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| **To:** | Brown, James (hultquist@iptl.com) |
| **Subject:** | TRADEMARK APPLICATION NO. 78802868 - CAROLINA TARHICKS - 4266-108 |
| **Sent:** | 2/21/2007 4:15:49 PM |
| **Sent As:** | ECOM102@USPTO.GOV |
| **Attachments:** | Attachment - 1<br>Attachment - 2<br>Attachment - 3<br>Attachment - 4 |

## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO**: 78/802868

**APPLICANT**: Brown, James

*78802868*

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P.O. Box 1451
Alexandria, VA 22313-1451

**MARK**: CAROLINA TARHICKS

**CORRESPONDENT'S REFERENCE/DOCKET NO** : 4266-108

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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

**RESPONSE TIME LIMIT**: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION**: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at http://tarr.uspto.gov/, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/802868

**THIS IS A FINAL ACTION**

**STATUS**

This letter is in response to the applicant's communication filed on January 21, 2007. Therein, the applicant: 1) responded to the refusal of the mark under Section 2(a) based on disparagement; 2) responded to the refusal of the mark based on false connection; 3) amended the identification of goods; and 4) disclaimed the geographically descriptive wording. Numbers 2, 3 and 4 are acceptable. The refusal for false connection is withdrawn.

For the reasons stated below, the refusal of the application because it consists of matter that may disparage or bring into contempt or disrepute the University of North Carolina Tar Heals is herein made **FINAL**.

**Refusal - Disparaging**

Registration is refused because the proposed mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols. Trademark Act Section 2(a), 15 U.S.C. §1052(a); *Harjo v. Pro-Football, Inc*., 50 USPQ2d 1705 (TTAB 1999), *rev'd in part* , 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005); *see Order Sons of Italy in Am. v. Memphis Mafia, Inc.*, 52 USPQ2d 1364 (TTAB 1999); TMEP §§1203.03 *et seq*.

The following two factors must be considered when determining whether matter may be disparaging under Section 2(a):

(1) What is the *likely meaning* of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and

(2) If that meaning is found to *refer to identifiable persons, institutions, beliefs or national symbols*, whether that meaning may be *disparaging to a substantial composite of the referenced group*.

*Harjo*, 50 USPQ2d at 1740-1741.

The examining attorney has submitted the relevant dictionary definition of the term "HICK". The definition itself and the accompanying quotation is significant evidence that the term would be disparaging to a person of ordinary sensibilities.

Parody Argument

Applicant argues that in the proper context of the applicable marketplace, the CAROLINA TARHICKS mark will be perceived as a parody of the registered mark and the University of North Carolina and that the case law "compels that Applicant's mark be treated in the legal context of parody rather than disparagement." Applicant's response Section I.A. However, there is no known "legal context of parody" in relation to Section 2(a) unless the law has recently changed. Although parody may sometimes reduce a likelihood of confusion, parody is not a defense to a Section 2(a) disparagement refusal and Applicant has cited no applicable case law as a basis for the parody argument. Applicant's mark may be a parody and still be disparaging to the target, Registrant.

The Examining Attorney has analyzed the mark in the proper context of the marketplace, contrary to Applicant's argument. In *Harjo*, the Board found that the mark "REDSKINS", when used in connection with the services in the marketplace, referred to Respondent's football team. However, the term had not lost its meaning in reference to Native Americans. *Id.* at 1742-3. This case is substantially different than *Harjo*. The meaning in the marketplace is intentionally derogatory toward the target, University of North Carolina. Applicant has provided evidence of the rivalry between Duke University and the Registrant. The evidences states, in part, "[I]n North Carolina, where both schools are located, the rivalry may be a way of aligning oneself with larger philosophic ideals – of choosing teams in life – a tradition of partisanship that reveals the pleasures and even the necessity of *hatred*." (Emphasis added). Response at Section I. A. The evidence and the marketplace indicate that Applicant's mark is not only a derogatory parody, but it is intentionally derogatory to the Registrant and does not appear to be humorous or light-hearted.

