

To: Til Valhalla Project, LLC (mitch@gibneylaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 88050248 - TIL VALHALLA PROJECT EST. 2017 - 18-153-TM-CL
Sent: 11/6/2018 4:53:51 PM
Sent As: ECOM126@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**

**U.S. APPLICATION
SERIAL NO.** 88050248

MARK: TIL
VALHALLA PROJECT
EST. 2017

88050248

**CORRESPONDENT
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**CORRESPONDENT'S
REFERENCE/DOCKET
NO:**

18-153-TM-CL

**CORRESPONDENT E-
MAIL ADDRESS:**

mitch@gibneylaw.com

PRIORITY 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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 11/6/2018

DATABASE SEARCH: The trademark examining attorney has searched the USPTO'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).

ISSUES APPLICANT MUST ADDRESS: On November 6, 2018, the trademark examining attorney and applicant's attorney Mitchell

§2.62(a); TMEP §§708, 711.

SUMMARY OF ISSUES:

- Refusal Under Trademark Act Section 2(b) - Simulation of Flag
- Advisory regarding Response Option - Deletion of Refused Matter
- Specimen Refusal
- Information about Specimen Required
- Requirement for an Amended Description of the Mark

REFUSAL UNDER TRADEMARK ACT SECTION 2(b) - SIMULATION OF FLAG

Registration is refused because the applied-for mark includes a simulation of a flag of the United States. Trademark Act Section 2(b), 15 U.S.C. §1052(b); *see* TMEP §1204. Trademark Act Section 2(b) bars registration of marks that include simulations of the flag, coat of arms, or other insignia of the United States, any state or municipality of the United States, or any foreign nation. TMEP §§1204, 1204.01(a).

A simulation refers to “something that gives the appearance or effect or has the characteristics of an original item.” *In re Family Emergency Room LLC*, 121 USPQ2d 1886, 1887 (TTAB 2017) (quoting *In re Advance Indus. Sec., Inc.*, 194 USPQ 344, 346 (TTAB 1977)); TMEP §1204. Whether the relevant matter in the mark is a simulation is determined by a visual comparison of the mark and the actual flag, coat of arms, or other insignia in question. *See In re Family Emergency Room LLC*, 121 USPQ2d at 1887 (citing *In re Advance Indus. Sec., Inc.*, 194 USPQ at 346); TMEP §1204.

When comparing the mark and the actual flag, coat of arms, or other insignia, the focus is on the relevant purchasers’ general recollection of the flag, coat of arms, or other insignia, “without a careful analysis and side-by-side comparison.” *In re Family Emergency Room LLC*, 121 USPQ2d at 1888 (quoting *In re Advance Indus. Sec., Inc.*, 194 USPQ at 346). The public should be considered to retain only a general or overall, rather than specific, recollection of the various elements or characteristics of design marks. *See In re Advance Indus. Sec., Inc.*, 194 USPQ at 346.

The following factors are considered when determining whether a design in a mark would be perceived as a flag, coat of arms, or other insignia of the United States, any state or municipality of the United States, or any foreign nation:

- (1) The colors, if any, that appear in the design;
- (2) The presentation of the mark, such as any stylization of the design and its relationship to other elements in the mark;
- (3) The presence of any words or other designs on the drawing; and
- (4) The use of the mark on the specimen(s), if one is provided, or in the record.

TMEP §1204.01(a) (citing *In re Family Emergency Room LLC*, 121 USPQ2d at 1888).

The attached encyclopedia evidence, consisting of an excerpt from Britannica, shows a picture of the actual flag of the United States. The applied-for mark includes the following matter: a drawing of a soldier saluting a flag flying over a field of graves.

The public would perceive the design in the mark as the flag of the United States because the location, number and shading of the stars and stripes in the flag, as well as the overall presentation of the mark, clearly depict the flag of the United States.

Therefore, registration is refused because the applied-for mark includes a simulation of a flag of the United States.

