

**To:** Clayton G. Keeler ([ckeeler@xarenasports.com](mailto:ckeeler@xarenasports.com))  
**Subject:** TRADEMARK APPLICATION NO. 78153828 - XARENA  
**Sent:** 1/23/03 8:09:37 AM  
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**Attachments:** [Attachment - 1](#)  
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## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/153828

**APPLICANT:** Clayton G. Keeler

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**MARK:** XARENA

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

**CORRESPONDENT EMAIL ADDRESS:**  
[ckeeler@xarenasports.com](mailto:ckeeler@xarenasports.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 78/153828

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

### **No Conflicting Marks Noted**

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 § 1207.01 *et seq.*

### **Informalities**

Although the examining attorney has not refused registration on any substantive basis, the applicant must respond to the following informalities.

### **Identification of Goods and/or Services**

The identification of goods and/or services is unacceptable as indefinite because "the arena will have multiple uses" is informational and may imply arena services, e.g., arena services, namely providing facilities for extreme sports and exhibitions in Class 43. The applicant must clearly indicate that it is providing restaurant services. The wording "pro shop" is unacceptable as indefinite because the specific nature of the services is not clear and is misclassified, e.g., retail store services, namely, pro shop services featuring sporting goods in Class 35. The wording "spectating" is unacceptable as indefinite because the specific nature of the services is not clear. Given the nature of an arena, spectating is part of providing the arena facilities and the applicant's customers are actually the spectators. Unless the applicant is actually viewing the games for customers, spectating would not be considered a service. TMEP §1301.01(a). The wording "video games" is unacceptable as indefinite because the specific nature of the goods and/or services is not clear and may contain goods and/or services classified in more than one class of

video game cartridges in Class 9; video game software in Class 9; coin-operated video games in Class 28; stand alone video game machines in Class 28; amusement arcades featuring coin-operated video games in Class 41. The applicant must amend the identification to specify the common commercial name of the goods. If there is no common commercial name, the applicant must describe the product and its intended uses. TMEP §1402.01. The applicant may adopt the following identification, if accurate. TMEP §§1402.01 and 1402.11.

Class 9: Video game cartridges.

Class 28: Coin-operated video games.

Class 35: Retail store services, namely, a pro shop featuring sporting goods.

Class 41: Amusement arcades featuring coin-operated video games.

Class 43: Arena services, namely providing facilities for extreme sports and exhibitions; restaurant services.

In addition, the examining attorney strongly recommends that the applicant consult *The Acceptable Identification of Goods and Services Manual*, available on-line at [www.uspto.gov/web/offices/tac/doc/gsmmanual/](http://www.uspto.gov/web/offices/tac/doc/gsmmanual/). As set forth in the TMEP, this manual "sets out acceptable language for identifying goods and services of various types." TMEP § 1402.04.

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

#### **Multiple Class Application - Intent to Use**

The application identifies goods and/or services that may be classified in several international classes. Therefore, the applicant must either: (1) restrict the application to the number of class(es) covered by the fee already paid, or (2) pay the required fee for each additional class(es). 37 C.F.R. §2.86(a)(2); TMEP §§810.01, 1401.04, 1401.04(b) and 1403.01.

Effective January 1, 2003, the fee for filing a trademark application is \$335 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date. 37 C.F.R. §2.6(a)(1).

If the applicant prosecutes this application as a combined, or multiple-class, application, the applicant must comply with each of the following.

- (1) The applicant must list the goods/services by international class with the classes listed in ascending numerical order, as shown above. TMEP §1403.01.
- (2) The applicant must submit a filing fee for each international class of goods/services not covered by the fee already paid. 37 C.F.R. §§2.6(a)(1) and 2.86(a); TMEP §§810.01 and 1403.01. Effective January 1, 2003, the fee for filing a trademark application is \$335 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date.

#### **Drawing of Mark**

The drawing is not acceptable because it contains gray design elements that 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). Please note that the new drawing must not be a material alteration of previously submitted drawing.

The requirements for a special-form drawing, in addition to the heading, 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 2 1/2 inches (6.1 cm.) high and 2 1/2 inches (6.1 cm.) wide. In no case may it 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.

**Drawing of the Mark**

The lining shown in the drawing appears to be a feature of the mark and not intended to indicate color. The applicant must insert a statement to that effect. 37 C.F.R. Section 2.37; TMEP section 807.09(e). The applicant may use the following form, if accurate:

The lining in the drawing is a feature of the mark and does not indicate color.

**Disclaimer Requirement**

The applicant must disclaim the descriptive wording "X ARENA" apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213, 1213.02(a) and 1213.02(c). The term "X" is defined as "extreme (games)." X sports include the type of sports indicated in the identification of services. See attached representative articles from the Lexis/Nexis database. The term ARENA is defined as "a large modern building for the presentation of sports events and spectacles." The applicant identifies its services as being arena services. A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use "X ARENA" apart from the mark as shown.

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

A disclaimer does not remove the disclaimed matter from the mark. It is simply a statement that the applicant does *not* claim exclusive rights in the disclaimed wording or design apart from the mark as shown in the drawing.

**Information for the Applicant**

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action.

To respond to this Office action electronically, the applicant must:

- o include the serial number in the subject line;
- o send the response to ecom102. E-mail sent to any other address will NOT be processed, and may result in ABANDONMENT of the application;
- o submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG format only. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
- o respond within six-months from the Office action mailing date, or within the period stated in the Office action;
- o respond in English; and
- o sign the response electronically, e.g. /john smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §§304.08 and 804.05.

**PLEASE NOTE:** Submission of duplicate papers is discouraged because it delays processing. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); *Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc.* 45 USPQ2d 2021 (TTAB 1998).

**Fee increase effective January 1, 2003**

Effective January 1, 2003, the fee for filing an application for trademark registration will be increased to **\$335.00** per International Class. The USPTO will not accord a filing date to applications that are filed on or after that date that are not accompanied by a minimum of \$335.00.

Additionally, the fee for amending an existing application to add an additional class or classes of goods/services will be \$335.00 per class for classes added on or after January 1, 2003.

Current status and status date information is available at <http://tarr.uspto.gov/>.

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

/Kelly F. Boulton/  
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**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>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

## a•re•na

**a•re•na** (e-rêˈne) *noun*

1. A large modern building for the presentation of sports events and spectacles.
2. A place or scene where forces contend or events unfold: *withdrew from the political arena; the world as an arena of moral conflict.*
3. The area in the center of an ancient Roman amphitheater where contests and other spectacles were held.

[Latin *harêna*, *arêna*, sand, a sand-strewn place of combat in an amphitheater, perhaps of Etruscan origin.]

**Word History:** Fans watching contact sports such as boxing, hockey, or football in modern arenas might be struck by the connection between the word *arena* and the notion of gladiatorial combat. This word is from Latin *harêna* (also spelled *arêna*), “sand.” *Harêna* then came to mean the part of a Roman amphitheater that was covered with sand to absorb the blood spilled by the combatants. *Arena* is first recorded in English during the 17th century, denoting this area of a Roman amphitheater. [\[1\]](#)

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