

FUS RO DAH
Application No. 85/589,294
Office Action Response

I. INTRODUCTION

The Examining Attorney has issued a refusal of the proposed mark FUS RO DAH (“Applicant’s Mark”) in connection with “clothing, namely, t-shirts, shirts, sweatshirts; headwear, namely, hats” in Class 25 (“Applicant’s Goods”) on the basis that it is allegedly ornamental in nature. However, Applicant’s Mark is not merely ornamental, but rather is a strong source identifier. Therefore, for the reasons further discussed herein, Applicant respectfully requests that the Examining Attorney withdraw the ornamental refusal.

A. Because Applicant’s Mark Is Not Merely Ornamental, But Rather Functions As A Strong Source Identifier In The Minds of Consumers It Should Be Allowed To Proceed To Publication

Matter that serves primarily as a source indicator, either inherently or as a result of acquired distinctiveness, and that is only incidentally ornamental or decorative, can be registered as a trademark. In re Paramount Pictures Corp., 213 USPQ 1111, 1114 (TTAB 1982). Specifically, when determining whether a proposed mark is ornamental as used on the goods, the Examining Attorney should consider: “(1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness.” TMEP § 1202.03. In the instant case, the proposed mark functions as a strong source identifier in the minds of consumers in that it (1) creates the commercial impression of a trademark; (2) is unique when used in connection with clothing; (3) has a source identifying function; and (4) at a minimum, has acquired distinctiveness. Thus, Applicant respectfully requests that the Examining Attorney withdraw the ornamental refusal.

i. The Proposed Mark Creates The Commercial Impression Of A Trademark

When weighing the commercial impression of the proposed mark, the significance of the proposed mark must be considered. TMEP § 1202.03(a). Applicant’s mark was created specifically to serve as a source identifier for Applicant and is not used as mere ornamentation. Indeed, not only is the proposed mark arbitrary for the goods, but the mark also serves to identify a secondary source of origin. Specifically, consumers who see the proposed mark on clothing will automatically associate the goods with the Applicant in that the proposed mark describes the sound of a unique dragon shout in *The Elder Scrolls* video game (developed by Applicant).

Further, while the Examining Attorney must also consider the size, location, and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function, In re Lululemon Athletica Can. Inc., 105 USPQ2d 1684, 1687 (TTAB 2013) (quoting In re Right-On Co., 87 USPQ2d 1152, 1156 (TTAB 2008)), the size of the mark on clothing is only one consideration in determining the registrability of a mark. In re Lululemon Athletica Can. Inc., 105 USPQ2d at 1689. In the instant case, the fact that proposed mark incorporates a larger font size does not mean that the mark is merely ornamental. Regardless of font size, the proposed mark serves a source identifying function. Consumers who see the proposed mark will automatically associate the goods with the unique dragon shout in *The Elder Scrolls* video game (developed by Applicant).

ii. The Proposed Mark Is Unique When Used In Connection With Clothing

When considering the relevant practices of the trade, it is relevant to judge whether the mark “is unique or unusual in a particular field, as opposed to a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods that would be viewed by the public as a dress or ornamentation for the goods.” TMEP § 1202.03(b). In the instant case, the proposed mark is not a commonly adopted or well-known form of ornamentation, such as a smiley face or peace symbol, but rather a distinctive word mark clearly associated with Applicant. Unlike the mere ornamentation of a

smiley face, for example, which generally does little to communicate source of origin, the source of the proposed mark belongs unmistakably to the Applicant as the developer of *The Elder Scrolls* video game.

iii. The Proposed Mark Serves Primarily As Secondary Source Identifier

Matter that serves primarily as a source identifier, and is only incidentally ornamental, can be registered as a trademark. See In re Paramount Pictures Corp., 213 U.S.P.Q. 1111, 1113 (TTAB 1982) (finding that the mark MORK & MINDY, as applied to a T-shirt, functioned as a source identifier, and stating that “the broad and liberal interpretation of our law is that, where such a sign also serves a source identifying function, it should be regarded as acceptable subject matter for registration”). Here, the proposed mark serves primarily as a source identifier for Applicant. In addition, “matter that serves as an identifier of a ‘secondary source’ is considered an arbitrary symbol and is registrable on the Principal Register.” TMEP § 1202.03. In the instant case, the proposed mark conveys “to the purchasing public the ‘secondary source’ of the T-shirt (rather than the manufacturing source).” *Id.* Specifically, the use of the mark on t-shirts automatically calls to mind the dragon shout in *The Elders Scrolls* video game which was developed by Applicant and/or the broader source-identifying association of “FUS RO DAH” with Applicant.

iv. The Proposed Mark Has Acquired Distinctiveness

Finally, evidence of distinctiveness may also weigh against a finding that the proposed mark is merely ornamental as used on the goods. TMEP § 1202.03(d). Here, Applicant asserts that FUS RO DAH is significantly distinct in nature and no claim of acquired distinctiveness is necessary. That said, Applicant has expended tens of millions of dollars developing, advertising and promoting *The Elder Scrolls* video games. Since its launch *The Elder Scrolls* has been a tremendous worldwide success and has garnered extensive media coverage and extraordinarily high consumer recognition. As a result, based on the extraordinarily well-known nature of *The Elder Scrolls* and the efforts of Applicant to finance, develop, advertise and promote *The Elder Scrolls* over several years, Applicant’s customers and the public in general have come to know and recognize the dragon shout FUS RO DAH and to automatically associate it with Applicant.

II. CONCLUSION

In light of the above, Applicant respectfully requests that the Examining Attorney withdraw the merely ornamental refusal and approve the application be publication.