To:	Puppy Herman Media (russ@puppyherman.com)
Subject:	TRADEMARK APPLICATION NO. 78404923 - THE IDIOT'S GUIDE TO... - N/A
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/404923

APPLICANT: Puppy Herman Media

78404923

CORRESPONDENT ADDRESS:
Puppy Herman Media
760 South Main St #144
Sharon MA 02067

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: THE IDIOT'S GUIDE TO...

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

CORRESPONDENT EMAIL ADDRESS:
russ@puppyherman.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 78/404923

The examiner has reviewed the applicant's response dated January 31, 2005 and determined the following. The identification change has been accepted and made of record. However, the Section 2(d) likelihood of confusion refusal is maintained and made FINAL.

Parody

In regards to the change of identification indicating the applicant's books are for humor and parody. 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 (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). While the applicant's books may be a parody the mark itself is not. For example, the evidence submitted in the applicant's response of a book titled "IDIOT'S GUIDE TO BEING AN IDIOT" more closely resembles a parody than just "IDIOTS GUIDE TO…". 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 (10th Cir. 1987) (LARDASHE for pants was not an infringement of the JORDACHE mark).

Final Refusal – Likelihood of Confusion

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 mark in U.S. Registration Nos. 2240844, 2431283, 2129136 and 2842338 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq*.

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 compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq*.

The applicant has applied to register the mark "IDIOT'S GUIDE TO…", for a "series of non-fiction books in the fields of [[current affairs,]] business, namely, marketing, computers, environment, [[film,]] gardening, health and fitness, history, home decorating,[humor,] medicine,[[politics, psychology,]] self-help, science, sports [[and theater]]" in international class 16.

The applicant's mark is nearly identical to those of the registrant. The applicant merely deleted portions of the registrant's mark. The mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *See In re Optical Int'l* , 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

Despite the deletions, the marks still sound and look similar making confusion likely.

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). TMEP §1207.01(a).

The goods/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/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). TMEP §1207.01(a)(i).

The applicant's goods and those of the registrant are highly similar. Both the applicant and the registrant's books feature humor, as a result, the books are sold in the same channels of trade making confusion likely.

Due to the similarity of the marks and the close relationship between the goods the examiner has determined that consumer confusion is likely. The application therefore is refused due to a likelihood of confusion under 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 has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

To reach the undersigned attorney by telephone after October 15, 2004, please call (571) 272 - 9273. Thank you.

NOTICE: FEE CHANGE

Effective January 31, 2005 and pursuant to the Consolidated Appropriations Act, 2005, Pub. L. 108-447, the following are the fees that will be charged for filing a trademark application:

(1) $325 per international class if filed electronically using the Trademark Electronic Application System (TEAS); or

(2) $375 per international class if filed on paper

These fees will be charged not only when a new application is filed, but also when payments are made to add classes to an existing application. If such payments are submitted with a TEAS response, the fee will be $325 per class, and if such payments are made with a paper response, the fee will be $375 per class.

The new fee requirements will apply to any fees filed on or after January 31, 2005.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

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

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at http://www.uspto.gov/teas/index.html.

Thank you,
/sean w. dwyer/

Sean W. Dwyer
United States Patent Trademark Office
Trademark Examiner
Law Office 103
571-272-9273

How to respond to this Office Action:

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) **CANNOT** currently be filed via TEAS.

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.

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