

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re the Matter of:*

Applicant: The Royalty Family, Inc.

Serial No.: 90/573,144

Filed: 11-March-2021

Mark: THE ROYALTY FAMILY / (Logo)



Date of Office Action: 05-October-2021

Examining Attorney: Tejbir Singh

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**Response to Office Action dated 05-October-2021**

This is in response to the Office Action dated 05-October-2021 received via e-mail at the correspondence e-mail address listed above. Applicant requests that the above-identified trademark be registered in the United States Patent and Trademark Office on the Principal Register established by the Trademark Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended).

**I. No Conflicting Marks Found**

Applicant acknowledges the Examiner's search clause that no similar registered or pending mark would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

## **II. Mark Description**

Further to 37 CFR §2.37, the Examiner is requiring a complete description of the mark. Applicant proposes the following description:

“The Mark consists of the stylized wording “The Royalty Family” with a crown design over the letter “a” in Royalty”.

Applicant would like to thank the Examining attorney for the suggestion.

## **III. Specimen (Specimen Does Not Show Use In Specific Classes)**

The Examiner has rejected the applied-for Mark because the specimen does not show the applied-for mark as actually used in commerce in connection with any of the goods and/or services specified in International Class(es) 035 and 038. Specifically, the Examiner notes,

“[t]he specimen consists of what is described as a screenshot. The specimen is not acceptable because there is no reference to any services anywhere on the specimen.”

Applicant notes, Trademark Class 035 is a service category that includes a range of business and professional services. Most of the included services help with carrying out, managing, or **advertising** a commercial or industrial enterprise. (***Emphasis added***). In this instance, Applicant is using the following, including but not limited to, **advertising, marketing and promotional services**, advertising, advertising agencies, outdoor advertising, layout services for advertising purposes, marketing, modeling for advertising or sales promotion, and **online advertising on a computer network**. (***Emphasis added***). In the particular instance, the applied for Mark is advertising both (i) its own content subscriptions and (ii) **products for third-parties**.

In addition, Class 038, as applied for, relates to the “electronic transmission and streaming of digital media content for others via global and local computer networks”. Briefly, IC 038 mainly includes services **allowing at least one person** to **communicate with another by a**

sensory means. Such services include those which (1) allow one person to talk to another, (2) transmit messages from one person to another, and (3) place a person in oral or visual communication with another (radio and television). (*Emphasis added*). At its primary level, IC 038 includes services, which consist essentially of the diffusion of radio or television programs.

In this instance, the specimen currently on record clearly shows “a person in oral or visual communication with another (radio and television (in this case visual means on the Internet)).

#### **IV. Adding IC 041**

In an effort to further clarify the Services associates with the Mark, Applicant hereby adds IC 041 to the application:

IC041 – “*Entertainment services in the nature of production of multimedia entertainment content*”


It should be noted that “Content-provider services involving the provision of online, non-downloadable videos are classified in Class 41 regardless of the subject matter of the videos. See, TMEP §1402.11(a)(ii). Furthermore, businesses and individuals commonly provide content services in addition to other types of services. For example, online audiovisual content providers may similarly offer both video-streaming services in Class 38 and online non-downloadable videos in Class 41. For example, “if the services involve *providing a website from which a user can receive “webcasted” transmissions* over the Internet: “Broadcasting (radio programs, television programs, multimedia programming, etc.) via the Internet, in Class 38” is an appropriate class of services.

In this instance, the Applicant is a “content provider” and assert that the services are more properly classified in IC 035, IC 038, and IC 041, *as amended*.

#### **V. Substitute Specimen(s)**

Per the Office Action, and in view of the amendment of the classification of services in the application. Applicant attaches herewith a substitute specimen showing (a) actual use in commerce at least as early as the filing date of the instant application and (b) the Mark in actual use in commerce for the services (IC035, IC038, and IC041) identified in the application.

Specifically, Applicant attaches hereto as **Exhibit A**, a copy of a specimen showing THE ROYALTY FAMILY w/ Logo Mark used in commerce in Class 035. **Exhibit A**, is a copy of THE ROYALTY FAMILY w/ Logo Mark content video entitled “We turned our backyard into a trampoline park” page on Applicant’s THE ROYALTY FAMILY YouTube channel. Furthermore, the content video has currently been viewed 2,570,260 times and the video was sponsored by TYLENOL® Cold medicine. The video clearly shows that TYLENOL® Cold medicine is sponsoring the video. Moreover, at the 9 min. and thirteen (13) second frame of the content video, the Applicant’s Mark is shown, which further shows advertising for both Applicant and Third parties. Applicant asserts this meets the criteria in IC 035 of “online advertising and marketing services.” Specifically, Applicant asserts that, *inter alia*, the specimen shows a point-of-sale display showing the mark directly associated with the goods.

“Thanks to TYLENOL® Cold for sponsoring this video. Found conveniently behind the pharmacy counter, use Extra Strength TYLENOL® Cold & Flu Medicine with Pseudoephedrine Only As Directed for relief of your cough, cold, flu and congestion symptoms. [#Tylenol](#)   
<https://www.tylenol.com/products/tyle...>”

In addition, attached hereto as **Exhibit B** is a copy of a specimen showing THE ROYALTY FAMILY w/ Logo mark used in commerce in Class 038. **Exhibit B**, is a copy of THE ROYALTY FAMILY w/ Logo Mark content video entitled “Going Back to KINDERGARTEN For a Day!” page on Applicant’s THE ROYALTY FAMILY YouTube channel. Furthermore, the content video has currently been viewed 44,476,528 times and the comments / “chat room” includes over 829K “likes” / comments. Clearly, **Exhibit B** shows an “online bulletin board” or “chat room” associated with the video content. It is noted that

“Online bulletin boards” and “chat rooms” are classified in Class 38 regardless of the content or subject matter. The rationale for this stems from the fact that these services allow individuals to communicate with each other, like other Class 38 services.” See, TMEP §1402(a)(iii). Applicant asserts this meets the criteria in IC 038 of “Electronic transmission and streaming of digital media content for others via global and local computer networks.” Specifically, Applicant asserts that the specimen shows the Mark on the digital media content.

In addition, attached hereto as **Exhibit C** is a copy of a specimen showing THE ROYLATY FAMILY w/ Logi mark used in commerce in Class 041. **Exhibit C**, is a copy of THE ROYALTY FAMILY w/ Logo Mark homepage on Applicant’s You Tube channel showing 15.7M subscribers. Furthermore, the content video(s) have currently been viewed 3,249,229,636 times. Clearly, **Exhibit C** shows use of the mark as a source for online non-downloadable videos. It is noted that “content-provider services involving the provision of online, non-downloadable videos are classified in Class 41 regardless of the subject matter of the videos.” See, TMEP §1402(a)(ii). Applicant asserts this meets the criteria in IC 041 of “Entertainment services in the nature of production of multimedia entertainment content.” Specifically, Applicant asserts that the specimen shows the Mark on the digital media content.

## **Exhibit D**

Declaration under 37 C.F.R. §2.20 supporting Specimen and Dates of Use

The specimen(s) were in use in commerce at least as early as the filing date of the application.

The mark was first used in commerce for International Class 035 on 12-April-2017.

The mark was first used in commerce for International Class 038 on 12-April-2017.

The mark was first used in commerce for International Class 041 on 12-April-2017.

The undersigned, being hereby warned that willful false statements and The like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Shane Popp  
Shane M. Popp  
Attorney for The Royalty Family, Inc.  
28-December-2021

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Dated: December 28, 2021

Respectfully submitted,

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