

**Serial No.: 88/121,320**  
**AT Ref. No.: 32866-39**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: Illustrated Syndicate, LLC  
Serial No.: 88/121,320  
Filed: September 18, 2018  
International Class 41  
Examiner: Michael A. Wiener, Law Office 108  
Mark: HEIRESS

**REQUEST FOR RECONSIDERATION**

In response to the Office Action issued on February 26, 2020, Applicant respectfully requests that the Examining Attorney reconsider and withdraw the Section 2(e)(1) refusal. For the reasons stated herein, Applicant's mark HEIRESS is not "merely descriptive" of Applicant's services. Applicant is filing a notice of appeal in conjunction with this Request for Reconsideration.

**I. Applicant has Further Developed its Character.**

Applicant's goods and services bearing the HEIRESS mark will include a female character named, Princess Reign, whose father is a king. But the king does not mark her as his heir to the kingdom. Instead, the king challenges his two sons to a competition to become his heir, and the female character seeks to prove that she is worthy. The character's name and/or title will not include the word "HEIRESS."

**II. The Term HEIRESS Does Not Directly Describe Applicant's Services.**

The Examining Attorney maintains a mere descriptiveness refusal under Section 2(e)(1) for the following services under International Class 41:

*Class 41: "presentation, distribution and rental of motion picture films; presentation and rental of sound and visual recordings; provision of entertainment news and entertainment information via communication and computer networks; providing entertainment services via a global communication network in the nature of websites featuring a wide variety of general interest entertainment information relating to motion picture films, musical videos, related film clips, photographs, and other multimedia materials; presentation of live stage shows; theater productions; entertainment services, namely, providing an on-line computer game; providing a web-based system and on-line portal for customers to participate in on-line gaming for recreational computer game playing purposes and operation and coordination of game tournaments for recreational computer game playing purposes; providing a web site through which people locate information about video games, video game tournaments, video game events, and competitions in the video game field; providing on-line digital publications in the nature of digital magazines and periodicals in the field of games."*

As the Examining Attorney notes, a mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of a good or service. Feb. 26, 2020 Office Action at \*1; TMEP § 1209.01(b).

The Examining Attorney emphasizes that he has submitted “*five*” dictionary definitions for the term HEIRESS. Feb. 26, 2020 Office Action at \*2 (emphasis in original); **Exhibit A** (reattaching dictionary definitions offered by the Examining Attorney).<sup>1</sup> A surplus of definitions does not change the analysis. The disagreement is not about what “heiress” means, but rather if it describes Applicant’s *services*, and it does not. HEIRESS is not an ingredient, quality, characteristic, function, feature, purpose, or use of any of the entertainment services listed in Applicant’s Application. Applicant’s use of the mark has little to do with the proffered dictionary definitions, and Applicant does not use the term to describe the services themselves. The connection between HEIRESS and Applicant’s stated Class 41 entertainment services is far more attenuated, rendering it suggestive rather than descriptive, as described below.

As the Examining Attorney notes, “[a]n identification of goods is a crucial element in any trademark application or registration.” That is because a mark may be generic or descriptive of one kind of good, but not so of another. Yet, the Examining Attorney has concluded that the HEIRESS mark is merely descriptive of a wide variety of Applicant’s goods and services across multiple applications, from downloadable ringtones (Class 9) to paper party hats (Class 28) and video games (Class 41). The Examining Attorney should analyze each application and identification of goods/services independently.

### **III. HEIRESS is Suggestive of Applicant’s Services.**

Even taking for granted the dictionary definitions, there is no direct connection with any definition of HEIRESS and the nature of the services themselves. The Trademark Trial and Appeal Board (the “Board”) has adopted a three-part test to help determine whether a mark is descriptive or suggestive: (a) the degree of imagination necessary to understand the product; (b) a competitor’s need to use the same terms; and (c) a competitor’s current use of the same or similar terms.<sup>2</sup> Consideration of these factors leads to a conclusion that HEIRESS is suggestive of Applicant’s services.

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<sup>1</sup> Applicant has identified only four definitions in the evidence, which are attached here. Nonetheless, the number of definitions provided does not impact Applicant’s argument.

<sup>2</sup> See *No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 USPQ 502 (TTAB 1985).

