IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of EKRA GROUP, INC.	Serial No.: 77 / 778633 Filed: July 10, 2009 Mark: COCKSURE Class: Intl. Cl. 041 **APPLICANT'S RESPONSE TO OFFICE ACTION**

TO: Leslie L. Richards
Trademark Examining Attorney
Law Office 106
U.S. Patent and Trademark Office

COMES NOW the Applicant, EKRA GROUP, INC., by and through its attorney of record, MICHAEL J. BOYLE, and submits this RESPONSE TO OFFICE ACTION OF OCTOBER 19, 2009.

RESPONSE

The United States Patent and Trademark Office (the "USPTO"), though its Examining Attorney, has issued an office action refusing registration to Applicant's mark, COCKSURE on the basis that the mark consists of or comprises immoral or scandalous material, and is thus not registerable pursuant to § 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). Additionally, the USPTO has refused registration on the basis that Applicant's mark is not COCKSURE, but instead COCKSURE MEN, and thus Applicant must submit substitute specimens showing its

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mark to be COCKSURE as well as a declaration that said specimen was used in commerce at least as early as the purported COCKSURE MEN mark. For the reasons that follow, Applicant disagrees with these determinations and asks for registration of Applicant's COCKSURE mark.

A. APPLICANT'S "COCKSURE" MARK IS NOT BARRED FROM REGISTRATION PURSUANT TO § 2(A) OF THE TRADEMARK ACT, 15 U.S.C. § 1052(a).

The Examining Attorney has refused registration of Applicant's COCKSURE mark on the basis that the word "cock" is scandalous and immoral. In support of the Examining Attorney's refusal, the Examining Attorney has provided dictionary definitions of the word "cock" suggesting that the word "cock" is a vulgar term for "penis."

The Applicant's mark, however, is *not* the word "cock." The Applicant's mark is the word "COCKSURE." The definitions for "cocksure" from the dictionaries cited by the Examining Attorney are as follows:

(1) *Yahoo! Education Dictionary*. 1. Completely sure; certain; 2. Too sure; overconfident.[1]

(2) *MSN Encarta Dictionary*. 1. Certain about something: absolutely sure of being correct about something or succeeding in some effort; 2. overconfident: arrogantly confident and self-assured.[2]

(3) *Merriam-Webster Online Dictionary*: 1. feeling perfect assurance sometimes on inadequate grounds; 2. marked by overconfidence or presumptuousness.[3]

The determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquires. *In re Mavery Media Group Ltd.*, 33. F.3d 1367, 1371, 31 USPQ 2d 1923, 1925 (Fed. Cir. 1994). In order to prove that a mark is scandalous, the USPTO

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[1] http://education.yahoo.com/reference/dictionary/entry/cocksure
[2] http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?lextype=3&search=cocksure
[3] http://www.merriam-webster.com/dictionary/cocksure

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must demonstrate that the mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable;… giving offence to the conscience or moral feelings;… [or] calling out [for] condemnation." *Id*. at 1371, 31 USPQ 2d at 1925 Even a cursory review of the definitions of "COCKSURE" reveals that the word "COCKSURE" is not remotely vulgar. Thus, even assuming *arguendo* that the word "cock" is scandalous or immoral, the word "COCKSURE" most certainly is not.

The letters C, O, C, and K admittedly appear sequentially within the Applicant's COCKSURE mark. Those four letters appear sequentially also in the marks COCKPIT,[4] POPPYCOCK JUST THE NUTS!,[5] COCKADOODLE DOO,[6] as well as in dozens of other marks registered with the USPTO. However, "[T]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-546 (1920). "[W]hat is critical is the overall appearance of the mark as used in the marketplace, not a deconstructionist view of the different components of the marks." *PlayMakers, LLC v. ESPN, Inc.*, 297 F. Supp. 2d 1277, 1283 (W.D. Wash. 2003), *aff'd*, 376 F.3d 894, 71 U.S.P.Q.2d 1759 (9th Cir. 2004).

The overall appearance of Applicant's COCKSURE mark is the word "COCKSURE," which is itself an independently defined word in the English language. While it is possible to extrapolate the word "cock" from the word "COCKSURE," just as the word "cock" alone may be extrapolated from the words "cockpit," "poppycock," or "cockadoodle doo," such a possibility is simply not enough to determine that the word "COCKSURE" is a vulgar, scandalous, or immoral term. Were the opposite true, or if a mark could be dissected and individual combinations of letters analyzed on a piecemeal basis, COCKPIT, POPPYCOCK

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[4] *See, e.g.*, COCKPIT, Reg. no. 3414696, Registered April 22, 2008.

[5] *See, e.g.*, POPPYCOCK JUST THE NUTS!, Reg. no. 3097960, Registered May 30, 2006. Interestingly, this mark contains the word "nuts," which is also a "vulgar" term used to describe testis. *See Merriam-Webster Online Dictionary* (http://www.merriam-webster.com/dictionary/nuts): 9. *usually vulgar*: TESTIS.

