

**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: 13-January-2022

Examining Attorney: Tejbir Singh

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**Response to Office Action dated 13-January-2022**

This is in response to the Office Action dated 13-January-2022 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. New Issue – Identification Amendment Exceeds Scope of Services in Original Application**

Applicant hereby deletes IC 041:

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

## **II. Specimen (Requirement for an Acceptable Specimen is Maintained)**

The Examiner has maintained the rejection for 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. Applicant respectfully disagrees.

Specifically, the Examiner notes,

“The applicant’s arguments are unpersuasive... For Class 035, applicant has **not provided any evidence that it is offering advertising services for others. There is no reference to applicant enticing third parties to advertise or market products / services through applicant’s programs.** For Class 038, any transmission or streaming is by Google through its YouTube platform. Just because an applicant is conducting an internet-based activity rendering a service that involves electronic transmission of data, **the applicant’s service is not automatically considered a telecommunications service in Class 038.** See, TMEP §1402.11(a)(iii). In this case, applicant itself is not providing the transmission or streaming service.” (**Emphasis added**).

Applicant wishes to clarify the services in which it seeks to trademark. First, as applied for, IC 035 relates to “On-line advertising and marketing services” There is no requirement that the advertising and marketing services be “*for others*”. Rather, Applicant is using the Mark, THE ROYALTY FAMILY as a **source** of advertising and marketing services on-line.

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 subscriptions and (ii) products for third-parties<sup>1</sup>.

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)).

### **III. 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) 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

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<sup>1</sup> The specimen clearly shows applicant using its mark THE ROYALTY FAMILY as a source of advertising third-party products (in this case, TYLENOL® Cold Medicine).

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, **Exhibit B**, is a further screenshot of the same video that explicitly shows that Tylenol Cold is sponsoring the video. Furthermore, **Exhibit B** shows THE ROYALTY FAMILY YouTube channel as the source of the advertisement and also shows a direct point-of-sale link from THE ROYALTY FAMILY video to the Tylenol Cold product(s). Accordingly, Applicant asserts that **Exhibit A** and **Exhibit B** show Applicant's programs as the source of advertising for third-parties.

In addition, attached hereto as **Exhibit C** is a copy of a specimen showing THE ROYALTY FAMILY w/ Logo mark used in commerce in Class 038. **Exhibit C**, 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 C** 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.

#### **IV. Examiner Interview Requested**

In view of the fact that the Examiner continues to maintain the specimen rejection(s), which is, in the view of the Applicant, based upon an incorrect reading of the requirements and meaning of IC 035 and IC 038, Applicant is requesting an Examiner interview pursuant to TMEP §709, with the Examiner’s supervisor to discuss the current rejection(s). Please feel free to contact the undersigned to schedule a convenient time to discuss the instant application. Applicant believes a discussion would be beneficial in this case.

### **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 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*

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Shane M. Popp  
Attorney for The Royalty Family, Inc.  
10-May-2022

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Dated: May 10, 2022

Respectfully submitted,

By *Shane Popp*  
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