**a) HEIRESS Requires Consumers to Use their Imaginations.**

The greater the number of imaginative steps required for a consumer to connect a mark to an accurate or direct description of the goods or services, the more likely the term is suggestive and not merely descriptive.<sup>3</sup> If there is no instantaneous connection as to the nature of the services, it is far more likely that the trademark is correctly deemed suggestive rather than descriptive.<sup>4</sup>

Here, HEIRESS requires consumers to engage in a multi-step analysis to understand the mark. Applicant's services will feature an animated female character. The plot will include a storyline in which the character is *not* a presumptive heiress. Rather, she is striving to become an heiress. The term HEIRESS does not actually describe Applicant's services, namely, entertainment services; it describes the aspirations of one of the characters found in the services.

Because there is no direct connection between the listed Class 41 services and the term HEIRESS, consumers must use their imaginations to build any such connection. Thus, this factor weighs in favor of a finding that the HEIRESS mark is suggestive of Applicant's services.

**b) Registration of HEIRESS Would Not Impede Competition.**

Competitors do not need to use the term HEIRESS in describing their own entertainment services. The term does not describe such services. To the extent that competitors' similar services feature female characters with the characteristics of an heiress, an abundance of synonyms exist to describe such characters, including: successor, beneficiary, inheritrix, descendant, and grantee. Various thesaurus entries are produced herewith as **Exhibit B**. Third parties would be at no commercial disadvantage, and competition among entertainment services would not be impeded by registration of the term HEIRESS. For example, the Examining Attorney includes in his evidence one such use of a synonym (albeit not for a good listed in Applicant's Application): a book manuscript entitled *The Inheritance*. Feb. 26, 2020 Office Action at \*35.

The Examining Attorney includes evidence of use of the term HEIRESS in a way that does not at all describe a competitor's goods or services. For example, the Examining

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<sup>3</sup> See *Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc.*, 561 Fed. 1014 (DCRI 1983).

<sup>4</sup> See *Stix Products, Inc. v United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (SDNY 1968).

Attorney's evidence includes a band, an individual's Facebook profile, and a non-profit organization that produces live plays. Feb. 26, 2020 Office Action at \*\*40–63, 70–73. There is no indication that the band members or individual whose Facebook profile is featured are “a woman who has received a large amount upon the death of a rich relative,” or any other of the Examining Attorney's proffered definitions of “heiress.” *Id.* at \*3. Likewise, the definition does not fit a band, social media profile, entertainer, non-profit organization, or production company. The term heiress is wholly unnecessary for any of these examples in the evidence to describe their goods or services.

Further, registration of HEIRESS would not completely remove the term from the popular lexicon. The “fair use” doctrine would protect use in a descriptive sense, not as a trademark, and in good faith.<sup>5</sup>

Thus, this factor also weighs in favor of classifying HEIRESS as suggestive.

#### **IV. Applicant's Evidence is Relevant and is Not De Minimus.**

The Examining Attorney takes issue with some of Applicant's examples of other registered marks because they are similar products that do not use the term HEIRESS, and with others because they use the term HEIRESS but are different products. In essence, it would appear that the only evidence that the Examining Attorney will accept as relevant would be the *same* services with the *same* mark, which would inevitably lead to a likelihood of confusion.

The Examining Attorney takes the position that the examples of SNOW WHITE and SPIDER-MAN because they are “not an actor or specific type of human being.” Feb. 26, 2020 Office Action at \*6. The requirement that evidence can only be based on “a specific type of human being” is overly specific and misstates the standard for determining whether a mark is merely descriptive. Indeed, a mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of a good or service. TMEP § 1209.01(b). The Examining Attorney may not add additional criteria to his analysis; evidence of analogous registrations is not limited only to those with “a specific type of human being.” Such a limitation denies the Examining Attorney the opportunity to consider analogous characters and marks for the same or similar services.

Under the Examining Attorney's overbroad criteria, THE PRINCESS AND THE FROG could not feature any princess characters or frog characters, nor could THE PINK PANTHER feature any panthers, let alone those that are and pink. Yet, the prominent characters in THE PRINCESS AND THE FROG are a frog and a woman who, through a quest for love and to save

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<sup>5</sup>*Int'l Stamp Art, Inc. v. U.S. Postal Serv.*, 456 F.3d 1270, 1274 (11th Cir. 2006).

