

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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 5/16/2018

This Office action responds to applicant's correspondence dated April 9, 2018.

The following requirement has been satisfied: initial requirement for information. TMEP §§713.02, 714.04. Applicant's disclaimer statement is acceptable.

The following refusal(s) and requirement(s) is/are continued and maintained: 1) refusal pursuant to Trademark Act Section 2(d); and 2) refusal pursuant to Trademark Act Section 2(e)(2).

After a review of applicant's response, the following new refusal(s) and/or requirement(s) apply.

REGISTRATION REFUSED PURSUANT TO TRADEMARK ACT SECTION 2(d)

Registration of the applied-for mark DETROIT CITY SOCCER CLUB is refused as to all classes, including 9, 16, 25, 28, and 41, because of a likelihood of confusion with the mark DETROIT CITY FOOTBALL CLUB in U.S. Registration No. 4745316. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the previously attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Similarities in the Marks

Marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

Although marks are compared in their entirety, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41

USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016) (“[T]he dominance of BARR in [a]pplicant’s mark BARR GROUP is reinforced by its location as the first word in the mark.”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Here, the registered mark consists solely of the wording “Detroit City Football Club.” The wording “football club” is disclaimed as generic in the registered mark, which is registered on the Supplemental Register. Thus, the first wording in the registered mark, “Detroit City,” is the dominant wording in the mark.

Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. See *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In the present case, the previously attached evidence shows that the wording “soccer club” in the applied-for mark is merely generic for applicant’s soccer exhibition services and descriptive of the nature and characteristics of its goods because they relate to and promote a soccer club. Applicant has confirmed in its response that it “intends to operate a major league soccer team.” Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording “Detroit City” the more dominant element of the mark.

The spelling of the shared dominant wording “Detroit City” in the applicant’s mark is similar to the spelling of this wording in the registered mark cited.

Moreover, the previously attached evidence and the evidence attached to this Office action shows that the wording “football club” is often used to refer to a soccer team. This evidence includes pages from the following Internet sites:

- Atlanta Football Club: <https://www.atlutd.com/club/about>
- LA Football Club: <https://www.lafc.com/club/crest>
- Octagon: <http://www.octagon.com/talent/soccerfootball>
- San Francisco Soccer Football: http://www.sfsfl.com/Page.php?PARAM_PAGE=History
- Soccer Factory: <http://thesoccerfactory.com/product-category/safc/>

Thus, the use of the wording “soccer club” in the applicant’s mark is unlikely to differentiate the applicant’s mark from the registrant’s mark, which contains the shared wording “Detroit City” and the wording “football club.”

There is no other wording and no design elements in either mark that might help consumers distinguish the marks from one another.

Similarities in the Goods and/or Services

Consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); see *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG’S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men’s, boys’, girls’ and women’s clothing likely to be confused with THE “21” CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women’s clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Here, applicant’s goods and services consist of the following:

Class 9

Fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, MP3 players, mobile telephones, smart telephones, tablets, laptop, and wireless speakers; Computer and video game software and programs; Magnets; Sunglasses; Pre-recorded DVDs in the field of soccer; Downloadable image files containing artwork, text, audio, video, games, and internet weblinks in the field of soccer; Downloadable video clips from soccer games via mobile communication devices; Computer keyboards; Mouse pads; Computer memory devices; blank USB flash drives

Class 16

Posters; Decals; Collectible trading cards and sports trading cards; Stickers; Bumper stickers; Printed paper signs; Printed media guides relating to a professional soccer team; Souvenir soccer event programs; Yearbooks in the field of soccer; Printed event admission tickets; Calendars; Paper mats in the nature of coasters for beer glasses; Printed photographs Photo prints; Magazines featuring information in the field of soccer; Paper hangtags; Pencils; Notebooks; Binders

