To:	Villanueva, Mike D (micv3@hotmail.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85685060 - GOD THEFATHER - N/A
Sent:	11/29/2012 3:43:54 PM
Sent As:	ECOM114@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85685060

MARK: GOD THEFATHER

85685060

CORRESPONDENT ADDRESS:
VILLANUEVA, MIKE D

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http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Villanueva, Mike D

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

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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: 11/29/2012

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

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$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.

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.

Statutory Refusal

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3437926. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or 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/or 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).

There is a likelihood of confusion because applicant's mark, GOD THEFATHER, and registrant's mark, THE GODFATHER and design, are transpositions of each other and one represents a parody of the other; and the applicant's goods, namely, a thletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms, are identical and move in the same trade channels as registrant's goods, namely, t-shirts, leading consumers to believe that applicant and registrant are affiliated.

See below for a discussion on parodies from the TMEP Section 1207.01(b)(x).

> 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 Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011) ("[P]arody 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.*http://rdms-tmep-vip.uspto.gov/RDMS/detail/manual/TMEP/Oct2012/TMEP-ch-1200-3d105e9115
>
> Cases involving a discussion of parody include the following: *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1192 (TTAB 2012) (sustaining oppositions to applications for the mark CRACKBERRY, for a variety of online computer services and clothing items, on the bases of a likelihood of confusion and likelihood of dilution by blurring with the mark BLACKBERRY, for handheld devices, including smartphones, and related goods and services, noting that "likelihood of confusion will usually trump any First Amendment concerns"); *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).http://rdms-tmep-vip.uspto.gov/RDMS/detail/manual/TMEP/Oct2012/TMEP-ch-1200-4d105e9127

Please note the following additional refusal.

Registration is refused because the applied-for mark as used on the specimen of record (1) is merely a decorative or ornamental feature of

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applicant's clothing; and (2) does not function as a trademark to identify and distinguish applicant's clothing from that of others and to indicate the source of applicant's clothing. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993); *In re Dimitri's Inc.* , 9 USPQ2d 1666, 1667 (TTAB 1988); *In re Astro-Gods Inc.*, 223 USPQ 621, 623 (TTAB 1984); TMEP §§904.07(b), 1202.03 *et seq.*

With respect to clothing, consumers recognize small designs or discrete wording as trademarks, rather than as merely ornamental features, when located, for example, on the pocket or breast area of a shirt. *See* TMEP §1202.03(a). However, consumers typically do not perceive larger designs or slogans as trademarks, especially when such matter is displayed across the front of a t-shirt. *See In re Pro-Line Corp.*, 28 USPQ2d at 1142 (holding "BLACKER THE COLLEGE SWEETER THE KNOWLEDGE," centered in large letters across most of the upper half of a shirt, to be a primarily ornamental slogan that is not likely to be perceived as a source indicator); *In re Dimitri's Inc.* , 9 USPQ2d at 1667-68 (holding "SUMO," used in connection with stylized depictions of sumo wrestlers and displayed in large lettering across the top-center portion of t-shirts and caps, to be an ornamental feature of the goods that does not function as a trademark); TMEP §1202.03(a), (b), (f)(i), (f)(ii).

In this case, the submitted specimen shows the applied-for mark, GOD THEFATHER, appearing directly on the upper-center area of the front of the shirt, where ornamental elements typically appear. *See* TMEP §1202.03(a), (b). Furthermore, the mark is displayed in a relatively large size on the clothing such that it dominates the overall appearance of the goods. Lastly, the applied-for mark appears to be a slogan with little or no particular trademark significance.

Therefore, consumers would view the applied-for mark as a decorative or ornamental feature of the goods, rather than as a trademark to distinguish applicant's goods from those of others and to indicate the source of applicant's goods.

In appropriate circumstances, applicant may overcome this refusal by satisfying one of the following options:

(1) Submit a different specimen (a verified "substitute" specimen) that was in actual use in commerce at least as early as the filing date of the application (or prior to the filing of an amendment to allege use; or prior to the expiration of the deadline for filing a statement of use) and that shows proper trademark use for the identified goods in International Class 25.

(2) Amend to the Supplemental Register, which is a second trademark register for marks not yet eligible for registration on the Principal Register, but which may be capable over time of functioning as source indicators.

(3) Claim acquired distinctiveness under Trademark Act Section 2(f) by submitting evidence that the applied-for mark has become distinctive of applicant's goods; that is, proof that applicant's extensive use and promotion of the mark allowed consumers now directly to associate the mark with applicant as the source of the goods.

(4) Submit evidence that the applied-for mark is an indicator of secondary source; that is, proof that the mark is already recognized as a source indicator for *other* goods or services that applicant sells/offers.

(5) Amend the filing basis to intent to use under Section 1(b), if the current filing basis is based on use in commerce under Section 1(a). This will later necessitate additional fee(s) and filing requirements.

For an overview of *all* the options referenced above and instructions on how to satisfy each option online using the Trademark Electronic Application System (TEAS) form, please go to http://www.uspto.gov/trademarks/law/ornamentalclothing.jsp.

Although there is no prescribed method or place for affixation of a mark to goods, the location of a mark on the goods "is part of the environment in which the [mark] is perceived by the public and . . . may influence how the [mark] is perceived." *In re Tilcon Warren Inc.*, 221 USPQ 86, 88 (TTAB 1984); *see In re Paramount Pictures Corp.*, 213 USPQ 1111, 1115 (TTAB 1982). Thus, where consumers have been conditioned to recognize trademarks in a certain location, as on the breast area of a shirt, ornamental matter placed in a different location is less

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likely to be perceived as an indicator of source. *See* TMEP §1202.03(a), (b).

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

Drawing/Specimen

The mark on the specimen disagrees with the mark on the drawing. In this case, the specimen displays the mark as GOD THEFATHER and design; and the drawing shows the mark as GOD THEFATHER.

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. 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). The mark on the drawing must be a substantially exact representation of the mark on the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a); *see* 37 C.F.R. §2.72(a)(1).

The drawing of the mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.* However, amending the mark in the drawing to conform to the mark on the specimen would be a material alteration in this case because the mark on the specimen creates a different commercial impression from the mark on the drawing. Adding a design element to mark is considered a material alteration.

Therefore, applicant must submit the following:

(1) A substitute specimen showing use in commerce of the mark on the drawing. *See* TMEP §807.12(a).; 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."** *See* 37 C.F.R. §§2.59(a), 2.193(e)(1); TMEP §904.05. If submitting a 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.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act 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. 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).

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Further action awaits response to the above.

/RaulCordova/

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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.

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

If applicant does not respond to this Office action within six months of the issue/mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. Where the application has been abandoned for failure to respond to an Office action, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to live status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a $100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a private attorney specializing in trademark matters to represent applicant in this process and provide legal advice. Although the undersigned trademark examining attorney is permitted to help an applicant understand the contents of an Office action as well as the application process in general, no USPTO attorney or staff is permitted to give an applicant legal advice or statements about an applicant's legal rights. TMEP §§705.02, 709.06.

For attorney referral information, applicant may consult the American Bar Association's Consumers' Guide to Legal Help at http://www.abanet.org/legalservices/findlegalhelp/home.cfm, an attorney referral service of a state or local bar association, or a local telephone directory. The USPTO may not assist an applicant in the selection of a private attorney. 37 C.F.R. §2.11.

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