

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: GTFlix TV, S.R.O.  
Mark: LEGALPORNO.COM  
Serial Number: 87086743  
Examining Attorney: William H. Dawe III  
Law office: USPTO – TMO Law Office  
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**1.0 RESPONSE TO OFFICE ACTION**

This Response to Office Action is offered in reply to the Office Action taken on October 6, 2016 regarding Serial Number 87086743.

In the Office Action, the PTO noted a refusal to register under 15 U.S.C. § 1052(e)(1). Applicant disagrees with the finding of “mere descriptiveness,” and offers argument and evidence in support of that position.

The Examining Attorney refused registration on the Principal Register on the grounds that the Proposed Mark “LEGALPORNO.COM” “merely describes a feature of applicant's feature of services . . . .” Applicant disputes this finding of “mere descriptiveness.”

## 2.0 ARGUMENT

### 2.1 The Legal Standard for a Finding of Descriptiveness

Pursuant to 15 U.S.C. § 1052(e)(1), the Examiner may refuse registration if the mark, “when used on or in connection with the goods of the applicant,” is “merely descriptive” of the applicant's goods.

A mark is merely descriptive under Section 2(e)(1) “if it **immediately** describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a significant function, purpose or use of the goods or services.” *In re Abcor Development Corp.*, 200 USPQ 215, 217 (CCPA 1978) (emphasis added). If any other services even momentarily came to the Examiner's mind, then the proposed mark is not merely descriptive.

A mark is not descriptive, but **suggestive** if a reasonable person must engage in a multistage reasoning process, or use some part of their imagination, thought, or perception, in order to determine what attributes of the goods or services the mark indicates. See *Abcor*, 200 USPQ at 218. Moreover, “any doubt with respect to the issue of descriptiveness should be resolved in applicant's favor.” *In re Grand Metropolitan Food Services, Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994). If the mental leap between the mark and the product's characteristics is not instantaneous, this strongly indicates suggestiveness. See *Investcorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519 (11th Cir. 1991). If one must exercise “mature thought or follow a multi-stage reasoning process” to determine the real and unequivocal attributes of the nature of the goods associated with the Mark, then the mark is suggestive and not descriptive. See *Rodeo Collection Ltd. v. West Seventh*, 812 F.2d 1215 (9th Cir. 1987).

An examiner might have justification to consider a mark to be merely descriptive if it “provides information directly about or is necessary to describe goods or services.” *Eldon Indus., Inc. v. Rubbermaid, Inc.*, 735 F. Supp. 786, 833 (N.D. Ill. 1990). There are two ways in which a mark can be descriptive: “[i]t can literally describe the product, or it can describe the purpose or utility of the product.” *20th Century Wear, Inc. v. Sanmark-Stardust, Inc.*, 747 F.2d 81, 87 (2d Cir. 1984). Terms adjudicated to be descriptive include “Apple Raisin Crisp” for breakfast cereal (see *Gen. Mill, Inc. v. Kellogg Co.*, 824 F.2d 622, 625 (8th Cir. 1987)), “The Sports Authority” for a sporting goods store (see *Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955 (2d Cir. 1996)), and “Tasty” for salad dressing (see *Henri’s Food Prods Co. v. Tasty Snacks, Inc.*, 817 F.2d 1303 (7th Cir. 1987)).

### **2.1.1 The proposed mark does not describe Applicant’s services**

The proposed mark does not describe the goods and services. The Mark “LEGALPORNO.COM” consists primarily of two constituent parts: “Legal” and “Porno.” Applicant freely admits that the term “Porno” is descriptive of the described services. “Legal,” however, is not in any way descriptive. The Examiner’s argument is essentially that, because some pornography is legal and some is not legal, the only possible meaning of “legal” is that it refers to pornography that is permitted by law. This is an overly simplistic view of the Mark and its multiple potential meanings.