Class 25

T-shirts; Fleece tops; Jerseys; Hats; Caps being headwear; Visors being headwear; Beanies; Shorts; Pants; Sweat suits; Jackets; Hooded sweatshirts; Scarves; Gloves; Socks; Headbands; Wristbands as clothing; Ponchos; Baby bibs not made of paper; Infant and toddler clothing, namely, one-piece clothing, overalls, socks, and dresses; Sleepwear; Loungewear; Slippers; Flip flops; Footwear; Shirts

Class 28

Toy figurines; Soccer ball bags; Soccer balls; Plush toys; Puzzles; Toy foam novelty items, namely, foam heads and fingers; Foosball tables and figurines; Golf accessories, namely, golf balls, divot repair tools, bag tags, ball markers, towels, tees, gloves; Christmas tree ornaments; Toy building blocks toys; Game tables; Tailgating games, namely, bag toss games, washer game sets in the nature of target games, tumbler towers game in the nature of stackable tumbling games, and game tables for tailgates; Fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, gaming devices, namely, in the nature of hand-held video gaming devices and video game consoles

Class 41

Entertainment services, namely, soccer exhibitions in the nature of soccer games that are rendered live in a stadium and recorded for the purpose of distribution through the media of television and radio and via the internet; Provision of entertainment in the nature of non-downloadable pre-recorded film clips from soccer games, presented via mobile communication devices; Provision of information in the field of soccer via the internet and mobile devices

The registrant’s goods and services also include clothing, footwear, and soccer games. Thus, applicant’s goods and services are highly similar or the same, in part, as the registrant’s goods and services.

Moreover, applicant’s goods include other goods that are commonly sold by sports teams as novelty items to promote their sports exhibition services. The attached Internet evidence shows that such goods are commonly sold together at sporting events and on the websites of sports teams:

The trademark examining attorney has attached evidence from the USPTO’s X-Search database consisting of a number of third-party marks

registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, for example magnets and DVDs in Class 9, posters and bumper stickers in Class 16, and soccer balls and plush toys in Class 28, are of a kind that may emanate from a single source under a single mark with soccer and/or other sports competition or exhibition services in Class 41 and clothing in Class 25. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii).

This evidence includes the following third-party registrations, which is a representative sampling of the more than 200 registrations found for soccer teams alone.

Serial Filed Status Mark

87077240	20160620	V®	MANCHESTER CITY 1894
86792003	20151019	V®	MANCHESTER CITY F.C.
86279344	20140513	V®	ORLANDO CITY
86279341	20140513	V®	ORLANDO CITY
86211332	20140305	V®	JFC JACKSONVILLE FC
86215856	20140310	V®	NEW YORK CITY FOOTBALL CLUB NYC
86187341	20140207	V®	ROWDIES
86187343	20140207	V®	ROWDIES
86180395	20140130	V®	QUAKES SAN JOSE 1974
85975899	20100615	V®	VANCOUVER WHITECAPS FC
85975857	20100615	V®	VANCOUVER WHITECAPS FC
85803527	20121214	V®	NEW YORK CITY FC
85337578	20110603	V®	PORTLAND TIMBERS
85333943	20110601	V®	SAN JOSE EARTHQUAKES
85180061	20101118	V®	KANSAS CITY SPORTING SC
85180039	20101118	V®	SPORTING KANSAS CITY
85807614	20121220	V®	SEATTLE REIGN FC
85807604	20121220	V®	SEATTLE REIGN FC
85873133	20130311	V®	TAMPA BAY ROWDIES
85117868	20100827	V®	INDIAN PREMIER LEAGUE
87027590	20160506	V®	SEATTLE SOUNDERS FC
86844444	20151209	V®	CRYSTAL PALACE F.C. 1905
86685799	20150707	V®	ATLANTA UNITED FC
86674910	20150625	V®	ATLANTA UNITED FC
86917733	20160224	V®	TORONTO FC
87316130	20170127	V®	FFF
87180971	20160923	V®	NC COURAGE
87293565	20170109	V®	NC COURAGE
87040115	20160517	V®	MIAMI REDHAWKS
86961490	20160401	V®	GREAT LAKES LOONS
86882390	20160121	V®	MIAMI FC
86882395	20160121	V®	MIAMI FC
87180972	20160923	V®	NORTH CAROLINA COURAGE

