

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

APPLICATION SERIAL NO. 85526099

MARK: BLUE IVY CARTER

85526099

CORRESPONDENT ADDRESS:

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APPLICANT: BGK Trademark Holdings,
LLC

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

505185.20005

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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: 2/7/2012

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(d) Refusal (Class 014 and 025) (Reg. No. 4015486)
- Prior Pending Application (Class 003) (Serial No. 85521357)
- Section 2(a) False Connection Refusal

- Section 2(c) Name of a Living Individual Refusal
- Request for Information Requirement
- Identification and Classification of Goods Requirement

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION (Classes 014 and 025 Only)

Registration of the applied-for mark is refused **for Classes 014 and 025** because of a likelihood of confusion with the mark in U.S. Registration No. 4015486. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

The applicant's mark is BLUE IVY CARTER for

Class 014: Key chains and key rings of precious metal; fine and costume jewelry, clocks and watches

Class 025: Clothing for adults, infants and toddlers, namely, shoes, shirts, pants, dresses, vest, undergarments, coats, jackets, shorts, sweatshirts, sweatpants, sweaters, blouses; clothing accessories, namely, belts, scarves, socks, gloves, earmuffs, hats, caps, tights, stockings, pantyhose, baby layettes for clothing, plastic baby bibs; footwear, headwear

The registrant's mark is BLUE IVY (with design) for Retail store services featuring clothing, jewelry, home and clothing accessories, and giftware.

Comparison of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

The applicant's mark BLUE IVY CARTER NYC, is similar to the registered mark BLUE IVY (with design), because both contain the term BLUE IVY. Although each mark contains additional elements, marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985)

(CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii). Here BLUE IVY is the common term in the marks and may cause confusion as to source.

Comparison of the Goods and Services

The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

The applicant's goods are closely related to the registrant's services, as one is clothing and jewelry and the other is a retail store service providing clothing and jewelry. The use of similar marks on or in connection with both products and retail-store services has been held likely to cause confusion where the evidence showed that the retail-store services featured the same type of products. *See In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (holding the use of similar marks both for jewelry and for retail-jewelry and mineral-store services was likely to cause confusion); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (holding the use of nearly identical marks both for coats and for retail outlets featuring camping and mountain climbing equipment, including coats, was likely to cause confusion, noting that "there is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion"); *In re U.S. Shoe Corp.*, 8 USPQ2d 1938, 1939 (TTAB 1988) (holding the use of nearly identical marks both for leather cowboy boots and for retail western-, outdoor-, and leisure-clothing-store services featuring boots was likely to cause confusion); TMEP §1207.01(a)(ii).

Accordingly, because confusion as to source is likely, registration is refused under Trademark Action Section 2(d) based on a likelihood of confusion.

The attached Internet evidence consists of websites for retailers providing retail store services featuring clothing and/or jewelry, and the clothing and/or jewelry itself under the same mark. This evidence establishes that the same entity provides the relevant goods and markets the services under the same mark.

Therefore, applicant's and registrant's goods and services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the

registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

EARLIER FILED APPLICATION MAY BE BAR TO REGISTRATION (Class 003 Only)

The filing date of pending Application Serial No. 85521357 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration **for Class 003 only** under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Applicant should note the following additional ground for refusal.

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 goods and services bearing the name BLUE IVY CARTER, is connected with the child through the control of her parents.

The examining attorney acknowledges the Application has been signed by Beyoncé Knowles; however, the Office cannot presume the connection. Applicant must state for the record the relationship between the Applicant (BGK Trademark Holdings, LLC) and BLUE IVY CARTER.

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 and clothing.

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 services, 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).

IDENTIFICATION AND CLASSIFICATION OF GOODS

The identification of goods is indefinite and must be clarified. See TMEP §1402.01. Applicant must specify the common commercial or generic name for the goods. If there is no common commercial or generic name, applicant must describe the product and intended consumer as well as its main purpose and intended uses.

Classes 003, 006, 012, 014, 016, 018, 020, 021, 024, 025, 035, 041 are acceptable as written.

The current wording used to describe the goods needs clarification because of the following:

"Hair accessories, namely, electric hair-curlers" in Class 009 is indefinite as on 1-1-2012, this Class 9 electric or electrothermic apparatus entry of 4-2-1991 was transferred to Class 26 (the class of its non-electric counterparts), and the wording "other than hand implements" was added to distinguish these goods from Class 8 hand implements, pursuant to the 10th Edition of the Nice Agreement.

“Baby teething rings,” are in Class 010.

Applicant may adopt the following identification, if accurate (changes are in bold):

Class 009: DVDs, CDs, and audio and visual sound recordings featuring musical performances; musical sound recordings; computer application software for mobile phones, portable media players, and handheld computers for use in downloading music, ring tones and video games; handheld and mobile digital electronic devices, namely, tablet PCs, cellular phones, laptops, portable media players, handheld computers; cases and covers for mobile phones and mobile digital electronic devices, namely, laptops, cell phones, radio pagers, mobile computers; downloadable web-based application software in the nature of a mobile application downloadable to handheld and mobile digital electronic devices for use in downloading music, ring tones and video games; decorative magnets, eyewear, eyeglass cases; computer bags; graduated glassware

Class 010: **Baby teething rings**

Class 026: Hair accessories, namely, hair ties, hair scrunchies, barrettes, hair bands, hair bows, hair clips, hair pins, hair ribbons, ponytail holders; novelty button; **Hair accessories, namely, electric hair curlers, other than hand implements**

Class 028: Playing cards, balls, namely, basketballs, baseballs, footballs, kick balls, rubber balls, beach balls, golf balls, hand balls, tennis balls, racquet balls, soccer balls, sport balls; dolls, baby multiple activity toys, baby rattles, baby swings

Applicant must correct the classification of the goods in the application and amend the application to classify them the International Classes shown above. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §§1401.02(a) and 1401.03(b).

Applicant must clarify the number of classes for which registration is sought. The submitted filing fees are insufficient to cover all the classes in the application. Specifically, the application identifies goods and/or services that are classified in at least 16 international classes, however applicant paid the fee for only 15 classes.

Applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. §2.86(a)(2); TMEP §§810.01, 1401.04, 1401.04(b) and 1403.01.

An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

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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/>.

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