

To: Next Adult Super Star, Inc. (AdultSuperStar@live.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85378025 - ADULT SUPER STAR - N/A
Sent: 11/18/2011 1:30:08 PM
Sent As: ECOM106@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)

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

APPLICATION SERIAL NO. 85378025

MARK: ADULT SUPER STAR

85378025

CORRESPONDENT ADDRESS:

NEXT ADULT SUPER STAR, INC.
NEXT ADULT SUPER STAR, INC.
9663 SANTA MONICA BLVD # 416
BEVERLY HILLS, CA 90210-4303

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

APPLICANT: Next Adult Super Star, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

AdultSuperStar@live.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: 11/18/2011

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.

NO CONFLICTING MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

INFORMALITIES

The applicant must respond to the following informalities.

Disclaimer

Applicant must disclaim the descriptive wording "ADULT" apart from the mark as shown because it merely describes a feature of the services,

e.g., that the word refers to a genre of programs that would be regarded as “adult entertainment” as evidenced from the specimen of record. *See* attached web evidence of what is regarded as adult entertainment. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

The following is the accepted standard format for a disclaimer:

No claim is made to the exclusive right to use “ADULT” apart from the mark as shown.

TMEP §1213.08(a)(i).

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). *See* TMEP §§1213, 1213.03.

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. TMEP §1213. A disclaimer does not affect the appearance of the applied-for mark. *See* TMEP §1213.10.

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.

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).

Specimen Does Not Show Use with Recited Services

The specimen is not acceptable because it does not show the applied-for mark used in connection with any of the goods and/or services specified in the application. An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

In this case, the specimen is described as an “ad campaign mailing insert” however appears to be a page from a search engine where one may select one of the subjects listed therein. The page is not an advertisement for the provision of “Digital video, audio, and multimedia publishing services; Entertainment in the nature of an on-going special variety, news, music or comedy show featuring Spoofs, parody, fiction, drama, and reality based programming broadcast over television, satellite, audio, and video media; Entertainment media production services for motion pictures, television and Internet; Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; Entertainment services, namely, a multimedia program series featuring comedy, action and adventure distributed via various platforms across multiple forms of transmission media; [of] Entertainment services, namely, multimedia production services for others. There is no indication that there is any show or program provided in connection with this mark in the material provided.

(Note: The spelling of “parady” in the identification has been corrected to “parody” in the Trademark Databases. If this is not correct, the applicant is asked to address this issue in response to this office action.)

Therefore, applicant must submit the following:

- (1) A substitute specimen showing the mark in use in commerce for each class of goods and/or services specified in the application; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**The substitute specimen was in use in commerce at least as early as the filing date of the application.**” 37 C.F.R. §2.59(a); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.* Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Section 1(a) to an

intent to use basis under Section 1(b), for which no specimen is required. *See* TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. *See* 15 U.S.C. §1051(c), (d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark and/or service mark for the identified goods and/or services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Filing Specimens Electronically: To submit a verified substitute specimen online via the Trademark Electronic Application System (TEAS), applicant should do the following: (1) answer “yes” to the TEAS response form wizard question to “submit a new or substitute specimen;” (2) attach a jpg or pdf file of the substitute specimen; (3) select the statement that “The substitute specimen(s) was in use in commerce at least as early as the filing date of the application.”; and (4) sign personally or enter personally his/her electronic signature, name in printed or typed form, and date after the declaration at the end of the TEAS response form. *See* 37 C.F.R. §§2.59(a), 2.193(a), (c)-(d), (e)(1); TMEP §§611.01(c), 804.01(b). Please note that these steps appear on different pages of the TEAS response form.

If applicant experiences difficulty in submitting the required substitute specimen, supporting statement and/or declaration, please e-mail <mailto:TEAS@uspto.gov> for technical assistance regarding the TEAS response form.

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.

RESPONSE

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>. 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 date of issuance of this Office action, (4) applicant’s name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

In the response, applicant should explicitly address each refusal and/or requirement raised in the Office action. If a refusal has issued, applicant may wish to argue against the refusal, i.e., submit arguments and/or evidence as to why the refusal should be withdrawn and why the mark should register. To respond to requirements, applicant should set forth in writing the required changes or statements.

Instructions for signing responses are provided below. *Pro Se* applicants 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.

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

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.

/Linda A. Powell/
Trademark Examining Attorney
U.S. Patent and Trademark Office

Law Office 106
linda.powelll@uspto.gov
(571) 272-9327

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>.

Adult Entertainment Business INFORMATION BULLETIN **144**

CITY OF SAN DIEGO DEVELOPMENT SERVICES
1222 FIRST AVENUE, 12TH FLOOR, SAN DIEGO, CA 92101
CALL (619) 446-5300 FOR APPOINTMENTS AND (619) 446-5300 FOR INFORMATION | December 2009

This information bulletin defines adult entertainment businesses and identifies where these establishments may be located within the City of San Diego. Some Planned District Ordinances contain adult entertainment regulations that supersede the information in this bulletin. For further information or clarification of the adult entertainment regulations, visit our web page at www.sandiego.gov/development-services, click on "Adult Entertainment Services Department's Development and Permit Information" located at 1222 1st Avenue, 12th Floor. Appointments are recommended; phone (619) 446-5300.