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the frog, becomes a princess. And, quite simply, THE PINK PANTHER is a panther who is a pink. Indeed, TOY STORY is a mark based entirely on stories about toys. Notably, neither the words “toy” nor “story” are disclaimed, despite their ubiquitous use describing each of those generic classes of services. Class 41 registration information for each of these marks is detailed below.

Applicant’s evidence is relevant here. Not only are Applicant’s examples of marks that are the same as a major character or primary game actor, but they are for similar services. The Examining Attorney argues that there is no overlap in services, which is incorrect. For example, SPIDER-MAN’s Class 41 registration is for “entertainment services rendered through the mediums of television and film exhibitions.” See **Exhibit C**. Applicant’s listed services include “presentation, distribution and rental of motion picture films.”

The main character of the SPIDER-MAN mark is a man with spider-like qualities. Whether those qualities make him “a specific type of human being” or not, the mark’s description of a quality of the character is analogous to the HEIRESS character seeking to become an heiress. Thus, the Examining Attorney should consider this and similar evidence.

Applicant has included third-party marks as examples of how, in many instances, the name of a character in a fictional story, used in connection with unrelated services such as entertainment services including motion pictures and video games can properly serve as a source-identifying mark, even when the character’s name gives some indication of the character’s qualities. Here, the HEIRESS mark is even further removed because the character’s name, Princess Reign, does not include the term HEIRESS and she is not presumed to be an heiress to her father’s kingdom.

Further, Applicant’s evidence is not *de minimus*. Applicant has presented a mere sample of registrations that are representative of numerous other registrations, including twelve registered HEIRESS marks, and six marks featuring characters similar to Applicant’s character. Applicant here offers examples of other marks that are similarly suggestive—or even more so—of qualities of the characters featured in the goods:

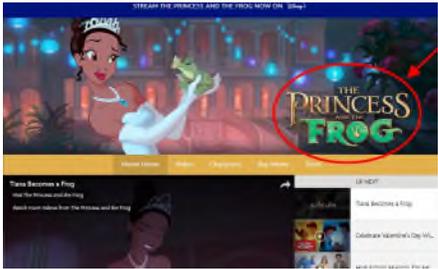
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TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>THE PINK PANTHER</p> <p>RN: 3641787</p> <p>SN: 77307466</p> <p>Owner: Metro-Goldwyn-Mayer Studios Inc. (Del. Corp.)</p> <p>245 N. Beverly Dr. Beverly Hills, CA 90210</p>	<p>Registered: June 23, 2009</p> <p>Int'l Class 41</p> <p>First Use: March 20, 1964</p> <p>Filed: Oct. 18, 2007</p>	<p>Entertainment services, namely, production of a series of comedy motion picture films for theatrical release and for distribution via television, cable television and the internet.</p>	<p>Features a panther character that is pink in color. Thus, it is THE PINK PANTHER.</p> <p>A USPTO accepted specimen for THE PINK PANTHER:</p>  <p>The poster for 'The Pink Panther' features a pink panther character at the top. Below it, the main cast members are depicted in a scene from the movie. The text on the poster includes: 'You only live once... so see the Pink Panther twice!!', 'THE PINK PANTHER', 'DAVID NIVEN · PETER SELLERS', 'ROBERT WAGNER · CAPUCINE', 'BRENDA DE SANZIO · COLIN GORDON · FRAN JEFFRIES', and 'CLAUDIA CARDINALE'.</p>

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TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>PINK PANTHER AND PALS</p> <p>RN: 3793576</p> <p>SN: 77268543</p> <p>Owner: Metro- Goldwyn-Mayer Studios Inc. (Del. Corp.)</p> <p>245 N. Beverly Dr. Beverly Hills, CA 90210</p>	<p>Registered: May 25, 2010</p> <p>Int'l Class 41</p> <p>First Use: March 7, 2010</p> <p>Filed: Aug. 30, 2007</p>	<p>Entertainment services, namely, an animated television series.</p> <div data-bbox="656 669 1468 877" data-label="Image"> </div>	<p>Features a panther character that is pink in color and his friends. Thus, it is a PINK PANTHER AND PALS.</p> <p>A USPTO accepted specimen for PINK PANTHER AND PALS:</p>

