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Subject: U.S. TRADEMARK APPLICATION NO. 85571928 - 303.121017 - SU - 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. 85571928

MARK:

CORRESPONDENT ADDRESS:
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GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Larry A. Donoso

CORRESPONDENT'S REFERENCE/DOCKET NO:

303.121017

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 6, 2014 are maintained and continue to be final: FAILURE TO FUNCTION/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).

SPECIMENS

Applicant argues that the specimens (displays) associated with the goods, in manner that would be perceived as a mark. Examining attorney respectfully disagrees. The mark, as seen on all of the submitted specimens, shows the mark (design) as a character in a series related to the "Oppy Club". The mark cannot be pulled out for the purposes of associating the design in connection with the identified services (EDUCATIONAL SERVICES, NAMELY, PROVIDING EDUCATIONAL PROGRAMS, TRAINING, AND COURSES OF INSTRUCTION IN THE FIELDS OF HEALTH, MEDICAL CARE, VISION, SPORTS AND FITNESS, NUTRITION, ENVIRONMENTAL AWARENESS, COMPUTERS AND INTERNET, SCIENCE, TECHNOLOGY AND INVENTION, MUSIC, AND READING, AND DISTRIBUTION OF PRINTED INSTRUCTIONAL COURSE MATERIALS IN CONNECTION THEREWITH).

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). 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 character is presented in a story form as the subject matter of a story, and not as a mark that can be pulled and designated as a service mark educational services.

As in the case of In re Hechinger Investment Co. of Delaware Inc. "Such use, in and of itself, is not sufficient to create a direct association among purchasers and prospective customers…".

Further, In the case of In re McDonald's Corporation - APPLE PIE TREE is used in the first set of specimens as an identifying name of one character in a puzzle which is presented as one of a number of puzzles and riddles. In the second set of specimens, it is used again to identify one character in a

procession of characters. There is nothing in either situation which separates the matter sought to be registered from the other elements shown on the specimens and informs the viewer that this term identifies a service. It is not that the subject matter must be more prominent than everything else on the specimens. We agree with applicant on that point. On the other hand, it must not blend so well with other matter on the specimens that it is difficult or impossible to discern which element is supposed to be the service mark. A commercial impression of a service mark must be readily apparent from the use of the term. If purchasers are put in the position of having to choose between a number of elements to decide which is intended to be the service mark, it is clear that there is no service mark use. Mere intent that a name or character be a service mark is insufficient if there is no acceptable use as such.

Similar to that case, in this case specimens fail to demonstrate the design mark as a service mark for applicant's services. The character has blended so well with the other characters that it is impossible to discern which element is a service mark.

The specimens fail to demonstrate the design mark as a service mark for applicant's services.

- The mark as seen on incoming page 22 – in a circular drawing with at least 8 other characters. The mark is not seen as a mark, but as a character. A larger version of the same mark is seen on incoming page 27, 35 and incoming page 45, incoming page 53, 56, 57, 62, 65 and 66. The mark is not shown on specimens showing trademark usage.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

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).

/Dezmona J. Mizelle-Howard/

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