UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/056900

JUL 25 2003

APPLICANT: Rodriguez, Terry

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MARK: RATZASS

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

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.

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

RE: Serial Number 76/056900

RESPONSE TO REQUEST FOR RECONSIDERATION

This letter is in response to the applicant's communication filed on May 2, 2003 requesting reconsideration of the examining attorney's Final Refusal dated October 30, 2002.

Request for Reconsideration Granted - Final Refusals Under Section 2(d) and Sections 1, 2 and 45 Maintained

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 2282769 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive. The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. The Final Refusal Under Section 2(d) is maintained (see below), however, the request for reconsideration of the refusal under Section 2(d) is granted.

Registration was refused under Trademark Act Section 1, 2 and 45, 15 U.S.C. Section 1051, 1052, and 1127, because the proposed mark is ornamental as used on the goods. The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. The Final

Refusal Under Sections 1, 2 and 45 is maintained (see below), however, the request for reconsideration of the refusal under Section 1, 2 and 45 is granted.

Proposed Amendment to Drawing Unacceptable

The proposed amendment of the drawing is unacceptable because it would materially alter the character of the mark. 37 C.F.R. §2.72; TMEP §§807.14, 807.14(a) and 807.14(a)(i). *See In re Wine Society of America, Inc.*, 12 USPQ2d 1139 (TTAB 1989); *In re Nationwide Industries Inc.*, 6 USPQ2d 1883 (TTAB 1988); *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986).

The mark as shown on the drawing submitted with the initially filed application is a typed version of the wording RATZASS. The applicant has submitted a proposed amended drawing which shows this term below the posterior side of a rat. Such an amendment clearly alters the character of the mark as originally filed and therefore is unacceptable.

Thus, the applicant should note that the continued refusals pertain to the mark as originally filed, i.e., the typed version of the term RATZASS.

Final Refusal Under Section 2(d) Maintained

Briefly, the applicant's mark is confusingly similar in appearance, sound, connotation and overall commercial impression to the mark of the registrant, while the goods are identical.

The applicant seeks to register the mark RATZASS while the registered mark is RAT SASS, both for clothing.

The applicant contends that the registrant's mark has a "distinct meaning" that is not confusingly similar to that of the applicant's mark, i.e., the meaning of the two marks "are clearly different." Additionally, the applicant submits that the sound of the marks is being given greater weight than necessary in the likelihood of confusion determination.

First, the examining attorney must inquire as to the "distinct meaning" the applicant believes the registrant's mark suggests. That is, while the term "SASS" clearly has an understood meaning, when combined with the term RAT, this term loses much of that meaning in the pronunciation of the two words together. The mark must be viewed as a whole. To claim that the meaning of the mark in its entirety is anything but a clever reference to the posterior of a rat seems illogical. Accordingly, there is no doubt that the marks in question have the same connotation and overall commercial impression.

Second, it should be noted that similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv). The applicant's contention that the marks sound similar "if not properly enunciated" is without merit. It would seem no matter how these terms are enunciated, they sound highly similar if not identical. Accordingly, the applicant's mark is confusingly similar in sound to the registrant's mark.

And finally, the examining attorney would like to note that even were the applicant allowed to amend the drawing to add the design, the refusal would still be maintained. The addition of the

design of a rat's posterior only reinforces the meaning of the mark and the fact that the applicant's mark is confusingly similar to the registrant's mark in appearance, sound, connotation and overall commercial impression.

Accordingly, the final refusal under Section 2(d) is maintained.

Final Refusal Under Sections 1, 2 and 45 Maintained

The proposed mark is ornamental when used on the goods for which registration is sought. Moreover, the material submitted by the applicant fails to demonstrate secondary source.

More specifically, and as noted in the prior office action, the proposed mark does not indicate the source of the goods nor distinguish them from the goods of others. That is, the proposed mark does not function as a trademark; it functions as a decorative feature on the applicant's goods and will be construed as nothing else.

The applicant's submission of material showing additional uses of the proposed mark merely reinforces the ornamental feature of the wording. The use of the proposed mark on the stickers is also ornamental. And, the use of the proposed mark on the web site for ordering the goods is merely advertisement for the goods and does not show secondary source; the applicant does not appear to use the mark for separate services apart from the ordering of the t-shirts and stickers on which the proposed mark is used.

Finally, the applicant's contention that "any ornamentation found in the specimen's is merely incidental" is not understood by the examining attorney. It is not clear what is meant by "merely incidental;" it is unclear what the legal basis for such an argument is.

Accordingly, the proposed mark is indeed ornamental and the final refusal under Sections 1, 2 and 45 is maintained.

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.

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

/Susan Kastriner Lawrence/
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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.

Fee increase effective January 1, 2003

Effective January 1, 2003, the fee for filing an application for trademark registration will be increased to **$335.00** per International Class. The USPTO will not accord a filing date to applications that are filed on or after that date that are not accompanied by a minimum of $335.00.

Additionally, the fee for amending an existing application to add an additional class or classes of goods/services will be $335.00 per class for classes added on or after January 1, 2003.