87066259 20160609 V® HASHTAG UNITED
86844441 20151209 V® CRYSTAL PALACE F.C.
86982700 20151028 V® ORLANDO PRIDE
86981783 20151007 V® ORLANDO PRIDE
86844765 20151210 V® D.C. UNITED
86362542 20140811 V® CHARLOTTE INDEPENDENCE
86979530 20150417 V® FC CINCINNATI
86312512 20140617 V® SAINT LOUIS FOOTBALL CLUB
86308922 20140613 V® SAINT LOUIS 17 64 FOOTBALL CLUB
86418744 20141008 V® COLUMBUS CREW SC 96
86398288 20140918 V® MLS
85804378 20121217 V® RSL
85391830 20110808 V® TOUS POUR GAGNER IMPACT MONTRÉAL
x79196273 20160712 V® FC ST. PAULI 1910
x79186981 20150918 V® FCSM FOOTBALL CLUB SOCHAUX-MONTBÉLIARD 1928
86438526 20141029 V® SWANSEA CITY AFC

Applicant's Arguments:

Applicant's response indicates that "[w]ith respect to the finding of likelihood of confusion, applicant is addressing the similarity of the marks in order to respond to this refusal of registration." However, applicant's response did not provide any argument concerning the refusal of registration pursuant to Trademark Act Section 2(d). Instead, applicant's response merely provided an argument concerning the refusal pursuant to Trademark Act Section 2(e)(2). This argument is addressed below.

Therefore, since the marks are similar and the goods and services are similar in part and marketed together to the same consumers through the same channels of trade, there is a likelihood of confusion between the marks and **registration is hereby refused as to all classes in accordance with the Trademark Act**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

REGISTRATION REFUSED PURSUANT TO TRADEMARK ACT SECTION 2(a)

Registration is further refused because the applied-for mark DETROIT CITY SOCCER CLUB consists of or includes matter which may falsely suggest a connection with the Detroit City Football Club. Trademark Act Section 2(a), 15 U.S.C. §1052(a). Although Detroit City Football Club is not connected with the goods and/or services provided by applicant under the applied-for mark, Detroit City Football Club is so well-known that consumers would presume a connection. *See id.*

Under Trademark Act Section 2(a), the registration of a mark that "consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs, or national symbols" is prohibited. *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013). To establish that an applied-for mark falsely suggests a connection with a person or an institution, the following is required:

- (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.

- (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 Pedersen, 109 USPQ2d at 1188-89; *In re Jackson Int'l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012); TMEP §1203.03(c)(i); *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).

Here, the mark sought to be registered, DETROIT CITY SOCCER CLUB, is a close approximation of the name of the Detroit City Football Club. The attached evidence discussed above shows that the wording "football club" is often used to refer to a soccer team. Thus, the mark DETROIT CITY SOCCER CLUB would be understood as a reference to the Detroit City Football Club. The applicant has not indicated in its application or response that the Detroit City Football Club is connected in any way with the goods sold or services performed by the applicant under the proposed mark. Lastly, the attached Internet evidence shows that the fame or reputation of the Detroit City Football Club is of such a nature that a connection with it would be presumed by consumers when the applicant's proposed mark is used on its goods and/or services. This evidence includes pages from the following Internet sites:

<https://www.detcityfc.com/history>

https://en.wikipedia.org/wiki/Detroit_City_FC

<https://detcityfcstore.com/>

<https://www.yelp.com/biz/detroit-city-football-club-detroit>

<http://r.duckduckgo.com/l/?kh=-1&uddg=http%3A%2F%2Fwww.crainsdetroit.com%2Ftaxid%2F19006307%2Fdetroit-city-football-club>