Documents Referenced in this Information Bulletin

- San Diego Municipal Code, [SDMC, Section 141.001](#)
- [Information Bulletin 122, How to Prepare a Typical Site Plan & Vicinity Map](#)
- [General Application, DS-2022](#)
- [Adult Entertainment Establishment Zoning Use Certificate](#)

any of the following:

- A. Another structure housing an adult entertainment business;
- B. The property line of a residentially zoned property;
- C. The property line of a church except those established in accordance with Section 141.001(B);
- D. The property line of a school;
- E. The property line of a public park;
- F. The property line of a social service institution.

If a church other than one established in accordance with Section 141.001(A), a school, a public park, a social service institution, or a residential zone is established within 1,000 feet of an adult entertainment business, the person possessing ownership or control of the adult entertainment business is prohibited to transfer ownership or control within 2 years of the date on which the school begins a course of instruction for students, the church or social service institution is opened for use, the public park is dedicated, or the ordinance establishing the residential zone becomes effective.

The person acquiring the ownership or control, however, shall be required to discontinue the adult entertainment business within 5 years from the date of the transfer of ownership or control if the business continues to be within 1,000 feet of the zone or properties listed in Section 141.001(B)(1).

Printed on recycled paper. Visit our web site at www.sandiego.gov/development-services. Upon request, this information is available in alternative formats for persons with disabilities.

DS-144 (12-09)

Page 2 of 3 City of San Diego • Information Bulletin 144 December 2009

III. ADMINISTRATIVE REVIEW
An Administrative Review is required for those Adult Entertainment Businesses meeting all the location standards listed in Section II of this bulletin.

IV. APPLICATION PACKAGE
Provide the following documents:

- A. General Application (DS-3022)**
All projects must be submitted with a General Application.
- B. Adult Entertainment Establishment Zoning Use Certificate**
Complete and sign the attached Adult Entertainment Establishment Zoning Use Certificate.
- C. 1000-foot Radius Map**
Provide 2 copies of an Assessor's Parcel Map outlining a 1000-foot radius around the subject property. Assessor's Parcel Maps may be obtained at the County Assessor's Office, 1009 Pacific Highway or Phone (619) 238-3771 or visit their web page at: www.sdsdm.com.
- D. Site Plan**
See Information Bulletin 122 Site Plan & Vicinity Map. Provide a fully dimensional site plan drawn to scale, showing:
 1. Boundary and dimensions of the property;
 2. Name and right-of-way width of bordering streets and alleys;
 3. Location and dimensions of existing and proposed buildings;
 4. Identification of the use of all structures, existing and proposed. If the proposed adult entertainment establishment is a stand alone in a multi-storied building, identify the lease space within that building;
 5. Distance from the building(s) to the property line(s);
 6. Distance from the front property line to the curb or to the center line of the street;
 7. Provide the owner's name, address, and phone number and the business owner's name, address, phone number and owner's parcel number for the specific site location.
- F. FEE**
The following fee will be charged at the time of application:

Application and review fee \$1,450.00
Records fee \$20.00
Mapping fee \$10.00

V. OPTIONS FOR SERVICE
All Adult Entertainment applications must be submitted by:

- A. Appointments:** To schedule an appointment, call (619) 446-5300.
- B. Walk-In Services:** Visit the Development Services Department at 1222 1st Avenue, 12th Floor, Check-In counter.

VI. OTHER PERMITS
All tenant improvements, additions, new build, sign, signs, change of use, etc., require a separate Construction Permit.

December 2009 City of San Diego • Information Bulletin 144 Page 3 of 3

Adult Entertainment Establishment Zoning Use Certificate

The Adult Entertainment Establishment Zoning Use Certificate is issued based on the information provided by the applicant on this application and other documentation provided. The issuance of the certificate is valid until the business use has changed, expanded or relocated. A new Adult Entertainment Establishment Zoning Use Certificate must be obtained prior to a change in ownership of an adult entertainment establishment. Changes in ownership of an adult entertainment establishment are limited by the provisions of Municipal Code Section 141.0691(b)(2). The business is required to operate in compliance with all applicable development regulations and operational standards of the zone. The applicant is responsible to comply with all City, County and State regulations. The Zoning Use Certificate is not a permit or license. Appropriate permits or licenses required by law must be obtained from the proper agency. A certificate issued in error or based upon inaccurate information does not confer a right to conduct a business.

1. Business Name: Telephone No.:

2. Business Address:

3. Legal Description (Lot, Block, Map No. or Parcel No. of Parcel Map No.):

4. Describe the proposed activities to be conducted on the premises, including any products or services provided:

The property owner or authorized agent and business owner must complete the following section and sign their name where indicated.

I am aware that the business described above is subject to the Adult Entertainment regulations (San Diego Municipal Code Section 141.0691). I certify that the proposed business location is not within 1,000 linear feet (measured in a straight line) of any other business that is subject to the Adult Entertainment regulations, a residential zone, church, school, public park, or social welfare institution (as defined in Municipal Code Sections 141.0691 and 141.0694). There is a copy of the aforementioned code, laws and rules, and certify that the proposed business will comply with all regulations.

Name of Property Owner or Agent:	Name of Business Owner (please print):
Mailing Address:	Mailing Address:
Telephone No.:	Telephone No.:
Signature: _____	Signature: _____
Date: _____	Date: _____

For City Use Only

Project No.: Application Date:

Zone, Ordinance, Emergency or Intestit Ordinance, Special Conditions:

Approved Denied

By: _____ Date: _____

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.