

To: Fair Use Parodies LLC (mtdabrow@uno.edu)
Subject: U.S. TRADEMARK APPLICATION NO. 85233920 - NO FAVRE LEAGUE - N/A
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85233920

MARK: NO FAVRE LEAGUE

85233920

CORRESPONDENT ADDRESS:

FAIR USE PARODIES LLC
FAIR USE PARODIES LLC
811 N ARNOULT RD
METAIRIE, LA 70001-5159

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APPLICANT: Fair Use Parodies LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

mtdabrow@uno.edu

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: 5/12/2011

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. See 37 C.F.R. § 2.23(a)(1). For a complete list of these documents, see TMEP § 819.02(b). In addition, such

applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

GENERAL INFORMATION REGARDING TRADEMARKS

The USPTO applies the following legal authorities when processing a trademark and service mark application:

- The Trademark Act of 1946;
- The Trademark Rules of Practice;
- Precedential court and Trademark Trial and Appeal Board decisions;
- USPTO's *Trademark Manual of Examining Procedure* (TMEP) (7th ed. Oct. 2010); and
- USPTO's *Trademark Trial and Appeal Board Manual of Procedure* (TBMP).

15 U.S.C. §§1051 *et seq.*; 37 C.F.R. pts. 2, 3, 6, 7, 10, 11; *see* TMEP intro., §§101, 107, 110.

Official USPTO letters and notices sent to applicants generally refer to one or more of these legal resources. Both the Trademark Act and the Trademark Rules of Practice can be viewed online at the Trademarks' Home Page at <http://www.uspto.gov/trademarks/index.jsp> by clicking on "Laws & Regulations" on the left side of the screen. The TMEP is also available via the Home Page by clicking on "Manuals, Guides, Official Gazette" on the left side of the screen. Trademark Trial and Appeal Board decisions and the TBMP can be found at their website located at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

The acronym "TMEP" used in official USPTO letters and notices refers to the USPTO's *Trademark Manual of Examining Procedure* (7th ed. Oct. 2010), a manual written by USPTO staff that explains the laws and procedures governing the trademark application, registration, and post registration processes. The TMEP can be viewed online at the Trademarks' Home Page at <http://www.uspto.gov/trademarks/index.jsp> by clicking on "Manuals, Guides, Official Gazette" on the left side of the screen.

Applicant may wish to hire an attorney to assist in prosecuting this application because of the legal technicalities involved. The Office, however, cannot aid in the selection of an attorney. 37 C.F.R. §2.11. Applicant may wish to consult a local telephone directory for a listing of attorneys specializing in trademark or intellectual property law, or seek guidance from a local bar association attorney-referral service.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES that applicant must address:

- SECTION 2(d) REFUSAL - LIKELIHOOD OF CONFUSION
- SECTION 2(a) REFUSAL - FALSE CONNECTION
- CONSENT OF PERSON NAMED IN MARK
- UNNECESSARY SECTION 2(F) CLAIM OF ACQUIRED DISTINCTIVENESS
- UNNECESSARY TRANSLATION - PLEASE DELETE
- UNNECESSARY CONCURRENT USE STATEMENT - PLEASE DELETE
- USE IN OTHER FORM STATEMENT - IMPROPER IN A SECTION 1(B) INTENT TO USE APPLICATION
- ADVISORY - POSSIBLE ORNAMENTATION REFUSAL UPON FILING OF ALLEGATION OF USE

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration Nos. 2988406 and 2976329. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are

necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

The proposed mark is NO FAVRE LEAGUE for *t-shirts*. The registered marks are FAVRE (2988406) for *Clothing, namely, shirts*; and BRETT FAVRE (2976329) for, among other things, *Clothing, namely, shirts, pants, caps, athletic shoes, shoes and jackets*.

