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Subject: U.S. TRADEMARK APPLICATION NO. 77980028 - LAMPOONTANG -
N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77980028

MARK: LAMPOONTANG



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Mixed Message Media, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

Mixed Media, Inc. (hereinafter referred to as "Applicant") has appealed the examining attorney's final refusal to register the proposed mark, LAMPOONTANG. The application was refused on the grounds that the proposed mark is disparaging within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. Section 1052(a). The trademark examining attorney respectfully requests that the Board affirm this refusal.

STATEMENT OF FACTS

On October 29, 2009, the Applicant applied to register the mark "LAMPOONTANG." On February 5, 2010, the Examining Attorney refused registration because Applicant's recitation of services was unacceptable. On February 9, 2010, the Examiner amended the recitation of services via Examiner's Amendment. On March 9, the Examiner issued an office action because the recitation of services was unacceptable.

On March 30, 2010, the Examining Attorney issued a final office action because the recitation of services was not acceptable. On June 1, 2010, Applicant filed a request to divide the application, which was accepted on August 5, 2010. On June 7, 2010, the Examiner issued a 2(a) refusal and a 2(d) refusal. The Examiner issued a refusal because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols under Trademark Act Section 2(a), 15 U.S.C. §1052(a) and was likely to cause confusion with Registration Nos. 2,334,353 and 2,744,334 under Trademark Act Section 2(d), 15 U.S.C. §1052(d). On September 1, 2010, Applicant responded against refusal and provided evidence to support their argument. On September 27, 2010, the Examining Attorney issued a final refusal regarding the refusal under Section 2(a) of the Trademark Act and likely to cause confusion with Registration Nos. 2,334,353 and 2,744,334 under Trademark Act Section 2(d), 15 U.S.C. §1052(d). This appeal followed

ISSUES ON APPEAL

The two issues on appeal is: 1) whether the Applicant's mark, "LAMPOONTANG," consists of or comprises disparaging matter and; 2) whether applicant's intended mark, when used in connection with applicant's services, so resembles the marks shown in U.S. Registration Nos. 2,334,353 and 2,744,334 as to be likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act. Trademark Act Section 2(a), 15 U.S.C. §1052(a).

ARGUMENTS

Registration is refused because the applied-for mark consists of or includes matter which may

disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols.

Trademark Act Section 2(a), 15 U.S.C. §1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d

1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB

1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding “no error in

the TTAB’s articulation of [the Section 2(a)] test for disparagement”), *remanded on other grounds*,

415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C.

Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); TMEP §§1203.03, 1203.03(c).

The following two factors must be considered when determining whether matter may be

disparaging under Trademark Act Section 2(a):

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner

in which the mark is used in the marketplace in connection with the goods and/or services; and

- (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

In re Squaw Valley Dev., 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP §1203.03(c).

Here, Applicant's proposed mark, LAMPOONTANG for "entertainment services, namely, providing online news and commentary in the field of entertainment; online entertainment and comedy services in the nature of comical performances, broadcasts, and webcasts featuring depictions of social, political, ethical, moral, religious and news-worthy current events; entertainment services, namely, providing a website featuring photographic, audio, video and prose presentations, which features comedic, adult, parodical, and satirical entertainment via a global computer network" is a disparaging term under Section 2(a) of the Trademark Act because a substantial composite of women would find the term POONTANG to be disparaging.

I. THE TERM LAMPOONTANG IS DISPARAGING IN THE CONTEXT OF THE MARKETPLACE AS APPLIED TO THE SERVICES DESCRIBED IN THE APPLICATION.

To "disparage" means "to speak slighting[ly] of: run down: depreciate." *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1276 (TTAB 2006) (internal punctuation omitted) (quoting *Webster's Third New International Dictionary* (unabridged ed. 1993)). The determination of whether a mark is disparaging depends upon the perspective of the object of disparagement. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1217 (TTAB 2010); *see also* TMEP §1203.03(c). A mark may be disparaging in two ways:

(1) Matter that is not, in and of itself, disgusting or otherwise unpleasant, may be applied or combined in such a way that it is offensive to the disparaged party. See, e.g., *In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB 1969) (holding design of an "X" superimposed over a hammer and sickle to disparage, and to bring into contempt and disrepute, a national symbol of the U.S.S.R.); or

(2) Matter may be inherently offensive, and, when directed at a specific individual or entity, may become even more offensive. See, e.g., *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1640 (TTAB 1988) (noting "the offensiveness of [applicant's mark, depicting a defecating dog,] becomes even more objectionable because it makes a statement about opposer itself").

Furthermore, under Trademark Act Section 45, a "person" may be a natural person (i.e., an individual) or a juristic person (i.e., a corporation, partnership, association, union or any other organization capable of suing or being sued). 15 U.S.C. §1127; TMEP §1203.03(a); see *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 888, 160 USPQ 715, 720 (C.C.P.A. 1969); *Popular Merch. Co. v. "21" Club, Inc.*, 343 F.2d 1011, 1015, 145 USPQ 203, (C.C.P.A. 1965). In addition, a "person" includes the United States and any agency of the federal government. 15 U.S.C. §1127; TMEP §1203.03(a); see, e.g., *NASA v. Record Chem. Co.*, 185 USPQ 563, 566 (TTAB 1975).

