

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In re the Application of:

Applicant:	RealHouse Productions, LLC	Trademark Law Office: 109
Mark:	FLORIDA MAN	Examiner: Frank Lattuca
Serial No.:	88344223	
Filed:	March 18, 2019	
Mailing Date:	May 31, 2019	

RESPONSE TO OFFICE ACTION

Applicant RealHouse Productions, LLC (“Applicant”) respectfully submits this response to the Office Action mailed on May 31, 2019. The Examining Attorney has preliminarily refused registration on the Principal Register of Application Serial No. 88/344,223 (the “Application”) for the word mark FLORIDA MAN (the “Mark”) in (i) Class 41 for entertainment services, namely, an ongoing television series featuring real life crime investigation stories exclusive to the state of Florida on the grounds that the Mark is merely descriptive, and (ii) Class 25 for T-shirts, hats, and sweatshirts, on the grounds that the Mark does not function as a trademark, but merely conveys an informational message. For the reasons set forth below and upon the evidence attached hereto, Applicant respectfully submits that the Examining Attorney’s refusal should be withdrawn because (i) the Mark is at least suggestive, rather than descriptive, and is therefore entitled to registration on the Principal Register, and (ii) the Mark functions as a trademark and does not constitute informational matter.

Additionally, the Examining Attorney cited “prior pending” Application Serial No. 88/420,781 on the grounds that it may later prevent registration of the Mark due to a likelihood of confusion. Respectfully, the filing date of the cited application does not precede Applicant’s filing date; in fact, it was filed on May 8, 2019, two months after the filing of Applicant’s Application on March 18, 2019. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the potential refusal on this basis.

I. THE MARK IS AT LEAST SUGGESTIVE, RATHER THAN DESCRIPTIVE, AND THEREFORE ENTITLED TO REGISTRATION

A. “FLORIDA MAN” Does Not Immediately Describe a True-Crime Television Series

As a threshold matter, it appears that the Examining Attorney analyzed the Mark in a disjointed fashion, as two separate words, rather than one combined mark. Applicant respectfully points out that this is improper.¹ See TMEP § 1209.03(d). The analysis should not be whether “FLORIDA” is descriptive, and whether “MAN” is descriptive, but whether the Mark “FLORIDA MAN,” as a whole, has a descriptive significance in relation to the services, *i.e.*, a television series about real life crime investigation stories.

To be characterized as merely descriptive, a mark must *immediately* and *directly* convey information about a significant quality, characteristic, function, feature or purpose of the goods. See *In Re Jose Remacle*, 66 U.S.P.Q.2d 1222, 2002 WL 31563187, at *2 (T.T.A.B. Nov. 18, 2002) (“The test for determining whether a mark is merely descriptive is whether it *immediately* conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product [] in connection with which it is used.” (emphasis added)); *In Re Styleclick.com Inc.*, 57 U.S.P.Q.2d 1445, 2001 WL 15915, at *2 (T.T.A.B. Nov. 29, 2000) (“It is well settled that a term is considered to be merely descriptive of goods . . . if it *immediately* describes an ingredient, quality, characteristic or feature thereof or if it *directly* conveys information regarding the nature, function, purpose or use of the goods.”); accord *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 189 U.S.P.Q. 759, 765 (2d Cir. 1976) (finding that a descriptive mark “conveys an *immediate* idea of the ingredients, qualities or characteristics of the goods.” (emphasis added)); *Towers v. Advent Software, Inc.*, 913 F. 2d 942, 944 (Fed. Cir. 1990) (stating that a descriptive mark “*directly* conveys information concerning the function, characteristics, purpose or use of the product” (emphasis added)). Further, the immediate idea must be conveyed with a “degree of particularity.” *Plus Prods. v. Med. Modalities Assocs., Inc.*, 211 U.S.P.Q. 1199, 1981 WL 40505, at *7 (T.T.A.B. Sept. 4, 1981); see, e.g., *In re The House Store, Ltd.*, 221 U.S.P.Q. 92, 1983 WL 51837, at *2 (T.T.A.B. Nov. 22, 1983) (holding that THE HOUSE STORE is not merely descriptive of retail store services in the field of furniture and housewares); *In re TMS*