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TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>THE PRINCESS AND THE FROG</p> <p>RN:</p> <p>SN: 77978756</p> <p>Owner: Disney Ent., Inc.  (Del. Corp.)</p> <p>500 S. Buena Vista St. Burbank, CA 91521</p>	<p>Registered: April 6, 2010</p> <p>Int'l Class 41</p> <p>First Use: Nov. 25, 2009</p> <p>Filed: Sept. 28, 2007</p>	<p>Production and distribution of motion picture films; production of sound and video recordings; production and provision of entertainment, namely, [ news, games, activities for children and] information relating to animated motion picture films, via communication and computer networks [; amusement park and theme park services; production and presentation of live stage shows; educational and entertainment services rendered in or relating to theme parks, namely, live stage shows, live amusement park shows, and presentation of live theatrical performances; presentation of live performances; entertainment in the nature of theater productions; entertainer services, namely, live performances by costumed characters or professional entertainers ]. (brackets in original).</p>	<p>The two main characters are a frog and a woman who, through a quest for love, turns, turns into a princess. Her kiss is able to restore the prince (and herself) from frog to human form. Thus, the characters are THE PRINCESS AND THE FROG.</p> <p>A USPTO accepted specimen for THE PRINCESS AND THE FROG (demarcation in original):</p>  <p>The image shows a screenshot of a website for 'The Princess and the Frog'. The title 'THE PRINCESS AND THE FROG' is prominently displayed in a stylized font, with 'THE PRINCESS' in white and 'AND THE FROG' in green. A red circle highlights the title. Below the title, there are several smaller images and text elements, including a character in a white dress and a frog. The website appears to be a promotional page for the movie.</p>

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TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>TEENAGE MUTANT NINJA TURTLES</p> <p>RN: 1534724</p> <p>SN: 73741362</p> <p>Owner: Viacom Int'l Inc.  (Del. Corp.)</p> <p>1515 Broadway</p> <p>New York, NY 10036</p>	<p>Registered: April 11, 1989</p> <p>Int'l Class 41</p> <p>First Use: Dec. 28, 1987</p> <p>Filed: July 21, 1988</p>	<p>Entertainment services, namely, a continuing television series of animated adventure shows.</p>	<p>Features characters that are turtles of teen age and have been mutated to possess human-like qualities, including the ability to stand upright and engage in martial arts. Thus, they are TEENAGE MUTANT NINJA TURTLES.</p> <p>A USPTO accepted specimen for TEENAGE MUTANT NINJA TURTLES:</p>



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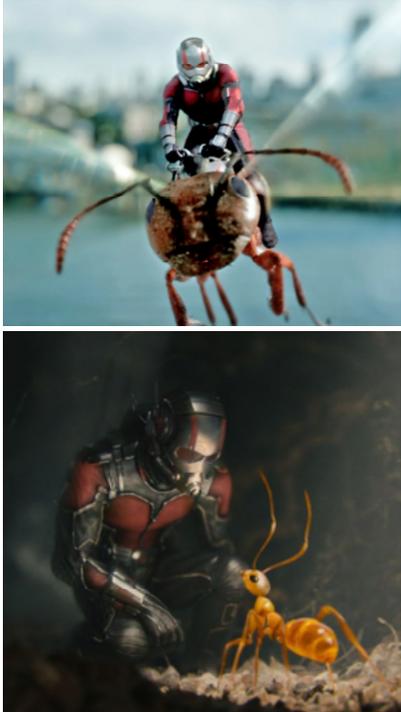
TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>TOY STORY</p> <p>RN: 3971114</p> <p>SN: 77729759</p> <p>Owner: Disney Ent., Inc. (Del. Corp.)</p> <p>500 South Buena Vista Street Burbank, CA 91521</p> <p>Prior Registration: 3623505</p>	<p>Registered: May 31, 2011</p> <p>Int'l Class 41</p> <p>First Use: Oct. 31, 1996</p> <p>Filed: May 5, 2009</p>	<p>Presentation, distribution, and rental of motion picture films; [ production, presentation and distribution of sound and video recordings for others; production of live entertainment shows for use in the following media, namely, audio and video media and by electronic means for others; [production of interactive programs for use in the following media, namely, television, cable, satellite,] audio and video media, [video cartridges, laser discs, computer discs] and by electronic means for others; ] production and provision of entertainment, namely, news, and information relating to the entertainment industry in general via communication and computer networks; amusement park and theme park services [ ; educational and entertainment services rendered in or relating to theme parks, namely, presentation of live stage shows, presentation of live show performances, theater productions; entertainer services, namely, live appearances by a professional entertainer ]. (brackets in original)</p>	<p>The entire story is about toys; it is a TOY STORY.</p> <p>A USPTO accepted specimen for TOY STORY:</p> 

