

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Home Box Office, Inc.
MARK: **HODOR**
SERIAL NO: 87/047,962
FILING DATE: May 24, 2016
Attn: Lourdes Ayala
Trademark Examining Attorney
Law Office 106

Office Action Response for Electronic Filing

The Examining Attorney has initially refused registration of the mark **HODOR** for “[c]lothing, namely, t-shirts” (Ser. No. 87/047,962) on the grounds that the mark is merely ornamental. For the reasons set forth below, Applicant respectfully requests that the Examiner withdraw her refusal of the specimen and allow the mark to be published.

The basis of the Examining Attorney’s argument is that Applicant’s mark is located directly on the front of the shirt and, therefore, appears to be ornamental. However, in its entirety, Applicant notes that its specimen is not merely a picture of shirts showing the mark, but rather, the specimen is a webpage from Applicant’s website – and specifically the online store portion of that website – where the mark also appears at the top middle of the webpage, similar to a “title” of the page. Applicant respectfully submits that when viewed in its entirety, the display of the mark, as centered at the top of Applicant’s web page (as well as the fact that the mark appears in close proximity to a photo of the goods, the price of the goods, and necessary ordering information) constitutes a point-of-sale display providing the means for potential consumers to place an order. *See* TMEP 904.03(i) (“A web page that displays a product can constitute a ‘display associated with the goods’ if it: (1) contains a picture or textual description of the identified goods; (2) shows the mark in association with the goods; and (3) provides a

means for ordering the identified goods.”); *In re Sones*, 590 F.3d 1282, 1286 (Fed. Cir. 2009) (citing cases); *In re Valenite, Inc.*, 84 U.S.P.Q.2d 1346, 1348 (T.T.A.B. 2007) (web page contains the information necessary to order the goods because it displays telephone numbers and links for customer service and technical resource center) (refusal of applicant’s specimen reversed with the Board nothing that “VALPRO” appearing at the top middle of the web pages shows the mark sufficiently near the picture of the goods to associate the mark with the goods).

The salient question is whether HODOR, which appears as the title of the webpage, will be recognized as an indication of origin for Applicant’s product. Applicant respectfully submits that the mark HODOR, prominently displayed at the top center of the webpage, creates a commercial impression separate and apart from the other material on the webpage. *See* TMEP 904.03(i)(B)(1); *In re Royal Viking Line A/S*, 216 U.S.P.Q. 795, 797 (T.T.A.B. 1982) (citing *In re Singer Mfg. Co.*, 118 U.S.P.Q. 310, 312 (C.C.P.A. 1958)) (“While a trademark or service mark need not be displayed in any particular size or degree of prominence, the important question is whether, when it is noticed, it will be understood as indicating origin of the goods or services.”).

A web page that displays a product can constitute a “display associated with the goods,” as long as the mark appears on the web page in association with the goods, and the web page provides a means for ordering the goods. *See* TMEP 904.03(i); *In re Dell*, 71 U.S.P.Q.2d 1725 (T.T.A.B. 2004) (citing *Lands’ End Inc. v. Manbeck*, 797 F. Supp. 511, 24 U.S.P.Q.2d 1316 (E.D. Va. 1992)). Web pages that display the trademarks in association with a picture of the goods or a sufficient description of them to understand what they are, and provide for online ordering of such goods are, in fact, electronic displays associated with the goods. *See id.*; TMEP 904.03(i).

In addition, web pages such as Applicant’s are not merely advertising, because in addition to showing or describing the goods, they provide a link for ordering the goods. *See*

TMEP 904.03(i); *In re Dell*, 71 U.S.P.Q.2d at 1727. An advertisement, “does not offer a way to directly purchase the goods”. TMEP 904.03(i). On the other hand, Applicant’s specimen shows an “electronic retail store, and the web page is a shelf-talker or banner which encourages the consumer to buy the product. A consumer using the link on the web page to purchase the goods is the equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a store to purchase it.” *In re Dell*, 71 U.S.P.Q.2d at 1727. The web page is, thus, a point-of-sale display by which an actual sale is made. *See id.*

Applicant’s specimen shows the prominent use of the HODOR mark on Applicant’s online store, where such products are directly available for purchase. As such, the use of HODOR is as a trademark and is not merely ornamental. For this reason, Applicant respectfully requests that its application pass to publication.

Dated: February 17, 2017

Respectfully submitted,
HOME BOX OFFICE, INC.

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