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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87205484
Applicant	WGVS USA, LLC
Applied for Mark	WORLD'S GREATEST VIDEOS
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Submission	Applicants Request for Remand and Amendment
Attachments	WORLDS GREATEST Req for Remand.pdf(152804 bytes) WORLDS GREATEST Amend to Supp Reg.pdf(94973 bytes)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: WGVS USA, LLC

Mark: WORLD'S GREATEST VIDEOS

Serial No.: 87/205,484

Filing Date: October 17, 2016

Examining Attorney: Cait Watts-Fitzgerald

Law Office: 111

**REQUEST FOR REMAND AND SUSPENSION FOR CONSIDERATION OF
ALLEGATION OF USE AND AMENDMENT**

Applicant, WGVS USA, LLC, ("Applicant") hereby requests the Trademark Trial and Appeal Board remand Application Serial No. 87/205,484 (the "Application") to register the mark WORLD'S GREATEST VIDEOS (the "Applicant's Mark") for consideration of the filing of an Allegation of Use and the amendment to the Supplemental Register, and suspend the present ex parte appeal.

BACKGROUND

Applicant filed the Application on October 17, 2016. The USPTO initially refused the Application on January 26, 2017, via a Non-Final Office Action (the "January 2017 Office Action") on the ground that the mark WORLD'S GREATEST VIDEOS was merely descriptive as the mark allegedly merely describes a characteristic or the quality of the Applicant's services pursuant to 15 U.S.C. §1052(e)(1). Applicant filed a response to the January 2017 Office Action on July 20, 2017. The USPTO issued a Final Office Action refusing registration on August 3, 2017. Applicant sought reconsideration via a submission dated February 2, 2018, on which date Applicant also filed a Notice of Appeal. Reconsideration was refused on February 8, 2018 and proceedings were resumed February 16, 2018. Applicant's and the Examiner's briefs were filed on April 17, 2018 and June 14, 2018, respectively, and an oral hearing has been scheduled for November 7, 2018 at 10:00 A.M.

Applicant has since commenced use of the applied-for mark, and as such, has filed an Amendment to Allege Use under 15 U.S.C. § 1051(c). Subsequently, Applicant is seeking to amend the Application from registration on the Principal Register to the Supplemental Register. In light of the amendments, Applicant requests that the Examining Attorney reconsider the refusal to register Applicant's Mark based on allegedly being merely descriptive as applied to the listed services and therefore, unable to function as a source identifier under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

Applicant respectfully submits that in view of the Amendment to Allege Use and amendment to the Supplemental Register, the present appeal should be terminated as moot, and the application should be approved for registration.

ARGUMENT

A. The Amendment to Allege Use and Amendment to the Supplemental Register Constitutes Good Cause to Remand Applicant's Application to the Examining Attorney for Consideration.

In accordance with TBMP § 1209.04, the Board may remand an application for consideration of an amendment upon showing of good cause. See also TBMP § 1205.01. Good cause exists when an applicant requests remand for consideration of an amendment in an attempt to comply with a requirement. TBMP § 1205.01 states:

A request for remand to consider an amendment will be granted upon a showing of good cause. Good cause will generally be found, for example, when the amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods or services in response to a requirement for an acceptable identification, when the amendment will obviate a ground for refusal, such as an amendment to the Supplemental Register or an amendment to assert a Trademark Act § 2(f) claim (15 U.S.C. § 1052(f)) in order to avoid or overcome a refusal under Trademark Act § 2(e)(1), Trademark Act § 2(e)(2) or Trademark Act § 2(e)(4), 15 U.S.C. § 1052(e)(1), 15 U.S.C. § 1052(e)(2) or 15 U.S.C. § 1052(e)(4), or when the examining attorney consents to remand for consideration of the amendment.

Furthermore, with the Amendment to Allege Use, Applicant has also filed to amend the Application from the Principal Register to the Supplemental Register. Not available until the mark was used in

commerce for the applied-for services, such amendment is intended to address and obviate the rejection under Section 2(e)(1) of the Trademark Act, and place the Application in condition for registration.

Applicant has timely filed the Amendment to Allege Use in accordance with 37 C.F.R. § 2.76(a) and TMEP § 1104.03, and filed to amend the Application to the Supplemental Register, 37 C.F.R § 2.75(b). Accordingly, Applicant has met the burden of showing good cause for a remand of the Application.

B. The Refusal to Register Applicant's Mark Should be Withdrawn in Light of the Amendments.

As stated, Applicant's Amendment to Allege Use and the ensuing amendment to the Supplemental Register are filed in an attempt to overcome the rejection recited and maintained in the Examining Attorney's various Actions. TMEP § 816.04 states:

In an application under §1...the applicant may amend to the Supplemental Register after a refusal to register on the Principal Register, including a final refusal. If the final refusal was under §2(e)(1)...of the Trademark Act...amendment to the Supplemental Register is procedurally an acceptable response.

Accordingly, it is believed the amendment to the Supplemental Register is permissible and proper. Therefore, Applicant respectfully requests the refusal under Section 2(e)(1) be withdrawn and the Application be approved for registration.

CONCLUSION

Applicant has demonstrated that good cause exists to remand the Application for consideration of the Amendment to Allege Use and amendment to the Supplemental Register. Further, in light of the amendments, Applicant respectfully requests the Examining Attorney withdraw the final refusal of the Application on mere descriptiveness grounds, and allow the Application to proceed to registration. Applicant further requests, based on the present circumstances, the appeal be terminated as moot.

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Applicant: WGVS USA, LLC

Mark: WORLD'S GREATEST VIDEOS

Serial No.: 87/205,484

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Dear Sir or Madam:

Please enter the following amendment and consider the accompanying remarks in the above-identified matter.

AMENDMENT

Amend the pending application as follows:

The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register').

REMARKS

The foregoing Amendment and these Remarks are filed in response to the refusal under Section 2(e)(1) of the Trademark Act cited initially in the January 26, 2017 Non-Final Office Action and maintained through the Examining Attorney's Brief filed June 14, 2018.

Applicant has filed with the U.S. Patent and Trademark Office, an Amendment to Allege Use ("AAU") for all International Classes recited in the subject application. Because it could not statutorily avail itself of the benefits of registration on the Supplemental Register until the AAU