¹ The only instances where a mark should be analyzed as separate words is where there is such “a significant physical separation” between the words of the mark on a specimen “that they cannot be viewed as a single mark.” *In Re Midwestern Pet Foods, Inc.*, No. 86702878, 2018 WL 3807783, at *4 (T.T.A.B. July 18, 2018); see also *In Re Rugged Footwear Co.*, No. SERIAL 78008156, 2004 WL 442303, at *2 (T.T.A.B. Mar. 3, 2004) (finding that “the vast physical separation of the two parts to applicant's mark . . . in the specimen is such that consumers would simply not view these two vastly separated phrases as a single mark”). As the Applicant has not yet submitted a specimen, the Examining Attorney cannot assume that the words within the Mark will be “vastly separated” to the point where it would warrant analysis of the individual words.

Corp. of the Americas, 200 U.S.P.Q. 57, 1978 WL 21540, at *2 (T.T.A.B. Aug. 15, 1978) (finding that THE MONEY SERVICE is not merely descriptive of a financial fund transfer services).

If a mark does not immediately and directly convey descriptive information about the product in connection with which it is used, but instead, some sort of reasoning, imagination, or further thought is required in order to understand the relationship between the mark and the service in question, then the mark is said to be suggestive, rather than merely descriptive, of the service. See *Stix Prods., Inc. v. United Merchants and Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968) (“A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.”); *In re Nett Designs*, 236 F.3d 1339, 1341 (Fed. Cir. 2001) (“[I]f a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods, then the mark is suggestive.”); see also, e.g., *In re Shutts*, 217 U.S.P.Q. 363, 1983 WL 51780, at *2 (T.T.A.B. Feb. 25, 1983) (reversing refusal to register, holding SNO-RAKE is suggestive, not merely descriptive, of a product used for raking snow because the “import [of the mark] would not be grasped without some measure of imagination and ‘mental pause’”).

In this case, “FLORIDA MAN” does not immediately convey information about Applicant’s goods and services to potential consumers. Instead, consumers encountering the Mark would have to undergo a multi-stage reasoning process to understand the association between the term “FLORIDA MAN” and Applicant’s true-crime television show. First, consumers must realize that the term has a special significance on the Internet as a “key word” used to “describe all the weird news stories about random Floridians committing weird and dumb crimes.” See Exhibit A (Urban Dictionary definition of “Florida Man”). Second, consumers must realize that Applicant is not selling this key word or the weird news stories, but rather its television show will undertake in-depth investigations into serious crimes in Florida. There is nothing to indicate that the television show will only feature men in Florida, as the Examining Attorney suggests, nor is there anything to indicate that the show will feature men in Florida engaging in the types of “weird and dumb” acts identified in the news stories. Indeed, a summary of the television series indicates that the show will focus on more severe crimes and murders. See Exhibit B (a news story from The Hollywood Reporter reporting on the television series). Even if consumers understand there is a connection between the term “FLORIDA MAN” and Applicant’s services, it would not be with any degree of particularity, and more information would be required for consumers to arrive at the conclusion that the mark is for a television show devoted to murder investigations based in Florida. This multi-stage reasoning process indicates that “FLORIDA MAN” is suggestive, rather than merely descriptive, of Applicant’s television series.