A. Similarity of Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *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). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

The applicant's mark and the registered marks all share the surname FAVRE. As shown in the attached web pages www.officialbrettfavre.com/bio/ and www.nfl.com/players/brettfavre..., Brett Favre is a famous quarterback who recently retired from the NFL after 20 years as a player. Therefore, consumers would be highly likely to be confused by the applicant's proposed trademark containing the highly distinctive term FAVRE and the registered marks FAVRE and BRETT FAVRE. Even though the applicant's mark contains additional terms "NO" and "LEAGUE", these terms merely add to the likelihood of confusion because they are a parody of the NFL (National Football League), as admitted by the applicant in their application.

The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

B. Similarity of Goods/Services

If the goods and/or services of the respective parties are "similar in kind and/or closely related," or identical as in the instant application and the cited registrations, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). Therefore, the additional terms in the applicant's proposed mark are less likely to avoid confusion with the existing registrations including the same name, FAVRE.

C. Conclusion

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant should note the following additional ground for refusal.

SECTION 2(a) REFUSAL – FALSE CONNECTION

Registration is refused because the applied-for mark consists of or includes matter which may falsely suggest a connection with the football player Brett Favre. Although Brett Favre is not connected with the goods and/or services provided by applicant under the applied-for mark, Brett Favre is so famous that consumers would presume a connection. Trademark Act Section 2(a), 15 U.S.C. §1052(a); see TMEP §§1203.03, 1203.03(e). See generally *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Nuclear Research Corp.*, 16 USPQ2d 1316 (TTAB 1990); *Univ. of Ala. 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 Trademark Act Section 2(a):

- (1) The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution;

- (2) The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- (3) The person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and
- (4) 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 and/or services.

In re Peter S. Herrick, P.A., 91 USPQ2d 1505, 1507 (TTAB 2009); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 (TTAB 2008); TMEP §1203.03(e); *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used to determine the existence of a false connection).

As stated above, the mark contains the term FAVRE, and the applicant states in their application that the "trademark parodies NFLs (National Football League's) acronym, as well as Brett Favre's departure from the NFL." Therefore, even the applicant admits that the surname FAVRE refers to the famous NFL all-star football player, Brett Favre. This admission satisfies prongs (1) and (2) above.

With respect to prong (3) above, it is presumed that Brett Favre is not associated with the applicant or the goods on which the mark will be used. Therefore, prong (3) is satisfied.

Finally, the named person in the mark, Brett Favre, is famous. He is the "the NFL's All-Time Winningest Quarterback," according to Brett Favre's official website, www.officialbrettfavre.com/bio/. *See also* www.nfl.com/players/brettfavre.... If applicant's goods and/or services are of a type that the named person or institution sells or uses, and the named party is sufficiently famous, then it may be inferred that purchasers of the goods and/or services would be misled into making a false connection of sponsorship, approval, support or the like with the named party. *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *In re Nat'l Intelligence Acad.*, 190 USPQ 570 (TTAB 1976). In the instant case, as can be seen by attached U.S. Registration Nos. 2988406 and 2976329, attached hereto and both owned by Brett Favre, the famous person named in the proposed mark does sell goods of the same type as the application, and thus, it is even more likely that consumers will make a false connection between Brett Favre and the goods provided by the applicant. Moreover, Brett Favre's connection with the NFL, on which the applicant's overall mark is parodied (according to the applicant) is highly likely. Therefore, prong (4) of the above test is also satisfied.

For all of these reasons, consumers would be likely to make a false connection between the source of the applicant's goods and the retired NFL quarterback Brett Favre, and so registration must be refused under Section 2(a) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

CONSENT OF PERSON NAMED IN MARK

Applicant must clarify whether the name or signature in the applied-for mark identifies a particular living individual. Written consent is required for registration of a name, including a pseudonym, stage name or nickname, or signature, if the name or signature identifies a specific living individual. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §813; *see* TMEP §§1206 *et seq.*

NOTE: If the applicant files a consent statement from Brett Favre, then this may overcome the Section 2(a) False Connection refusal made above.

If the name or signature shown in the mark identifies a particular living individual, then applicant must submit the following:

- (1) A written consent, personally signed by the individual whose name or signature appears in the mark, authorizing applicant to register the name, pseudonym, stage name, nickname or signature as a trademark and/or service mark with the USPTO; and
- (2) A statement that FAVRE identifies a living individual whose consent is of record. If the name represents that of a pseudonym, stage name or nickname, applicant must include a statement that FAVRE identifies the [pseudonym/nickname] of Brett Favre, a living individual whose consent is of record.