<http://www.crainsdetroit.com/taxid/19006307/detroit-city-football-club>

<https://www.wxyz.com/news/detroit-city-fc-unveils-2018-home-schedule-first-game-on-april-14>

<https://www.detroitnews.com/picture-gallery/sports/2016/05/28/detroit-city-fc-3-fc-united-of-manchester-3/85112672/>

Thus, all prongs of the test have been satisfied. Therefore, since the applied-for mark DETROIT CITY SOCCER CLUB consists of or includes matter which may falsely suggest a connection with the Detroit City Football Club, registration is refused in accordance with the Trademark Act. Trademark Act Section 2(a), 15 U.S.C. §1052(a).

The following refusal(s) and/or requirement(s) are continued and maintained.

REGISTRATION REFUSED PURSUANT TO TRADEMARK ACT SECTIONS 2(e)(2)

Registration is further refused because the applied-for mark DETROIT CITY SOCCER CLUB is primarily geographically descriptive of the origin of applicant's goods and/or services. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); *see* TMEP §§1210, 1210.01(a).

A mark is primarily geographically descriptive when the following is demonstrated:

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The goods and/or services for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a goods-place or services-place association; that is, purchasers would be likely to believe that the goods and/or services originate in the geographic place identified in the mark.

TMEP §1210.01(a); *see In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014).

The evidence of record and the attached evidence shows that the word “city” is often used in connection with a city name that precedes the word “city.” The evidence also shows that the wording “Detroit City” is often used as an alternative reference to the City of Detroit and includes pages from the following Internet sites.

Detroit City:

- Detroit City Chess: <http://detroitchess.com/location>
- Detroit City Design Summit: <https://www.detroitdesignfestival.com/event/detroit-city-design-summit/>
- Detroit City Distillery: <http://www.detroitcitydistillery.com/>
- Detroit City Nut: <https://www.detroitcitynut.com/about/>
- Made in Detroit: <https://www.madeindetroit.com/collections/mens/products/mens-ms214>
- Moishe House Detroit City: <https://www.moishehouse.org/find-a-house/detroit-detroit-city/>
- Pure Detroit: http://shop.puredetroit.com/MEN-UNISEX-APPAREL_c_90.html

Additional evidence of record further shows that use of the word “city” after a city’s name is not uncommon and is understood by consumers to refer to that city. This evidence includes pages from the following Internet sites.

Other City Examples:

- Chicago City Day School: <https://www.chicagocitydayschool.org/>
- Chicago City Soccer Club: <https://www.chicagocitysoccerclub.com/page/show/1723009-community-outreach-program>
- Denver City Golf: <https://www.cityofdenvergolf.com/tournaments/denver-city-amateur>
- Houston City Servers: <http://www.houstoncityservers.com/>
- Seattle City Rotaract: <http://www.seattlecityrotaract.org/meeting-information.html>

Thus, the primary significance of the mark is a generally known geographic place and the first prong of the test is met.

The application indicates that the applicant is based in or in close proximity to the City of Detroit, which the evidence shows is also sometimes referred to as Detroit City. Thus, the second prong of the test is met. Purchasers would be likely to believe that the goods and/or services originate in the geographic place identified in the mark because the applicant is based there, the applicant’s goods and services are sold and provided there, and because the wording “Detroit City” is used to refer to the City of Detroit, particularly in and near Detroit. Thus, the third and final prong of the test is met and the wording “Detroit City” is primarily geographically descriptive of the origin of applicant’s goods and/or services.

The addition of generic or highly descriptive wording to a geographic word or term does not diminish that geographic word or term’s primary geographic significance. TMEP §1210.02(c)(ii); *see, e.g., In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853-54 (TTAB 2014) (holding HOLLYWOOD LAWYERS ONLINE primarily geographically descriptive of attorney referrals, online business information, and an online business directory); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1920 (TTAB 2008) (holding NORMANDIE CAMEMBERT primarily geographically descriptive of cheese).

