

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 76719328

MARK: V I V A

**\*76719328\***

**CORRESPONDENT ADDRESS:**

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**APPLICANT:** Viva XXXII LLC

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

147112.00001

**CORRESPONDENT E-MAIL ADDRESS:**

**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.

**ISSUE/MAILING DATE:**

The referenced application 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.

**Search for Conflicting Marks**

The trademark examining attorney has searched the Office'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).

**Summary of Issues**

**SUMMARY OF ISSUES:**

- Refusal -- Swatch Drawing -- Applicant Seeks Registration of More Than One Mark
- Requirement -- Identification of Goods
- Advisory -- Potential Refusal -- Failure to Function as a Trademark -- Nondistinctive Repeating Pattern

**Refusal -- Swatch Drawing -- Application Seeks Registration of More than One Mark**

Registration is refused because applicant seeks registration of more than one mark in its application. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; *see* TMEP §§1202.19(g)–(g)(ii); 1214.01. An application must be limited to only one mark. 37 C.F.R. §2.52; TMEP §§807.01, 1214.01; *see* 15 U.S.C. §1051(a)(1), (b)(1); *In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999); TMEP §§1202.19(g)–(g)(ii).

In the present case, the mark drawing consists of a “swatch” showing the applied-for repeating-pattern mark within a square, rather than depicting the pattern's particular placement on an item. Generally, swatch-type drawings do not adequately depict the nature of repeating patterns, because the commercial impression of these patterns may change depending on the nature of the pattern, the type of item the pattern appears on, the particular placement of the pattern on that item, and the size and scale of the elements in the pattern as applied. Thus, a swatch-type drawing may encompass more than one mark and each mark may create a different commercial impression. *See* TMEP §1202.19(a)(iii).

Accordingly, a swatch-type drawing is acceptable only when an applicant has submitted sufficient evidence to establish that the mark is applied to various items but that these various uses of the repeating pattern nonetheless create the same commercial impression. In the absence of this evidentiary showing, swatch-type drawings of repeating patterns, such as the mark drawing here, are deemed to encompass more than one mark.

See TMEP §§1202.19(a)(iii), 1202.19(g)–(g)(ii); cf. *In re Upper Deck Co.*, 59 USPQ2d 1688, 1689-91 (TTAB 2001) (holding unregistrable a mark comprising a hologram on a trading card when the hologram may have a myriad of shapes, sizes, contents and the like); *In re Elvis Presley Enters.*, 50 USPQ2d 1632, 1633-34 (TTAB 1999) (holding unregistrable a mark comprising all likenesses and images of one particular person in all possible manners of presentation without limitation as to age, manner of dress, or pose).

**Because applicant has submitted a swatch-type mark drawing that encompasses more than one mark, and has not provided evidence that the mark, as applied to the various identified goods, would create the same commercial impression, registration is refused. See 15 U.S.C. §§1051, 1127; TMEP §§1202.19(g)–(g)(ii).**

Applicant may respond by satisfying one of the following response options, as appropriate:

- (1) **Amend the mark drawing** to depict the repeating-pattern mark as it appears on a particular item encompassed by the identification of goods, and **amend the mark description** accordingly. The drawing must show the precise placement of the pattern on the particular item, which may be on only a portion of the item or over the entire surface of the item. The shape of the item must appear in broken lines to indicate that it is not claimed as part of the mark. 37 C.F.R. §2.52(b)(4); TMEP §807.08. The mark description must indicate that the mark consists of a pattern, specify how the pattern will appear on the relevant item, and describe any portions of the mark that are shown in broken lines and thus are not claimed as a feature of the mark. See TMEP §§807.08, 808.02. If necessary, **amend the identification** to delete goods that are inconsistent with the item appearing in the amended mark drawing. See TMEP §1202.19(f). If the repeating pattern will be applied to multiple goods, a drawing showing the pattern's placement on one of the goods is appropriate if all of the identified goods are similar in form and function, and the mark will appear in a similar manner on all of the goods. Likewise, if the repeating-pattern mark will appear in a similar manner on various sizes of similarly shaped product packaging, then a drawing showing the mark appearing on one version of the packaging depicted in broken lines is acceptable.
- (2) **Submit evidence** that (i) the applied-for mark is used, or will be used, in various ways or on a variety of items, but (ii) it will nonetheless be perceived as a source indicator and create the same commercial impression across all uses. The *evidence of variable use* referred to in (i) above need not show every use of the repeated pattern on the relevant items, but it should establish that the use (or intended use) of the mark in connection with the identified goods or services is so varied that a single depiction of the mark on a particular item would not accurately reflect the nature of the mark. This may include declarations, marketing materials, and other similar matter. The *evidence as to the commercial impression* referred to in (ii) above must be substantial and must establish that the pattern will be perceived as a source indicator and create the same commercial impression in the minds of consumers. Relevant evidence may include consumer declarations; advertisements or other materials showing various instances of the pattern being used together in one place (e.g., a single advertisement that shows the pattern being used in various ways on various goods, but nonetheless projecting the same commercial impression); sales figures relevant to the various items featuring the pattern; and any other evidence of the applicant's efforts to promote the various uses of the repeating pattern as a single source indicator for the relevant goods or services, including "look-for"-type evidence. See TMEP §1202.19(a)(iii).

