PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85472044
Filing Date: 11/14/2011

NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	**YES**
MARK INFORMATION	
***MARK**	THE SLANTS
***STANDARD CHARACTERS**	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	THE SLANTS
***MARK STATEMENT**	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
***OWNER OF MARK**	Tam, Simon Shiao
***STREET**	8026 S.E. Reedway St.
***CITY**	Portland
***STATE** **(Required for U.S. applicants)**	Oregon
***COUNTRY**	United States
***ZIP/POSTAL CODE** **(Required for U.S. applicants only)**	97206
PHONE	(503) 754-8703
LEGAL ENTITY INFORMATION	

*TYPE	INDIVIDUAL
* COUNTRY OF CITIZENSHIP	United States
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	041
IDENTIFICATION	Entertainment in the nature of live performances by **a musical band**
*FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 11/15/2006
FIRST USE IN COMMERCE DATE	At least as early as 11/15/2006
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT11\IMAGEOUT 11\854\720\85472044\xml1\ FTK0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT 11\854\720\85472044\xml1\ FTK0004.JPG
	\\TICRS\EXPORT11\IMAGEOUT 11\854\720\85472044\xml1\ FTK0005.JPG
SPECIMEN DESCRIPTION	Flyers advertising performances
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	Ronald Coleman
FIRM NAME	GOETZ FITZPATRICK LLP
INTERNAL ADDRESS	1 Penn Plaza
STREET	Suite 4401
CITY	New York
STATE	New York

COUNTRY	United States
ZIP/POSTAL CODE	10119
PHONE	2126958100
EMAIL ADDRESS	rcoleman@goetzfitz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	
***NAME**	Ronald Coleman
FIRM NAME	GOETZ FITZPATRICK LLP
INTERNAL ADDRESS	1 Penn Plaza
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***CITY**	New York
***STATE** **(Required for U.S. applicants)**	New York
***COUNTRY**	United States
***ZIP/POSTAL CODE**	10119
PHONE	2126958100
***EMAIL ADDRESS**	rcoleman@goetzfitz.com
***AUTHORIZED TO COMMUNICATE VIA EMAIL**	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	275
***TOTAL FEE PAID**	275
SIGNATURE INFORMATION	
***** **SIGNATURE**	/Simon Shiao Tam/
***** **SIGNATORY'S NAME**	Simon Shiao Tam
***** **SIGNATORY'S POSITION**	Owner
***** **DATE SIGNED**	11/14/2011

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85472044
Filing Date: 11/14/2011

To the Commissioner for Trademarks:

MARK: THE SLANTS (Standard Characters, see mark)
The literal element of the mark consists of THE SLANTS.
The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Simon Shiao Tam, a citizen of United States, having an address of
8026 S.E. Reedway St.
Portland, Oregon 97206
United States
requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.
International Class 041: Entertainment in the nature of live performances by a musical band

In International Class 041, the mark was first used at least as early as 11/15/2006, and first used in commerce at least as early as 11/15/2006, and is now in use in such commerce. The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Flyers advertising performances.
Specimen File1
Specimen File2
Specimen File3

The applicant's current Attorney Information:
Ronald Coleman of GOETZ FITZPATRICK LLP
1 Penn Plaza
Suite 4401
New York, New York 10119
United States

The applicant's current Correspondence Information:

Ronald Coleman
GOETZ FITZPATRICK LLP
1 Penn Plaza
Suite 4401
New York, New York 10119
2126958100(phone)
rcoleman@goetzfitz.com (authorized)

A fee payment in the amount of $275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Simon Shiao Tam/ Date Signed: 11/14/2011
Signatory's Name: Simon Shiao Tam
Signatory's Position: Owner

RAM Sale Number: 4120
RAM Accounting Date: 11/15/2011

Serial Number: 85472044
Internet Transmission Date: Mon Nov 14 16:48:48 EST 2011
TEAS Stamp: USPTO/FTK-66.251.23.10-20111114164848549
373-85472044-4808b9c85f3636e2c33bf8b705e
545ba2b7-CC-4120-20111114153506454362

THE SLANTS


THE SUNSET PRESENTS SUNDAY BLOODY SUNSET
WITH
THE MOON-SPINNERS
THE SLANTS
THE GET-OFF
THE SUNSET
5433 BALLARD AVE
SEATTLE
KB-CHAW
$5
SUNDAY MARCH 1ST - 4PM
FEATURING: $2 PBR'S - $3 BLOODY MARY'S

THE VAGUE PROPHETS

THE SLANTS

THE SUBTERRANEAN HOWL

SUNDAY MAY 24TH 7:00

HIGH DIVE

BURNSIDE SXSW SHOWCASE

SUBMERGED

WEDNESDAY MARCH 18TH
333 E. SECOND ST.
AT TRINITY

STARRING:

