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Subject: U.S. Trademark Application Serial No. 87633805 - NAME THAT MOVIE - N/A - 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. 87633805

Mark: NAME THAT MOVIE

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Applicant: Prestige Entertainment Group, LLC

Reference/Docket No. N/A

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: February 08, 2021

THIS REFUSAL IS PARTIAL AND ONLY APPLIES TO INTERNATIONAL CLASS 28

Applicant's request for reconsideration is denied. See 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not:

(1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Applicant is correct that the July 5, 2019 refusal obviates the refusal in International Class 41. Accordingly, that refusal should not have been made Final the July 7, 2020 Office action, and the refusal is now, again, treated as obviated. Accordingly, International Class 41 is acceptable with the 2(f) claim.

Applicant argues in favor of its 2(f) claim with respect to International Class 28 by again pointing to registrations owned by iconic television programs. However, the presence of a few television programs branded in a variety of fields, including lottery tickets and slot machines, does not indicate that it is self-evident that all of the goods and services owned under the mark for those programs would be related. Moreover, here, applicant's prior registration is not for television programs at all, but instead is for an on-line forum. As such, applicant's argument appears to rely on a belief that all goods and services which may be registered under the name of a television program are also related to all other goods and services registered under the name of that television program. This argument is not persuasive.

Applicant also requested suspension of the application until applicant submits an allegation of use and this can be amended to the Supplemental Register. However, "suspension of action" means suspending action *by the examining attorney*. It does not mean suspending or extending an applicant's time to respond. The Trademark Act requires that an applicant respond within six months of an examining attorney's Office action, and the examining attorney has no discretion to suspend or extend the time for the applicant's response. *See* 15 U.S.C. §1062(b); TMEP §716. Here, a suspension pending submission of an allegation of use would constitute an indefinite extension of the six month response time for applicant to resolve the descriptiveness issue. Accordingly, such suspension is improper.

Here, applicant has not submitted an allegation of use, and has not, and indeed, may not, amend to the Supplemental register, until that submission is made.

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated July 7, 2020 are **maintained and continued**:

- SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE WITH RESPECT TO INTERNATIONAL CLASS

28

See TMEP §§715.03(a)(ii)(B), 715.04(a).

In addition, the following requirement(s) and/or refusal(s) made final in that Office action are obviated:

- SECTION 2(e)(1) REFUSAL WITH RESPECT TO INTERNATIONAL CLASS 41.

See TMEP §§715.03(a)(ii)(B), 715.04(a).

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

If applicant has not filed an appeal and time remains in the six-month response period, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes 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). Filing 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(c).

/Chris Reams/

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