To:	CyberNet Entertainment (mrandazza@firstamendment.com)
Subject:	TRADEMARK APPLICATION NO. 78680513 - FUCKINGMACHINES - N/A
Sent:	10/5/2006 2:59:58 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/680513

APPLICANT: CyberNet Entertainment

78680513

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MARK: FUCKINGMACHINES

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at http://tarr.uspto.gov/, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/680513

This letter responds to applicant's communication filed on August 22, 2006.

The Office has reassigned this application to the undersigned trademark examining attorney.

The substitute specimen is accepted, and the specimen requirement is satisfied and withdrawn.

The proposed amendment to the identification cannot be accepted because it refers to services that are not within the scope of the identification that was set forth in the application at the time of filing. While the identification of services may be amended to clarify or limit the services, additions to the identification or a broadening of the scope of the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07.

The original identification of services, which was acceptable, was "Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials."

Applicant wishes to amend the identification of services to "Entertainment, instruction, and commentary of an erotic/sexual nature, created by and for adults only, presented in images, recorded audio, recorded video, transmitted over the internet a website with access limited to adult viewers, excluding any use of the Mark other than in media or venues where erotic and adult-oriented content is provided."

The language limiting access to applicant's web site to adults, and its venues to those where adult-oriented conduct is provided, are acceptable limitations on the services.

The language regarding "instruction, and commentary …" is outside the scope of the original recitation of services.

If applicant wishes to continue prosecution of this application, applicant may return to the original identificaton of services, or adopt the following recitation of services:

Entertainment services of an erotic/sexual nature, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials, with access limited to adult viewers, excluding any use of the Mark other than in media or venues where erotic and adult-oriented content is provided."

Section 2(a) Refusal Maintained and Continued

The refusal under Trademark Act Section 2(a) is maintained and continued for the reasons set forth below. 15 U.S.C. §1052(a); 37 C.F.R. §2.64(a).

To be considered "scandalous," a mark must be "shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; … giving offense to the conscience or moral feelings; … [or] calling out for condemnation," in the context of the marketplace as applied to goods or services described in the application. *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1930 (TTAB 1996). Scandalousness is determined from the standpoint of "not necessarily a majority, but a substantial composite of the general public, … and in the context of contemporary attitudes." *Id.*

Applicant advances three arguments for withdrawal of the Section 2(a) scandalous refusal. The constitutional argument will not be addressed here. Applicant's constitutional argument would appear to render void Section 2(a) of the Trademark Act. A determination that Section 2(a) is unconstitutional cannot be made by an examining attorney, and must be pursued

by way of an appeal to the Trademark Trial and Appeal Board.

Applicant also argues that the potential consumers for applicant's adult entertainment services, as opposed to the general public, would not find the mark scandalous. This argument has some merit, and some support in the above quoted language from *Mavety Media Group*. However, applicant's argument, if accepted, would mean that Section 2(a) would almost never be applied to marks used in connection with pornographic goods and services. The Office has not adopted this policy, and instead determines scandalousness from the viewpoint of "a substantial composite of the general public." As in the case of applicant's constitutional argument, any change in Office policy can only occur pursuant to an appeal to the Trademark Trial and Appeal Board.

Applicant's third argument is that due to widespread usage and changes in social attitudes, the term "fucking" is no longer immoral or scandalous.

Although the word is frequently used, it still is considered shocking in most formal or polite situations. For example, the word is bleeped out on basic cable, and broadcasters can be fined by the FCC for letting the word go out over the airwaves. The examining attorney believes the dictionary entry attached to the previous office action is sufficient to establish that a substantial composite of the general public would find the mark offensive.

Where no other relevant, non-scandalous, meanings of the allegedly scandalous matter are evident from the record, reliance solely on dictionary definitions is sufficient to demonstrate the scandalous nature of the proposed mark. *See, e.g., In re Boulevard Entertainment, Inc.*,334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (1-800-JACK-OFF and JACK OFF held scandalous where all dictionary definitions of "jack-off" were considered vulgar); *In re Tinseltown, Inc.*, 212 USPQ 863 (TTAB 1981) (BULLSHIT held scandalous where all dictionary definitions of that term were considered vulgar); *cf. In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1373, 31 USPQ2d 1923, 1928 (Fed. Cir. 1994) ("[i]n view of the existence of such an alternate, non-vulgar definition," it was error to find BLACK TAIL scandalous solely on dictionary definitions).

The more egregious the allegedly scandalous nature of a mark, the less evidence required to support a conclusion that a substantial composite of the general public would find the mark scandalous. *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (less evidence required; "the inclusion in a mark of a readily recognizable representation of genitalia certainly pushes the mark a substantial distance along the continuum from marks that are relatively innocuous to those that are most egregious").

Registration is refused under Section 2(a) because a substantial composite of the general public would find the mark offensive.

Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

/Michael Engel/

Trademark Examining Attorney

Law Office 107

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HOW TO RESPOND TO THIS OFFICE ACTION:

- ONLINE RESPONSE: You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at http://www.uspto.gov/teas/index.html. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE**.
- REGULAR MAIL RESPONSE: To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office,*** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at http://tarr.uspto.gov.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at http://portal.uspto.gov/external/portal/tow.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at http://www.uspto.gov/main/trademarks.htm

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.