B. The Term “FLORIDA MAN” Is Susceptible to Multiple Meanings

Furthermore, to be characterized as merely descriptive, the mark, when considered in conjunction with the particular goods and services, must do nothing but describe those goods and services. See *In re Quick-Print Copy Shop, Inc.*, 205 U.S.P.Q. 505, 525 n. 7 (C.C.P.A. 1980) (finding that, in the context of “merely descriptive” marks, the word “‘merely’ is considered to mean ‘only’” (emphasis added)); *In re Colonial Stores, Inc.*, 157 U.S.P.Q. 382, 385 (C.C.P.A. 1968) (reversing refusal to register, holding SUGAR & SPICE is not merely descriptive of bakery products because “the mark clearly does not tell the potential purchaser *only* what the goods are, . . . or, of prime concern here, their ingredients” (emphasis added)). Accordingly, a mark that is susceptible to multiple meanings, only one of which may be descriptive of the goods and services, is not merely descriptive within the contemplation of Section 2(e)(1) of the Lanham Act. See *Henry Siegel Co. v. M & R Int’l Mfg. Co.*, 4 U.S.P.Q.2d 1154, 1987 WL 123838, at *5 (T.T.A.B. July 28, 1987) (if a mark “projects a double meaning,” it is not “merely descriptive”). Indeed, such multi-meaning marks are routinely characterized as suggestive and therefore registrable. See, e.g., *Security Center Ltd. v. First Nat’l Security Ctrs.*, 592 F. Supp. 723 (E.D. La. 1984), *rev’d on other grounds*, 750 F.2d 1295 (5th Cir. 1985) (finding SECURITY CENTER is not merely descriptive, but rather suggestive, of high-security storage services because it has multiple meanings only one of which is descriptive); *In re Nat’l Tea Co.*, 144 U.S.P.Q. 286, 1965 WL 7345, at *2 (T.T.A.B. Jan. 22, 1965) (reversing refusal to register, finding NO BONES ABOUT IT is not merely descriptive of hams because it “has a double connotation or significance as applied to hams”); *In Re Compassion in World Farming*, U.S. Ser. No. 86/039,608, 2017 WL 914070, at *4 (T.T.A.B. Feb. 14, 2017) (non-precedential) (holding that GOOD EGG is not merely descriptive of egg products because it “has multiple meanings (*i.e.*, a high quality egg or a good fellow), one of which is not merely descriptive”).

Here, “FLORIDA MAN,” when considered in conjunction with Applicant’s services, is susceptible to multiple meanings. FLORIDA MAN could mean several different things, including the literal interpretation—a man from Florida—urged by the Examining Attorney, the “Florida Man” key word (referenced above), or, in this case, a television series about murder investigations. For example, a Google search for “Florida Man” shows various daily news stories about men in Florida, posts about a “Florida Man” meme, and posts about a Florida Man superhero—none of which relate to the intended services for the Mark in its applied-for capacity. See Exhibit C (screenshots of “Florida Man” Google search results). Accordingly, Applicant’s Mark is not *merely* or *only* descriptive of Applicant’s goods and services and is properly characterized as suggestive.

C. Classification of “FLORIDA MAN” as Descriptive Is Inconsistent with Prior Registrations of Similar Marks on the Principal Register

Applicant respectfully submits that the Examining Attorney’s refusal to register “FLORIDA MAN” due to descriptiveness would lead to inconsistent and contradictory results. While Applicant is mindful that prior determinations are not binding on the USPTO, given the strong policy in favor of consistency of decisions (*see In re Nett Designs*, 236 F.3d at 1342 (“encourag[ing] the PTO to achieve a uniform standard for assessing registrability of marks”)), Applicant respectfully draws attention to a number of similar marks that have been successfully registered on the Principal Register, including CALIFORNIA GIRLS in Class 41 for “entertainment services, services, namely, adult cabarets [and] nightclubs” (U.S. Reg. No. 4,917,094); FLORIDA BOYS in Class 25 for “hats, t-shirts, and wristbands” (U.S. Reg. No. 4,737,439); TEXAS GIRL in Class 25 for clothing (U.S. Reg. No. 3,452,361); TEXAS GIRL in Class 3 for “hair shampoo and conditioner” (U.S. Reg. No. 4,580,942); TEXAS GIRL in Class 28 for dolls (U.S. Reg. No. 4,091,367); CALIFORNIA GIRL in Classes 6, 12, 14, 16, 18, 21, 24, 26 (U.S. Reg. No. 4,285,020); CALIFORNIA GIRL in Class 3 for “personal care preparations” (U.S. Reg. No. 4,274,346); and CALIFORNIA GIRLS in Class 33 for “white wine” (U.S. Reg. No. 3,845,593). *See* Exhibit D (true and correct copies of the statuses and registration certificates for the foregoing marks).

