

To: BlackStar Creative, LLC (pperkins@creativegeniuslaw.com)
Subject: U.S. Trademark Application Serial No. 87732976 - PROFESSIONAL BLACK GIRL - N/A
Sent: December 31, 2019 08:07:30 AM
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Attachments: [Attachment - 1](#)

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 87732976

Mark: PROFESSIONAL BLACK GIRL

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Reference/Docket No. N/A

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FINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS) and/or Electronic System for Trademark Trials and Appeals (ESTTA). A link to the appropriate TEAS response form and/or to ESTTA for an appeal appears at the end of this Office action.

Issue date: **December 31, 2019**

INTRODUCTION

This Office action is in response to applicant's communication filed on December 7, 2019.

In a previous Office action dated June 7, 2019, the trademark examining attorney refused registration of the applied-for mark based on the following: Trademark Act Section 2(e)(1) as merely descriptive of the services in Class 41. In addition, applicant was required to satisfy the requirement to amend the identification of services in Class 41.

The trademark examining attorney maintains and now makes **FINAL** the refusal and requirement in the summary of issues below. *See* 37 C.F.R. §2.63(b); TMEP §714.04.

SUMMARY OF ISSUES MADE FINAL that applicant must address:

- Section 2(e)(1) Refusal – Merely Descriptive – *Class 41 Only*
- Identification of Services – *Class 41 Only*
- Request to Divide - *Advisory*

SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE – Class 41 Only

Registration was refused because the applied-for mark merely describes the feature or subject matter of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Applicant has applied to register the mark "PROFESSIONAL BLACK GIRL" for, in relevant part, "online publishing, namely, original video series and digital media that celebrates everyday black girlhood and womanhood" in Class 41. In its December 7, 2019 response, applicant

amended the wording in the identification of services to “providing online publishing, namely, original video series and digital media that celebrates everyday black girlhood and womanhood, not downloadable,” however, as described further below, this wording is unacceptable and therefore the original wording remains operative.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

Applicant argues that the applied-for mark “does not describe characteristics, functions or qualities” of its services. In reaching this conclusion, applicant first notes that “BLACK GIRL” is not a profession and therefore that the term “PROFESSIONAL” cannot be merely descriptive. Applicant then later states that the applied-for mark cannot be merely descriptive because “GIRL” typically refers to a child, and children are not “typically deemed” professionals.

First, marks comprising more than one element must be considered as a whole and should not be dissected; however, a trademark examining attorney may consider the significance of each element separately in the course of evaluating the mark as a whole. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1253, 103 USPQ2d 1753, 1756-57 (Fed. Cir. 2012) (reversing Board’s denial of cancellation for SNAP! with design for medical syringes as not merely descriptive when noting that the Board “to be sure, [could] ascertain the meaning and weight of each of the components that ma[de] up the mark”); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009) (holding HOTELS.COM generic for information and reservation services featuring temporary lodging when noting that the Board did not commit error in considering “the word ‘hotels’ for genericness separate from the ‘.com’ suffix”).

Further, the determination of whether a mark is merely descriptive is made in relation to an applicant’s services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system).

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

The newly-attached evidence from Merriam-Webster shows that “GIRL” can mean “a young woman” and is often used to describe “a female friend” as well as “a friendly way of addressing a woman”. Thus the applied-for mark, when viewed in relation to the applicant’s services, will be understood to feature professional black women. Similarly although “BLACK GIRL” is not a profession, as argued in the applicant’s response, when viewed in relation to the applicant’s services, the term “PROFESSIONAL” will be viewed as modifying “BLACK GIRL”, and therefore consumers would understand the applicant to provide videos featuring professional black women.