In this case, the term POONTANG in the mark LAMPOONTANG is inherently offensive and disparaging to women. Looking at the first prong of the test, the dictionary evidence supports the proposition that the likely meaning of the matter in question is offensive, vulgar and disparaging. For example, Yourdictionary.com defines the term POONTANG as: 1. sexual intercourse with a woman. 2. a woman or women collectively regarded only as sexual partner: a disparaging or dismissive term. Freedictionary.com states: 1. *Vulgar Slang*; Sexual intercourse with a woman. 2. *Offensive Slang* used as disparaging term for woman. Finally, Dictionary.com defines POONTANG as: Slang:

Vulgar 1. sexual intercourse with a woman. 2. Offensive . a woman regarded as a sexual object. Thus, in the context of applicant's sexually themed services the term LAMPOONTANG is disparaging to women because the term POONTANG is a crude, vulgar and offensive way in which to refer to a woman. (*See definitions attached to the Office Actions dated June 7, 2010 and September 27, 2010*).

In addition, the second prong states that if meaning is found, whether that meaning is disparaging to a substantial composite of the referenced group must be determined. In light of the above definitions, which state the term POONTANG, by definition, is an offensive way to refer to women, they are the group disparaged. Furthermore, after taking into consideration Applicant's website and other similar websites, no other non-offensive meaning of the word "POONTANG" is applicable in the context of Applicant's services. Women are the identifiable persons in which LAMPOONTANG is disparaging. Thus, the second prong of the test has been satisfied

Furthermore, the context in which applicant uses its mark makes clear that the applicant intends the connotation of the mark LAMPOONTANG to be the crude, vulgar, disparaging and offensive meaning of the term POONTANG. The examiner attached evidence from Applicant's website and others that use the wording POONTANG with women in degrading sexual positions. Applicant's website states: "Lampoontang- Chuckle While You Choke Your Chicken...Michelle goes for a ride on Aidan's Steed!... Seth enjoying a ride in Amber's mudsleeve!" These headings are listed with pictures of nude women and men, thus showing that the term POONTANG is used in a sexually explicit context by applicant. Other websites assert: POONTANG XXX Hardcore Pussy

Milfs Teens Amateurs Mobile Porn and PREGGO & HER FRIEND TAKE ON SOME COCK!... PREGGO POONTANG. These websites show that in the relevant industry, the term POONTANG, in all its incarnations, is used in a sexually explicit, crude and disparaging fashion. When consumers encounter the word “POONTANG” alongside these other elements, they will inevitably extract disparaging meaning of the word.

The applicant argues that the Examiner improperly dissected the LAMPOONTANG mark. *See Applicant’s Brief* p.5. The applicant asserts that the mark at issue is LAMPOONTANG and not ‘lampoon or poontang.’ The question of disparagement must be considered in relation to the goods or services identified in the application. In a similar case, in *Squaw Valley*, the terms SQUAW and SQUAW ONE were found to be disparaging when used in connection with clothing in Class 25 and retail store services in the field of sporting goods and equipment and clothing in Class 35, because the likely meaning of “Squaw” is an American Indian woman or wife, and the examining attorney’s evidence established prima facie that a substantial composite of Native Americans would consider the term to be offensive. *In re Squaw Valley Development Co.*, 80 USPQ2d 1264 (TTAB 2006). Here, when considered in relation to applicant’s sexually themed services, prefacing the term POONTANG with the letters LAM does not obviate the offensive and disparaging nature of the term. In the context of the Applicant’s usage of its mark, it is clear that the term “LAMPOONTANG” is intended to carry the commonly accepted and disparaging meaning of a woman regarded as a sexual object.

The applicant also argues that LAMPOONTANG is neither offensive nor disparaging. However, the previously discussed dictionary evidence clearly shows that

the meaning of “POONTANG” is “offensive slang used as a disparaging term against a woman.” Thus, by definition, POONTANG is an offensive and disparaging term.

In addition, even Applicant concedes that POONTANG just refers to the act of sexual intercourse. (*See Applicant’s Brief* p.9.) Referring to women as the crude and vulgar name of a sex act is disparaging. In a case similar to the case at bar, *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581 (TTAB 2008), the court held SEX ROD to be disparaging because it is sexually vulgar and offensive and the public will associate it with opposer’s mark RED SOX. Like SEX ROD, LAMPOONTANG is, at best, sexually vulgar and crude. As used on the applicant’s website, the public will associate the term with women. Thus, because of the crude and vulgar nature of the term, it is disparaging to women.