Applicant states that its intent in the trademark is to provide a light-hearted parody in the context of spirited rivalries by "humorously" playing on the HEEL element of TAR HEEL. However, the intent of applicant is not relevant to a disparagement inquiry. *Harjo v. Pro Football Inc*., 50 USPQ2d 1705, 1736 (TTAB 1999)); *see, e.g.*, *In re Anti-Communist World Freedom Congress, Inc*., 161 USPQ 304, 305 (TTAB 1969).

Applicant also states that the TARHICKS does not rise to the level of disparagement under §2(a) because it does not invoke unseemly issues of racism, sexism, profanity, and/or scandalousness that are involved in the cited cases. However, Applicant provides no basis for these arguments. Whether a mark is disparaging is determined separately by the target group in each case. And the targeted or relevant group must be determined on the basis of the facts of each case. *Harjo v. Pro Football Inc*., 50 USPQ2d 1705, 1739 (TTAB 1999). For cases involving disparagement of individuals or commercial entities, the perception of a "reasonable person of ordinary sensibilities" may be appropriate. *Id.* at 1741. Applicant's provides no relevant analysis with the case at hand even though in cases such as *Order Sons of Italy in America v. Memphis Mafia Inc*., 52 U.S.P.Q.2d 1364 (T.T.A.B. 1999) and *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q. 2d 1600 (T.T.A.B. 1999), the Board found no evidence of disparagement.

In *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988), the Board found that the applicant's design of a dog defecating strongly resembled the opposer's running dog symbol and that the evidence of record established that the symbol "points uniquely and unmistakably to opposer's persona." *Id.* at 1640. TMEP §1203.03(c). With regard to whether the mark may be disparaging or "would be considered offensive or objectionable" by a reasonable person of ordinary sensibilities, the Board found that "the offensiveness of the design becomes even more objectionable because it makes a statement about the opposer itself, and holds opposer up to ridicule and contempt." *Id.* at 1640.

This case is similar to *Greyhound Corp.* because the Applicant's mark strongly, even intentionally, resembles Registrant's TAR HEELS mark and "points uniquely and unmistakably" to Registrant's mark. The offensive mark intentionally makes a statement about the Registrant itself, namely, that the University is comprised of students, faculty, administration, and alumni who are "provincial" or "unsophisticated," [1] and holds Registrant up to ridicule and contempt.

Legally Sufficient Showing of Disparagement

Applicant also argues, "*even* if the Examining Attorney fails to appreciate the lighthearted nature of Applicant's mark and its perception by the referenced group as a parody, the disparagement refusal should be withdrawn because the Examining Attorney has failed to provide any evidence tailored to the views of the referenced group." Response at I.B.

First, whether the Examining Attorney appreciates the nature of the parody or humor of Applicant's mark is not at issue. The mark is *legally* unregistrable. There is no "it's just a joke" defense to a 2(a) disparagement refusal. Again, Applicant's intent is Irrelevant. In *In re Tinseltown, Inc.*, 212 USPQ 863 (TTAB 1981), the Board rejected the Applicant's argument that its intent to use the mark on the outside surfaces of its accessories is to satirize the use of designers' names on such products.

