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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DATE: October 15, 2019

Collier L Johnson II
Trademark Examining Attorney
Law Office 123
United States Patent and Trademark Office

RE: Serial No: 88380822
Mark: Out Here Being Cute
Applicant: Izzy & Liv LLC
Office Action Of: June 24, 2019

APPLICANT'S RESPONSE TO OFFICE ACTION

The following is the response of Applicant, Izzy & Liv LLC, by Counsel, to the Office Action sent via email on June 24, 2019, by Examining Attorney Collier L. Johnson II.

COMMONPLACE MESSAGE REFUSAL

The Examining Attorney has refused registration of Applicant's standard character OUT HERE BEING CUTE mark pursuant to Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051-1053, 1127 on the grounds that the mark does not function as a trademark to indicate the source of the applicant's goods and/ or services and to distinguish them from others. More specifically, the Examining Attorney asserts that the applied-for mark is a commonplace term, message or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment. The Applicant respectfully disagrees with this finding due to the inherent distinctiveness of the mark, as the mark almost automatically points

customers to Izzy & Liv LLC. Furthermore, Applicant requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant's mark.

Requirements of Valid Trademark

As defined in Section 45 of the Lanham Act, a "trademark includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register . . . , to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

The Mark Identifies the Source of Goods

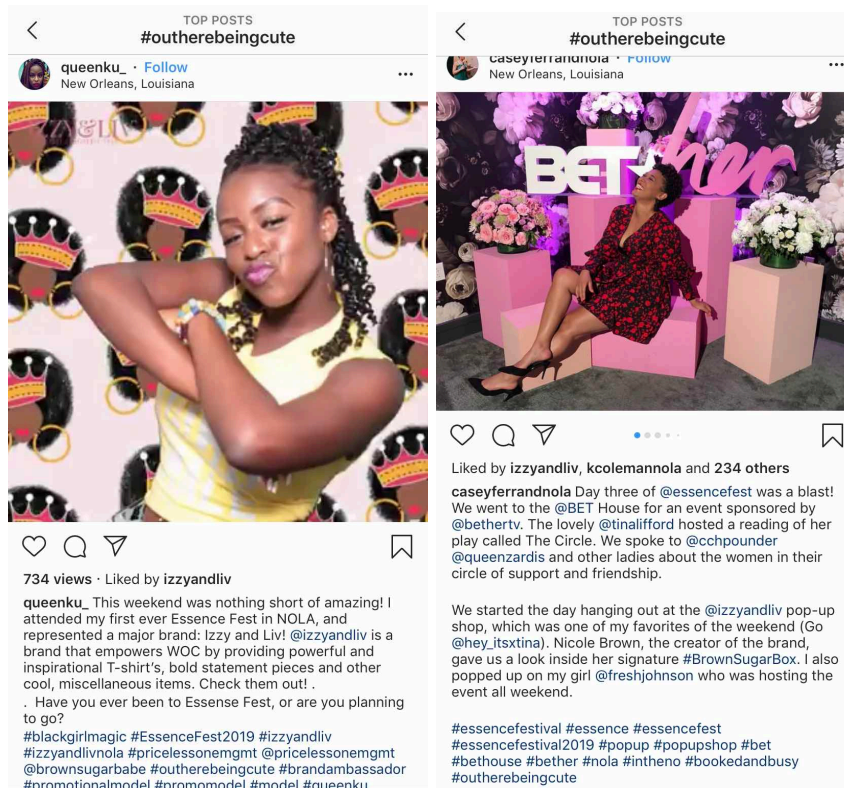
"A mark is protectable if it is either 1) inherently distinctive, or 2) has become distinctive through a secondary meaning." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992). "A product is inherently distinctive if its 'intrinsic nature serves to identify a particular source.'" *Abraham v. Alpha Chi Omega* (citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 120 S.Ct. 1339, 146 L.Ed.2d 182 (2000).) "Inherent distinctiveness is attributable to a mark when the mark 'almost automatically tells a customer that it refers to a brand ... and immediately signal[s] a brand or product source.'" *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 240 (5th Cir.2010).

In *Abraham v. Alpha Chi Omega*, the court held that the individual Greek symbols were not eligible as a trademark; however, the combined use of particular Greek symbols were distinctive enough to indicate Alpha Chi Omega as the source.

Much like the defendant in *Abraham v. Alpha Chi Omega*, in this case, the combined use of the words "OUT HERE BEING CUTE" is used as a source identifier for Izzy & Liv LLC.

The words “being cute” may be a common term alone; however, the combination of the words with “out here” make the term distinctive enough to serve as a source indicating mark.

Another very critical element in determining whether a term or phrase functions as a trademark is the impression the term has on the relevant public. *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455 (TTAB 1998). In this case, the Applicant’s distinctive mark has become popular among the national public. Some consumers can be seen making reference to the Applicant’s mark in association with the Applicant in absence of any branded “OUT HERE BEING CUTE” merchandise. Please see the images below. This is a great example to show that the general public associates the mark with the Applicant.