[6] *See, e.g.*, COCKADOODLE DOO, Reg. no. 3094414, Registered May 16, 2006.

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JUST THE NUTS!, and COCKADOODLE DOO would fit the definition of immoral and scandalous as well.

Additionally, The USPTO must consider the mark in context of the market as applied to only the goods described in the application for registration. *In re Mavery*, 33. F.3d at 1371, 31 USPQ 2d at 1925, *citing In re Old Glory Condom Corp.*, 26 USPQ 2d 1216, 1219 (TTAB 1993). Whether a mark comprises scandalous matter is to be ascertained from the standpoint of a substantial composite of the general public. *Id*. It may be true that specimen use or a design element of a mark reinforcing a scandalous meaning may be persuasive evidence that a substantial composite of the general public will consider a term or phrase scandalous. However, the word "COCKSURE" has no scandalous or immoral meaning to reinforce by reference to any design element of Applicant's COCKSURE mark or any of Applicant's specimens of use. Extrapolating four sequential letters from Applicant's mark, ascribing a vulgar meaning to those letters alone, referencing specimen use or design elements as evidence that the general public will find those four letters alone scandalous, and denying registration to Applicant's mark on that basis, is wholly inappropriate.[7]

Because the crux of the Examining Attorney's office action is devoted to attempting to demonstrate the scandalous or immoral character of the word "cock," there is nothing in the Examining Attorney's office action to suggest that the USPTO has met its burden of demonstrating that a "substantial composite of the general public" would be scandalized by

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[7] It is notable that the word COCKSURE has been registered as a mark with the USPTO on four separate occasions. *See* Reg. Nos. 2490584, 2347812, 2238920, and 0554553. Applicant admittedly uses its mark in connection with various adult entertainment products and services, as opposed to clothing or fruits and vegetables. The Examining Attorney's derivation of a vulgar meaning from four letters of a benign term that has been the subject of multiple prior registrations, the latest of which was in 2001, *see* Reg. no. 2490584, could appear to be the result of disparate treatment of the Applicant and its mark as opposed to a genuine determination of the registerability of the Applicant's mark. Not only are the "Section 1052(a) prohibitions against scandalous marks not 'an attempt to legislate morality,' but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government," *In re McGinley*, 660 F.2d 481, 486, 211 USPQ 668, 674 (CCPA 1981), but such disparate treatment could be violative of Applicant's due process and equal protection rights. Moreover, Applicant contends that Applicant's mark is an expression of speech, and as such Applicant has a right under the First Amendment of the U.S. Constitution to register the mark that is the subject of this application.

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Applicant's COCKSURE mark as it is used by the Applicant. Therefore even assuming that COCKSURE could be ascribed a vulgar meaning, the USPTO, without more, is in error in concluding that a substantial composite of the general public would necessarily attach to the mark COCKSURE such a vulgar meaning rather than its obvious, non-scandalous meaning.

In the absence of any evidence that Applicant's COCKSURE mark would be considered scandalous by a substantial composite of the general public, the issue of whether Applicant's mark comprises scandalous matter should be resolved in favor of the Applicant. The Examining Attorney should pass Applicant's mark for publication with the knowledge that if any member of the general public does find Applicant's mark to be scandalous, an opposition proceeding can be brought and a more complete record can be established. *In re Mavery*, 33 F.3d at 1374, 31 USPQ 2d at 1928. Such action is respectfully requested.

B. APPLICANT'S SPECIMENS DEMONSTRATE USE OF ITS COCKSURE MARK IN COMMERCE AND NO OTHER MARK.

The Examining Attorney has concluded that the mark on Applicant's specimens disagree with the mark on the drawing. Specifically, the Examining Attorney contends that the specimens demonstrate the mark as COCKSURE MEN rather than COCKSURE alone. The Applicant disagrees with the Examining Attorney's conclusion.

The Examining Attorney's basis for asserting that the Applicant's mark is COCKSURE MEN rather than COCKSURE is, evidently, the presence of the word "men" below the stylized word "COCKSURE" in the proofs offered by the Applicant, such as follows:

Trademarks has been ascribed six basic functions: (1) designation of source or origin of a particular product or service; (2) denotation of a particular standard of quality which is

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embodied a product or service; (3) identification of a product or service as distinct from products or services of another; (4) symbolization of good will of a mark's owner; (5) representation of advertising investment; and (6) protection from confusion and deception." 1-1 Gilson on Trademarks § 1.03.

The use of the word "men" below the Applicant's COCKSURE mark is not designed to be, nor was it ever considered by Applicant to be, a part of the Applicant's mark. The Applicant's products and services comprise various forms of adult entertainment. The word "men," as it appears in the Applicant's specimens, is merely descriptive of the type or genre of the services and/or products that Applicant is providing using its COCKSURE mark. COCKSURE is the *brand*, "men" is *merely descriptive* of the product.

