

To: Ellen Reilly(reilly@iplawdenver.com)
Subject: U.S. Trademark Application Serial No. 97120356 - BRECKENRIDGE OKTOBERFEST - 12390-T-2
Sent: August 26, 2022 12:46:27 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[Breckenridge.jpg](#)
[Oktoberfest definition.jpg](#)

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 97120356

Mark: BRECKENRIDGE OKTOBERFEST

Correspondence Address:

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Applicant: Breckenridge Tourism Office, Inc.

Reference/Docket No. 12390-T-2

Correspondence Email Address: reilly@iplawdenver.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 26, 2022

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

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

Summary of Issues Applicant Must Address

- Refusal Based on Trademark Act Section 2(e)(2) – Geographic Descriptiveness of the Mark

Possible Response to Geographic Descriptiveness Refusal

- Claim of Acquired Distinctiveness; Deletion of Disclaimer of Exclusive Rights to Use "BRECKENRIDGE"; Addition of Disclaimer of Exclusive Rights to Use "OKTOBERFEST"

Refusal Based on Trademark Act Section 2(e)(2) – Geographic Descriptiveness of the Mark

Registration is refused because the applied-for mark is primarily geographically descriptive of the origin of applicant's 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 to the purchasing public is a generally known location; (2) The goods or services originate in the place identified in the mark; and (3) The purchasing public would be likely to believe that the goods or services originate in the geographic place identified in the mark; that is, to make a goods-place or services-place association. *See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *5 (TTAB 2020) (citing *In re Nantucket, Inc.*, 677 F.2d 95, 96-97, 213 USPQ 889, 891 (C.C.P.A. 1982)); *see also In re Newbridge Cutlery Co.*, 776 F.3d 854, 860-61, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *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 JT Tobacconists*, 59 USPQ2d 1080, 1081 (TTAB 2001)); TMEP §1210.01(a).

A goods-place or services-place association may be presumed where (1) the location in the mark is generally known to the purchasing public, (2) the term's geographical significance is its primary significance, and (3) the goods and/or services do, in fact, originate from the named location in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988) (finding a services-place association was presumed between applicant's restaurant services and California because the services originated in California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 850 (TTAB 1982) (finding a goods-place association was presumed between applicant's t-shirts and Denver because the goods had their geographical origin in Denver); *see also In re Nantucket, Inc.*, 677 F.2d 95, 102, 213 USPQ 889, 895 (C.C.P.A. 1982) (Nies, J., concurring) ("[W]e must start with the concept that a geographic name of a place of business is a descriptive term when used on the goods of that business. There is a public goods/place association, in effect, presumed." (internal footnote removed)).

The attached evidence demonstrates that Breckenridge is a known geographic location and describes the origin of the services:

- The attached dictionary entry shows that Breckenridge is a geographic location.
- The application indicates that the applicant is located in Breckenridge, Colorado.
- The applicant's specimen shows that the applicant provides its services in Breckenridge,

Colorado.

Purchasers who encounter the term "Breckenridge" with the identified services would immediately understand that the applicant's services originate in Breckenridge; therefore the wording in the mark is geographically descriptive.

The addition of generic or highly descriptive wording to a geographic term does not diminish that geographic term's primary geographic significance. TMEP §1210.02(c)(ii); *see, e.g., Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *6-7 (TTAB 2020) (holding CHARLESTON HARBOR TOURS primarily geographically descriptive of various travel tour and cruise services because TOURS is generic for the services and CHARLESTON HARBOR is a well-known harbor in Charleston, South Carolina); *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). That is, the added term "Oktoberfest" does not diminish the geographic significance of the mark. The attached dictionary entry shows that "Oktoberfest" indicates a type of festival such as that provided by the applicant.

For these reasons, the examining attorney finds that because the mark is geographically descriptive of the applicant's services, registration of the applicant's mark is refused under Trademark Act Section 2(e)(2).

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

Possible Response to Descriptiveness Refusal: Claim of Acquired Distinctiveness; Deletion of Disclaimer of Exclusive Rights to Use "BRECKENRIDGE"; Addition of Disclaimer of Exclusive Rights to Use "OKTOBERFEST"

Claim of Acquired Distinctiveness

The application record indicates that applicant has used its mark for a long time; therefore, applicant has the option to amend the application to assert a claim of acquired distinctiveness under Trademark Act Section 2(f). *See* 15 U.S.C. §1052(f); TMEP §1212.05.

To amend the application to Section 2(f) based on five years' use, applicant should request that the application be amended to assert a claim of acquired distinctiveness under Section 2(f) and submit the following written statement claiming acquired distinctiveness, if accurate:

The mark has become distinctive of the goods and/or services through the applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

TMEP §1212.05(d); *see* 15 U.S.C. §1052(f); 37 C.F.R. §2.41(a)(2); TMEP §1212.08. This statement must be verified with an affidavit or signed declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.41(a)(2); TMEP §1212.05(d); *see* 37 C.F.R. §2.193(e)(1).