The term “Legal Porno” can evoke a number of different images and impressions in the mind. It can indeed mean pornography permitted by law. It can also mean pornography regarding legal matters, e.g., pornographic films using law offices or courtrooms as themes or backdrops. The “Porno” portion of

the term can be thought of colloquially to indicate something particularly interesting to the legal community, just as the term “food porn” can refer to images of especially appetizing dishes rather than adult content featuring food. A composite of the general public would also likely view the mark as a refutation of the sometimes-unsettling genre of “barely legal” pornography, which is filmed to convey the impression that adult actors in a given scene have just recently reached the age of legal consent. The ambiguity was clearly intended, and more certainly serves to show that the Mark itself is not merely descriptive.

In fact, the descriptive meaning that the Examiner imputes has no inherent value to anyone. Whether products or services associated with a given trademark are legally permitted is automatically assumed by any potential consumer, particularly in the context of federal trademark registration; the PTO does not give its imprimatur on marks used in connection with illegal activity. For this reason, there is little to no trademark value in telling customers that something is legally permitted. Making such an explicit notice could in fact have a deleterious effect on business, as customers would wonder why a business would go out of its way to confirm something they already assumed. One would not think of the mark “legal chicken,” as referring solely to the legality of the poultry sold, to be a particularly valuable trademark. This may not necessarily be the case in heavily regulated areas, such as medical marijuana, but that is not Applicant’s business. Generally, pornography is only illegal when it is legally obscene, which is a very difficult standard to meet these days, given the American public’s extremely liberal standards of decency. See *Miller v. California*, 413 U.S. 15 (1973).

If the mental leap between the mark and the product's characteristics is not instantaneous, this strongly indicates suggestiveness. See *Investcorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519 (11th Cir. 1991). If one must exercise "mature thought or follow a multi-stage reasoning process" to determine the real and unequivocal attributes of the nature of the goods associated with the Mark, then the mark is suggestive and not descriptive. See *Rodeo Collection Ltd. v. West Seventh*, 812 F.2d 1215 (9th Cir. 1987). The Office Action ignores all of these alternative meanings and assumes, incorrectly, that all consumers will interpret the mark in exactly the same manner. The Examiner thus ignores that a mark with multiple potential meanings is more likely to be suggestive than descriptive. See *West & Co. v. Arica Institute, Inc.*, 557 F.2d 338, 342 (2d Cir. 1977) (finding that "psycho-calisthenics" was suggestive because it had multiple potential meanings).

It is apparent that the use of the term "legal" in conjunction with a descriptive term is meant to modify it in a manner that is not merely descriptive, or at least not in the manner that the Examiner ascribes. Applicant has provided multiple other meanings of the term "Legal" in the Mark. The PTO has evidently determined that use of the term "legal" is not necessarily descriptive, either, as it has granted registration of several other marks including this term without requiring a disclaimer or a showing of acquired distinctiveness. (See, e.g., Registration Certificate for "NEVER LEGAL," Reg. No. 5,171,830, attached as **Exhibit 1**, in connection with clothing products; see also Registration Certificate for "Legal Eagles," Reg. No. 4,862,107, attached as **Exhibit 2**, in conjunction with

various types of software programs; Registration Certificate for "LEGAL LIMIT,"<sup>1</sup> Reg. No. 5,058,675, attached as **Exhibit 3**, in connection with cigars; Registration Certificate for "BlinkLegal," Reg. No. 5,138,905, attached as **Exhibit 4**, in connection with litigation-related software; Registration Certificate for "1<sup>ST</sup> LEGAL,"<sup>2</sup> Reg. No. 5,075,193, attached as **Exhibit 5**, in connection with alcoholic drinking glasses; Registration Certificate for "LEGAL VISION," Reg. No. 5,063,825, attached as **Exhibit 6**, in connection with vehicle camera equipment<sup>3</sup>; Registration Certificate for "LEGALNATURE," Reg. No. 5,016,934, attached as **Exhibit 7**, in connection with retail stores for customizable legal forms and legal document preparation; Registration Certificate for "Street Legal,"<sup>4</sup> Reg. No. 5,003,347, attached as **Exhibit 8**, in connection with automobile cleaning products; Registration Certificate for "LEGAL SEA FOODS," Reg. No. 2,713,727, attached as **Exhibit 10**, in connection with seafood and related dipping sauces; Registration Certificate for "LEGAL PIERCINGS," Reg. No. 3,948,927, attached as **Exhibit 11**, in connection with multiple types of jewelry<sup>5</sup>; Registration Certificate for "LEGAL DIESEL," Reg. No. 4,494,087, attached as **Exhibit 12**, in connection with "chemical additives for diesel fuel"; Registration Certificate for "LEGAL ARTS," Reg. No. 3,630,381, attached as **Exhibit 13** in connection with graphic design, visual art, animation, and related technology services.) In light of this pattern, the PTO should grant registration of Applicant's Mark for the sake of