ADVISORY REGARDING RESPONSE OPTION - DELETION OF REFUSED MATTER

Applicant may respond to this refusal by submitting a substitute drawing showing the flag deleted from the drawing. *See* TMEP §§807.14(a), 1204.04(b). Deleting this unregistrable matter will only overcome the refusal if it is wholly separable from the applied-for mark and its removal does not materially alter the mark. *See* TMEP §807.14(a). Applicant should not delete any other matter from the mark drawing unless required elsewhere in this Office action.

Applicant should note the following additional ground for refusal.

SPECIMEN REFUSAL

Registration is also refused because the specimen in International Class 025 appears to consist of a digitally altered image or a mock-up of the mark on the goods or their packaging and does not show the applied-for mark in actual use in commerce. 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).

An image of a product or packaging that has been digitally created or otherwise altered to include the mark does not show actual use of the mark in commerce. See 15 U.S.C. §1127; TMEP §§904.04(a), 904.07(a); cf. *In re Chica, Inc.*, 84 USPQ2d 1845, 1848 (TTAB 2007) (holding that “a mere drawing of the goods with an illustration of how the mark may be displayed” was not an acceptable specimen because it did not show actual use in commerce); *In re The Signal Cos.*, 228 USPQ 956, 957-58 n.4 (TTAB 1986) (noting that a printer’s proof of an advertisement would not be an acceptable specimen because it does not show actual use in commerce). In addition, a photo of the mark on a label, tag, or piece of paper that appears on applicant’s or a third party’s goods or packaging is generally not acceptable to show applicant’s use of the applied-for mark in commerce. See 15 U.S.C. §1127; TMEP §§904.03(a), 904.07(a). Applicant must show the mark on applicant’s own goods or packaging as it is seen by the purchasing public, with goods that have actually been sold or transported in commerce. See TMEP §904.07(a).

In this case, the specimen consists of a screenshot of the applicant’s website with the applied-for mark displayed at the upper left corner of the webpage. The specimen filed in applicant’s co-pending application at Serial No. 88035110, which was filed shortly before the instant application, shows a nearly identical screen shot of the applicant’s website with a different mark displayed at the top of the webpage. Because the screenshot for the same website varies between these filings, it appears the specimens were digitally created or otherwise altered to include the applied-for mark for purposes of the application and does not show actual use of the mark in commerce.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). “Use in commerce” means (1) a bona fide use of the applied-for mark in the ordinary course of trade (and not merely to reserve a right in the mark), (2) the mark is placed in any manner on the goods, packaging, tags or labels, or displays of the goods, and (3) the goods are actually sold or transported in commerce. See 15 U.S.C. §1127.

In addition to the examples of specimens in (2) in the above paragraph, examples of specimens for goods also include instruction manuals, containers, and webpages that include a picture or textual description of the goods associated with the mark and the means to order the goods. See TMEP §§904.03 *et seq.*

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a different specimen (a verified [“substitute” specimen](#)) that (a) 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 and (b) shows the mark in actual use in commerce for the goods and/or services identified in the application or amendment to allege use. A “verified substitute specimen” is a specimen that is accompanied by the following statement made in a signed affidavit or supported by a declaration under 37 C.F.R. §2.20: “The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application or prior to the filing of the amendment to allege use.” The substitute specimen cannot be accepted without this statement.
- (2) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, see the [Specimen webpage](#).

Although applicant’s mark has been refused registration, applicant may respond to the refusals by submitting evidence and arguments in support of registration. However, if applicant responds to the refusals, applicant must also respond to the requirements set forth below.

INFORMATION ABOUT SPECIMEN REQUIRED

A specimen must show the mark as used in commerce, which means use in the ordinary course of trade (not merely to reserve a right in the mark). 15 U.S.C. §§1051, 1052, 1127. A specimen shows a mark used in commerce for goods only if it shows the mark placed on the goods, packaging, tags or labels affixed to the goods, or displays of the goods, and the goods are actually sold or transported for sale in commerce. 15 U.S.C. §1127. Because the specimen of record appears to be digitally created or altered, or is otherwise a mock-up, it does not appear to show the mark as actually used in commerce. Therefore, to permit proper examination of the application, applicant must submit additional information for the record about the specimen and how the mark as shown in the specimen is in use in commerce with applicant’s goods. See 37 C.F.R. §2.61(b); TMEP §814.