Here, the attached evidences shows that the wording “soccer club” merely describes a type of organization that provides soccer exhibition services. Thus, the addition of this wording to applicant’s proposed mark does not diminish the geographic significance of the wording “Detroit City” in the mark.

Supplemental Register Option Not Available

Although an amendment to the Supplemental Register would normally be an appropriate response to this refusal, such a response is not appropriate in the present case. The instant application was filed under Trademark Act Section 1(b), 15 U.S.C. §1051(b), and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been timely filed. 37 C.F.R.

§2.47(d); TMEP §§815.02, 816.02 and 1102.03.

If applicant files an amendment to allege use and also amends to the Supplemental Register, please note that the effective filing date of the application will then be the date of filing of the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§206.01 and 816.02.

Applicant's Arguments

Applicant has acknowledged that “[a]pplicant’s goods and services will originate in the City of Detroit...” The applicant has also acknowledged that one definition of the wording Detroit City is as a reference to the City of Detroit.

Applicant nevertheless claims that the wording “Detroit City,” which is an inexact transposition of the wording “City of Detroit,” is not “an alternative reference to the City of Detroit” and claims that there are several other things, besides Detroit, that this wording may refer to.

However, it is well-established law that descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). “That a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e).

Moreover, applicant’s own evidence includes a page from the Wikipedia website showing that the wording “Detroit City” refers to the City of Detroit.

Therefore, applicant’s claim that the wording “Detroit City” does not refer to the “City of Detroit” in the context of applicant’s goods and/or services is without merit.

If applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES REQUIRED

Applicant’s proposed amendments to the identification of goods and services is unacceptable in part. Specifically, the following underlined wording in the identification of goods and services is indefinite and must be clarified as set forth below. See TMEP §1402.01. The exact nature of the goods and services cannot be determined from this wording.

Class 9

Fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, MP3 players, mobile telephones, smart telephones, tablets, laptop, and wireless speakers; Computer and video game software and programs; Magnets; Sunglasses; Pre-recorded DVDs in the field of soccer; Downloadable image files containing artwork, text, audio, video, games, and internet weblinks in the field of soccer; Downloadable video clips from soccer games via mobile communication devices; Computer keyboards; Mouse pads; Computer memory devices; blank USB flash drives

Class 16

Posters; Decals; Collectible trading cards and sports trading cards; Stickers; Bumper stickers; Printed paper signs; Printed media guides relating to a professional soccer team; Souvenir soccer event programs; Yearbooks in the field of soccer; Printed event admission tickets; Calendars; Paper mats in the nature of coasters for beer glasses; Printed photographs Photo prints; **[The wording “photo prints” is unclear but may be encompassed by the preceding wording, and may therefore be unnecessary.]** Magazines featuring information in the field of soccer; Paper hangtags; Pencils; Notebooks; Binders

Class 25

T-shirts; Fleece tops; Jerseys; Hats; Caps being headwear; Visors being headwear; Beanies; Shorts; Pants; Sweat suits; Jackets; Hooded

sweatshirts; Scarves; Gloves; Socks; Headbands; Wristbands as clothing; Ponchos; Baby bibs not made of paper; Infant and toddler clothing, namely, one-piece clothing, overalls, socks, and dresses; Sleepwear; Loungewear; Slippers; Flip flops; Footwear; Shirts

Class 28

Toy figurines; Soccer ball bags; Soccer balls; Plush toys; Puzzles; Toy foam novelty items, namely, foam heads and fingers; Foosball tables and figurines; Golf accessories, namely, golf balls, divot repair tools, bag tags, ball markers, **towels**, [*The nature of the goods must be clarified. If not golf towels, the goods are misclassified. Towels are generally classified in Class 24.*] tees, gloves; Christmas tree ornaments; Toy building blocks toys; Game tables; Tailgating games, namely, bag toss games, washer game sets in the nature of target games, tumbler towers game in the nature of stackable tumbling games, and game tables for tailgates; Fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, gaming devices, namely, in the nature of hand-held video gaming devices and video game consoles

