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Subject: U.S. TRADEMARK APPLICATION NO. 85466110 - WORLD FAMOUS -
KOI-TM003 - Request for Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 85466110

MARK: WORLD FAMOUS



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: King of Ink, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

KOI-TM003

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/5/2013

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated August 29, 2012, is maintained and continues to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Applicant argues that consumers viewing the proposed mark "WORLD FAMOUS" "would have no idea whatsoever regarding the nature or characteristics of applicant's tattoo services."

However, as noted in the Final Office Action, laudatory words or terms that attribute quality or excellence to goods and/or services are considered merely descriptive. TMEP §1209.03(k). Thus, laudatory terms, phrases and slogans are nondistinctive and unregistrable on the Principal Register without proof of acquired distinctiveness. *See In*

re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK a laudatory, descriptive phrase that touts the superiority of applicant's bicycle racks); *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA a laudatory, descriptive phrase for applicant's beer and ale); *In re The Place, Inc.*, 76 USPQ2d 1467 (TTAB 2006) (holding THE GREATEST BAR a laudatory, descriptive term for applicant's restaurant and bar since term "greatest" immediately informs prospective purchaser that applicant's establishment is superior in character or quality when compared to other restaurants and bars); *In re Dos Padres, Inc.*, 49 USPQ2d 1860 (TTAB 1998) (holding QUESO QUESADILLA SUPREME a laudatory, descriptive term for applicant's cheese); *In re Ervin*, 1 USPQ2d 1665 (TTAB 1986) (holding THE ORIGINAL a laudatory, descriptive term for applicant's specific type of gaming equipment).

Here, applicant's mark merely describes a characteristic of applicant's services, namely, a laudatory phrase indicating that applicant's tattoo and body piercing services are well or widely known throughout the world.

In addition, as previously noted, whether a term or phrase is merely descriptive, however, is determined *not in the abstract* but in relation to the identified goods/services, the context in which it is being used on or in connection with those goods/services and the possible significance that the term or phrase would have to the average purchaser of the goods/services because of the manner of its use. *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 Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); *In re Recovery*, 196 USPQ 830 (TTAB 1977); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the examining attorney must consider the potential significance the mark would have, in context, to the average purchasers of the goods/services in the marketplace. *In re Omaha National Corp.*, *supra*; *In re Abcor Development Corp.*, *supra*; *In re Venture Lending Associates*, *supra*.

Here, in relationship to applicant's tattoo and body piercing services, the relevant consumer would understand the wording "world famous" as referring to the fact that applicant's tattoo and/or body piercing services are allegedly well or widely known throughout the world.

Applicant has submitted printouts of third-party applications and registrations for marks containing the wording "world famous" to support the argument that this wording should not be considered descriptive. However, the goods and/or services listed in the third-party applications and registrations submitted by applicant, (i.e., clothing, paper goods, restaurant services, etc.) are different from those at issue and thus are not directly relevant to the present case.

Regardless, the Board has held that a merely descriptive mark "is not registrable simply because other similar (or arguably so) marks appear on the register or in the Official

Gazette.” *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 2995); *In re Consolidated Foods Corp.*, 200 USPQ 477, 481 (TTAB 1877); *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977).

Moreover, the cited third party registrations are unitary marks having different connotations and commercial impressions due to the additional wording in the marks: Reg. Nos. 4285316, 4285315 and 4245827.

With respect to the third-party applications, such evidence demonstrates only that the applications for the subject marks were filed.

Applicant has already filed a timely notice of appeal with the Board on February 28, 2013. As such, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

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