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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86803751
Applicant	Imaginif, Inc.
Applied for Mark	HICCUP
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**TRADEMARK**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Imaginif, Inc.  
For the Mark : **HICCUP**  
Serial No. : 86/803,751  
Filing Date : October 29, 2015  
Examining Attorney : Khanh M. Le  
Law Office : 116  
Last Office Action : June 27, 2018  
Attorney Docket No. : IMAG 500018US01

Cleveland, OH 44115  
February 25, 2019

Attention: TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**BRIEF FOR APPLICANT**

## BACKGROUND

The pending application for HICCUP was filed under Section 1(b) and received U.S. Trademark Application Serial No. 86/803,751 with a filing date of October 29, 2015.

The application originally identified the following services:

International Class 041: live theatrical presentations; live events; entertainment services, namely, providing non-downloadable prerecorded online theatrical presentations; television appearances by an entertainer; photography services; digital imaging services; portrait photography; children's theatrical services, namely, presentation of live show performances; presentation of live show performances directed to children; entertainment in the nature of theater productions.

The trademark examining attorney found no conflicting marks that would bar registration under Trademark Act Section 2(d). However, the Examining Attorney found that certain wording in the identification of services required clarification, i.e., "live events" and "television appearances by an entertainer." November 17, 2015, Office Action, TSDR p.2.

Applicant filed a Response to the Office Action, including an amendment to the identification of services. December 2, 2015, Response to Office Action, TSDR p.2. Following a telephone conference with counsel for Applicant, the identification of services was further amended and now recites:

International Class 041: Live theatrical presentations; entertainment services in the nature of live theater performances; entertainment services, namely, providing nondownloadable prerecorded online theatrical presentations; entertainment services, namely, live television appearances by an entertainer; photography services; digital imaging services; portrait photography; children's theatrical services, namely, presentation of live show performances; presentation of live show performances directed to children; entertainment in the nature of theater productions.

December 3, 2015, Examiner's Amendment, TSDR p.1. A Notice of Publication issued on February 17, 2016.

On November 3, 2017, Applicant filed a Statement of Use, including two specimens of use. The Examining Attorney, however, issued a rejection, citing the following reasons: (1) Failure to Function as a Services Mark Refusal, (2) Specimen of Use Requirement, and (3) Mark in Drawing Does Not Match Mark in Specimens of Use. December 5, 2017, Office Action.

Applicant filed a response, arguing that the applied-for mark HICCUP functions as a service mark, that the specimen of use requirement has been met, and that the mark in the drawing matches the mark in each of the specimens of use. The Examining Attorney then withdrew the following refusal and requirement: (1) Failure to Function as a Services Mark Refusal and (2) Specimen of Use Requirement. However, the requirement for a specimen that features the mark as it is shown in the drawing was made FINAL under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.63(b); TMEP §§904, 904.07(a), 1301.04(g)(i). June 27, 2018, Final Office Action, TSDR p.2.

### **ARGUMENT**

Registration of the HICCUP mark has been refused under 37 C.F.R. §2.51 on the ground that the mark as depicted on the drawing disagrees with the mark as it appears in the specimens. The Examining Attorney maintains that the drawing in this §1 application displays the mark as HICCUP, and the specimens display the mark as "Hiccup Hangout," "The Hiccup Family," "Rhubarb Hiccup," "Sylvester Hiccup," "Boyzenberry Hiccup" and



“Hiccup Clan.”

Applicant contends that the mark is registrable for at least the following reason. The HICCUP mark depicted in the drawings makes a separate and distinct commercial impression apart from the HICCUP HANGOUT or THE HICCUP FAMILY text used on the specimens.

Although the mark on the drawing must be a complete mark under a §1 application, an applicant has some latitude in selecting the mark it wants to register. See TMEP §807.12(d). The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. *Id.* An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen. *Id.* The determinative factor is whether the subject matter in question makes a separate and distinct commercial impression apart from the other element(s). See *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Serval, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999); *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989). “It all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct ‘trademark’ in and of itself.” See 1 J.T. McCarthy, *Trademarks and Unfair Competition* §19:59 (4<sup>th</sup> ed. 2017).

The applied-for mark is HICCUP, which is employed with entertainment services. Although there is a lot of online material on these services, the applicant has “culled out exactly that element which serves to distinguish [the] product from others.” See McCarthy

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