To:	Tully, Michael L. (foster@tdfoster.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85076485 - INFANT MESSENGER - 6420.001-01
Sent:	10/26/2012 7:48:01 AM
Sent As:	ECOM107@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85076485

MARK: INFANT MESSENGER

85076485

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

CORRESPONDENT ADDRESS:
THOMAS D. FOSTER
TDFOSTER - INTELLECTUAL PROPERTY LAW
12626 HIGH BLUFF DR STE 150
SAN DIEGO, CA 92130

APPLICANT: Tully, Michael L.

CORRESPONDENT'S REFERENCE/DOCKET NO :
6420.001-01
CORRESPONDENT E-MAIL ADDRESS:
foster@tdfoster.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 10/26/2012

THIS IS A FINAL ACTION.

Application Serial No. 77/388071 has been abandoned. Prosecution of this application is, therefore, resumed.

CLASS 28

1. **Potential bar to registration**

Application Serial No. 77/388071 has been abandoned. Reference to this application as a potential bar to registration in Class 28 is WITHDRAWN.

2. **Disclaimer**

The requirement that applicant disclaim INFANT is CONTINUED and made FINAL.

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use "INFANT" apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

An INFANT is a very young child. See http://www.encarta.msn.com attached to the office action of October 15, 2010. Presumably, applicant's toys are intended for infant use. A term that describes an intended user or group of users of a product or service is merely descriptive. *E.g.*, *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); *see* TMEP §1209.03(i).

A "disclaimer" is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark; it does not affect the appearance of the mark. TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive of the goods, and is wording or an illustration that others would need to use to describe or show their goods and services in the marketplace. 15 U.S.C. §1052(e); *see* TMEP §§1209.03(f), 1213.03 *et seq*.

A disclaimer does not physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing. TMEP §§1213, 1213.10.

If applicant does not provide the required disclaimer, the USPTO can refuse to register the entire mark. TMEP §1213.01(b).

The following cases further explain the disclaimer requirement: *Dena Corp. v. Belvedere Int'l Inc* ., 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Brown-Forman Corp.*, 81 USPQ2d 1284 (TTAB 2006); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983).

CLASS 9

1. **SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION [Class 9 only]**

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No(s). 3310190; 3310191; 3310193; 3310194. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); TMEP §1207.01; *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.* , 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

Comparison of Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.* , 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Registrant is using AOL INSTANT MESSENGER and INSTANT MESSENGER. Applicant intends to use INFANT MESSENGER. INFANT MESSENGER is likely to be perceived as similar to the INSTANT MESSENGER marks because the marks resemble each other in appearance. Each mark contains the term MESSENGER as its second term and is preceded by a descriptive term – INSTANT on the one hand referring to delivery time and INFANT on the other referring to content type. The marks are highly similar.

Applicant has argued that the marks are parodies. The fact that a mark is intended to be a parody of another trademark is not, by itself, sufficient to overcome a likelihood of confusion refusal, because "[t]here are confusing parodies and non-confusing parodies." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §31.153 (4th ed. 2010); *see also Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1592 (TTAB 2008) ("Parody is not a defense if the marks would otherwise be considered confusingly similar."). "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." *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905, 910, 231 USPQ 963, 965 (D. Neb. 1986), *aff'd* , 836 F.2d 397, 5 USPQ2d 1314 (8th Cir. 1987). Thus, "[w]hile a parody must call to mind the actual product to be successful, the same success also necessarily distinguishes the parody from the actual product." *Id. See Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006) (holding

contemporaneous use of applicant's mark, LESSBUCKS COFFEE, and opposer's marks, STARBUCKS and STARBUCKS COFFEE, for identical goods and services, likely to cause confusion, noting that "parody is unavailing to applicant as an outright defense and, further, does not serve to distinguish the marks"); *Columbia Pictures Indus. Inc., v. Miller,* 211 USPQ 816, 820 (TTAB 1981) (holding CLOTHES ENCOUNTERS for clothing, and CLOSE ENCOUNTERS OF THE THIRD KIND for t-shirts, likely to cause confusion, noting that the "right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use conflicts with the prior use and/or registration of the substantially same mark by another"); *see also Jordache Enters. v. Hogg Wyld Ltd.*, 828 F.2d 1482, 4 USPQ2d 1216, 1220, 1222 (10th Cir. 1987) (noting that "a parody of an existing trademark can cause a likelihood of confusion, " but affirming district court's holding that contemporaneous use of LARDASHE and JORDACHE, both for jeans, is not likely to cause confusion).

In this instance, INFANT MESSENGER is not likely to be perceived as a parody because the proposed mark is not a joke and is not likely to be perceived as such by the consumer. It is likely to be perceived as a way of delivering content about infants and young children, much like the registrant delivers content quickly.

Comparison of the Goods and Services

The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.* , 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

Registrant is using its mark in connection with electronic transmission of data, images documents and electronic mail. Applicant intends to use its mark on software and hardware for instant messaging and delivery of other communications including data, images and presumably mail/messages. Both registrant and applicant are using their marks in connection with electronic delivery of content. Consumers familiar with AOL INSTANT MESSENGER and INSTANT MESSENGER are likely to assume that software called INFANT MESSENGER for instant messaging and content delivery is related to the registrant's services identifying a specific type of messaging pertaining to infants. The similarities between the marks, therefore, and the relatedness of the good and services create a substantial likelihood that consumers may be confused as to the source of the goods and services.

2. SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE [Class 9 Only]

The refusal under Trademark Act Section 2(e)(1) is now made FINAL for the reasons set forth below. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a).

The determination of whether a mark is merely descriptive is made in relation to an applicant's goods, not in the abstract. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.* , 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

MESSENGER describes a type of software. [See attached materials from the Internet attached to the office action of October 15, 2010]. INFANT identifies a young child. See http://www.encarta.msn.com attached to the office action of October 15, 2010. INFANT MESSENGER describes software and hardware used in connection therewith to deliver information about infants. Presumably, applicant's goods incorporate this function.

Material obtained from the Internet is generally accepted as competent evidence. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

OPTIONS

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

(1) Submitting a response that fully satisfies all outstanding requirements, if feasible; 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), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is $100. 37 C.F.R. §2.6(a)(15).

/Kathleen M. Vanston/
Examining Attorney
Law Office 107
(571) 272-9235
kathy.vanston@uspto.gov [for informal inquiries only]

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

To:	Tully, Michael L. (foster@tdfoster.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85076485 - INFANT MESSENGER - 6420.001-01
Sent:	10/26/2012 7:48:02 AM
Sent As:	ECOM107@USPTO.GOV
Attachments:	

IMPORTANT NOTICE REGARDING YOUR

U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION HAS ISSUED ON 10/26/2012 FOR
SERIAL NO. 85076485

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

TO READ OFFICE ACTION: Click on this **link** **or** go to **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 e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable **response time period**. Your response deadline will be calculated from **10/26/2012** (or sooner if specified in the office action).

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.

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

Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.