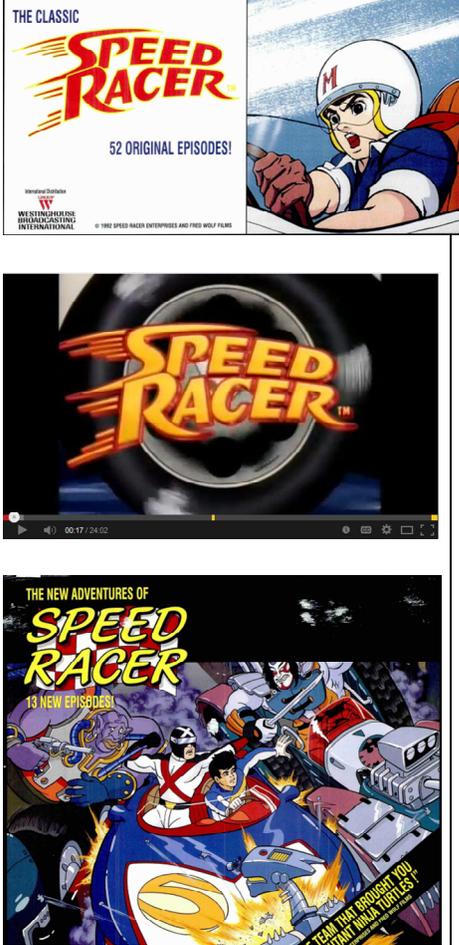
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TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>ICE AGE</p> <p>RN: 4373161</p> <p>SN: 85485372</p> <p>Owner: Twentieth Century Fox Film (Del. Corp).</p> <p>10210 W. Pico Blv. Los Angeles, CA 90035</p> <p>Prior Registrations: 2879905; 2882756; 3327536</p>	<p>Registered: July 23, 2013</p> <p>Int'l Class 41</p> <p>First Use: March 15, 2002</p> <p>Filed: Dec. 1, 2011</p>	<p>Production and distribution of audio and visual works in the nature of motion picture films; providing on-line information in the field of motion picture film and video entertainment related to motion picture films via the Internet; entertainment services in the nature of non-downloadable videos and images featuring motion picture films transmitted via the Internet and wireless communication networks.</p>	<p>The story takes place during the ICE AGE. While the term does not describe a particular <i>character</i>, it describes the entire setting and the only time period in which key characters such as a woolly mammoth, saber-toothed tiger, and saber-toothed squirrel lived.</p> <p>A USPTO accepted specimen for ICE AGE:</p> 

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TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>ICE AGE</p> <p>RN: 5632630</p> <p>SN: 87908768</p> <p>Owner: Twentieth Century Fox Film (Del. Corp).</p> <p>10210 W. Pico Blv. Los Angeles, CA 90035</p> <p>Prior Registrations: 4373161; 4373162; 4377063</p>	<p>Registered: Dec. 18, 2018</p> <p>Int'l Class 41</p> <p>First Use: April 11, 2012</p> <p>Filed: May 4, 2018</p>	<p>Providing on-line computer games; providing electronic games services by means of the internet; entertainment services, namely, providing interactive online computer games utilizing communication networks, including global communication networks.</p>	<p>The story takes place during the ICE AGE. While the term does not describe a particular <i>character</i>, it describes the entire setting and the only time period in which key characters such as a woolly mammoth saber-toothed tiger, and saber-toothed squirrel lived.</p> <p>A USPTO accepted specimen for ICE AGE:</p> 

TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>ANT-MAN</p> <p>RN: 4893365</p> <p>SN: 86173097</p> <p>Owner: Marvel Characters, Inc. (Del. Corp.)</p> <p>500 South Buena Vista, Burbank, CA 91521</p>	<p>Registered: Jan. 26, 2016</p> <p>Int'l Class 41</p> <p>First Use: July 16, 2012</p> <p>Filed: Jan. 23, 2014</p>	<p>Production, distribution, and rental of motion picture films; production rental of sound and visual video recordings; entertainment services, namely, multimedia production and provision of continuing entertainment programs, news programs, and current event information programs, which are all delivered via communication and computer networks; production and provision of entertainment news and entertainment information featuring entertainment information relating to motion picture films, comic books, related film clips, photographs, and other multimedia materials; providing information, news, and commentary in the field of entertainment via communication and computer networks; providing a website featuring information in the field of motion picture films, comic books, related film clips, photographs, and other multimedia materials; providing a website featuring information in the field of entertainment.</p>	<p>Features a man who, predictably, shrinks to the size of an ant. He is an ANT-MAN.</p> <p>A USPTO accepted specimen for ANT-MAN:</p>  <p>Other images of ANT-MAN from the motion pictures, showing his relative size:</p> 

TM/SN/RN/ Disclaim./ Owner	Status/ Key Dates	Full Goods/ Services	Description (some specimens have been cropped for sizing)
<p>SPEED RACER</p> <p>RN: 1797317</p> <p>SN: 74174508</p> <p>Owner: Speed Racer Ent., Inc. (Cal. Corp.)</p> <p>416 Forth Street            Santa Monica, CA            90401</p>	<p>Registered:            Oct. 5, 1993</p> <p>Int'l Class 41</p> <p>First Use:            Nov. 24, 1992</p> <p>Filed:            June 10, 1991</p>	<p>Entertainment services, namely, an animated television series.</p>	<p>Features a race car driver who races at high speeds. He is a SPEED RACER.</p> <p>USPTO accepted specimens for SPEED RACER:</p> 

Copies of the above-referenced registrations can be found at **Exhibit D**.

Applicant’s 15 total examples of similar third-party registrations are not *de minimis*. But, if Applicant’s evidence is *de minimus*, the Examining Attorney’s evidence is even more so. After, pursuant to the Examining Attorney’s criteria, weeding out inapplicable examples that do not have anything to do with the definition of an “heirress,” use of the term as a descriptor rather

than as a mark, and use of the term in products different from those listed in Applicant's Application, there is little left: only a handful of books and a play.

**V. The Examining Attorney Should Consistently Apply Trademark Principles While Deciding Each Application on its Own Merits.**

While Applicant agrees that the Examining Attorney must review each application on its own merits, third-party registrations are relevant and can demonstrate “that a particular term has descriptive [or suggestive] significance as applied to certain goods or services.”<sup>6</sup> Further, as a federal entity, the USPTO should strive to consistently apply trademark principles across various applications.<sup>7</sup> Thus, consideration of other registrations, though not binding, aid the Examining Attorney in reaching a result that is consistent with prior USPTO action.

**VI. Any Doubt as to Descriptiveness Should be Resolved in Favor of the Applicant.**

Applicant notes that determining whether a mark or wording is merely descriptive or suggestive may require the drawing of fine lines. The Application is not, as the Examining Attorney suggests, clearly merely descriptive. To the extent the analysis is a close-call, doubts as to registrability are normally resolved in favor of applicants.<sup>8</sup>

**Conclusion**

Having responded to the Examining Attorney's Office Action, Applicant respectfully submits that the Application is now in proper condition for publication, notification of which Applicant requests at the Examining Attorney's convenience. If it would advance the prosecution of this Application, Applicant invites the Examining Attorney to telephone the undersigned.

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<sup>6</sup> *Institut National Des Appellations D'Origine v. Vintners International Co.*, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); see also *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) (“Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry.”); TMEP §§ 1213 and 1213.03(a) (disclaimers are required of unregistrable components, e.g., a merely descriptive term).

<sup>7</sup> *In re Rodale Inc.*, 80 USPQ2d 1696 (TTAB 2006).

<sup>8</sup> See *In re Am. Standard Inc.*, 223 USPQ 353, 355 (TTAB 1984); *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984); *In re The Officers' Organization*, 221 USPQ 184, 186 (TTAB 1983).