
To: Skeeziks, LLC (rlp@powleygibson.com)
Subject: TRADEMARK APPLICATION NO. 78435362 - TICK, TICK...BOOM! - 111.13(US)
Sent: 2/13/2008 4:13:17 PM
Sent As: ECOM108@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/435362

MARK: TICK, TICK...BOOM!

CORRESPONDENT ADDRESS:

Robert L. Powley
Powley & Gibson, P.C.
304 Hudson Street, 2nd Floor
New York NY 10013

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Skeeziks, LLC

CORRESPONDENT'S REFERENCE/DOCKET
NO:

111.13(US)

CORRESPONDENT E-MAIL ADDRESS:

rlp@powleygibson.com

REQUEST FOR RECONSIDERATION DENIED IN PART AND GRANTED IN PART

ISSUE/MAILING DATE: 2/13/2008

Applicant is requesting reconsideration of a final refusal issued/mailed July 24, 2007.

After careful consideration of the law and facts of the case, the examining attorney must *deny* the request for reconsideration *in part* and adhere to the final action with respect to the Title of a Single Work refusal for the applicant's goods classified in International Class 009, the following specified goods classified in International Class 016, namely "printed publications, namely songbooks; lyric and music printed in sheet or book form" and for the applicant's services classified in International Class 041. No new facts or reasons have been presented that are significant and compelling with regard to the point at issue. Please see further discussion below on the continued Title of a Single Work refusal.

Next, the applicant's request for reconsideration is *granted in part*. After further consideration, the Ornamentation refusal issued for International Classes 021 and 025 is hereby **withdrawn**. Additionally, as stated above the Title of a Single Work refusal is now **limited** to Class 009, 041 and particular goods classified in International Class 016. Therefore, the applicant's specified International Class 016 goods, namely "posters, greeting cards and post cards" are **not** subject to Title of a Single Work refusal because

these goods are not creative works.

Accordingly, applicant's request for reconsideration is *denied in part*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

Title of a Single Work Refusal

The stated refusal refers to Classes 009 and 041 and to the following Class 016 goods: "printed publications, namely songbooks; lyric and music printed in sheet or book form" and does not bar registration in the other classes or of the specified Class 016 goods, namely "posters; greeting cards; and post cards."

The refusal under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052 and 1127, is **CONTINUED**.

In response to the examining attorney's final refusal, the applicant requests reconsideration of the refusal by reiterating the argument that the proposed mark is not a title of a single work because the mark is being used in connection with a series of creative works and therefore capable of functioning as a trademark. The examining attorney notes that the applicant did not submit any new evidence in support of this argument. Rather, the applicant maintains that the two copyrights granted in connection with the applicant's play under the name Tick, Tick...Boom! demonstrate the mark is used in conjunction with a series of plays. The applicant also argues that performances of the play in numerous venues and locations under the proposed mark have resulted in source identification as a service emanating from the applicant.

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the points at issue in the final action. TMEP §715.03(a).

Thus, the examining attorney hereby CONTINUES the Title of a Single Work refusal under Sections 1, 2 and 45 with respect to the aforementioned classes and goods, continuing the arguments and supplementing the evidence presented by the examining attorney in the December 19, 2006 Office action and the Final Office action. The applicant's mark TICK, TICK...BOOM! is the title of a single work, namely it is the title of applicant's theatrical performance. As previously stated, the applicant has not demonstrated use of the proposed mark to identify a series of creative works under trademark law. Rather, the applicant submitted copyright registrations issued in connection with the applicant's play. Although the new orchestration, musical composition and script revisions may be sufficient to obtain a separate copyright for the applicant's theatrical work as a derivative work, these edits and additions do not evidence a series of creative works under trademark law. Rather, the copyrights show that the applicant's play has been revised over time. Different versions of the same work do not establish a series of creative works. TMEP §1202.08(c).

Next, changes in venue and length of a performance do not evidence a series of creative works. *See In re Canada*, Serial No. 76/394362, 2004 TTAB Lexis 282, at *7-8 (TTAB May 5, 2004) (unpublished opinion). Although the applicant's play is performed in a number of venues and locations throughout the country, TICK, TICK...BOOM! is used in connection with these performances as the name of applicant's play. The title of a single live theater production does not function as a service mark. Therefore, considering the evidence and the applicant's arguments, the applicant's request for reconsideration is *denied in part* and the Title of a Single Work refusal is **continued** with respect to

Classes 009, 041 and the specified Class 016 goods, namely "printed publications, namely songbooks; lyric and music printed in sheet or book form." 37 C.F.R. §2.64(b); TMEP §715.04.

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

Information Regarding Request to Divide Application

The examining attorney notes the applicant's option to file a request to divide out the goods that have not been refused registration because the above continued final refusal applies only to certain goods and to certain classes of goods and services within the applicant's statement of use.

Applicant has the option of dividing its application into two or more separate applications in accordance with 37 C.F.R. §2.87. See TMEP §§1110 *et seq.* regarding requests to divide. A request to divide can be used to divide out certain classes or specific goods or services that have been refused registration, for example, and allow the rest of the application to proceed toward registration.

Division of an application requires a fee of \$100.00 for each new application created. 37 C.F.R. §2.6(a)(19). In addition, when dividing out some, but not all, of the goods or services within a class, the application filing fee of \$375 must be submitted for each new separate application created by the division. 37 C.F.R. §2.6; TMEP §1110.02. Any outstanding time period for action by the applicant at the time of division will apply to each new separate application created by the division. 37 C.F.R. §2.87(b); TMEP §1110.05.

A request to divide an application may be filed at any time after filing the application and before the date the trademark examining attorney approves the mark for publication; or, during an opposition, upon motion granted by the Trademark Trial and Appeal Board. In addition, a request to divide an application under Trademark Act Section 1(b) may be filed with a statement of use under 37 C.F.R. §2.88 or at any time between the filing of a statement of use and the date the trademark examining attorney approves the mark for registration. 37 C.F.R. §2.87(c); TMEP §1110.01.

If applicant wishes to divide the application, applicant should submit a request on paper in a separate document from any other amendment or response. A request to divide cannot be filed electronically. The title "Request to Divide Application" should appear at the top of the first page of this request. 37 C.F.R. §2.87(d). Applicant must specify the classes or goods or services that are to be divided out of the application, and submit all the fees.

/Natalie Polzer/
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STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 2/13/2008 FOR
APPLICATION SERIAL NO. 78435362

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=78435362&doc_type=REC&mail_date=20080213 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable **response time period**. Your response deadline will be calculated from **2/13/2008**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**