

To: Adams, Augustus G. (augadams1@gmail.com)
Subject: TRADEMARK APPLICATION NO. 77148019 - INTELLIGENT PARODIES - N/A
Sent: 7/23/2007 12:10:34 PM
Sent As: ECOM106@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/148019

MARK: INTELLIGENT PARODIES

77148019

CORRESPONDENT ADDRESS:
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4119 DAVIS PL NW APT 205
WASHINGTON, DC 20007-1254

RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Adams, Augustus G.

CORRESPONDENT'S REFERENCE/DOCKET NO :
N/A

CORRESPONDENT E-MAIL ADDRESS:
augadams1@gmail.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 7/23/2007

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: TEAS Plus applicants should submit the following documents using the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>: (1) written responses to Office actions; (2) preliminary amendments; (3) changes of correspondence address; (4) changes of owner's address; (5) appointments and revocations of attorney; (6) amendments to allege use; (7) statements of use; (8) requests for extension of time to file a statement of use, and (9) requests to delete a §1(b) basis. If any of these documents are filed on paper, they must be accompanied by a \$50 per class fee. 37 C.F.R. §§2.6(a)(1)(iv) and 2.23(a)(i). Telephone responses will not incur an additional fee. NOTE: In addition to the above, applicant must also continue to accept correspondence from the Office via e-mail throughout the examination process in order to avoid the additional fee. 37 C.F.R. §2.23(a)(2).

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

Registration is refused because the proposed mark, as used on the specimen of record, is used only as the title of a single creative work, namely, the title of a specific book/DVD/ videotape/CD; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052 and 1127; *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (C.C.P.A. 1958); *see In re Scholastic, Inc.*, 23 USPQ2d 1774, (TTAB 1992); TMEP §1202.08. Single creative works include works in which the content does not change, whether that work is in printed, recorded or electronic form.

Applicant may respond to this refusal by submitting evidence that the proposed mark is used to identify a series, rather than a single work. The name for a series of creative works indicates that each work in the series comes from the same source as the others. *Scholastic*, 23 USPQ2d at 1776. Evidence of a series includes copies of at least two different book covers or packaging for prerecorded works (not two copies of the same work) showing the mark as a source identifier for the series as well as distinguishing the mark from the individual titles of the works. *Id.*

If applicant cannot satisfy the requirement for evidence of a series, applicant may amend the Section 1(a) filing basis (use in commerce) to Section 1(b) (intent to use), and the refusal will be withdrawn. However, should applicant amend the basis to Section 1(b), registration cannot be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use along with evidence of use on a series. 15 U.S.C. §1051(c); 37 C.F.R. §§2.76, 2.88; TMEP Chapter 1100.

In order to amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.**” 15 U.S.C. §1051(b); 37 C.F.R. §§2.34(a)(2) and 2.35(b)(1); TMEP §806.01(b).

The Trademark Trial and Appeal Board in *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984) and *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) refers to *In re Cooper*, 254 F. 2d 611, 117 USPQ 396 (C.C.P.A. 1958), as the “seminal case” in this area of trademark law. In *Cooper*, the U.S. Court of Custom and Patent Appeals affirmed a refusal to register a mark for a single children’s book. The Court essentially held that the title of a single book, even an arbitrary title, is merely descriptive of the literary work itself “and is not associated in the public mind with the publisher, printer or bookseller” whereas “[t]he name for a series, at least while it is still being published, has a trademark function in indicating that each book of the series comes from the same source as the others.” *In re Cooper*, 117 USPQ at 400.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

The applicant must disclaim the descriptive wording “parodies” apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). The wording is merely descriptive because it tells us something about the subject matter of the material.

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP §1213.08(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use parodies apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm’r Pats. 1983).

A disclaimer does *not* physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing.

The following cases explain the disclaimer requirement more fully: *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983); *In re EBS Data Processing, Inc.*, 212 USPQ 964 (TTAB 1981); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977).

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

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Dominick J. Salemi/
Trademark Attorney
Law Office 106
Phone: 571 272 9330
Fax: 571 273 9106 (formal responses)

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office Action should be filed using the Office’s Response to Office action form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for

Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 7/23/2007 FOR
APPLICATION SERIAL NO. 77148019

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://portal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77148019&doc_type=OOA&mail_date=20070723 (or copy and paste this URL into the address field of your browser), or visit <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **7/23/2007**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.**