date

2000/07/28

Examining Attorney

KIM, SOPHIA S.

Attorney of Record

DOUGLAS H PAULEY

FUNKY MUNKY

Print: Aug 21, 2004

75518199

DESIGN MARK

Serial Number

75518199

Status

REGISTERED

Word Mark

FUNKY MONKEY

Standard Character Mark

No

Registration Number

2331144

Date Registered

2000/03/21

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

JOHNNY RAY COMPANY, INC. CORPORATION COLORADO 1129 PEARL ST. BOULDER
COLORADO 80302

Goods/Services

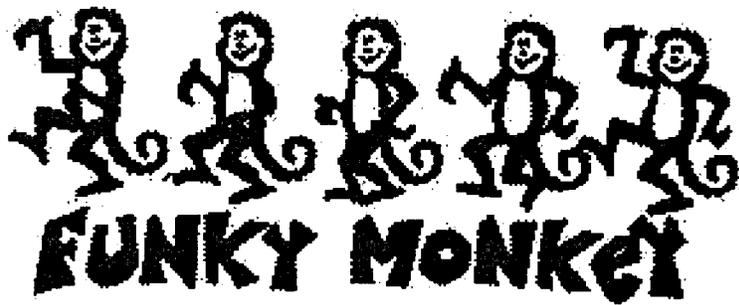
Class Status -- ACTIVE. IC 025. US 022 039. G & S: T-shirts, tank
tops, sweatshirts, pullovers, jumpers, jackets, vests, and hats.
First Use: 1996/01/15. First Use In Commerce: 1996/01/15.

Filing Date

1998/07/13

Examining Attorney

CARRUTHERS, ALICE SUE



Print: Aug 21, 2004

76098947

DESIGN MARK

Serial Number

76098947

Status

REGISTERED

Word Mark

FUNKY MUNKY

Standard Character Mark

No

Registration Number

2863952

Date Registered

2004/07/20

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

GALLE, Jodi INDIVIDUAL UNITED STATES 1586 Spring Hill Mall West Dundee ILLINOIS 60118

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Retail stores in the field of jewelry, non-edible gift items and collectibles, excluding toys. First Use: 1996/12/00. First Use In Commerce: 1996/12/00.

Filing Date

2000/07/28

Examining Attorney

KIM, SOPHIA S.

Attorney of Record

DOUGLAS H PAULEY



Print: Aug 21, 2004

76588692

DESIGN MARK

Serial Number

76588692

Status

NEW APPLICATION - RECORD INITIALIZED NOT ASSIGNED TO EXAMINER

Word Mark

FUNKY MONKEY

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

GREENMAN, STANLEY INDIVIDUAL UNITED STATES 339 Mill River Road Oyster Bay NEW YORK 11771

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Retail outlets featuring toys, games, books, apparel, pre-recorded video and audio tapes, compact discs, DVD's and records.

Prior Registration(s)

2641650

Filing Date

2004/04/26

Examining Attorney

UNKNOWN

Attorney of Record

CHARLES E. BAXLEY

FUNKY MONKEY