In addition to the foregoing, applicant’s evidence showing the alleged acquired distinctiveness further demonstrates the descriptiveness of the applied-for mark (“‘Professional Black Girl’ Is a Love Letter to Black Women Worldwide”, “‘Professional Black Girl’ Celebrates the Magic Black Women Create Every Day”, “Are You A ‘Professional Black Girl’?”, “‘Professional Black Girl’ Web-series Epitomizes the Excellence of Black Womanhood”, “#ProfessionalBlackGirl Celebrates the Everyday Magic of Black Women”). Such headlines demonstrate not only that consumers would understand “GIRL” to refer to women, but also that the applied-for mark describes the feature or subject matter of applicant’s services because applicant provides videos featuring professional black women. Further still, applicant’s attached evidence from ebony.com states that “Blay interviewed 15 Black girls and women...askingeach participant to talk about what makes them...professionalBlack girls.” Therefore, the wording “PROFESSIONAL BLACK GIRL” merely describes the feature or subject matter of the applicant’s services by providing videos in which interviewees describe what makes them “professional Black girls”.

Applicant also argues that it has coined the term “PROFESSIONAL BLACK GIRL” and is the main or only user of the term as showed by its attached Google search results. However, the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that “PROFESSIONAL BLACK GIRL” is merely descriptive. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); TMEP §1209.03(c).

In light of the foregoing, because applicant provides videos featuring professional black women who discuss what it means to be a professional black woman, the wording “PROFESSIONAL BLACK GIRL” merely describes the feature or subject matter of applicant’s services.

As a result, “PROFESSIONAL BLACK GIRL” is merely descriptive of the feature or subject matter of applicant’s services, and therefore registration must be refused on the Principal Register under Section 2(e)(1) of the Trademark Act.

SUPPLEMENTAL REGISTER ADVISORY

The applied-for mark has been refused registration on the Principal Register. Applicant may respond by submitting evidence and arguments

against the refusal. In addition, applicant may respond by doing one of the following: (1) amending the application to seek registration under Trademark Act Section 2(f), or (2) amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §§1052(f), 1091.

To amend the application to the Supplemental Register, applicant must provide a written statement requesting that the application be amended to the Supplemental Register. TMEP §816.01; *see* 15 U.S.C. §1091; 37 C.F.R. §2.47.

IDENTIFICATION OF SERVICES – Class 41 Only

Applicant must clarify the wording in the identification of services in International Class 41 because it is indefinite. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

Applicant originally identified its services as “online publishing, namely, original video series and digital media that celebrates everyday black girlhood and womanhood” in Class 41. In its December 7, 2019 response, applicant amended the wording in the identification of services to “providing online publishing, namely, original video series and digital media that celebrates everyday black girlhood and womanhood, not downloadable.” The proposed amendment to the identification of services is not acceptable for the reasons stated in this Office action. Thus, the previous wording in the existing identification remains operative for purposes of future amendments and for determining the scope of future amendments. *See* TMEP §1402.07(d).

This wording is indefinite because it does not make clear what the services are. Publishing services in Class 41 generally refers to the service of publishing the periodicals or printed matter of others. However, “digital video, audio, and multimedia publishing services” in Class 41 is different from providing the publication itself. This service encompasses the presentation of the works online, not providing the work itself. Applicant must clarify the nature of the services.

Applicant may substitute the following wording, if accurate:

International Class 41:

Digital video and **multimedia** publishing services, namely, video and **multimedia** that celebrates everyday black girlhood and womanhood

If instead applicant is merely providing online non-downloadable videos, applicant should clarify the wording to state “Providing on-line videos featuring everyday black girlhood and womanhood, not downloadable.”

Applicant may amend the identification to clarify or limit the services, but not to broaden or expand the services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted services may not later be reinserted. *See* TMEP §1402.07(e).

For assistance with identifying and classifying services in trademark applications, please see the USPTO’s online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). *See* TMEP §1402.04.

REQUEST TO DIVIDE – Advisory

In response to a refusal or requirement that pertains only to certain classes, goods, and/or services, an applicant may [file a request to divide the application](#) (form # 3) into two or more separate applications so that any acceptable classes, goods, and/or services may be transferred to the divided out application(s) and proceed toward registration. *See* 37 C.F.R. §2.87; TMEP §1110 *et seq.* Any outstanding deadline in effect at the time the application is divided will generally apply to each new divided out application. *See* 37 C.F.R. §2.87(e); TMEP §1110.05 (see list of exceptions).