As can be seen in the DVD cover[8] provided as a specimen, for instance, the word "COCKSURE" appears substantially as it does in the example above, except that a conspicuous "TM" appears next to the word "COCKSURE." In addition, along the bottom portion of the DVD cover is written the words "A COCKSURE STUDIOS PRODUCTION." It is logical, therefore, that Applicant's COCKSURE mark is functioning as the Applicant's mark – it is designating "Cocksure Studios" as the source of the product upon which Applicant's COCKSURE mark appears. The word "men" adds nothing to the efficacy of the Applicant's COCKSURE mark aside from stating that the particular product and/or service offered by the Applicant features men.

Applicant's use of its COCKSURE mark, with a designation of genre rather than source in close proximity to the mark itself, is mirrored by other registrants' uses of their marks.

The owner of the mark LACOSTE,[9] in International Class 003 (perfumes, colognes, etc.), utilizes its mark in conjunction with words descriptive of its products in close proximity. The LACOSTE mark in question is used by its owner on its products in conjunction with the words

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[8] The DVD cover was included as a specimen to the USPTO with the digital file name "004. COCKSURE DVD.jpg"

[9] USPTO Reg. no. 1262783, Registered January 6, 1982.

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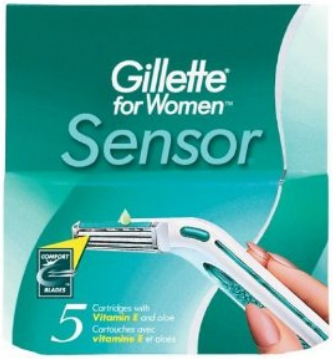
"challenge," "red," "elegance," "pour homme," "essential," and "essential sport."[10] In fact, the specimen submitted by the owner of the LACOSTE mark in question submitted a specimen for its renewal of the mark on April 28, 2008 that displayed not simply a bottle upon which the word LACOSTE appeared alone, but also displayed the words "eau de toilette" just below it.[11] LACOSTE was granted renewal of its LACOSTE mark despite the fact that, using the Examining Attorney's logic, the mark as claimed and the specimen no longer agreed.

The owner of the mark GILLETTE[12] in International Class 008 (safety razors and safety razor blades) uses its mark in a similar manner. For instance, in the following image[13] the owner of the GILLETTE mark has utilized GILLETTE directly above the words "for women:"



The Examining Attorney's conclusion that the Applicant's COCKSURE mark disagrees with the specimens provided is incorrect because the word "men" appearing with the word "COCKSURE" does nothing to affect the efficacy or commercial impact of the word "COCKSURE" as a mark, just as the addition of the words "eau de toilette" or "for women" do nothing to alter the efficacy or commercial impact of LACOSTE or GILLETTE, respectively, as marks. Countless examples of products displaying an owner's mark in close proximity to an

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[10] http://www.lacoste-parfums.com/mens-fragrances/ (Accessed April 13, 2010)
[11] Applicant reviewed the specimens of use in question utilizing the USPTO Trademark Document Retrieval ("TDR") system available Online at http://tmportal.uspto.gov/external/portal/tow (Accessed April 13, 2010).
[12] USPTO Reg. no. 0767865, Registered April 7, 1964.
[13] Image obtained from http://www.amazon.com/Gillette-Sensor-Refill-Cartridges-5-Count/dp/B000FKHMM4 (Accessed April 13, 2010)

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indicator of the genre or type of product exist on the shelves of every commercial retailer in America. An assertion that a mark used as such somehow diminishes its efficacy as a mark, or somehow alters the nature of the mark itself, is in error. Were it not, the LACOSTE mark discussed *supra* could not have been renewed.

The Applicant, who provides products and services through its Cocksure Studios, has applied for registration of its mark COCKSURE on the Principal Register of the USPTO, and in doing so has provided specimens of use showing precisely how the Applicant, in keeping with widely-used commercial standards, utilizes its COCKSURE mark in commerce. The USPTO determination concerning the Applicant's use of its COCKSURE diverges dramatically from the standards and practices utilized commercially. Thus, the USPTO's denial of registration to the Applicant's mark based upon the assessment that the Applicant's mark is not COCKSURE, but rather COCKSURE MEN, is in error.

The Examining Attorney should rescind its request for the Applicant to submit a substitute specimen in accordance with TMEP § 807.12(a), or any verified affidavit or signed declaration in support thereof, and should accept the Applicant's specimens of use as submitted as examples of Applicant's commercially-acceptable utilization of Applicant's mark which satisfies the requirements of Section 1 of the Trademark Act as well as 37 C.F.R. § 2.51(a). Such action is respectfully requested

CONCLUSION

In view of the foregoing, and as the Examining Attorney's search of Office records failed to reveal any similar registered or pending marks which would bar registration under Trademark Act § 2(d), Applicant believes that its application is in condition for publication.

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RESPECTFULLY SUBMITTED this 15th day of April 2010.

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