

**To:** Chang, David T ([david\\_chang40@hotmail.com](mailto:david_chang40@hotmail.com))  
**Subject:** TRADEMARK APPLICATION NO. 78126848 - GHETTOPOLY...A STOLEN PROPERTY FENCING G ETC. - N/A  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/126848

**APPLICANT:** Chang, David T

**CORRESPONDENT ADDRESS:**  
DAVID T CHANG  
226 Chestnut St.  
St. Mary's PA 15857

**RETURN ADDRESS:**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
[ecom102@uspto.gov](mailto:ecom102@uspto.gov)

**MARK:** GHETTOPOLY...A STOLEN PROPERTY FENCING G ETC.

**CORRESPONDENT'S REFERENCE/DOCKET NO :** N/A

**CORRESPONDENT EMAIL ADDRESS:**  
[david\\_chang40@hotmail.com](mailto:david_chang40@hotmail.com)

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

Serial Number 78/126848

This letter responds to the applicant's communication(s) dated October 24, 2002.

The examining attorney has reviewed the above referenced response and determined the following:

REGISTRATION

**1. Likelihood of Confusion**

Registration was also refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 21,536,501, as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive.

The examining attorney has considered the applicant's arguments in favor of registration, carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(d) is maintained and made *FINAL*.

The applicant has applied to register the mark, **GHETTOPOLY (and Design)** for a board game. Registration was refused based on a prior registration for "**MONOPOLY** also for a board game. The applicant argues that the marks are distinctively different, and the examining attorney has considered those arguments. The examining attorney must analyze each case in two steps to determine whether there is

a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Secondly, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

### *DuPont Analysis*

#### **A. The Sound, Commercial Meaning, and Impression of the Marks are Closely Related.**

The proposed mark and the prior registered mark are highly similar under the analysis set forth above. In particular, the sound, commercial meaning and impression of the marks are closely related. The issue in this case is whether the users of the applicant's and the defendant's services which be confused as to the source of origin of the services. And in determining the likelihood of confusion, the similarity between the marks must be considered. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). In considering the degree of similarity of marks the Tenth Circuit in the case opined in *Universal Money Ctrs. V. American Telephone & Telegraph Co.*, 22 F.3d 1527 (10<sup>th</sup> Cir. 1994), *cir denied*, 115 S.Ct. 644 (1994):

The degree of similarity between marks is tested on three levels as encountered in the marketplace: sight, sound, and meaning. In evaluating similarity, we must not engage in a "side-by-side" comparison. Rather the court must determine whether the alleged infringing mark will be confusing to the public when singly presented. Further, similarities between marks should be given more weight than differences. *Warner Bros. V. American Broadcasting Cos.*, 720 F.2d 231 (2d Cir. 1983); 42 USPQ 2d 1455, 949 F.Supp 1539 (1996).

### *Well Known Mark*

The issue under Section 2(d) is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b). In considering the commercial impression of the marks, an additional fact to be considered in this instance is the well known nature of the registrant's mark; the so called "fame" of the mark: With regard to famous marks, Trademark Manual of Examining Procedure states:

The fame of a registered mark is a factor to be considered in determining likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (Trademark Trial and Appeal Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH). The Court of Appeals for the Federal Circuit has stated:

[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.

Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

*Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456.

When present, the fame of the mark is "a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1328, 54 USPQ2d 1894, 1898. However, like the other *du Pont* factors, the fame of a mark may be considered only if there is relevant evidence of record. See TMEP §1207.01 and cases cited therein. In *Tiffany & Broadway v. Commissioner*, 167 F. Supp.2d 949 (S.D. Tex. 2001), the fame of four registered marks cited against the applicant was a significant factor in finding a likelihood of confusion between applicant's TIFFANY for ladies' dress shoes and registrant's TIFFANY and TIFFANY & CO. for a variety of goods, including jewelry, china, silverware, glassware, leather goods, belt buckles, ties, scarves, clocks, watches, brushes and lamps, and for retail store services specializing in the sale of jewelry, watches, clocks, and gift items. The *ex parte* record included excerpts from 18 news articles where the registrant Tiffany & Company was identified as a

famous business; citations to three published decisions in which the fame of the TIFFANY mark had been judicially recognized; and evidence that the registrant's goods were sold at over 60 Tiffany locations worldwide--including 34 in the United States--and through independently-owned retail stores and mail order outlets.

