

Examining officer:

Thank you for your time reviewing our filing. Below is the response to the Office Action regarding U. S. Application NO. 88319207 - MARK: FOO. We hope it alleviates your concerns.

### **Purpose for Registering**

The applicant Andrew William Conner has been using his nickname and mark FOO since the 1990s. During the early 2000's it became synonymous as his brand which distinguishes and identifies his journalistic work on multiple mediums. This response aims to show that nationally consumers have come to identify the applicant with the mark, that goods and services under the mark are identified with the applicant, and confusion is unlikely with other marks.

### **About the Industry**

The industry in which the applied-for mark predominantly functions is journalistic news services. This industry gathers facts and publishes them across media including print, radio, broadcast television, and other services. The variety of services included in news can be commentary, fact-checking, photography, original reporting, videography, and other services. This can be performed by a company or individual across several outlets. These services and the mark in which they are under serve to differentiate the news outlet or reporter in several ways.

In journalism, consumers can immediately ascertain features of a brand's reporting by its mark. These traits that a mark carry are the reliability of the information, the editorial process used to gather and display facts, a correction and redaction process if needed, and political leanings of the presenting journalist or organization to name a few qualities. Trustworthiness of the marks in the field are a leading concern among consumers. The University of Missouri's Reynolds Journalism Institute conducted research which focused on consumer recognition of the trustworthiness of sources by brand. (See evidence)

In recent history, the industry has had to contend with 'fake news'. Fake news consists of deliberate disinformation or hoaxes spread via traditional news media (print and broadcast) or online social media. According to one survey consumers believed that fake news was disseminated by mainstream media outlets some, if not most, of the time. (See Evidence) In 2016 64% of Americans reported a confusion on facts, and 23% reported they shared a made up news story. (See evidence) Fake news can take the shape of wrongful facts, photoshopped images, or deepfake video which superimposes faces in video.

A strong journalistic mark informs consumers the source and trustworthiness of their goods and services in this industry called news.

### **The FOO Mark**

The applicant uses FOO to inform consumers as the quality, source, and trustworthiness of the goods and services provided.

FOO has been used by the applicant as an identification of himself and his journalistic work in news services for over five years. These services include but are not limited to interviews, news gathering of current events, original photography of current events, written and video reporting and commentary on current events, editorial reviews, televised appearances by the applicant across news platforms, and commentary and analysis of eSports in a journalistic capacity.

Consumers have come to characterize the would be mark to signify who, the new media slant of the reporting, the way the facts are gathered through immersion journalism, original reporting, the ethics and editorial process, the visual style and editing of the photos and videos gathered, and ultimately a seal of approval by FOO of the final product.

The applicant has used FOO on social media service Twitter since July 2008. The brand is associated with original first hand accounts of news. News reports in the means of 'Tweets' from FOO assured consumers the reporting was live, accurate, and was accompanied by a reliable visual style. The applicant clocked over 9,000 Tweets before moving the FOO content to other platforms. Despite having left the platform the account still has over 50,000 followers which indicates a strong and healthy brand consumers identify with.

On social media video site YouTube he co-hosts a channel created September 2010 which has grown to 615,000 subscribers and has earned over 57,000,000 views. On the channel the applicant editorially tests gear and reports to the audience their feasibility and effectiveness. Consumers can identify the style of video and immersion journalism associated with the brand's use of the applied-for mark.

Offline, the applicant attended and covered of events a year under the applied-for mark. This is mentioned in the Post-Gazette feature. (See evidence). The applicant received press badges and lanyards with this mark showing use since 2013 and his founding of the news outlet Jekko, Inc. where his content primarily lives. The applicant continuously uses the applied-for mark in a series of news reporting that signifies where the goods and services come from and quality, as the applicant uses it as a seal of approval.

Since the applicant's industry is news, it is common for him or his work to appear on other platforms and news networks. Consumers can identify the applicant with the applied-for mark regardless of the news network FOO products appear on - whether it be CNN, FOX, NBC, etc. Other journalists such as Anthony Bourdain (Reg. No. 4509637 & 4504461) have similar trademarks to identify and protect their brands. The networks have promoted the applied-for mark and it is recognized by others. One example is the applicant making an appearance on WQED commercials. (See evidence)

The case for the applicant to be granted the applied-for mark is clear.

### **RESPONSE: SECTION 2(d) REFUSAL: LIKELIHOOD OF CONFUSION**

Thank you for asking for clarification. We believe consumers will not experience confusion between FOO (Serial No. 88319207) and that of Registrations ED FOO (Reg. No. 5480114), SCI FOO (Reg. No. 4861970), and FOO CAMP (Reg. No. 3273775).

The application for FOO outlines, "News reporter services in the nature of news gathering and news commentary". Dictionary.com defines a reporter as an individual. "*a person* who reports, especially one employed to report news or conduct interviews for newspapers or broadcasts."

FOO CAMP, ED FOO, and SCI FOO, on the other hand outline, "conducting conferences and summits" as their primary services. Each mark defines the topic of the convention and reason for the gathering. Consumers have a low likelihood of confusion with the applied-for mark as conferences are location dependent, typically held on an annual basis, and are organized by multiple individuals. Whereas a reporter is location independent, produces on a continuous basis, and is an individual that can make personal live appearances across media.