Accordingly, applicant must respond to the following questions and requests for documentation to satisfy this request for information:

- (1) How are applicant's goods sold? Specify the retail, wholesale, or other sales environment in which the goods are sold.
- (2) Please provide copies of invoices, bills of sale, or other documentation of sales of the goods.
- (3) Was the specimen created for submission with this application?
- (4) Does the specimen show applicant's product as it is currently being sold to consumers?
- (5) How do applicant's goods appear in the actual sales environment? If sold in stores, provide photos showing the goods for sale in the stores. If sold online, identify the websites and provide copies of the webpages showing the goods for sale. And if sold in another type of sales environment, provide photos and/or documentation showing the goods for sale in that environment.
- (6) If the information in question (5) about how the goods appear in the actual sales environment is not available to applicant, then please describe how applicant's goods are transported for sale and provide photos and other documentation showing how applicant's mark appears on the goods and/or its packaging when the goods are being transported for sale.

See 37 C.F.R. §2.61(b); TMEP §814.

Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814. Merely stating that information is available on applicant's website is an insufficient response and will not make the relevant information of record. See *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

INSTRUCTIONS FOR SUBMITTING A SUBSTITUTE SPECIMEN

If applicant files a response online using TEAS, the substitute specimen must be submitted in jpg or pdf format. 37 C.F.R. §2.56(d)(4); TMEP §904.02(a). If the nature of the specimen is unclear, a description should be provided, as well as an explanation of how it is used. TMEP §904.02(a). When validating an electronic submission through TEAS, applicant should ensure that the substitute specimen is attached to the submission. If the substitute specimen cannot be viewed from the "Validation Page," the specimen failed to attach properly and will not be included with the response.

To submit a verified specimen or verified substitute specimen online using the Trademark Electronic Application System (TEAS) response form, (1) answer "Yes" to form wizard question #2 and #10; and then, continuing on to the next portion of the form, under the heading "Classification and Listing of Goods/Services/Collective Membership Organization," do the following for each relevant class for which a specimen is being submitted: (2) check the box next to the following statement: "Check here to modify the current classification number; listing of goods/services/the nature of the collective membership organization; dates of use; and/or filing basis; or to submit a substitute specimen, a foreign registration certificate, or proof of renewal of a foreign registration. If not checked, the changes will be ignored."; (3) under "Specimen File," attach a specimen (attachment may not exceed 5 megabytes); (4) describe in the box below where you attached the file what the specimen consists of; and (5) check the box next to the following statement below the specimen description (to ensure that the declaration language is inserted into the form): "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use]. Additionally, when submitting a verified specimen, the TEAS online form **requires two signatures**: one in the "Declaration Signature" section and one in the "Response Signature" section.

REQUIREMENT FOR AN AMENDED DESCRIPTION OF THE MARK

Applicant must submit an amended description of the mark because the current one is incomplete and does not describe all the significant aspects of the mark. 37 C.F.R. §2.37; see TMEP §§808.01, 808.02. Descriptions must be accurate and identify all the literal and design elements in the mark. See 37 C.F.R. §2.37; TMEP §§808 *et seq.*

If applicant responds to the Trademark Act Section 2(b) refusal above by submitting a substitute drawing showing the flag deleted from the drawing, the following description is suggested, if accurate:

The mark consists of two concentric circles. Inside the inner circle is a stylized depiction of a soldier saluting a field of gravestones. Between the two circles are the following: the wording "TIL VALHALLA PROJECT" at the top, the wording "EST. 2017" at the bottom, a set of three stars in varying sizes at the bottom left and a set of three stars in varying sizes at the bottom right.

ASSISTANCE

Please call or email the assigned trademark examining attorney with questions about this Office action. Although the trademark examining attorney cannot provide legal advice or statements about applicant's rights, the trademark examining attorney can provide applicant with additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06. Although the USPTO does not accept emails as responses to Office actions, emails can be used for informal communications and will be included in the application record. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Julie H. Choe/
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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 the Trademark Electronic Application System (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 the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or 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/trademarks/teas/correspondence.jsp>.

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