

To: SOBEL, WILLIAM ALAN (wasobel@earthlink.net)
Subject: TRADEMARK APPLICATION NO. 78884448 - MICKEY DORA DA CAT - N/A
Sent: 8/24/2007 5:04:43 PM
Sent As: ECOM107@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/884448

MARK: MICKEY DORA DA CAT

78884448

CORRESPONDENT ADDRESS:
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RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: SOBEL, WILLIAM ALAN

CORRESPONDENT'S REFERENCE/DOCKET NO :
N/A

CORRESPONDENT E-MAIL ADDRESS:
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OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 8/24/2007

THIS IS A FINAL ACTION.

This letter responds to applicant's communication filed on 07/19/07. The refusal under Trademark Act Section 2(a) is now made FINAL for the reasons set forth below. 15 U.S.C. §1052(a); 37 C.F.R. §2.64(a).

Refusal—False Connection

Registration was refused under Section 2(a) of the Trademark Act because the proposed mark consists of or comprises matter, which may falsely suggest a connection with the famous surfer Mickey Dora. The examiner determined that although not connected with the goods or services applicant provides under the proposed mark, the individual Mickey Dora is so famous that consumers would presume a connection with applicant. Trademark Act Section 2(a), 15 U.S.C. §1052(a); TMEP §§1203.03, 1203.03(e) and 1203.03(f); *See generally University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Nuclear Research Corp.*, 16 USPQ2d 1316 (TTAB 1990); *University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

The following is required for a showing of false connection under Section 2(a):

- the mark sought to be registered is the same as or a close approximation of the name or identity of a person or institution;
- the mark would be recognized as such;
- the person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and
- the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its goods or services.

In re Nuclear Research Corp., 16 USPQ2d 1316 (TTAB 1990); *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985); *Buffett v. Chiâ€Chi’s, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

In the Office Action dated 03/23/07, the examiner attached evidence from various e-commerce websites showing that Mickey Dora, or Mikolos “Mickey” Szandor Dora II (1934-2002), was a very well known surfer who went by the nickname “Da Cat.”

Here, applicant seeks to register the mark “MICKEY DORA DA CAT.” As explained, the term at issue need not be the actual, legal name of the party falsely associated with applicant’s mark. *See, e.g., Buffett v. Chiâ€Chi’s, Inc.*, 226 USPQ 428, 429 (TTAB 1985) (MARGARITAVILLE held to be the persona of singer Jimmy Buffet). The term must, however, be so uniquely and unmistakably associated with the named party as to constitute that party’s name or identity. *Id.*; *See also In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985).

The examining attorney noted the amount of information readily available about Mr. Dora via online articles and web logs suggested that his fame or reputation is of such a nature that a connection with him or his estate would be presumed when applicant’s mark is used on its goods. Therefore, unless applicant is connected with Mr. Dora or his estate, the examining attorney must refuse registration of applicant’s mark under Section 2(a) of the Trademark Act.

The applicant responded to the examiners refusal arguing that applicant’s comic strip is a parody of the real person and any reasonable person would view the mark as such. However, the examiner is unaware of any parody defense to the false connection refusal. In fact, parody is a defense to Copyright Infringement under the Fair Use Doctrine, but these principles do not apply to Trademark Law. Accordingly, applicant’s arguments remain irrelevant to the case.

Even assuming parody was a defense to the false connection refusal, applicant’s mark would not be considered a parody whatsoever because the mark is identical to the name of the individual for whom the false connection refusal was issued. Applicant’s focus on the characters in the comic strip is irrelevant because the comic strips are not the mark that is applied for. The mark applied for is MICKEY DORA “DA CAT,” which has not been altered in any way that pokes fun at the real person.

The applicant further argues that the third and fourth elements of the 2(a) analysis could not be met and the refusal should be withdrawn. However, the applicant has misinterpreted the third element of the analysis, bringing about an incorrect conclusion.

Specifically, the test requires a determination of whether the person or institution identified in the mark is “connected” with the goods sold or services performed by applicant under the mark.” Applicant makes the argument that MICKEY DORA is “connected” to the applicant’s comic strips, simply because the comic strips are a representation of the famous surfer. However, applicant’s understanding of “connection,” as mentioned above, is misconstrued.

In *In re Sloppy Joe’s International Inc.*, 43 USPQ2d 1350, 1353-34 (TTAB 1997), the Trademark Trial and Appeal Board held that Ernest Hemingway’s friendship with the original owner of applicant’s bar, his frequenting the bar and his use of the back room as an office is not the kind of “connection” contemplated by §2(a). **Rather, a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant’s services would be necessary to entitle the applicant to registration. [Emphasis added]**

Here, the applicant has failed to show any “commercial connection” to Mickey Dora, or his estate, as requested in the Office Action and as required to overcome this refusal. Indeed, applicant’s admission that its mark is a “parody” of the actual person makes clear that “the mark sought to be registered is the same as or a close approximation of the name or identity of a person or institution.”

In view of the foregoing, the refusal under Section 2(a) of the Trademark Act is continued, maintained and made final.

Response to a Final Action

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).

/David A. Hoffman/
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RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office Action should be filed using the Office's Response to Office action form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 8/24/2007 FOR
APPLICATION SERIAL NO. 78884448

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://portal.uspto.gov/external/portal/tow?DDA=Y&serial_number=78884448&doc_type=OOA&mail_date=20070824 (or copy and paste this URL into the address field of your browser), or visit <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **8/24/2007**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.**