Second, the Examining Attorney's submission of the definition of "HICK" is sufficient to support a disparagement refusal on first action. A dictionary definition shows what a "reasonable person with ordinary sensibilities" would determine to be the meaning of the term, and provides an example sentence showing how a reasonable person feels about being perceived as a HICK. Applicant argues that this evidence does not address whether the element "HICKS" is disparaging " *according to the view of the referenced group.*" Applicant identifies the referenced group as "students, faculty, administration, or alumni" of the University of North Carolina at Chapel Hill." Applicant is under the mistaken belief that the Examining Attorney must provide evidence of the perception of the referenced group themselves. In *In re Tinseltown*, *supra*, the Board rejected Applicant's argument that the mark should be evaluated based on a particular segment of society because there was no limitation in the identification on the channels of trade for Applicant's clothing accessories. Additionally, the "referenced group" of students, faculty, administration, or alumni of the University of North Carolina would clearly comprise individuals within the definition of a "reasonable person with ordinary sensibilities." Additionally, students and alumni of the University of North Carolina would obviously contain a significant number of individuals from the South and its underlying rural areas. Therefore, any evidence of the general perception of the term "HICK" would include the "referenced group." Applicant may not construct its own marketplace and limited context of a sports rivalry and assume that everyone in this context would understand, and not be offended by, the Applicant's intended joke or parody. Further, Applicant's usage of the term implies that the Registrant, an institution of higher education, is comprised of persons who are gullible, uneducated, unsophisticated and inferior to the rival school which comprises only the sophisticated and educated. Again, the mark is intentionally derogatory.

Evidence of the perception of the term by the general public is sufficient to uphold a disparagement refusal when the targeted group comprises the general public. The attached evidence from the Internet shows the likely meaning of "HICK" to be " a derogatory term for a person from a rural area. It connotes a degree of crude simplicity and backward conservativism in values, manners, and mores." (See attached). This refers to "HICK" in a disparaging manner because the definition of "derogatory" includes: Disparaging; belittling.[2] The Examining Attorney may conclude that the targeted group would consist of persons from rural areas of the South because this is Applicant's target group.

The Examining Attorney also attaches articles from a LEXIS/NEXIS search which shows that the perception of the term "HICK" is derogatory and offensive. (Please see attached twenty-six (26) articles). The articles include the opinion of a "North Carolinian" who found being portrayed as HICKS "quite offensive". In an article from The Tulsa World, regarding a college sports rivalry, the author stated, "[I]t was Nord, OU's offensive coordinator in one of those pre-Stoops dreary seasons (1995), who *insulted* Sooners everywhere with his crude comments about Oklahomans being *hicks* and badly in need of full sets of dentures." (Emphasis added). If the persons from the University of Oklahoma are *insulted* by the term HICKS, the Examining Attorney may conclude that the target group of the University of North Carolina will also find the term offensive and derogatory. The evidence also indicates that some people find HICKS to be the equivalent of a racial stereotype because it generally refers to white, uneducated people from rural areas. This contradicts Applicant's argument that it does not reach the level of other cases on the issue.

Accordingly, *even if* the Examining Attorney appreciates the lighthearted nature of Applicant's mark as a parody, the evidence clearly shows that the targeted group *and* consumers in general would find the mark offensive and derogatory. The Examining Attorney has provided an abundance of evidence showing that the term "HICKS" is disparaging to a person of ordinary sensibilities who would comprise the target group.

Doubts Regarding the Refusal

Due to the abundance of evidence showing that the term "HICKS" would be offensive and disparaging to the Registrant, Carolinians and the public in general, there is no doubt that Applicant's mark CAROLINA TARHICKS is legally unregistrable because it is disparaging under Section 2(a) of the Trademark Act. Applicant's intent for the mark to be a whimsical joke or parody to be used only in the context of a sports rivalry is not a factor in the Section 2(a) refusal. And neither is the Examining Attorney's personal opinion or amount of appreciation of the supposed intent.

**Final Response**

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

(1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or

(2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of $100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq*.; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is $100. 37 C.F.R. §2.6(a)(15).

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

/Michael Webster/

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**HOW TO RESPOND TO THIS OFFICE ACTION:**

- ONLINE RESPONSE: You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at http://www.uspto.gov/teas/index.html. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE**.
- REGULAR MAIL RESPONSE: To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office,*** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at http://tarr.uspto.gov.

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

THE SELECTED  STORY NUMBERS:
3,5,7,10,12,19,24,26-27,30-32,34-36,42,50,55,57,59,66,68,70,80-81,85

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