JACKIE BRISTOW 8 PM
THE SUMMER WARDROBE 9 PM
THE SERVICE INDUSTRY 10 PM
SWEET WATER 11 PM
BLIND PILOT 12 AM
THE SLANTS 1 AM

SXSW 09 music

SUBMERGED

R rock.

www.bdcdistribution.com

BDC burnside distribution corporation

To:	Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A
Sent:	1/6/2012 2:08:58 PM
Sent As:	ECOM102@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5 Attachment - 6 Attachment - 7 Attachment - 8 Attachment - 9 Attachment - 10 Attachment - 11 Attachment - 12 Attachment - 13 Attachment - 14 Attachment - 15 Attachment - 16 Attachment - 17 Attachment - 18 Attachment - 19 Attachment - 20 Attachment - 21 Attachment - 22 Attachment - 23 Attachment - 24 Attachment - 25 Attachment - 26 Attachment - 27 Attachment - 28 Attachment - 29 Attachment - 30 Attachment - 31 Attachment - 32 Attachment - 33 Attachment - 34 Attachment - 35

Attachment - 159
Attachment - 160
Attachment - 161
Attachment - 162

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

CORRESPONDENT ADDRESS:
RONALD COLEMAN
GOETZ FITZPATRICK LLP
1 PENN PLZ STE 4401
NEW YORK, NY 10119-0196

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A
CORRESPONDENT E-MAIL ADDRESS:
rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/6/2012

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 OFFICE'S DATABASE OF MARKS

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

SECTION 2(A) – MARK IS DISPARAGING

Registration is refused because the applied-for mark consists of or includes matter which may disparage or

bring into contempt or disrepute persons, institutions, beliefs or national symbols. Trademark Act Section 2(a), 15 U.S.C. §1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd* , 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding "no error in the TTAB's articulation of [the Section 2(a)] test for disparagement"), *remanded on other grounds*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd* , 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); TMEP §§1203.03, 1203.03(c).

The following two factors must be considered when determining whether matter may be disparaging under Trademark Act Section 2(a):

> (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services; and
>
> (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

In re Squaw Valley Dev., 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP §1203.03(c).

To "disparage" means "to speak slighting[ly] of: run down: depreciate." *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1276 (TTAB 2006) (internal punctuation omitted) (quoting *Webster's Third New International Dictionary* (unabridged ed. 1993)). The determination of whether a mark is disparaging depends upon the perspective of the object of disparagement. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1217 (TTAB 2010); *see also* TMEP §1203.03(c). A mark may be disparaging in two ways:

> (1) Matter that is not, in and of itself, disgusting or otherwise unpleasant, may be applied or combined in such a way that it is offensive to the disparaged party. See, e.g., In re Anti-Communist World Freedom Cong., Inc., 161 USPQ 304, 305 (TTAB 1969) (holding design of an "X" superimposed over a hammer and sickle to disparage, and to bring into contempt and disrepute, a national symbol of the U.S.S.R.).; or
>
> (2) Matter may be inherently offensive, and, when directed at a specific individual or entity, may become even more offensive. See, e.g., Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d 1635, 1640 (TTAB 1988) (noting "the offensiveness of [applicant's mark, depicting a defecating dog,] becomes even more objectionable because it makes a statement about opposer itself").

The attached evidence shows the likely meaning of "THE SLANTS" to be a negative term regarding the shape of the eyes of certain persons of Asian descent. *See* attached definitions of "Slant". This refers to "persons of Asian descent" in a disparaging manner because it is an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals. *See* Online Etymology Dictionary, Mother Chronicles, "Slant Eyes, Almond Eyes, What's in those Chinese Eyes?".

The term "slants" and the full equivalent "slant-eyes" has long been a derogatory term directed towards those of Asian descent. The etymology of the term suggests that its use became prevalent during the various wars of the 20th century, starting with World War II and increasing in use in the Vietnam war as a

term to deride and mock the citizens of the countries at war with the United States and those of Asian descent in general. *See* The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United States.