Widely Used Commonplace Message

The examiner further asserts that the mark is a widely used term that is merely informational and, therefore, is not eligible for registration. The Examination Guide for Merely Informational Matter, Section 1202.04, states the following:

The critical inquiry in determining whether matter functions as a trademark or service mark is how the proposed mark would be perceived by the relevant public. *See D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1713; *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1827 (TTAB 2012) (noting that the critical inquiry in determining whether a mark functions as a trademark is the "commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the goods or merely as an informational phrase)"); *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229; *In re Remington Prods., Inc.*, 3 USPQ2d at 1715.

Whether a term is widely used or merely informational should be determined on a case-by-case basis, as all situations are not the same. *See* TMEP §1202.04(d).

In this case, it can be argued that at least most of the relevant public will associate the mark with Izzy & Liv LLC. When conducting a search of the mark via Google search engine, the very first and reference is the Applicant's website. All references, thereafter, are either related to Izzy & Liv or are infringers of the Applicant's product. Further towards the bottom of the page, the search query provides a list of related searches. Six out of eight listings are references to the Applicant's Website, as displayed in the image below.

Searches related to out here being cute

| | |
|---|---|
| out here being cute svg | shero shirt |
| brown sugar tees | brown skin beauty t shirt |
| brown sugar t shirt | izzy and liv macys |
| izzy and liv | izzy & liv matawan nj |



The fact that the mark is not a widely used term can be demonstrated by the results of Google Trends. Google Trends is an analytical site that tracks the popularity of top search queries. When searching the phrase through Google Trends, there is no activity for over a year.

This is a great example to show that the mark is not widely used aside from its association with the Applicant.

The examiner presented three weblinks as evidence of the mark being widely used. The first link displays a forum post from April 2, 2019 located at <https://www.lipstickalley.com/threads/royal-tea-party-part-11.1611370/page-288>. Here, the phrase “out here being cute” is being used to show how “cute” it is that Princess Eugenie posted a picture of Prince Harry and Megan Markel. Underneath the photo, Princess Eugenie captions, “Welcome cousins.” The TMEP states that “Matter is merely informational and does not function as a mark when, based on its nature and the context of its use by the applicant and/or others in the marketplace, consumers would perceive it as merely conveying general information about the goods or services or an informational message, and not as a means to identify and distinguish the applicant’s goods/services from those of others.” The “out here being cute” in the link was clearly being used to simply provide “general information” and an opinion about the individuals in the picture. Additionally, because the phrase “out here being cute” was used as mere 4 words in a 17-word sentence, thereby drastically distinguishing the context of use from the Applicant’s, the overall impression of this use on a reader is very different than that of the Applicant.

Another link, located at <https://www.imgrumweb.com/hashtag/swimsuitbabe>, displays a social media post from June 19, 2019, stating that the woman is “out here being cute” in her sunglasses. Much like the reference above, here the phrase is used only in an informational context. The Applicant uses the phrase as a brand with the connotation of celebrating one’s culture in a fashionable way.

It can be argued that the individuals used this term after recognizing the term on a t-shirt marketed by the Applicant, seeing as though these references come approximately three years after the mass marketing efforts of the Applicant’s merchandise displaying the mark, “Out Here Being Cute.”

The third link attached, <https://people.com/shop/curvy-girl-by-ashley-stewart-plus-size-the-cute-graphic-tee-black-1x-ashley-stewart-pc2338c7b2aca2310dde250ab19b80bc8.html>, displays the Ashley Stewart, a women's clothing store, as a blatant infringer of the Applicant's common law rights and copyright rights to the mark. Ashley Stewart's official website shows that the estimated date of publication was October 24, 2018, while the Applicant's first use in commerce was July 1, 2016. Additionally, Ashley Stewart's version of the t-shirt is almost an exact depiction of Applicant's t-shirt. The font, spacing and positioning of the mark are all the same. We assert that the above-mentioned links are poor examples of the mark being a commonplace term, and we do not believe that a display of infringement functions as proper evidence for a widely used message.

Conclusion

The Applicant has satisfied the requirements of a valid trademark with the use of the mark "OUT HERE BEING CUTE," and has been using the mark in commerce since July 1, 2016. Over the past few years, the Applicant has used the mark to brand a line of products and to distinguish those products from others, while indicating Izzy & Liv LLC as the source. The Applicant has responded to all issues raised in the Office Action, and hereby submits that its application is in condition for allowance, and requests that it be promptly passed to publication. If any further information or response is required, please contact the Applicant's attorney. The attorney may be reached via telephone at (571) 214-9734.

Respectfully submitted,



Raven Willis, Esq.
Attorney of Record