

**To:** Nicole Haff([nicole@romanolaw.com](mailto:nicole@romanolaw.com))  
**Subject:** U.S. Trademark Application Serial No. 97119568 - SNORKEL MCCORKLE  
**Sent:** August 23, 2022 02:52:34 PM EDT  
**Sent As:** [tmng.notices@uspto.gov](mailto:tmng.notices@uspto.gov)

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**Attachments**

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

**U.S. Application Serial No.** 97119568

**Mark:** SNORKEL MCCORKLE

**Correspondence Address:**

NICOLE HAFF  
ROMANO LAW PLLC  
55 BROAD STREET, 18TH FLOOR  
NEW YORK NY 10004 UNITED STATES

**Applicant:** SNORKEL MCCORKLE LLC

**Reference/Docket No.** N/A

**Correspondence Email Address:** [nicole@romanolaw.com](mailto:nicole@romanolaw.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 23, 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**

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.

### **Portion of a Title of a Single Work Refusal**

Registration is refused because the applied-for mark, as used on the specimen of record, is used only as a portion of a title of a single creative work, namely, a portion of a title of a specific book or e-book; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Scholastic, Inc.*, 23 USPQ2d 1774, 1776-79 (TTAB 1992); TMEP §§1202.08, 1202.08(d); *cf. Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162-63, 64 USPQ2d 1375, 1378-79 (Fed. Cir. 2002); *In re Cooper*, 254 F.2d 611, 615-16, 117 USPQ 396, 399-400 (C.C.P.A. 1958).

In this case, the submitted specimen shows the applied-for mark, SNORKEL MCCORKLE, appearing describe location, on a book cover, or in product listings. Such use shows SNORKEL MCCORKLE to be the name of the main character in a book titled SNORKEL MCCORKLE AND THE LOST FLIPPER. There is no evidence in the application record that applicant's book/e-book is part of a series of creative works, nor are there other specimens or evidence in the record otherwise showing proper trademark use of the applied-for mark for the identified goods. While the record includes specimens for downloadable music files, the mark is not used in a manner that connotes an indicator of source for the downloadable audio goods. Rather, the listings describe the various audio files as theme music for the character/book. The downloadable audio files are sold via Etsy through an account titled SNORKELMCCORKLEBOOKS, which is different from the applied-for mark. Overall, consumers would view the applied-for mark as a portion of a title of a single work, rather than as a trademark to indicate the source of applicant's goods and to distinguish them from the goods of others.

An applicant may establish that the portion of the title of a creative work is used on a series by submitting more than one book cover or e-book cover with the mark used in all the titles. For example, if the mark on the drawing is "THE LITTLE ENGINE" and on the book it appears as "THE LITTLE ENGINE THAT WENT TO THE FAIR," registration should be refused because the mark is a portion of a title of a single work. *See In re Nat'l Council Books, Inc.*, 121 USPQ 198, 199 (TTAB 1959) (finding "NATIONAL" to be a portion of the title "NATIONAL GARDEN BOOK"). To establish use on a series, the applicant may submit additional book covers showing use of, e.g., "THE LITTLE ENGINE GOES TO SCHOOL," and "THE LITTLE ENGINE AND THE BIG RED CABOOSE." When a mark is used merely as a portion of the title of a creative work, the applicant has a heavier burden in establishing that the portion for which registration is sought serves as a trademark for the goods. The mere use of the same words in more than one book title is insufficient to establish the words as a mark for a series. The applicant must show that the public perceives the portion sought to be registered as a mark for the series. *In re Scholastic Inc.*, 23 USPQ2d 1774, 1777 (TTAB 1992) (holding THE MAGIC SCHOOL BUS used as a portion of the book titles in "THE MAGIC SCHOOL BUS AT THE WATERWORKS" and "THE MAGIC SCHOOL BUS INSIDE THE EARTH," functions as a mark for a series, because the record contained evidence of repeated use of the designation displayed prominently on book covers, as well as evidence that applicant promoted THE MAGIC SCHOOL BUS as a series title, that others used the designation in book reviews to refer to a series of books, and that purchasers recognized the designation as indicating the source of a series of books).

In appropriate circumstances, applicant may overcome this refusal by satisfying one of the following options:

(1) **Submit evidence** that the applied-for mark (a) is used on a **series** of creative works, (b) creates a **separate commercial impression** apart from the complete title, and (c) is **promoted or recognized** as a mark for the series.

(2) **Amend the filing basis** to [intent to use under Section 1\(b\)](#) (which includes withdrawing an amendment to allege use, if one was filed). This option will later necessitate additional fee(s) and filing requirements.

For an overview of these response options and instructions on how to satisfy each option using the Trademark Electronic Application System (TEAS) response form, see the [Title of a Single Work](#) webpage.

### **Assistance**

Please call or 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.](#)

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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.

## United States Patent and Trademark Office (USPTO)

### USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued  
on August 23, 2022 for  
**U.S. Trademark Application Serial No. 97119568**

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.

# Note To The File

Serial Number: 97119568  
Date: 08/23/2022 2:48 pm  
Created by: Jordan Baker

SNORKEL MCCORKLE

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## Searched

- Google

User: Jordan Baker

| Statistics for Case<br>97119568 |                                 |                |               |                     |                       |                           |
|---------------------------------|---------------------------------|----------------|---------------|---------------------|-----------------------|---------------------------|
| #                               | Search                          | Total<br>Marks | Dead<br>Marks | Live Viewed<br>Docs | Live Viewed<br>Images | Status/Search<br>Duration |
| 1                               | 97119568                        | 1              | 0             | 1                   | 1                     | 0:00                      |
| 2                               | "snorkel mccorkle"[on]          | 1              | 0             | 1                   | 1                     | 0:00                      |
| 3                               | *sn\$1{v0:2}r\$1{"ckqx"}*       | 320            | 0             | 131                 | 131                   | 0:02                      |
| 4                               | *m{"ckq"}\$1{v0:2}r\$1{"ckqx"}* | 176            | 0             | 64                  | 64                    | 0:02                      |
| 5                               | 3 and 4                         | 1              | 0             | 1                   | 1                     | 0:01                      |

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