

**To:** Radio One, Inc. ([chicago.trademarks@klgates.com](mailto:chicago.trademarks@klgates.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77679195 - BLACKFAITHLOVE.COM - N/A  
**Sent:** 5/20/2009 5:31:13 PM  
**Sent As:** ECOM104@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/679195

**MARK:** BLACKFAITHLOVE.COM

**\*77679195\***

**CORRESPONDENT ADDRESS:**

Benita P. Collier  
K&L Gates LLP  
P.O. Box 1135  
Chicago IL 60690-1135

**RESPOND TO THIS ACTION:**

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

**GENERAL TRADEMARK INFORMATION:**

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

**APPLICANT:** Radio One, Inc.

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[chicago.trademarks@klgates.com](mailto:chicago.trademarks@klgates.com)

**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: 5/20/2009**

The referenced application has been reviewed by the assigned trademark examining attorney. The applicant must address all issues below in a timely manner. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

**Search of Office's Database of Marks – No Conflicting Marks**

The Office records have been searched and there are no similar registered or pending marks that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

However, the applicant must address the following requirements.

**Identification/Classification of Services Requires Amendment**

The wording used to describe some of the applicant's services needs clarification because it is indefinite and/or includes services classified in the wrong international classes. See TMEP §§1401 *et seq.*, 1402.01, 1402.03. The Trademark Office requires a degree of particularity necessary to clearly identify and classify goods and services covered by a mark in applications filed under all statutory bases. See *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007). Descriptions of goods and services in applications must be specific, explicit, clear and concise. See 15 U.S.C. §§1051(a)(2), 1051(b)(2), 1053, 1126(d)-(e), 1141(f); 37 C.F.R. §2.32(a)(6); TMEP §§1401 *et seq.*, 1402.01, 1402.01(c), 1402.03; see *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm'r Pats. 1954); *In re Cardinal Labs., Inc.*, 149 USPQ 709, 711 (TTAB 1966).

The applicant must clarify the identification of services to specify the generic or common commercial name for the problematic services specified below, or provide other required information, and must classify the services properly. If there is no common commercial or generic

name, applicant must describe the nature of the services, the main purposes and intended uses, the intended consumers, and/or the relevant channels of trade. The applicant should note the following when amending the identification and/or classification.

- Careful use of grammar and punctuation, especially commas and semicolons, helps to group related—or distinguish unrelated—goods and services.
- The applicant must be as complete and specific as possible and avoid the use of indefinite words and phrases. *See* TMEP §§1402.01, 1402.03(a). If applicant uses indefinite wording, such as “accessories,” “components,” “devices,” “equipment,” “materials,” “parts,” “systems,” “products,” “services in connection with,” “such as,” “including,” “and like services,” “concepts,” or “not limited to,” to refer to goods or services, such words must be followed by “namely,” followed by a list of the specific goods identified by their common commercial names.
- Periodically the Office revises its international classification system and the policies regarding acceptable identifications of goods and services. Identifications are examined in accordance with Rules of Practice and Office policies and procedures in effect on the application filing date. TMEP §1402.14. Descriptions of goods and services found in earlier-filed applications and registrations are not necessarily considered acceptable identifications when a later-filed application is examined. *See* TMEP §§702.03(a)(iv), 1402.14. **For guidance identifying and classifying goods and services, please use the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahhtml/tidm.html>, which is continually updated in accordance with prevailing rules and policies.** *See* TMEP §§702.03(a)(iv), 1402.04.

