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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 85521357

**MARK:** BLUE IVY CARTER GLORY IV

**\*85521357\***

**CORRESPONDENT ADDRESS:**

CBH BY BENTON CLOTHIER LLC  
CBH BY BENTON CLOTHIER LLC  
4705 5TH ST  
LONG ISLAND CITY, NY 11101-5410

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[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

**APPLICANT:** CBH By Benton Clothier LLC

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

linebuilder@gmail.com

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 2/2/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**SUMMARY OF ISSUES**

- Section 2(a) False Connection Refusal
- Section 2(c) Name Identifying a Particular Individual Refusal
- Request for Information
- Specimen Refusal - Picture of the Mark Only

**SEARCH OF OFFICE'S DATABASE OF MARKS**

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

## **SECTION 2(a) FALSE CONNECTION – REFUSAL**

Registration is refused because the applied-for mark consists of or includes matter which may falsely suggest a connection with BLUE IVY CARTER. Although BLUE IVY CARTER is not connected with the goods provided by applicant under the applied-for mark, BLUE IVY CARTER is so famous that consumers would presume a connection. Trademark Act Section 2(a), 15 U.S.C. §1052(a); *see* TMEP §§1203.03, 1203.03(e). *See generally* *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

The following is required for a showing of false connection under Trademark Act Section 2(a):

- 1) The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- 2) The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- 3) The person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and
- 4) The fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its goods and/or services.

*In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1507 (TTAB 2009); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 (TTAB 2008); TMEP §1203.03(e); *see also* *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used to determine the existence of a false connection).

Please see attached third party evidence showing BLUE IVY CARTER to be a famous infant whose parents are singer Beyoncé and rap artist Jay-Z. This evidence shows BLUE IVY CARTER is a famous individual. As Applicant's mark contains the term BLUE IVY CARTER, the fame of the individual is of such a nature consumers will see a connection between them and applicant's mark. Additionally, as the attached evidence demonstrates, the purchasing public is aware of celebrities promoting and sponsoring lines of fashion in their names. Thus there will be a presumption, though incorrect, that a line of cosmetics bearing the name BLUE IVY CARTER, is connected with the child through the control of her parents.

Applicant should note the following additional ground for refusal.

## **SECTION 2(c) NAME IDENTIFYING A PARTICULAR INDIVIDUAL**

Registration is refused because the applied-for mark consists of or includes a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §1206; *see, e.g., In re Hoefflin*, 97 USPQ2d 1174 (TTAB 2010).

For purposes of Section 2(c), a name in a mark identifies a particular living individual if the person bearing the name will be associated with the mark as used on the goods because he or she (1) is "so well

known that the public would reasonably assume [a] connection” or (2) is “publicly connected with the business in which the mark is being used.” *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010); *see also Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005); *In re Sauer*, 27 USPQ2d 1073, 1075 (TTAB 1994).

As stated above, BLUE IVY CARTER is a famous individual, who is so well known that the public would reasonably assume a connection. Applicant is again referred to the evidence demonstrating that the purchasing public would assume this connection exists because of the trade practice of celebrities promoting or sponsoring their own line of cosmetics.

The refusal under Section 2(c) will be withdrawn if applicant provides the following:

- 1) A statement that the name shown in the mark identifies **BLUE IVY CARTER**, a living individual whose consent is of record; and
- 2) A written consent, personally signed by the individual whose name, signature, or portrait appears in the mark, authorizing applicant to register the identifying matter as a trademark with the USPTO (e.g., “I, **BLUE IVY CARTER**, consent to the use and registration of my name as a trademark and/or service mark with the USPTO”).

*See* TMEP §§813, 813.01(a), 1206.04(a).

Applicant is advised that the written consent must include a statement of the party’s consent to applicant’s *registration*, and not just the *use*, of the identifying matter as a trademark. *See Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1912-13 (TTAB 2005); *In re New John Nissen Mannequins*, 227 USPQ 569, 571 (TTAB 1985); *Reed v. Bakers Eng’g & Equip. Co.*, 100 USPQ 196, 199 (PTO 1954); TMEP §1206.04(a).

