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Subject: U.S. TRADEMARK APPLICATION NO. 85571922 - 303.121018 - SU - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 2

Files: evid1.jpg, 85571922.doc

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

U.S. APPLICATION SERIAL NO. 85571922

MARK:

CORRESPONDENT ADDRESS:
JOHN W GOLDSCHMIDT JR

FERENCE & ASSOCIATES LLC

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PITTSBURGH, PA 15143

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

APPLICANT: Donoso, Larry A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

303.121018

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

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. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated March 5,

2014 are maintained and continue to be final: Failure to Function – Character and Specimens. *See* TMEP §§715.03(a)(ii)(B), 715.04(a). .*See* TMEP §§715.03(a)(ii)(B), 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.

FAILURE TO FUNCTION – CHARACTER

Registration is refused because the applied-for mark, as used on the specimen of record, identifies only a particular character; it does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; *see In re Hechinger Inv. Co. of Del.*, 24 USPQ2d 1053, 1056 (TTAB 1991); *In re McDonald's Corp.*, 229 USPQ 555, 555 (TTAB 1985); TMEP §§904.07(b), 1301.02(b).

A design of a character is registrable as a service mark only where the record shows that it is used in a manner that would be perceived by consumers as identifying and distinguishing the services in addition to identifying the character. *In re Hechinger*, 24 USPQ2d at 1056; TMEP §1301.02(b). To further explain –

"Under 15 U.S.C. §1127, a name or design of a character does not function as a service mark, unless it identifies and distinguishes services in addition to identifying the **character**. If the name or design is used only to identify the **character**, it is not registrable as a service mark. *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1053 (TTAB 1991) (design of dog appearing in advertisement does not function as mark for retail hardware and housewares services); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (APPLE PIE TREE does not function as mark for restaurant services, where the specimen shows use of mark only to identify one **character** in a procession of characters); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (design of zoo animal **character** distributed to restaurant customers in the form of an iron-on patch not used in a manner that would be perceived as an indicator of source); *In re Burger King Corp.*, 183 USPQ 698 (TTAB 1974) (fanciful design of king does not serve to identify and distinguish restaurant services). See **TMEP §1202.10** regarding the registrability of the names and designs of characters in creative works."

In this case, the specimen shows the applied-for mark used only to identify a character and not as a service mark for applicant's services because the mark is presented as a character and is not seen in connection with any services. The specimens show the applied-for mark used only to identify a character in connection with a "story of the month" about the Oppys, one of which is applicant's mark. The

applicant has provided additional specimens. On the first page of the supplemental specimens, the mark is again seen in connection with a character, (EyePod Saurus), and not in connection with the identified services. The other additional specimen, the endowment information, does not show the mark in connection with the services. Again, the mark is seen as a character, that is part of a group of characters, but not shown in a trademark manner in connection with applicant's services. The mark does not identifiy and distinguish services in addition to identifying the character. It is only used to identify the character. See attachments evidencing other instances in which a character would be perceived as a character and not a trademark for specific goods and services based on the presentation.

SPECIMENS

Registration is refused because the specimen does not show the applied-for mark in use in commerce in connection with any of the goods and/or services specified in International Class(es) 41 in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Chengdu AOBI Info. Tech. Co.*, 111 USPQ2d 2080, 2081-82 (TTAB 2011); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). Specifically, the mark is not seen in connection with the educational services.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the statement of use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a); *see In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013).

Examples of specimens for goods include tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, and displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.* Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. TMEP §904.03(i). Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C).

Applicant may respond to this refusal by submitting, for each applicable international class, a different specimen (a verified "substitute" specimen) that (a) was in actual use in commerce prior to the expiration of the deadline for filing the statement of use and (b) shows the mark in actual use in commerce for the goods and/or services identified in the statement of use.

Applicant, however, may not withdraw the statement of use. *See* 37 C.F.R. §2.88(g); TMEP §1109.17.

For more information about this refusal and instructions on how to submit a verified "substitute" specimen online using the Trademark Electronic Application System (TEAS) form, please go to http://www.uspto.gov/trademarks/law/specimen.jsp.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Dezmona J. Mizelle-Howard/

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