

To: Zuffa, LLC (TRADEMARKS2-LASVEGAS@LRLAW.COM)
Subject: U.S. TRADEMARK APPLICATION NO. 77636476 - 69144-06007
Sent: 2/24/2010 5:29:04 PM
Sent As: ECOM101@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/636476

MARK:

77636476

CORRESPONDENT ADDRESS:

JENNIFER K. CRAFT
LEWIS AND ROCA LLP
3993 HOWARD HUGHES PKWY STE 600
LAS VEGAS, NV 89169-5996

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Zuffa, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

69144-06007

CORRESPONDENT E-MAIL ADDRESS:

TRADEMARKS2-LASVEGAS@LRLAW.COM

NON-FINAL OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 2/24/2010

The statement of use 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.

1. Refusal – Does Not Function as a Trademark:

Registration is refused because the applied-for mark, as used on the specimen of record, does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987); TMEP §§904.07(b); 1202 *et seq.*

The applied-for mark, as shown on the specimen, does not function as a trademark. Specifically, as used on the specimen of record, the octagon shape appears to be part of the lid and is not likely to be regarded as a source-indicator for the applied-for goods.

The specimen of record, along with any other relevant evidence of record, is reviewed to determine whether an applied-for mark is being used as a trademark. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (C.C.P.A. 1976); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (TTAB 1998). Not every word, design, symbol or slogan used in the sale or advertising of goods and/or services functions as a mark, even though it may have been adopted with the intent to do so. A designation cannot be registered unless purchasers would be likely to regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB 1992); TMEP §1202.

Applicant may respond to this refusal by submitting the following:

(1) A substitute specimen showing the mark in use in commerce for the goods specified in the statement of use; 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 prior to the expiration of the time allowed applicant for filing a statement of use.” 37 C.F.R. §2.59(b)(2); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute 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 goods or packaging, or displays associated with the goods at their point of sale. *See* TMEP §§904.03 *et seq.*

Applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

To submit a verified substitute specimen online via the Trademark Electronic Application System (TEAS), applicant should do the following: (1) answer “yes” to the TEAS response form wizard question to “submit a new or substitute specimen;” (2) attach a jpg or pdf file of the substitute specimen; (3) select the statement that “The substitute specimen(s) was in use in commerce at least as early as the filing date of the application.”; and (4) sign personally or enter personally his/her electronic signature and date after the declaration at the end of the TEAS response form. *See* 37 C.F.R. §§2.59(a), 2.193(a), (c)-(d), (e)(1); TMEP §§611.01(c), 804.01(b). Please note that these steps appear on different pages of the TEAS response form.

If applicant experiences difficulty in submitting the required substitute specimen, supporting statement and/or declaration, please e-mail TEAS@uspto.gov for technical assistance regarding the TEAS response form.

2. Requirement – Mark Differs on Drawing and Specimen:

The mark on the specimen disagrees with the mark on the drawing. In this case, the specimen displays the mark as a three-dimensional cooler with a circular opening on top of an octagonal shaped lid, while the drawing shows the mark as a two-dimensional octagon.

A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services specified in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 1109.09(b). The mark on the drawing must be a substantially exact representation of the mark as used on the specimen. 37 C.F.R. §2.51(b); TMEP §807.12(a); *see* 37 C.F.R. §2.72(b)(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), (b)(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.

Therefore, applicant must submit the following:

- (1) A substitute specimen showing use in commerce of the mark on the drawing. *See* 37 C.F.R. §2.59(b)(1); TMEP §904.05.; 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 prior to the expiration of the deadline for filing the statement of use.”** *See* 37 C.F.R. §§2.59(b)(2), 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.* Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*

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. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a).

Applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

To submit a verified substitute specimen online via the Trademark Electronic Application System (TEAS), applicant should do the following: (1) answer “yes” to the TEAS response form wizard question to “submit a new or substitute specimen;” (2) attach a jpg or pdf file of the substitute specimen; (3) select the statement that “The substitute specimen(s) was in use in commerce at least as early as the filing date of the application.”; and (4) sign personally or enter personally his/her electronic signature and date after the declaration at the end of the TEAS response form. *See* 37 C.F.R. §§2.59(a), 2.193(a), (c)-(d), (e)(1); TMEP §§611.01(c), 804.01(b). Please note that these steps appear on different pages of the TEAS response form.

If applicant experiences difficulty in submitting the required substitute specimen, supporting statement and/or declaration, please e-mail TEAS@uspto.gov for technical assistance regarding the TEAS response form.

3. Advisory – TEAS Plus Applicants:

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. 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 \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. Responding by telephone to authorize an examiner's amendment will not incur this additional fee.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Colleen Dombrow/
Trademark Attorney
Law Office 101
Direct Dial: (571) 272-8262
Facsimile: (571) 273-9101

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

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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Subject: U.S. TRADEMARK APPLICATION NO. 77636476 - 69144-06007
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Sent As: ECOM101@USPTO.GOV
Attachments:

IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION

Your trademark application (Serial No. 77636476) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on **2/24/2010** to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:

1. **Read** the Office letter by clicking on this **link** http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77636476&doc_type=OOA&mail_date=20100224 **OR** go to <http://tportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact TDR@uspto.gov.

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

2. **Contact** the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. **Respond** within 6 months, calculated from **2/24/2010** (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) [Response to Office Action form](#). If you have difficulty using TEAS, contact TEAS@uspto.gov.

ALERT:

Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** (loss) of your application.

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.