Applicant also highlights that there are many television shows whose titles have successfully registered, even where the title has something to do with the subject matter of the show; the USPTO often determines that these titles are suggestive, rather than descriptive and, therefore, entitled to registration. Some examples include DREAM HOUSE (U.S. Reg. No. 2,342,086), GOOD EATS (U.S. Reg. No. 3,1859,11), THE BIGGEST LOSER (U.S. Reg. No. 3,074,579), and THE REAL HOUSEWIVES (U.S. Reg. No. 3,744,137). *See* Exhibit E (true and correct copies of the statuses and registration certificates for the foregoing marks).

D. Any Doubt as to Descriptiveness Must Be Resolved in Applicant’s Favor

For the reasons provided above, Applicant respectfully submits that the Examining Attorney has not satisfied the burden of establishing that the Mark is merely descriptive. *See In re Eon Comm’s Corp.*, No. 75/439399, 2001 WL 300515, at *3 (T.T.A.B. Mar. 26, 2001) (the examining attorney has the burden of establishing that a mark sought to be registered is merely descriptive). Notably, however, any doubt as to the “merely descriptive” character of “FLORIDA MAN” must be resolved in Applicant’s favor by characterizing the Mark as suggestive. Given that there is only a “thin line between a suggestive and merely descriptive designation,” where there are any doubts, “it is the Board’s practice to resolve all doubt in the applicant’s favor and publish the mark for opposition.” *In re Morton-Norwich Prod., Inc.*, 209 U.S.P.Q. 791, 1981 WL 48121, at *1 (T.T.A.B. Jan. 23, 1981); *see also Plyboo Am., Inc. v.*

Smith & Fong Co., 51 U.S.P.Q.2d 1633, 1640 (T.T.A.B. 1999) (finding that there is a “thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment”); *In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953, 1955 (T.T.A.B. 2006) (precedential) (“[W]here doubt exists as to whether a term is descriptive, such doubt should be resolved in favor of the applicant.”); *In re The Gracious Lady Service, Inc.*, 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972) (“It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition purposes . . .”).

In accordance with the Board’s practice and precedent, Applicant respectfully submits that the Examining Attorney should resolve any doubt as to the descriptive nature of “FLORIDA MAN” for services involving a television series in Applicant’s favor, and publish the Mark for opposition in Class 41. *See, e.g., Heb Grocery Co., LP*, U.S. Ser. No. 85/027,087, 2012 WL 2930644, at *3 (T.T.A.B. June 29, 2012) (non-precedential) (reversing refusal to register; holding XTREME HEAT for very spicy or extremely hot cheese curl snacks is suggestive, and noting “any doubt [as to this conclusion] has been resolved in applicant’s favor”); *In re Aid Labs*, 221 U.S.P.Q. 1215, 1983 WL 51854, at *2 (T.T.A.B. 1984) (reversing refusal to register; “resolving any doubt in favor of the applicant” and holding that PEST PRUF for animal shampoo with insecticide highly suggestive, and not merely descriptive); *In re Atavio*, 25 U.S.P.Q.2d 1361, 1992 WL 421451, at *3 (T.T.A.B. 1992) (reversing refusal to register; “frankly admit[ting] that doubt exists,” but resolving such doubt in favor of applicant and holding ATAVIO, a Spanish word meaning “ornament,” for fashion jewelry is highly suggestive, not merely descriptive).

II. “FLORIDA MAN” FUNCTIONS AS A TRADEMARK AND IS NOT AN INFORMATIONAL MATTER

A. “FLORIDA MAN” Is Not an Informational Matter

To constitute informational matter, an applied-for mark must be so commonplace that it would not function as a source indicator for the goods and/or services but would instead be perceived by consumers as a slogan or informational message. *See In Re Eagle Crest, Inc.*, 96 U.S.P.Q.2d 1227, 2010 WL 3441109, at *2 (T.T.A.B. Aug. 10, 2010). “The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.” *In Re Hulting*, 107 U.S.P.Q.2d 1175, 2013 WL 5407310, at *2 (T.T.A.B. June 10, 2013) (quoting *In Re Eagle Crest*, 96 U.S.P.Q.2d at 1229); *accord In Re Aerospace Optics, Inc.*, 78 U.S.P.Q.2d 1861, 2006 WL 1087849, at *2 (T.T.A.B. Apr. 12, 2006). So the question is: “would the term be perceived as a source indicator or merely an informational slogan?” *In Re Remington Prod. Inc.*, 3 U.S.P.Q.2d 1714, 1987 WL 124304, at *2 (T.T.A.B. Jan. 29, 1987).