The examining attorney submitted Lexis Nexis evidence of the fame of the registered mark, Monopoly, in the initial refusal. One excerpt for example states that over 150 million copies of the game Monopoly have been sold world wide. *McClathy Newspapers Inc. September 1, 2002*. Furthermore, in its response the applicant submits evidence of a Supreme Court suit involving the game "Monopoly," which also evidences the fame of the mark. *Anti-Monopoly, Inc. v. Hasbro, Inc.*, 525 U.S. 813; 119 S. Ct. 48; 142 L. Ed. 2d 37 (1998). The evidence indicates that the game monopoly has existed for many years, may have been known by the name "Monopoly" as early as 1911. As opined by the Trademark Trial and Appeal Board, therefore, the fame of the mark is a dominant consideration in the likelihood of confusion in this case.

#### Parody

The applicant argues, however, that it's mark, Ghettopoly, is a parody of the famous "Monopoly" mark. <sup>[1]</sup> The applicant's argument is unconvincing. With regard to parodies, the Trademark Trial and Appeal Board has opined:

Parody is not a defense to a likelihood of confusion refusal. There are confusing parodies and non-confusing parodies. See 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §31.153 (4<sup>th</sup> ed. 2000). A true parody actually decreases the likelihood of confusion because the effect of the parody is to create a distinction in the viewer's mind between the actual product and the joke. While a parody must call to mind the actual product to be successful, the same success also necessarily distinguishes the parody from the actual product. *Mutual of Omaha Insurance Co. v. Novak*, 648 F. Supp. 905, 231 USPQ 963 (D. Neb. 1986).

Another example of parody can be found in *Columbia Pictures Industries Inc., v. Miller*, 211 USPQ 816 (TTAB 1981) (CLOTHES ENCOUNTERS held likely to be confused with CLOSE ENCOUNTERS OF THE THIRD KIND, for men's and women's clothing); *Cf., Jordache Enterprises, Inc. v. Hogg Wyld, Inc.*, 828 F.2d 1482, 4 USPQ2d 1216 (10<sup>th</sup> Cir. 1987) (LARDASHE for pants was not an infringement of the JORDACHE mark).

A parody is intended to create a distinct commercial impression, which is intended to be a "joke." A parody is distinct from a mark which disparages or brings into ridicule a group of persons. The examining attorney provided evidence in the initial office action that the proposed mark is disparaging, makes fun of various social groups and races. The proposed mark, then may not be considered a "Parody." <sup>[2]</sup> See also *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3<sup>rd</sup> 806 (2<sup>nd</sup> Cir. 1999) ("[A] parodist whose expressive work aims its parodic commentary at a trademark is given considerable leeway, but a claimed parodic use that makes no comment on the mark is not permitted trademark parody use").

The applicant has also made reference to the following claims:

#### First Amendment

It is well settled that free speech is not a viable defense to the claim of trademark violations. *Purcell v. Summers*, 145 F.2d 979 (4<sup>th</sup> Cir. 1944); *Urantia Found v. Maaherra*; 895 F.Supp 1329 (Arizona Dist. 1995). The courts have opined that the free speech issue with regard to trademarks is relevant only when the trademark is not being used as a source identifier. See *Anti-Monopoly, Inc. v. Gen. Mills Fun Group*, 611 F.2d 296 (9<sup>th</sup> Cir. 1979). Moreover, the courts have concluded that the use of a trademark as a source identifier is a "noncommercial use exemption" to the First Amendment. *Matel Inc. et al. V. MCA Records, Inc., et al*, 296 F.3<sup>rd</sup> 894 (9<sup>th</sup> Cir 2002). The applicant's free speech claim then is not relevant to the issue of the registrability of the proposed mark.

#### Defamation

Although the applicant has not made it clear the relevance of the issue of defamation to the trademark application. The applicant should note that the courts have normally addressed the issue of defamation arising from trademark usage; rather than initial applications for trademarks. <sup>[3]</sup> See, *Matel Inc. et al. V. MCA Records, Inc., et al*, 296 F.3<sup>rd</sup> 894 (9<sup>th</sup> Cir 2002).

