To:	DBS Concept Mills, Inc. (mark@trademarkfalkin.com)
Subject:	TRADEMARK APPLICATION NO. 78437667 - HARRY POTS HER - N/A
Sent:	1/28/2005 5:16:23 PM
Sent As:	ECOM115@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5 Attachment - 6 Attachment - 7 Attachment - 8 Attachment - 9 Attachment - 10 Attachment - 11 Attachment - 12 Attachment - 13 Attachment - 14 Attachment - 15 Attachment - 16 Attachment - 17 Attachment - 18 Attachment - 19 Attachment - 20 Attachment - 21 Attachment - 22 Attachment - 23 Attachment - 24 Attachment - 25 Attachment - 26 Attachment - 27 Attachment - 28 Attachment - 29 Attachment - 30 Attachment - 31 Attachment - 32 Attachment - 33 Attachment - 34 Attachment - 35 Attachment - 36 Attachment - 37

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/437667

APPLICANT: DBS Concept Mills, Inc.

78437667

CORRESPONDENT ADDRESS:

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

MARK: HARRY POTS HER

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

CORRESPONDENT EMAIL ADDRESS:
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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 78/437667

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

Refusal Under Section 2(d) – 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, so resembles the marks in U.S. Registration Nos. 2,525,908; 2,526,111; 2,568,097; and 2,574,410 (all owned by the same registrant) as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registrations.

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 (C.C.P.A. 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). TMEP §§1207.01 *et seq*.

The applicant has applied to register HARRY POTS HER (Standard Character Mark) for "Motion pictures in the nature of adult entertainment." Registration No. 2,525,908 is HARRY POTTER (Typed). Registration No.2,526,111 is HARRY POTTER (Stylized). Both of the foregoing registrations are for a variety of goods in International Class 9, including "Motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animations; prerecorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and/or animations . . . short motion picture film cassettes featuring comedy, drama, action, adventure and/or animation to be used with hand-held viewers or projectors . . ." Registration No. 2,568,097 is HARRY POTTER (Typed). Registration No. 2,574,410 is HARRY POTTER (Stylized). Both of the foregoing registrations are for a variety of services in International Class 41, including "Entertainment services in the nature of . . . Live-action, comedy, drama and animated motion picture theatrical films; Production of live-action, comedy, drama, and animated motion picture theatrical films; Theatrical performances both animated and live-action . . ."

The marks are essentially phonetic equivalents, HARRY POTS HER *v.* HARRY POTTER. Similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv).

Moreover, if the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980). TMEP §1207.01(b). In this case, the applicant's goods and the registrant's goods and services are highly related. Both the applicant and the registrant are in the motion picture industry, and the applicant's and the registrant's goods both include motion picture films.

With respect to a comparison of the applicant's goods and the registrant's services, consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463,

6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S for retail grocery and general merchandise store services held confusingly similar to BIGGS for furniture); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men's, boys', girls' and women's clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (use of similar marks for trucking services and on motor trucks and busses is likely to cause confusion).

In this case, the registrant produces motion picture films. The applicant's goods are motion picture films. Upon seeing highly similar marks used on or in connection with highly related goods and services, consumers are likely to believe that the goods and services emanate from the same source.

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). 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). TMEP §1207.01(b)(x).

The marks are phonetic equivalents. The applicant's goods and the registrant's goods and services are highly related. The similarities among the marks, and the goods and services are so great as to create a likelihood of confusion among consumers. 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. Warnerâ€'Lambert Co.*, 203 USPQ 191 (TTAB 1979).

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.

Prior Pending Applications

The examining attorney also encloses information regarding pending Application Serial Nos. 78/240779; 78/240780; 78/336318; 78/342387; 78/342408; 78/435778; 78/435742; 78/435770; and
78/435758 (owned by the same registrant cited above). The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may use the registrations as an additional basis for refusing registration in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §1208.01.

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

1. Advisory Regarding Domestic Representative

Applicant ***may*** designate a domestic representative upon whom notices or process may be served. Trademark Act Section 1(e), 15 U.S.C. §1051(e); 37 C.F.R. §2.24; TMEP §§604, 811 and 1013. If applicant does not designate a domestic representative, notices or process in proceedings affecting the mark may be served on the Director of the USPTO. Trademark Act Section 1(e), 15 U.S.C. §1051(e).

2. Identification of Goods

a. The wording "Motion pictures in the nature of" in the identification of goods is unacceptable as indefinite. The applicant may amend this wording to "Motion picture films featuring," if accurate. TMEP §1402.01.

b. The applicant may adopt the following identification of goods in International Class 9, if accurate: Motion pictures films featuring adult entertainment.

c. 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.

3. Advisory Regarding Potential Refusal

The proposed mark appears to be the title of a single creative work, namely, the title of a specific motion picture film. In view of this, applicant is advised that registration may be refused upon consideration of an amendment to allege use or statement of use. Such a refusal would be based on a determination that the proposed mark, as used on the specimen, does not function as a trademark. 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), *cert. denied*, 358 U.S. 840, 119 USPQ 501 (1958); *In re Hal Leonard Publishing Corp.*, 15 USPQ2d 1574 (TTAB 1990); *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984); TMEP §1202.08.

Applicant is advised that the name of a *series* of creative works may be registrable if the designation serves to identify and distinguish the source of the goods. *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992). Therefore, if applicant will be using the mark to identify a series, rather than a single work, then applicant should provide such evidence for the record at the time the allegation of use is filed. Evidence of a series includes copies of multiple book covers or videotape/CD packaging showing the mark in the series titles.

A prompt response to this Office action will expedite the handling of this matter.

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.

/Barbara A. Gaynor/
Barbara A. Gaynor
Trademark Examining Attorney
Law Office 115
(571) 272-9164

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

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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