There is a fee for each new application created. *See* 37 C.F.R. §§2.6(a)(19)(ii), 2.87(b); TMEP §1110.04. And if dividing out some, but not all, of the goods or services within a class, an additional application filing fee will be required for each new separate application created by the division. 37 C.F.R. §§2.6(a)(1)(i)-(iii), 2.87(b); TMEP §1110.02.

In this case the outstanding refusal and requirement only pertain to Class 41. As such, *applicant may divide Class 25 into a new application and proceed toward registration on the Principal Register as to the goods in Class 25.* Further, applicant should note that although the wording “BLACK GIRL” is currently disclaimed, this wording is not descriptive as to the goods in Class 25. Therefore, if applicant were to divide Class 25 into a new application, *the disclaimer may be withdrawn as to the goods in Class 25.*

RESPONSE GUIDELINES

If applicant does not timely respond within six months of the issue date of this final Office action, the following class to which the final refusal and requirement apply will be **deleted** from the application by Examiner’s Amendment: Class 41. 37 C.F.R. §2.65(a); *see* 15 U.S.C. §1062(b).

In such case, the application will proceed for Class 25 only.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner’s amendment by telephone or e-mail without incurring this additional fee.

How to respond. [Click to file a request for reconsideration of this final Office action](#) that fully resolves all outstanding requirements and refusals **and/or** [click to file a timely appeal to the Trademark Trial and Appeal Board \(TTAB\)](#) with the required filing fee(s).

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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA maintenance or [unforeseen circumstances](#) could affect an applicant’s ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.



SINCE 1828

girl

DICTIONARY THESAURUS



Just BARE Chicken No Antibiotics Ever, 100% Natural Chicken  **amazon fresh** Shop now

girl noun

Save Word


\ ˈgɜr(-ə) \

Definition of girl

- 1
 - a : a female child from birth to adulthood
 - b : DAUGHTER
 - c : a young woman
 - d *sometimes offensive* : a single or married woman of any age
- 2
 - a : SWEETHEART
 - b *often offensive* : a female servant or employee
- 3 *US, informal*
 - a : a female friend
// I love going to a spa and dinner with my *girls*.
— Karen Clifton
 - b —used as a friendly way of addressing a woman or girl
// Hey *girl*, I like your taste in Christmas gifts.
— Miranda Crace
// *Girl*, you need to give yourself some credit.
— John Van Meter

Other Words from girl

Synonyms

Just BARE Chicken No Antibiotics Ever, 100% Natural Chicken  **amazon fresh** Shop now

WORD OF THE DAY
shindig
a usually large or lavish party
Get Word of the Day daily email!
Your email address **SUBSCRIBE**

Just BARE Chicken No Antibiotics Ever, 100% Natural Chicken  **amazon fresh** Shop now

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Subject: U.S. Trademark Application Serial No. 87732976 - PROFESSIONAL BLACK GIRL - N/A
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Sent As: ecom117@uspto.gov
Attachments:

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on **December 31, 2019** for
U.S. Trademark Application Serial No. 87732976

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be [abandoned](#). Please follow the steps below.

- (1) [Read the official letter](#).
- (2) **Direct questions** about the contents of the Office action to the assigned attorney below.

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Direct questions about navigating USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the [Trademark Assistance Center \(TAC\)](#).

(3) **Respond within 6 months** (or earlier, if required in the Office action) from **December 31, 2019**, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond

GENERAL GUIDANCE

- [Check the status of your application periodically](#) in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- [Update your correspondence email address](#), if needed, to ensure you receive important USPTO notices about your application.
- [Beware of misleading notices sent by private companies about your application](#). Private companies not associated with the USPTO use public information available in trademark registrations to mail and email trademark-related offers and notices – most of which require fees. All **official USPTO correspondence** will only be **emailed from the domain “@uspto.gov.”**