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<sup>1</sup> The term "legal limit" in connection with a heavily regulated good such as cigars is very clearly referring to legal regulations on the permissible amount of tobacco or other substances in these products. This is analogous to a "barely legal" mark in the context of pornography.

<sup>2</sup> This is an obvious reference to a person having their first legal alcoholic beverage upon reaching the legal drinking age.

<sup>3</sup> The PTO required a disclaimer of the term "VISION" for this mark, but not "LEGAL."

<sup>4</sup> "Street-legal" is a term referring to a vehicle that is legally fit and licensed to operate on public roads. (See Wikipedia page for "Street-Legal Vehicle," attached as **Exhibit 9**.)

<sup>5</sup> The PTO required disclaimer of the term "Piercings," but not "Legal."

consistency, if nothing else. So as not to confuse the issues, however, Applicant is willing to disclaim the term “porno” from the Mark.

The Examiner also misunderstands the alternative potential meanings of “LEGALPORNO,” ignoring the term’s expressive connotations. A consumer may, upon looking at Applicant’s web site, view the Mark as a message meant to slyly express disdain at the genre of “barely legal” pornography.<sup>6</sup> This meaning is not a merely descriptive one indicating that the models in the videos displayed on Applicant’s web site are of legal age, but rather is an expressive one that communicates a message about the wider pornographic industry. The Federal Circuit in *In re Tam* recently affirmed that trademarks may communicate an expressive message that serves a valuable communicative function in the marketplace of ideas. See *In re Tam*, 808 F.3d 1321, 1327-28 (Fed. Cir. 2015) (recognizing that the trademark “The Slants” was expressive speech that communicated a message about redefining and “taking back” a racial epithet). This meaning is one that an average consumer may reasonably reach, and cannot possibly be considered merely descriptive.

### **3.0 PRIOR PENDING APPLICATION**

The Examiner notes that the prior-filed application for the term “LEGALPORNO.COM,” Serial No. 86,426,058 may be confusingly similar to Applicant’s Mark. This prior-filed application has since been abandoned and does not provide any reason to delay registration of Applicant’s Mark.

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<sup>6</sup> The term “barely legal” is suggestive of models who are just over the age of consent. The PTO has found that this term is entitled to trademark protection. (See Registration Certificate for “Barely Legal,” Reg. No. 2,060,025, attached as **Exhibit 14**; see also Registration Certificate for “Barely Legal XXX,” Reg. No. 3,063,002, attached as **Exhibit 15**.) The PTO granted registration for these marks without requiring Section 2(f) evidence or disclaimer of the term “legal.”

#### **4.0 ADDITIONAL INFORMATION**

The Examiner has requested that Applicant provide further "information regarding the services and wording appearing in the mark," such as "pertinent screenshots of applicant's website as it relates to the services." Applicant feels that the specimens of use on file with the PTO sufficiently show how the mark is used. If there remains any doubt of this, however, Applicant provides four additional screenshots.

1. The home page of Applicant's <legalporno.com> web site with search filters displayed, attached as **Exhibit 16**.
2. The "Forums" page of Applicant's web site, attached as **Exhibit 17**.
3. The "Studios" page of Applicant's web site allowing users to search for adult content by studio, attached as **Exhibit 18**.
4. The "Models" page of Applicant's web site allowing users to search for adult content by model, attached as **Exhibit 19**.

#### **5.0 CONCLUSION**

For the reasons set forth above, the Proposed Mark is neither generic nor merely descriptive. Accordingly, Applicant respectfully requests that Applicant's mark proceed to registration on the Principal Register.

Submitted

/s/ Alex J. Shepard

Alex J. Shepard