#### B. The Goods of the Parties Are Identical

Secondly, the goods of the parties are identical. As noted in the initial refusal, the goods or services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Both the applicant and the registrant offer

The presumption under Trademark Act Section 7(b), 15 U.S.C. Section 1057(b), that the registrant is the owner of the mark, extends to all services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960 (TTAB 1980). As such, it is presumed that the applicant may offer computer consulting, programming and other services offered by the registrant, in addition to its educational services. Furthermore, in cases of doubt, the examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.* 203 USPQ 191 (TTAB 1979).

## 2. Falsely Suggest a Connection

The refusal under Trademark Act Section 2(a), 15 U.S. C. Section 1052(a); TMEP Sections 1203.3(e) and 1203.03(f) is continued and made Final.

The examining attorney herein incorporates the arguments above by reference, including the evidence previously submitted.

## 3. Disparages and Brings Into Contempt

The refusal under Trademark Act Section 2(a), 15 U.S. C. Section 1052(a) is continued and made Final.

The examining attorney herein incorporates the arguments above by reference, including the evidence previous submitted.

### Informalities

#### **Drawing of the Mark**

The drawing remains unacceptable because it will not reproduce satisfactorily. The applicant must submit a new drawing showing the mark clearly and conforming to 37 C.F.R. §2.52. TMEP §807.07(a).

The requirements for a special-form drawing are as follows:

- (1) The drawing must appear in black and white; no color is permitted.
- (2) Every line and letter must be black and clear.
- (3) The use of gray to indicate shading is unacceptable.
- (4) The lining must not be too fine or too close together.
- (5) The preferred size of the area in which the mark is displayed is 2½ inches (6.1 cm.) high and 2½ inches (6.1 cm.) wide. It should not be larger than 4 inches (10.3 cm.) high or 4 inches (10.3 cm.) wide.
- (6) If the reduction of the mark to the required size renders any details illegible, the applicant may insert a statement in the application to describe the mark and these details.

37 C.F.R. §2.52; TMEP §§807.01(b) and 807.07(a). The Office will enforce these drawing requirements strictly.

The Office prefers that the drawing be depicted on a separate sheet of smooth, nonshiny, white paper 8 to 8½ inches (20.3 to 21.6 cm.) wide and 11 inches (27.9 cm.) long, and that the sheet contain a heading listing, on separate lines, the applicant's complete name; the applicant's address; the goods or services recited in the application; and, if the application is filed under Section 1(a) of the Act, the dates of first use of the mark and of first use of the mark in commerce; or, if the application is filed under Section 44(d), the priority filing date of the foreign application. 37 C.F.R. §2.52(b); TMEP §§807.01(a), 807.01(b), 807.01(c) and 807.07(a).

The requirement as to the drawing is continued and made **Final**.

#### *Advisory Note:*

The applicant filed a subsequent request which was not a part of the response requesting that the mark be amended to : Ghettopoly...Astolen Property Fencing Game. The applicant should note:

*Drawing May not be Materially Altered*

An applicant cannot amend the drawing of the mark if the change materially alters the mark. TMEP §807.14(a). The Office determines whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application. 37 C.F.R. §2.72. TMEP §807.14(a)(i).

Effective October 30, 1999, 37 C.F.R. §2.72 was amended. The revised rule applies to applications pending on or after October 30, 1999. Under the new rule, an applicant cannot amend the drawing of the mark if the change materially alters the mark. The new rule also requires the Office to determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application. TMEP §807.14(a)(i).

### **Applicant's Response**

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Commissioner if permitted by 37 C.F.R. Section 2.63(b). 37 C.F.R. Section 2.64(a). Regarding petitions to the Commissioner, see 37 C.F.R. Section 2.146; TMEP sections 1702 and 1704. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.65(a).

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

/pbm/  
Paula B. Mays  
Trademark Examining Attorney  
Law Office 102  
(703) 308-9102 ext. 159  
E-Mail: ecom102@uspto.gov  
Facsimile (703) 746-8102

### **How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

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[1] The applicant argues that similar to the "Hasbro" case where the appellee was successful, its mark is a parody of the famous trademark.

[2] The mark in the Supreme Court decision was "AntiMonopoly" a play off the word game monopoly, which automatically conjures the image of a joke.

[3] It is assumed that the applicant tries to argue that its mark is not defamatory, however, no such assertion has been made by the examining attorney.