The targeted or relevant group must be determined on the basis of the facts of each case. *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1739 (TTAB 1999), *rev’d*, 284 F. Supp. 2d 96, 124 & n.25, 125, 68 USPQ2d 1225, 1247 & n.25 (D.D.C. 2003) (finding no error in the TTAB’s application of this approach), *remanded on other grounds*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff’d*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); *see also* TMEP §1203.03(c). For cases involving disparagement of individuals or commercial entities, the perception of a “reasonable person of ordinary sensibilities” may be appropriate. *Harjo*, 50 USPQ2d at 1740.

In some situations, a disparaging term may be subject to multiple interpretations, at least one of which may refer to the disparaged party. In such a case, specimen use or a

design element that reinforces one interpretation over the other is persuasive evidence that consumers will select the desired interpretation. *See, e.g., In re In Over Our Heads Inc.*, 16 USPQ2d 1653, 1654 (TTAB 1990) (finding that design element of naked buttocks highlighted physical act of mooning, and therefore the mark MOONIES with the design determined not to refer to the Unification Church, whose followers are commonly referred to as “moonies”). Here, applicant’s sexually explicit specimens of use are persuasive evidence that consumers will interpret the term LAMPOONTANG to refer to women in a crude, vulgar and disparaging fashion.

Finally, the term POONTANG is by definition offensive and disparaging to women when used in connection with Applicant’s services as part of the mark LAMPOONTANG. The context of Applicant’s services and specimen makes it is clear that applicant intends it to be crude, vulgar, offensive and therefore disparaging to women. Under the two prong test set forth above, the mark should be found to be disparaging under Section 2(a). A reasonable person would believe that LAMPOONTANG disparages women.

A. Applicant’s mark, LAMPOONTANG, and the registered marks, LAMPOON, are confusingly similar because they are very similar and create the same overall commercial impression.

In determining likelihood of confusion, the examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont deNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq.* The mere deletion of wording

from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark. In this case, as indicated above applicant has merely added the wording TANG, which does not alleviate the likelihood of confusion.

In addition, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison but 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 §1207.01(b).

B. Applicant's services are of such a nature that their offer and sale under highly similar mark as the registered marks is likely to cause confusion as to the source.

The question of registrability here hinges on a comparison of applicant's services as described in the application with the services described on the face of the cited registrations. The goods and services in the registrations are simply stated to be "providing an on-line publication containing humorous, parodical or satirical subject matter and paper goods and printed matter, namely, magazines, newspapers and books containing humorous, parodical or satirical subject matter" Similarly, the applicant's goods are "Entertainment services, namely, providing online news and commentary in

the field of entertainment; online entertainment and comedy services in the nature of comical performances, broadcasts, and webcasts featuring depictions of social, political, ethical, moral, religious and news-worthy current events; entertainment services, namely, providing a website featuring photographic, audio, video and prose presentations, which features comedic, adult, parodical, and satirical entertainment via a global computer network.” The goods and services are presumed to travel through the usual channels of trade to the usual purchasers of such goods and services. *In re Dennison Mfg. Co.*, 222 USPQ. 1015, 1016 (TTAB 1983); *Knorr-Nahrungsmittel Akg v. Havland International, Inc.*, 206 USPQ 827, 835 (TTAB 1980). In this case, both the applicant and registrant produce news and satirical websites.

Furthermore, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See, e.g., In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988). The only exceptions are when the matter common to the marks is merely descriptive or diluted, and not likely to be perceived by purchasers as distinguishing source, or when the marks in their entireties convey a significantly different commercial impression. TMEP §1207.01(b)(iii); *see, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645 (TTAB 2010); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984). The examiner attached registrations from X-Search in the Final Office action that provide both registrant’s and applicant’s goods and

services. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely providing a website featuring information, printed matter and on-line publications are of a kind that may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Finally, since the registrations contain no restrictions as to respective trade channels, the applicant and registrant will likely sell their similar goods and services through the same trade channels and to the same classes of purchasers.

C. Channel of Trade

The conditions surrounding the marketing of the goods and services are such that they are likely to be marketed in the same channel of trade and encountered by the same purchasers. Moreover, the registrant has not indicated the manner in which its goods are marketed or the type of consumer who uses its goods. The applicant only contends that it is highly unlikely that any potential consumer would be confused. *See Applicant's Brief* page 17. Regardless of how discerning purchasers might be in distinguishing the goods and services, are likely to be encountered by the same purchasers. As indicated above, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant

is the owner of the marks and that use of the marks extends to all goods and/or services identified in the registrations. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii).

The applicant also argues that the lack of actual confusion is very persuasive for not finding a likelihood of confusion. *See Applicant's Brief at page 20*. Confusion, however, is not required. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g.*, *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an *ex parte* proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

CONCLUSION

For the foregoing reasons, refusal on the grounds that the proposed mark is disparaging within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. Section 1052(a) and likely to cause confusion with Registration Nos. 2,334,353 and 2,744,334 under Trademark Act Section 2(d), 15 U.S.C. §1052(d) should be upheld. The trademark examining attorney respectfully requests that the Board affirm these refusals.

Respectfully submitted,

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