For these reasons, registration is refused under Sections 1 and 45 of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

#### **Requirement -- Identification of Goods**

The word "clothing" in the identification of goods is indefinite and too broad and must be clarified because the word does not make clear the nature of the goods and could identify goods in more than one international class. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. The following are examples of acceptable identifications: "clothing for protection against accidents, irradiation and fire" in International Class 9; "surgical gowns" in International Class 10; "pet clothing" in International Class 18; and "shirts," "shorts," and "pants" in International Class 25. Therefore, applicant must amend the identification to specify the type of clothing.

If applicant's "clothing" is in International Class 25, applicant may amend the identification to insert the word "namely," after "clothing" and then list the specific types of clothing items in that class (e.g., shirts, pants, coats, dresses).

Applicant may adopt the following identification in International Class 25, if accurate:

"clothing, namely, <specify items by common commercial name, e.g., shirts, pants>; headwear; footwear," in International Class 25.

The identification of goods in International Class 33 is acceptable and does not require amendment.

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as

acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e). For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netathtml/tidm.html>. See TMEP §1402.04.

#### **Advisory -- Potential Refusal -- Failure to Function as a Trademark -- Nondistinctive Repeating Pattern**

Applicant is advised that, upon consideration of an allegation of use, registration may be refused on the ground that the applied-for mark, as used on the specimen of record, consisting of a repeating pattern used on some or all of the surfaces of goods and/or packaging for goods, is merely an ornamental and/or a nondistinctive feature of the goods and/or packaging for the goods; it does not function as a trademark to indicate the source of applicant's goods and to identify and distinguish them from others. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; see *In re F.C.F. Inc.*, 30 USPQ2d 1825, 1828 (TTAB 1994); TMEP §§1202.03 *et seq.*, 1202.19(e) *et seq.*

The USPTO will not register an applied-for mark unless it functions as a mark. See 15 U.S.C. §§1051, 1052, 1127; *In re Bose Corp.*, 192 USPQ 213, 215 (C.C.P.A. 1976) ("Before there can be registration, there must be a trademark . . ."); *In re Int'l Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977) ("Registration presupposes the existence of a trademark to be registered."); TMEP §1202. That is, the mark must serve as an indicator of the source of the goods or services, identifying and distinguishing them from those of others. See 15 U.S.C. §1127; TMEP §1202. Not every designation that a party places on goods or packaging, or uses in connection with services, is an inherently distinctive source indicator, regardless of the party's intentions when adopting the designation. *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Vertex Grp., LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) ("As is the case with any trademark, mere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself.").

The following factors are considered when determining whether the public would perceive the applied-for mark as a trademark or merely as a decorative or ornamental feature: the commercial impression made by the mark on the specimen, any prior registrations of the same mark for other goods and/or services, promotion of the applied-for mark as a trademark, and the practices of the relevant trade. See *In re The Todd Co.*, 290 F.2d 597, 599-600, 129 USPQ 408, 409-10 (C.C.P.A. 1961); *In re Dimitri's Inc.*, 9 USPQ2d 1666, 1668 (TTAB 1988); *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1115 (TTAB 1982); *In re Jockey Int'l, Inc.*, 192 USPQ 579, 581-83 (TTAB 1976); TMEP §§1202.03 *et seq.*

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

/Michael P. Keating/  
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**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](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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