Class 41

Entertainment services, namely, soccer exhibitions in the nature of soccer games that are rendered live in a stadium and recorded for the purpose of distribution through the media of television and radio and via the internet; Provision of entertainment in the nature of non-downloadable pre-recorded film clips from soccer games, presented via mobile communication devices; Provision of information in the field of soccer via the internet and mobile devices

Applicant must amend this wording to specify the common commercial or generic name for the goods and/or services. If there is no common commercial or generic name for the goods and/or services, then applicant must describe the nature of the goods and/or services as well as their main purpose, channels of trade, and the intended consumer(s). See TMEP §1402.01.

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

An applicant may only amend an identification to clarify or limit the goods and/or services, but not to add to or broaden the scope of the goods and/or services. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

The specific problems with the identification discussed above are provided for clarity only. Applicant should review the entire identification to ensure that it accurately identifies applicant's goods and/or services using common commercial wording.

It is the applicant's duty to identify the goods and/or services, and any goods and/or services deleted from the application by amendment may not be reinserted at a later point in prosecution. TMEP §1402.01(e).

Applicant may find acceptable identification wording by: 1) using the sample wording provided in the *Identification Manual* for this purpose; 2) researching the Register for wording that has recently been accepted by the Office and is consistent with the current rules governing identifications; 3) using wording that is the common name widely used in the relevant industry or trade; or 4) drafting wording that otherwise complies with the requirements described in the Code of Federal Regulations as exemplified by the entries in the *Identification Manual*.

ASSOCIATION INFORMATION REQUIRED

Due to the renown of the institution or person named in the mark, applicant must specify for the record whether the person or institution named in the mark has any connection with applicant's goods and/or services, and if so, must describe the nature and extent of that connection. See 37 C.F.R. §2.61(b); TMEP §1203.03(c)(i).

RESPONSE GUIDELINES

There is no required format or form for responding to an Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at <http://www.uspto.gov/teas/index.html>. However, if applicant responds on paper via regular mail, the response should include the title "Response to Office Action" and the following information: (1) the name and law office number of the examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4)

applicant's name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

The response should address each refusal and/or requirement raised in the Office action. If a refusal has issued, applicant can argue against the refusal; i.e., applicant can submit arguments and evidence as to why the refusal should be withdrawn and the mark should register. To respond to requirements, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

E-mail may not be used to file responses to Office actions. These documents may be filed electronically using TEAS. TMEP § 304.02. Further, **e-mail may not be used to request an advisory opinion** as to the likelihood of overcoming a refusal or requirement.

QUESTIONS ABOUT THIS ACTION

As noted above, if applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp and send technical questions to TEAS@uspto.gov via e-mail.

For status inquiries, an applicant may check the status of or view documents filed in his or her trademark and/or service mark application or registration 24 hours a day, 7 days a week using the Trademark Status and Document Retrieval (TSDR) database on the USPTO website at <http://tsdr.uspto.gov/>. To obtain this status or view these documents, enter the application serial number or registration number and click on "Status" or "Documents."

For all other non-legal matters, including petitions to revive or reinstate an application, please contact the Trademark Assistance Center (TAC). TAC may be reached by e-mail at TrademarkAssistanceCenter@uspto.gov or by telephone at (800) 786-9199. For non-technical matters, TAC is open from 8:30 a.m. to 8:00 p.m. Eastern Standard Time (EST), Monday through Friday, except on federal government holidays. A list of federal government holidays is available at the following website: <http://www.opm.gov/policy-data-oversight/snow-dismissal-procedures/federal-holidays/#url=2014>.

If applicant has questions regarding the legal issues in this Office action, applicant may call the assigned trademark examining attorney.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/efennessy/
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailling date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail 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 the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or 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 <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.