

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: 11/7/2018 1:03:33 PM
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**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
ADDRESS:**
MITCHELL
GHANEIE
LAW OFFICE OF L.
JACK GIBNEY
8777 SAN JOSE
BLVD
SUITE 502
JACKSONVILLE,
FL 32217

APPLICANT: Til
Valhalla Project, LLC

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

18-153-TM-CL

**CORRESPONDENT E-
MAIL ADDRESS:**

mitch@gibneylaw.com

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LETTER:**

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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. 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: 11/7/2018

This Office action is supplemental to and supersedes the previous Office action issued on November 6, 2018 in connection with this application. The assigned trademark examining attorney inadvertently omitted a requirement relevant to the mark in the subject application. *See* TMEP §§706, 711.02. Specifically, a disclaimer of the wording "EST. 2017" is required because it is not inherently distinctive.

The trademark examining attorney apologizes for any inconvenience caused by the delay in raising this issue.

Applicant must address all issues raised in this Office action, in addition to the issues raised in the Office action dated November 6, 2018. The issues raised in the previous November 6, 2018 Office action are as follow and are maintained: the Section 2(b) simulation of flag refusal, the advisory regarding deletion of refused matter, the specimen refusal, the requirement for information about specimen and the requirement for an amended description of the mark.

The following is a SUMMARY OF ISSUES that applicant must address:

- 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
- **NEW ISSUE:** Requirement for a Disclaimer

Applicant must respond to all issues raised in this Office action and the previous November 6, 2018 Office action, within six (6) months of the date of issuance of this Office action. 37 C.F.R. §2.62(a); *see* TMEP §711.02. If applicant does not respond within this time limit, the application will be abandoned. 37 C.F.R. §2.65(a).

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 screenshots 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.

REQUIREMENT FOR A DISCLAIMER

Applicant must provide a disclaimer of the unregistrable parts of the applied-for mark. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). A disclaimer of an unregistrable part of a mark will not affect the mark’s appearance. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 979-80, 144 USPQ 433, 433 (C.C.P.A. 1965).

In this case, applicant must disclaim the wording “EST. 2017” because it is not inherently distinctive. These unregistrable terms at best are merely informational about the goods and/or services and are commonly used in business; thus the terms do not function as a mark. *See* 15 U.S.C. §§1051-1053, 1127; *In re Boston Beer Co.*, 198 F.3d 1370, 1372-74, 53 USPQ2d 1056, 1058-59 (Fed. Cir. 1999); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006); TMEP §§807.14(a), 1202.04, 1213.03(a), (b).

Determining whether a term functions as a trademark or service mark depends on how such matter would be perceived by the relevant public. *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Aerospace Optics, Inc.*, 78 USPQ2d at 1862; TMEP §1202.04. “The more commonly a [term] is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark [or service mark].” *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (quoting *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229); TMEP §1202.04.

The attached dictionary evidence shows that the term “EST.” is an abbreviation for the word “established” and “established” is defined as “to come into existence or begin operating.” Because consumers are accustomed to seeing this term commonly used by many businesses to impart information to consumers, they will perceive this term or slogan only as informational matter rather than as a trademark or service mark that identifies the source of applicant’s goods and/or services.

The examining attorney has attached several sample registrations from the Office’s database of registered marks wherein “EST. 2017” was disclaimed for goods and services. *See* attached copies of U.S. Registration Nos. 5510989, 5591689, 5594130. This shows that others in business use similar wording to describe their goods and/or services.

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use “EST. 2017” apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this issue using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

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