The Examining Attorney claims that Applicant's Mark is not registerable because it is a "commonplace term, message, or expression widely used by a variety of sources." But unlike the cases Examining Attorney cites in support of its assertion (none of which involve clothing or items in Class 25), "FLORIDA MAN" does not involve a slogan or informational message that encourages consumers to act or purchase in a certain way. For example, *In Re Volvo Cars of N. Am. Inc.*, 46 U.S.P.Q.2d 1455, 1998 WL 239298 (T.T.A.B. Apr. 8, 1998), involved the phrase "DRIVE SAFELY," which the TTAB perceived as offering "nothing more than a public service message from an automobile manufacturer who is concerned about safety." *Id.* at *2. Similarly, *In Re Remington Prod. Inc.*, concerned the phrase "PROUDLY MADE IN THE USA," which the TTAB concluded would be perceived merely as a common message to encourage purchasers to give preference to American products. 1987 WL 124304, at *2. Here, "FLORIDA MAN" is not acting or being used in such a capacity to relay a warning message or advise consumers of what to purchase.

Nor is the Mark being used as a slogan. *See* TMEP § 1213.05(b)(i) ("A slogan is a type of phrase and is defined as 'a brief attention-getting phrase used in advertising or promotion' and 'a catch phrase used to advertise a product.'" (citing Merriam-Webster.com)). The Examining Attorney points to the popularity of "Florida Man" as an Internet meme to show that it is widely used, even though the USPTO has registered clothing involving "memes" in the past. *See, e.g.*, U.S. Reg. No. 4,376,980 (NYAN CAT registered in Class 25), attached hereto as Exhibit F. But this conclusion overlooks the fact that the so-called "meme" is really just screenshots of news stories about people in Florida. For example, the Wikipedia page attached by the Examining Attorney describes how the "meme" is based on "multiple unrelated news articles describing various actual people who hail from or live in Florida." As such, the Mark is not being used as a slogan in an advertising or promotional capacity. Thus, the Examining Attorney's finding that the Mark constitutes informational matter is unfounded.

B. Refusal on Informational Material Grounds Is Premature

In any event, the Examining Attorney's refusal of the applied-for mark "FLORIDA MAN" on the basis of it being merely informational matter is premature, as Applicant has yet to submit a specimen. *See, e.g., In Re Home Dynamix, LLC*, No. 87116576, 2017 WL 6939352, at *3 (T.T.A.B. Dec. 21, 2017) (refusing registration on informational matter grounds based on a review of the specimen); *In Re Aerospace Optics.*, 2006 WL 1087849, at *3 (same); *see also* TMEP § 1202.04(b) ("The size, location, dominance, and significance of the wording as it is used in connection with the goods or services should also be considered to determine if any of these elements further support the perception of the wording merely as an informational message rather than as indicating the source of goods or services."). Without a specimen, the Examining Attorney cannot properly consider how the public will perceive the Mark as a source indicator or

an informational slogan. *See In Re Hulting*, 2013 WL 5407310, at *2 (noting that the critical inquiry is how the designation would be perceived by the relevant public); *In Re Remington Prod. Inc.*, 1987 WL 124304, at *2 (same). As such, the Examining Attorney's conclusion is based on mere speculation of how the Mark will featured on the clothing, based on other T-shirts available online. In focusing on these shirts, rather than how Applicant intends to use the Mark, the Examining Attorney erroneously assumes that Applicant's use of the Mark will be exactly the same. But without first reviewing a specimen, it would be impossible for the Examining Attorney to determine how the Mark will be used—whether on the front of the shirt, as depicted in the Examining Attorney's examples, or on a tag. Given that Applicant has not submitted a specimen, the Examining Attorney should reserve judgment on this ground until he can properly evaluate how the Mark will be used on clothing.

Therefore, Applicant respectfully requests that the Examining Attorney allow Applicant's Mark to pass to publication in Classes 41 and 25 in accordance with 37 C.F.R. § 2.80.

Dated: December 2, 2019

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