

To: Killer Queen, LLC (schlossd@gtlaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86529342 - 071363.01160
Sent: 4/15/2015 5:10:52 PM
Sent As: ECOM109@USPTO.GOV
Attachments:

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

U.S. APPLICATION SERIAL NO. 86529342

MARK:

86529342

CORRESPONDENT ADDRESS:

DANIEL I. SCHLOSS
GREENBERG TRAUIG
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<http://www.uspto.gov/trademarks/teas/response>

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Killer Queen, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

071363.01160

CORRESPONDENT E-MAIL ADDRESS:

schlossd@gtlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 4/15/2015

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Search

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Does Not Function as a Service Mark – Identifies Design of Character – Class 41

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). 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 shark does not identify and distinguish applicant's musical and dance performances.

Refusal Pertains to One of More than Two Classes

The stated refusal refers to International Class 41 only and does not bar registration in the other classes.

Applicant's Options

Applicant may respond to the stated refusal by submitting evidence and arguments against the refusal. In addition, applicant may respond by doing one of the following:

- (1) Deleting the class to which the refusal pertains;
- (2) Filing a request to divide out the goods and/or services that have not been refused registration, so that the mark may proceed toward publication for opposition in the classes to which the refusal does not pertain. *See* 37 C.F.R. §2.87. *See generally* TMEP §§1110 *et seq.* (regarding the requirements for filing a request to divide). If applicant files a request to divide, then to avoid abandonment, applicant must also file a timely response to all outstanding issues in this Office action, including the refusal. 37 C.F.R. §2.87(e); or
- (3) Amending the basis, if appropriate. TMEP §806.03(h). (The basis cannot be changed for applications filed under Trademark Act Section 66(a). TMEP §1904.01(a).)

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

Application Informalities

Mark Differs on Drawing and Specimen – Material – Class 41

Registration is refused because the specimen does not show the applied-for mark in the drawing in use in commerce in International Class 41. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). Specifically, the specimen displays the mark as a stylized depiction of a forward leaning shark in nearly a front profile with a portion of a dorsal fin, two pectoral fins and two legs and feet substituted for the caudal fin on the tail; the shark

has five gills, a full mouth with teeth and round eyes with eyelids; however, the drawing displays the mark as a stylized depiction of an upright shark in right profile with a dorsal fin, one pectoral fin and a portion of the caudal fin on the tail; the shark has three gills and only a portion of the shark's mouth, without teeth, appears in the drawing; the shark also has oval eyes without eyelids.

The drawing shows the mark sought to be registered, and must be a substantially exact representation of the mark as used on or in connection with the goods and/or services, as shown by the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a). Because the mark in the drawing is not a substantially exact representation of the mark on the specimen, applicant has failed to provide the required evidence of use of the applied-for mark in commerce on or in connection with applicant's goods and/or services. *See* TMEP §807.12(a).

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 application or amendment to allege 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).

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).

Regarding whether applicant may submit an amended drawing in response to this refusal, applicant is advised that the drawing of a mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.* In this case, amending the mark in the drawing to conform to the mark on the specimen would be a material alteration and would not be accepted, because the difference between the mark in the specimen and the drawing is significant and each mark creates a different commercial impression. Specifically, the mark in the specimen depicts a walking shark, while the mark in the drawing depicts a shark in the upright position, without legs or feet, with numerous additional differences in appearance to the mark as depicted in the specimen.

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a different specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the applied-for mark in actual use in commerce for the goods and/or services identified in the application or amendment to allege use.
- (2) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen at a subsequent date.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to

http://www.uspto.gov/trademarks/law/J3_1.jsp.

Identification of Goods

A portion of the identification of goods in International Classes 25 and 28 are unacceptable as indefinite because the goods listed were not specific enough and may be classified in several different International Classes. *See* TMEP §1402.01.

Please note that the identification of goods and services in International Classes 9, 16, 21 and 41 are acceptable as submitted.

Class 17

“Figurines made of rubber”;

Class 19

“Figurines of stone”;

Class 20

“Figurines of ____ {specify, e.g., bone, ivory, plastic, wax, plaster, wood}”;

Class 21

“Mugs; figurines of ____ {china, crystal, earthenware, glass, porcelain, terra cotta}”;

Class 25

The wording “costumes” in the identification of goods must be clarified because it is too broad and could include goods in other international classes. *See* TMEP §§1402.01, 1402.03.

Applicant may adopt the following identification of goods, if accurate:

“T-shirts, sweatshirts, hats, {specify, e.g., dance, Halloween} ____ costumes”;

Class 28

The wording “figurines” in the identification of goods must be clarified because it is too broad and could include goods in other international classes. *See* TMEP §§1402.01, 1402.03.

Applicant may adopt the following identification of goods, if accurate:

“Plush toys, action figures, {specify, e.g., modeled plastic toy} ____ figurines; costume masks; doll costumes”.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>.

Please note that, while the identification of services may be amended to clarify or limit the services, adding to the services or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include services that are not within the scope of the services set forth in the present identification.

Multiple Class Requirements

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fee(s) already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least nine classes; however, applicant submitted a fee(s) sufficient for only six class(es). Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Stated Requirement Pertains to Specific Goods

The stated refusal refers to the following goods and does not bar registration for the other goods: “costumes; figurines.”

Color Claim

Applicant has submitted a color drawing and provided a mark description referencing color, but has not provided a complete color claim. Applications for marks depicted in color must include a complete list of all the colors claimed as a feature of the mark. 37 C.F.R. §2.52(b)(1); see TMEP §§807.07(a) *et seq.*

If black, white and/or gray are not being claimed as a color feature of the mark, applicant must state that the colors black, white and/or gray represent background, outlining, shading and/or transparent areas and are not part of the mark. TMEP §807.07(d). Generic color names must be used to identify the colors in the mark, e.g., magenta, yellow, turquoise. TMEP §807.07(a)(i)-(a)(ii).

Therefore, applicant must provide the required color claim. The following is suggested, if accurate: **“The colors black, white and blue are claimed as a feature of the mark.”** TMEP §807.07(a)(i).

Mark Description

Applicant must submit an accurate and concise description of the literal and design elements in the mark. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. The following is suggested, if accurate:

The mark consists of a stylized depiction of a standing shark in right profile; the shark's body is blue; the shark's snout is white; and the sharks gills, eyes, mouth and outline are black.

Response

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.

/David Collier/
Examining Attorney
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **4/15/2015** FOR U.S. APPLICATION SERIAL NO. 86529342

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **4/15/2015** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see

<http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.