Deletion of Disclaimer of Exclusive Rights to Use "BRECKENRIDGE"

With the claim of acquired distinctiveness, the disclaimer of the geographically descriptive term "BRECKENRIDGE" should be deleted. Exclusive rights to use only generic wording within a claim of acquired distinctiveness should be disclaimed. *See* 15 U.S.C. §1056(a); *In re Am. Inst. of Certified*

Pub. Accountants, 65 USPQ2d 1972, 1981-85 (TTAB 2003); TMEP §§1213, 1213.03(a)

Addition of Disclaimer of Exclusive Rights to Use "OKTOBERFEST"

With the claim of acquired distinctiveness, applicant must provide a disclaimer of exclusive right to use the generic word "Oktoberfest" apart from the mark as shown. *See* 15 U.S.C. §1056(a); *In re Am. Inst. of Certified Pub. Accountants*, 65 USPQ2d 1972, 1981-85 (TTAB 2003); TMEP §§1213, 1213.03(a). A disclaimer of an unregistrable part of a mark will not affect the mark's appearance. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 979-80, 144 USPQ 433, 433 (C.C.P.A. 1965).

In this case, applicant must disclaim the term "OKTOBERFEST" because it is not inherently distinctive. This term is a generic term for applicant's services and is thus an unregistrable component of the mark. *See* 15 U.S.C. §1052(e)(1); *In re Am. Inst. of Certified Pub. Accountants*, 65 USPQ2d at 1981-85; TMEP §§1212.02(e), 1213.03(b).

A mark is generic if its primary significance to the relevant public is the class or category of goods or services with which it is used. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *5 (2020); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i). Determining whether a mark is generic requires a two-step inquiry: (1) What is the genus of goods and/or services at issue?; (2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services? *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d at 989-90, 228 USPQ at 530; *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1463 (TTAB 2015); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of services is often defined by an applicant's identification of goods or services. *In re Meridian Rack & Pinion*, 114 USPQ2d at 1463. The application identifies the services as "entertainment in the nature of organizing and promoting cultural festivals wherein facilities for food, refreshments, dancing, concerts, souvenirs, contests, and other forms of amusement are provided," which adequately defines the genus at issue. The attached dictionary entry indicates that "OKTOBERFEST" indicates these types of services -- "a fall festival usually featuring beer drinking."

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified goods or services. *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013). In this case, the relevant public comprises ordinary consumers because there are no limitations on the identification of services. The dictionary entry shows that the term "OKTOBERFEST" in the mark designates a fall festival, and thus the relevant public would understand this designation to refer primarily to the genus of services.

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use "OKTOBERFEST" apart from the mark as shown.

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

How to respond. [Click to file a response to this nonfinal Office action.](#)

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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

Breckenridge

Define Relate List Discuss See Hear Love

Definitions

from The American Heritage® Dictionary of the English Language, 5th Edition.

A town of central Colorado west-southwest of Denver. Founded as a mining camp in 1859, it is a popular ski area and mountain resort.

Etymologies

Sorry, no etymologies found.

Examples

DON TREUL, EDITOR, BRECKENRIDGE AMERICAN: Nancy, this is a very sad occasion here in **Breckenridge**.

CNN Transcript May 20, 2008

BRECKENRIDGE - Authorities have concluded that no crime occurred when a Texas Christian University student's buttocks were branded with a hot hanger during a fraternity trip to **Breckenridge** last month.

Summit Daily News - Top Stories

BRECKENRIDGE - Thirty-five teams of two lined up for the first running of the Five Peaks in **Breckenridge** on Saturday.

Summit Daily News - Top Stories

BRECKENRIDGE - Thirty-five teams of two lined up for the first

running of the Five Peaks in **Breckenridge** on Saturday.

[Summit Daily News - Top Stories](#)

BRECKENRIDGE - A presentation - "Our Energy Future: Policy and Politics" - will be held Friday from 7-8: 30 p.m. at the new Colorado Mountain College auditorium in **Breckenridge**.

[Summit Daily News - Top Stories](#)

BRECKENRIDGE - Authorities have concluded that no crime occurred when a Texas Christian University student's buttocks were branded with a hot hanger during a fraternity trip to **Breckenridge** last month.

[Summit Daily News - Top Stories](#)

BRECKENRIDGE, Colorado - On the heels of the record setting highest priced residence ever purchased in **Breckenridge**, \$8.29 million, another real estate record has been broken.

[Vail Daily - Top Stories](#)

BRECKENRIDGE - A trial date was set Monday for **Breckenridge** massage therapist Wang Kho, who faces a felony sexual assault charge regarding an incident with an 18-year-old female client.

Oktoberfest noun

 Save Word

Ok-to-ber-fest | \ äk'tōbə(r), fest \
plural -s

Definition of *Oktoberfest*

: a fall festival usually featuring beer drinking

First Known Use of *Oktoberfest*

1911, in the meaning defined [above](#)

History and Etymology for *Oktoberfest*

German, from *Oktober* October + *fest* festival

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10:28:15 AM 8/24/2022

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 26, 2022 for
U.S. Trademark Application Serial No. 97120356

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.