The following services were listed in the wrong International Class in the application, or described insufficiently such that the accuracy of their classification could not be determined:

- In Class 41, the wording “online dating services” is misclassified. These services are in Class 45.
- In Class 41, the wording “providing online information about dating, astrology, fashion, and style” is misclassified. These services are in Class 45.
- In Class 41, the wording “providing commercial advertising services, namely, promoting the goods and services of others through the dissemination of their advertising materials via a global computer network” is misclassified. These services are in Class 35.
- In Class 41, the wording “electronic mail services” is misclassified. These services are in Class 38.
- In Class 41, the wording “computer services, namely, providing news and information concerning subjects and topics of interest to individuals of common cultural heritage...” is indefinite and may be misclassified. The services of providing news and information are classified based on the underlying nature of the topics/subject matter covered. In this case, “subjects and topics of interest to individuals of common cultural heritage” is too vague because it may still include a variety of topics. The applicant must specify the particular topics or a clearly identifiable unifying subject matter.
- In Class 41, the wording “providing search engines...” is misclassified. These services are in Class 42.

If accurate, and inserting specific information where directed, the applicant may adopt any or all of the following identifications of services. *See* TMEP §1402.01. PLEASE NOTE: The applicant has currently paid for any one (1) class of its choosing.

- Class 35: Providing commercial advertising services, namely, promoting the goods and services of others through the dissemination of their advertising materials via a global computer network;
- Class 38: Electronic mail services;
- Class 42: Computer services, namely, providing search engine services for obtaining data on a global computer network;
- Class 45: Online dating services; Providing online information about dating, astrology, fashion, and style;
- Class ?: Providing news and information in the field of [**applicant must specify particular topics**] via a global computer network.

The applicant may use different wording of its own when amending the identification/classification of goods or services. The applicant must follow the guidelines discussed above to ensure specificity and accuracy. Please note that while identifications of goods or services can be clarified or limited by amendment; adding to the goods or services or broadening the scope of the goods or services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, the applicant may not amend the identification to include goods or services that are not within the scope of the present identification.

## Requirements for Multiple-Class Applications

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the following for those goods and/or services based on an intent to use the mark in commerce under Trademark Act Section 1(b):

- (1) Applicant must list the goods and/or services by international class; and
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>).

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

The applicant must also resolve the following issue.

### **Disclaimer Required**

Applicant must disclaim the descriptive wording “.COM” apart from the mark as shown because it merely identifies the fact that the applicant has an Internet presence. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). The “.COM” top-level domain (TLD) indicator is never inherently distinctive. Rather, it is mere informational material that indicates to consumers that the mark represents an Internet domain name. TLDs are disclaimed because they are not part of the inherent source-indicating features of marks.

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof, rather than refuse registration of the entire mark. 15 U.S.C. §1056(a). A “disclaimer” is a statement added to the record that states that the applicant does not claim exclusive rights, separate and apart from the entire mark, to an unregistrable component of a mark whether it be wording or design. TMEP §1213. A disclaimer does not affect the appearance of the applied-for mark, because the disclaimed matter is not physically removed. See TMEP §§1213, 1213.10.

Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03. Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

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

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

### **RESPONDING TO THE OFFICE ACTION**

There is no required format or form for responding to an Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at <http://www.uspto.gov/teas/index.html>. However, if applicant responds on paper via regular mail, the response should include the title “Response to Office Action” and the following information: (1) the name and law office number of the examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4) applicant’s name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

The response should address each refusal and/or requirement raised in the Office action. If a refusal has issued, applicant can argue against the refusal; i.e., applicant can submit arguments and evidence as to why the refusal should be withdrawn and the mark should register. To respond to requirements, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

The response must be personally signed or the electronic signature manually entered by applicant or someone with legal authority to bind applicant (i.e., an attorney, a corporate officer of a corporate applicant, the equivalent of an officer for unincorporated organizations or limited liability company applicants, a general partner of a partnership applicant, each applicant for applications with multiple individual applicants). TMEP §§605.02, 712.

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

/Cory Boone/  
Trademark Examining Attorney  
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**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](mailto: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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**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 5/20/2009 FOR**  
**APPLICATION SERIAL NO. 77679195**

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=77679195&doc\\_type=OOA&mail\\_date=20090520](http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77679195&doc_type=OOA&mail_date=20090520) (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 **5/20/2009**.

**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](mailto: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.**