Much like the surnames simple additions to "FOO" such as "ED FOO", "SCI FOO", and "FOO CAMP" are enough to help consumers distinguish the providers of goods and services. Building on that premise, FU 30 (Serial No. 87560036) is significantly different using the Chinese characters with a numeric signifier. It is not likely to cause confusion. Additionally, a Google web search for "FU 30" provides no results for that trademark in question. The applicant is more concerned about using "FOO" singularly for providing professional goods and services in the journalism industry.

To address the examiner's concerns about trademarks providing news. Any trademark or brand can be the subject of news. Brands publish press releases or hold conferences, about their projects all the time. This is substantially different than a third party reporter that gathers facts and provides expert commentary. For example professional eSports player and commentator

NINJA (Serial No. 88481530) can attend E3 conference and comment on it without confusion. Or when new media journalist Philip Defranco (Reg. No. 5615881) doing the same. Should in the future the applied-for FOO mark have to cover a topic or person with a similar name, the applicant will go above and beyond to label all trademarks and their respective owners in coverage to prevent any confusion.

We hope this and alleviates the examiner's concerns over potential likelihood of confusion.

**RESPONSE:**

**SECTION 2(e)(4) REFUSAL: PRIMARILY MERELY A SURNAME**

The applicant uses the applied-for mark as an arbitrary forename without surname to identify the goods and services they produce. The applied-for mark in commerce is used singularly when possible. The mark is recognized by others in the industry. Though some news outlets go on to call reference the applicant as 'Conner' this is an editorial decision is similar to how trademarks such as Madonna Louise Ciccone's MADONNA (Reg. No. 1473554) are addressed and functions.

The applicant has no intentions of patrolling those who use their forename in conjunction with the surname "Foo". Furthermore, let us address some additional concerns;

The term FOO is not merely a surname.

Dictionary.com describes Foo as, "Foo is an intentionally meaningless placeholder word often used in computer programming." The first published instance of this was a 1965 edition of MIT's Tech Engineering News. Prior to this Foo has military history of being mentioned in Australian graffiti "Foo was here" in World War I and was the name for unidentified aircraft in World War II.

While phonetically similar, FOO has significantly different connotations from the Chinese characters "FU". FU is a literary combination of poetry and prose developed during the Han Dynasty in the years 50 BC to 100 AD. The secondary definition of FU as a Chinese character '福' is "Good Luck". (See examples) Lastly, in English slang FU as an acronym is pronounced differently as "F U" and is an offensive term asking the recipient to go away.

FOO as a surname is extremely rare.

The evidence from LEXISNEXUS attached to the office action should be re-considered. Developers and programmers of digital communication providers such as cell phones, voice over

IP, and other digital services often use FOO as a temporary placeholder for accounts. The result of which is several false positives within the mentions 6,576 instances as a surname.

Additionally, duplicates in the LEXISNEXUS database exist between cell, home, and office numbers. Even if all the results were valid, FOO as a surname would be 0.00002% of the US population. Common surnames would include Smith, Johnson, Williams, and Brown in descending order - each of which has over 1,000,000 United States citizens with the surname. (See chart)

Upon the last numbers released, Twitter claim 312 Million users a month. A user search for individuals with the surname "FOO" show only seven users. Only three, including the applicant, are located in the United States of America. Facebook produces unreliable results with FOO being used as a programming placeholder and "Foo Foo" being a common fake name. This is similar false positive issue described with using LEXISNEXUS.

The applicant distinguishes his brand using only the applied-for mark of FOO. Though each outlet has their own established way of dealing with names, other journalists are instructed to report it as such in press releases. As such, the applicant is the only one using "Foo" singularly across social media. His stylized signature, seen in the original samples of use, is simple FOO as well. The use of FOO as a surname by others is not a concern as long as they do not drop their forename to reference themselves.

## **RESPONSE: PARTIAL SECTIONS 1, 2, AND 45 REFUSAL: FAILURE TO FUNCTION**

Additional evidence has been provided. The evidence includes two photo book packaging produced, edited, and approved by the applicant branding the applied-for mark in question. Additional articles and samples of writing have also been added showing The applicant publishes the goods and controls their quality.

## **RESPONSE: IDENTIFICATION OF GOODS AND SERVICES**

The applicant approves the suggested substitution of the wording for better accuracy.

Class 016: Printed materials, namely, written articles in the field of news gathering and news commentary; Series of non-fiction books in the fields of journalism and travel; Photographic prints and **printed art** reproductions; Printed material, namely, art prints, books, booklets, calendars, posters, in the field of photography

Class 041: News reporter services in the nature of news gathering and news commentary; Entertainment services, namely, live, televised, and movie appearances by a professional entertainer; Entertainment services, namely, arranging and conducting live performances of news analysis and commentary on the internet; Entertainment services, namely, **presentation of live** performances featuring video game playing and eSports with commentary and narration

## **CONCLUSION**

The applicant hopes to have illustrated to the examining attorney

### **Additional evidence provided:**

Dictionary.com definition of Foo.

Lanyards showing the applicant being recognized as FOO and press at events.

Still image of the applicant using the applied-for mark on two media outlets.

Sample packaging of a Randyland photo book taken and produced by FOO

Sample packaging of a Pittsburgh photo book taken and produced by FOO.

Internet evidence for citation of number of Twitter users.

Internet evidence of “FU 30” not being found on Google.

Internet evidence of eSport players and commentators at E3 conference.

Internet evidence that the applicant’s YouTube hosting reached over 50M views.

Additional statements:

The mark has become distinctive of the goods and services through the applicant’s substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least five years immediately before the date of this statement.