The examining attorney notes BLUE IVY CARTER is a minor. If the record indicates that the person whose name or likeness appears in the mark is a minor, the question of who should sign the consent depends on state law. If the minor can validly enter into binding legal obligations, and can sue or be sued, in the state in which he or she is domiciled, then the minor may sign the consent. Otherwise, the consent should be signed by a parent or legal guardian, clearly setting forth his or her status as a parent or legal guardian. *See* TMEP §803.01 regarding the filing of an application in the name of a minor.

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If applicant chooses to respond to the refusal(s) to register, then applicant must also respond to the following requirement(s).

## **INFORMALITIES**

### **REQUEST FOR INFORMATION**

Due to the notoriety of the institution or person named in the mark, and the fact that there is no information in the application record regarding a connection with applicant, applicant must specify whether the person or institution named in the mark has any connection with applicant’s goods, and if so, must describe the nature and extent of that connection. *See* 37 C.F.R. §2.61(b); TMEP §1203.03(e).

Failure to respond to a request for information can be grounds for refusing registration. TMEP §814; *see In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003). Merely stating that information about the goods are available on applicant's website is an inappropriate response to a request for additional information, and is insufficient to make the relevant information of record. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

### **SPECIMEN REFUSAL – A PICTURE OF THE MARK ONLY**

The specimen is not acceptable because it is merely a photocopy of the drawing or a picture or rendering of the applied-for mark; it does not show the applied-for mark in actual use in commerce on the goods. *See* 37 C.F.R. §2.56(c); TMEP §904.04(a). Trademark Act Section 45 requires use of the mark “on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto.” 15 U.S.C. §1127; *see* 37 C.F.R. §2.56(b)(1); TMEP §904.03.

An application based on Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of goods. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Therefore, applicant must submit the following:

- (1) A substitute specimen showing the mark in use in commerce for each class of goods specified in the application; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**The substitute specimen was in use in commerce at least as early as the filing date of the application.**” 37 C.F.R. §2.59(a); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. *See* TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. *See* 15 U.S.C. §1051(c), (d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods listed in the application as of the filing date of the application.**” 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Pending receipt of a proper response, registration is refused because the specimen does not show the

applied-for mark in use in commerce as a trademark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

### **DECLARATION FOR A SUBSTITUTE SPECIMEN**

To submit a verified substitute specimen online via the Trademark Electronic Application System (TEAS), applicant should do the following: (1) answer “yes” to the TEAS response form wizard question to “submit a new or substitute specimen;” (2) attach a jpg or pdf file of the substitute specimen; (3) select the statement that “The substitute specimen(s) was in use in commerce at least as early as the filing date of the application.”; and (4) sign personally or enter personally his/her electronic signature, name in printed or typed form, and date after the declaration at the end of the TEAS response form. *See* 37 C.F.R. §§2.59(a), 2.193(a), (c)-(d), (e)(1); TMEP §§611.01(c), 804.01(b). Please note that these steps appear on different pages of the TEAS response form.

If applicant experiences difficulty in submitting the required substitute specimen, supporting statement and/or declaration, please e-mail <mailto:TEAS@uspto.gov> for technical assistance regarding the TEAS response form.

### **PRO SE RESPONSE GUIDELINES**

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

If applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. Where the application has been abandoned for failure to respond to an Office action, applicant’s only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to live status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

### **TELEPHONE OR EMAIL FOR CLARIFICATION**

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. *See* TMEP §§705.02, 709.06.

### **APPLICANT MAY WISH TO SEEK TRADEMARK COUNSEL**

Because of the legal technicalities involved in this application, applicant may wish to hire an attorney specializing in trademark or intellectual property law. For attorney referral information, applicant may

consult the American Bar Association's Consumers' Guide to Legal Help at <http://www.abanet.org/legalservices/findlegalhelp/home.cfm> or a local telephone directory. The USPTO cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

**TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE:** Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at