To:	Agron, Ashley, J (mafiasis21@aol.com)
Subject:	TRADEMARK APPLICATION NO. 78253958 - AMERICAN PET IDOL - N/A
Sent:	10/31/03 11:15:35 AM
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Attachments:	Attachment - 1 Attachment - 2 Attachment - 3

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/253958

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MARK: AMERICAN PET IDOL

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

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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 78/253958

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

Section 2(d) - Likelihood of Confusion Refusal

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the marks in U.S. Registration Nos. 2715725 and 2751431 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP §§1207.01 *et seq*. See the enclosed registrations.

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods/services, to cause confusion, or to cause mistake or to deceive. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods/services. The overriding concern is to prevent buyer confusion as to the source of the goods/services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining

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Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, 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).

1. Similarity of Marks

The examining attorney must compare the marks for similarities of sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

In the present case, the respective marks are very similar in appearance, sound, commercial impression and connotation. The applicant's mark merely adds the descriptive term "PET" between the terms "AMERICAN IDOL" in the registered marks. While the examining attorney cannot ignore a disclaimed portion of a mark and must view marks in their entireties, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant.

2. Commercial Relationship of Marks

If the marks of the respective parties are identical or highly similar, the examining attorney must consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

The 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 services 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).

In this case, the services appear to be closely related. The registrant provides talent shows on a popular television show. The applicant's "entertainment contests" ostensibly include talent contests for pets that are in the nature of the applicant's services. The prospective audience for each of the services would believe that the registrant has expanded its scope to include pet talent shows.

3. Parody Not A Defense

Parody is generally 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 (4th 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). Here, however, the examiner finds that the respective marks and services are so similar that prospective consumers would be confused as to the source. *See, e.g., 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 (10th Cir. 1987) (LARDASHE for pants was not an infringement of the JORDACHE mark).

4. Conclusion

For the reasons stated above, the examining attorney finds that the applicant's mark is confusingly similar to the registered mark, and registration is properly refused under the Trademark Act Section 2(d).

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 informal requirement.

Recitation of Services

The recitation of services is unacceptable as indefinite because it is unclear as to the nature of the applicant's "entertainment contests." The applicant may adopt the following recitation, if accurate:

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"Entertainment services, namely, pet talent contests," in International Class 41.

TMEP §1402.11.

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 services that are not within the scope of the services recited in the present identification.

Disclaimer:
The applicant must disclaim the descriptive wording "PET" 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 that applicant's services presumably include *pet* contests.

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 "PET" apart from the mark as shown.

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

Form of Business Designation is Indefinite
In the application, the applicant's name is that of an individual, but it is identified as a corporation. This does not adequately designate the applicant's form of business in accordance with TMEP section 802.03. The applicant must amend the application to specify whether it is an individual or a corporation. If it is an individual, the applicant must indicate its country of citizenship. If it is a corporation, the applicant must specify its state of incorporation. TMEP section 802.03.

If the record indicates that the applicant is not the owner of the mark, the examining attorney must refuse registration on that ground. The statutory basis for this refusal is Trademark Act Section 1, 15 U.S.C. Section 1051. When an application is filed in the name of the wrong party, this defect cannot be cured by amendment or assignment. 37 C.F.R. Section 2.71(d); TMEP section 803.06. However, if the application was filed by the owner, but there was a mistake in the manner in which the applicant's name is set forth in the application, this may be corrected. See TMEP section 1201.02(c) for examples of correctable and non-correctable errors.

Comments
Current status and status date information is available, via push button telephone, for all federal trademark registration and application records maintained in the automated Trademark Reporting and Monitoring (TRAM) system. The information may be accessed by calling (703) 305â€‘8747from 6:30 a.m. until midnight, Eastern Time, Monday through Friday, and entering a sevenâ€‘digitregistration number or eightâ€‘digit application number, followed by the "#" symbol, after the welcoming message and tone. Callers may request information for up to five registration number or application number records per call.

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 addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

The applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The Patent and Trademark Office cannot aid in the selection of an attorney.

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, and the applicant's telephone number.

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

/jbg/
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How to respond to this Office Action:

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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/**

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pet1

pet (pèt) *noun*

1. An animal kept for amusement or companionship.
2. An object of the affections.
3. A person especially loved or indulged; a favorite: *the teacher's pet.*

adjective

1. Kept as a pet: *a pet cat.*
2. **a.** Particularly cherished or indulged: *a pet grandchild.* **b.** Expressing or showing affection: *a pet name.*
3. Being a favorite: *a pet topic.*

verb

pet·ted, **pet·ting**, **pets** *verb*, *transitive*

To stroke or caress gently; pat. See synonyms at caress.

verb, *intransitive*

Informal.

To make love by fondling and caressing.

[Scottish Gaelic *peata*, tame animal, pet, from Old Irish.]

— pet ¹ter *noun*[1]

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