

To: Jeff Levy(trademark@rlflp.com)
Subject: U.S. Trademark Application Serial No. 97120228 - UPON A STAR - 5259.0005
Sent: August 24, 2022 01:52:57 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

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

U.S. Application Serial No. 97120228

Mark: UPON A STAR

Correspondence Address:

JEFF LEVY
RITHOLZ LEVY FIELDS LLP
235 PARK AVENUE SOUTH, THIRD FLOOR
NEW YORK NY 10003 UNITED STATES

Applicant: Inner Peace Studio LLC

Reference/Docket No. 5259.0005

Correspondence Email Address: trademark@rlflp.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 24, 2022

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.

SEARCH OF USPTO DATABASE OF MARKS

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.

SUMMARY OF ISSUES:

- Mark is the Name of a Performing Artist

MARK IS THE NAME OF A PERFORMING ARTIST

Registration is refused because the applied-for mark, as used on the specimen of record, merely identifies the name of a featured performer(s) on a sound recording; it does not function as a trademark to indicate the source of applicant's goods and to identify and distinguish them from others. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Polar Music Int'l AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983); *In re Arnold*, 105 USPQ2d 1953, 1957 (TTAB 2013). Sound recordings include musical and other performances on electronic, magnetic, or vinyl media or as downloadable files. *See* TMEP §1202.09(a).

Applicant may respond to this refusal by satisfying one of the following:

(1) Submitting evidence that (a) the name is used on a **series** of sound recordings, and (b) the performer **controls the quality** of the recordings and **controls the use** of the name, such that the name has come to represent an assurance of quality to the public. *See In re Polar Music Int'l AB*, 714 F.2d at 1572, 221 USPQ at 318; *In re Arnold*, 105 USPQ2d at 1958; TMEP §1202.09(a)-(a)(ii), (a)(ii)(B).

Evidence of a series includes photographs or screenshots of at least two different CD covers, webpages showing at least two different downloadable recordings, or similar types of images for at least two different recorded works that show the name sought to be registered. TMEP §1202.09(a)(i); *see In re Polar Music Int'l AB*, 714 F.2d at 1572, 221 USPQ at 318. This evidence must show the mark on goods that are actually being used with the goods sold in commerce.

Evidence of control. If the sound recordings are recorded directly under applicant's control, applicant may submit the following statement as evidence of control, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: "**The applicant produces the goods and controls their quality.**" TMEP §1202.09(a)(ii)(B); *see* 37 C.F.R. §2.193(e)(1). Other evidence of control includes licensing contracts or similar documentation. TMEP §1202.09(a)(ii)(B); *see In re Polar Music Int'l AB*, 714 F.2d at 1568-72, 221 USPQ at 316-18.

(2) Submitting evidence that (a) the name is used on a **series** of sound recordings, and (b) the name is **promoted and recognized by others** as the source of the series of sound recordings. *See In re Arnold*, 105 USPQ2d at 1958; TMEP §1202.09(a)-(a)(ii)(A).

Evidence of a series includes the items referenced above in response option (1).

Evidence of promotion and recognition includes advertising that promotes the name as the source of the series, third-party reviews showing use of the name by others to refer to the series, and declarations from the sound recording industry, retailers, and purchasers showing recognition of the name as an indicator of the source of a series of recordings. TMEP §1202.09(a)(ii)(A); *cf. In re First Draft, Inc.*, 76 USPQ2d 1183, 1191 (TTAB 2005); *In re Scholastic, Inc.*, 23 USPQ2d 1774, 1777-78 (TTAB 1992).

(3) Amending the application to seek registration on the **Supplemental Register**. Trademark Act Section 23(c), 15 U.S.C. §1091(c); *see* 37 C.F.R. §§2.47, 2.75(a); TMEP §§816, 1202.09(a).

If applicant cannot satisfy one of the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), and the refusal will be withdrawn. *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 along with satisfying one of the above requirements. *See* 15 U.S.C. §1051(c), (d); 37 C.F.R. §§2.76, 2.88; TMEP §1103. If the same specimen is submitted with an allegation of use, and applicant does not either provide the additional evidence described above or amend to the Supplemental Register, the same refusal will issue.

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 a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce 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).

Response guidelines. For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see [“Responding to Office Actions”](#) and the informational [video “Response to Office Action”](#) for more information and tips on responding.

Please email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

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

/Leah Barrett/
Leah Barrett
Trademark Examining Attorney
Law Office 126
(571) 272-6416
leah.barrett@uspto.gov

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.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 24, 2022 for
U.S. Trademark Application Serial No. 97120228

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.

Statistics for Case 97120228						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120226[sn]	1	0	1	1	0:00
2	*up\$on*[bi,ti] not dead[ld]	1563	0	0	0	0:02
3	*{"sz"}tar*[bi,ti] not dead[ld]	21726	0	0	0	0:00
4	2 and 3	17	0	17	17	0:00
5	2 and "009"[cc]	1037	0	0	0	0:01
6	2 and ("009" "035" "042" a b "200")[ic]	635	0	0	0	0:01
7	2 and ("009" a b "200")[ic]	262	0	262	262	0:02
8	2 and "041"[cc]	846	0	0	0	0:01
9	2 and ("041" "035" "042" a b "200")[ic]	663	0	0	0	0:01
10	2 and ("041" a b "200")[ic]	26	0	0	0	0:00
11	2 and ("041" a b "200")[ic]	300	0	300	300	0:01
12	"upon a star"	35	0	8	8	0:01
13	3 and "009"[cc]	11279	0	0	0	0:00
14	3 and ("009" "035" "042" a b "200")[ic]	6526	0	0	0	0:01
15	3 and ("009" a b "200")[ic]	3413	0	0	0	0:01
16	3 and "041"[cc]	9007	0	0	0	0:00
17	3 and ("041" "035" "042" a b "200")[ic]	6286	0	0	0	0:01
18	3 and ("041" a b "200")[ic]	3273	0	0	0	0:01
19	*{"sz"}tar[bi,ti] not dead[ld]	12790	0	0	0	0:01
20	19 and ("009" "041")[cc]	7473	0	0	0	0:00
21	19 and ("009" "041")[cc]	7473	0	0	0	0:01
22	19 and ("009" "041" "035" "042" a b "200")[ic]	4691	0	0	0	0:01
23	19 and ("009" "041" a b "200")[ic]	3372	0	0	0	0:01
24	19 and ("009" a b "200")[ic]	2064	0	0	0	0:01
25	19 and ("041" a b "200")[ic]	1561	0	0	0	0:01
26	star[bi,ti] not dead[ld]	10825	0	0	0	0:01
27	26 and ("009" "041")[cc]	6415	0	0	0	0:00
28	26 and ("009" "041" "035" "042" a b "200")[ic]	3999	0	0	0	0:01
29	26 and ("009" "041" a b "200")[ic]	2889	0	0	0	0:01
30	26 and ("009" a b "200")[ic]	1714	0	0	0	0:01
31	26 and ("041" a b "200")[ic]	1400	0	0	0	0:01
32	"uponastar"	1	0	1	1	0:00
33	"up on a star"	0	0	0	0	0:01

Session started 08/24/2022 11:28 am

Session ended 08/24/2022 11:38 am

Total search duration 26.00

Session duration 9 minutes 42 seconds

Adjacency Level 1

Near Level 1