See TMEP §§813, 813.01(a), 1206.04(a).

However, if the name or signature in the mark does not identify a living individual, then applicant must submit a statement that **FAVRE** does not identify a living individual. TMEP §§813.01(b), 1206.05.

UNNECESSARY SECTION 2(F) CLAIM OF ACQUIRED DISTINCTIVENESS

Applicant claims that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f). However, this claim is unnecessary because the mark appears to be inherently distinctive. *See* 15 U.S.C. §1052(f); TMEP §1212.02(d).

Applicant can withdraw the claim of acquired distinctiveness by instructing the trademark examining attorney to delete it from the application record. *See* TMEP §1212.02(d). If applicant does not withdraw the claim, it will remain in the application record and be printed on the registration certificate.

UNNECESSARY TRANSLATION – PLEASE DELETE

The applicant provided a translation statement that appears to be unnecessary because the terms in the translation statement are not in the mark as filed. More specifically, the translation statement references foreign wording “No Favre Liga”, but the proposed mark is “NO FAVRE LEAGUE” and this wording is in English and does not require a translation. 37 C.F.R. §2.32(a)(9); *see* TMEP §809. Therefore, the translation statement provided by the applicant should be deleted from the record.

UNNECESSARY CONCURRENT USE STATEMENT – PLEASE DELETE

The applicant has included a “Concurrent Use Claim” in the application. However, this claim appears to be unnecessary and also premature.

In a concurrent use application, the applicant normally requests a geographically restricted registration. The applicant seeks registration for a specified geographical area of the United States and lists one or more parties who concededly have rights in the mark in other geographical areas of the United States. These other parties may own applications or registrations, or they may have common law rights in a mark, but no application or registration.

TMEP § 1207.04(a). TMEP § 1207.04(b) states that “[i]n an application based on a bona fide intent to use the mark in commerce under 15 U.S.C. §1051(b), the applicant may not amend to seek concurrent use registration until the applicant files an acceptable allegation of use. 37 C.F.R. §§2.73 and 2.99(g).

USE IN OTHER FORM STATEMENT – IMPROPER IN A SECTION 1(B) INTENT TO USE APPLICATION

The applicant must delete the statement that the “mark was first used anywhere in a different form....and in commerce at least as early as 02/03/2011” since the applicant was filed under Section 1(b) as an intent to use application. Statements about the use of the mark are inappropriate until an acceptable allegation of use has been filed.

ADVISORY – POSSIBLE ORNAMENTATION REFUSAL UPON FILING OF ALLEGATION OF USE

Applicant is advised that, upon consideration of an allegation of use, registration may be refused on the ground that the applied-for mark, as used on the specimen of record, is merely ornamental, and as such does not function as a trademark to identify and distinguish applicant’s goods from those of others and to indicate the source of applicant’s goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (C.C.P.A. 1961); *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987); TMEP §§904.07(b), 1202.03 *et seq.*

The following factors are considered when determining whether the public would perceive the applied-for mark as a trademark or merely as a decorative or ornamental feature: the commercial impression made by the mark on the specimen, any prior registrations of the same mark for other goods and/or services, promotion of the applied-for mark as a trademark, and the practice of the relevant trade. *See In re Todd Co.*, 290 F.2d 597, 129 USPQ 408 (C.C.P.A. 1961); *In re Dimitri’s Inc.*, 9 USPQ2d 1666 (TTAB 1988); *In re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982); *In re Jockey Int’l, Inc.*, 192 USPQ 579 (TTAB 1976); TMEP §§1202.03 *et seq.*

RESPONSE GUIDELINES

There is no required format or form for responding to an Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at <http://www.uspto.gov/teas/index.html>. However, if applicant responds on paper via regular mail, the response should include the title “Response to Office Action” and the following information: (1) the name and law office number of the examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4)

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