Since that time, the research of the Office indicates that the term "slants" retains it's offensive and derogatory meaning. Importantly, the oldest and largest Asian American civil rights organization in the United States, the Japanese American Citizens League (JACL), has uissued a publication on hate speech that specially states that the term "slant" is derogatory and should not be used. *See* attached webpage excerpt and literature on hate speech from JACL. Moreover, numerous dictionaries define "slants" or "slant-eyes" as a derogatory or offensive term. *See* attached definitions from, among others, Oxford Dictionary of Modern Slang, American Heritage Dictionary, Online Etymology Dictionary, New Partridge Dictionary of Slang and Unconventional English, The Color of Words: An Encyclopedic Dictionary of Ethnic Bias in the United States, American English Compendium, and Urbandictionary.com. Further, many listings of slang and offensive terms include the word "slants" and its derivatives such as slant-eyes, slanted-eyes, and the pictoral representation as a slur or derogatory. *See* listing of racial slurs from Wikipedia.org, http://gyral.blackshell.com/names.html, http://www.asianjoke.com/others/ethnic_slurs.htm, and www.fact-index.com/list_of_ethnic_slurs.html.

More specifically, the band's name has been found offensive numerous times. First, a band performance and a speaking engagement for the lead singer were cancelled because there had been concerns raised over the name of his band. *See* The Daily Swarn, "Oregon Governor Cancels Asian Band the Slants' Performance at Asian Youth Conference." Second, articles on the band have noted that the name has been controversial and that the band chose the name, in part due to the history of the term. *See* Northwest Asian Weekly, "Rock band to trademark Office: Our Name is Not Disparaging to Asians", "Shuffled! The Slants". Further, several bloggers and commenters to articles on the band have indicated that they find the term and the applied-for mark offensive, even after extensive dialogue with the applicant. *See* attached blogs and article comments, including BigWOWO and Ben Efsaneyim.

Applicant may have chosen the applied-for mark to be self-deprecating and to attempt tp reappropriate the disparaging term. The lack of a disparaging intent is not dispositive on the issue of Section 2(a) disparagement in the Federal registration analysis. The intent of an applicant to disparage the referenced group is not necessary to find that the mark does, in fact, disparage that group. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1220 (TTAB 2010); *see also In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB 1969) (finding applicant's intent to disparage the referenced group immaterial to the disparagement determination). Further, while applicant may not find the term offensive, applicant does not speak for the entire community of persons of Asian descent and the evidence indicates that there is still a substantial composite of persons who find the term in the applied-for mark offensive.

Please note that the denial of the trademark application does not mean that the applicant must use a different name with its music performances or is otherwise prohibited from using the wording "The Slants" in association with its music. Rather, it is a denial of a federally registered trademark, not the right to use the words. *See In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) (quoting *In re McGinley*, 211 USPQ 668, 672 (CCPA 1981) ("[I]t is clear that the PTO's refusal to register [applicant's] mark does not affect [its] right to use it. No conduct is proscribed….").

The Office research indicates that the applied-for mark remains disparaging to a substantial composite of Asian-Americans. Accordingly, registration is refused under Section 2(a) as disparaging.

GENERAL INFORMATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Mark Shiner/
Trademark Examining Attorney
Law Office 102
Phone: 571-272-1489
E-mail: mark.shiner@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

To:	Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A
Sent:	1/6/2012 2:09:00 PM
Sent As:	ECOM102@USPTO.GOV
Attachments:	

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION HAS ISSUED ON 1/6/2012 FOR SERIAL NO. 85472044

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this **link** **or** go to **http://portal.uspto.gov/external/portal/tow** and enter the application serial number to **access** the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable **response time period**. Your response deadline will be calculated from **1/6/2012** (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System Response Form.

HELP: For *technical* assistance in accessing the Office action, please e-mail **TDR@uspto.gov**. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon Shiao Tam Mark: THE SLANTS Serial No.: 85472044 Filing Date: March 5, 2010	Examining Attorney: Mark Shiner Law Office: 102

RESPONSE TO OFFICE ACTION DATED JANUARY 6, 2012

Applicant submits this response to the Office Action dated January 6, 2012, in which the Examining Attorney refused registration of Applicant's standard character mark on the grounds that the mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a). In response, Applicant respectfully submits the following:

I. THE APPLICATION DOES NOT JUSTIFY A FINDING THAT THE APPLICANT'S STANDARD CHARACTER MARK IS DISPARAGING.

The Examining Attorney relied, in making his denial, on materials assertedly showing the "likely meaning" of "THE SLANTS" to be "a negative term regarding the shape of the eyes of certain persons of Asian descent," citing sources indicating that the word can refer to "persons of Asian descent . . . in a disparaging manner" and "is an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals."

Applicant disputes the relevance of these materials, and certainly the conclusion the Examining Attorney draws from them, for reasons set forth below. Fundamentally, Applicant's response is that in contrast to all disparagement-based refusals to register cited by the Examining Attorney, the applied-for mark "THE SLANTS" has meanings other than the disparaging

meaning that is the Examining Attorney deemed "likely," the word "slant" being a common English word (and the dominant portion of numerous trademark registrations). The Application provides no basis, based on the goods or services described in the application for registration, for the Examining Attorney's conclusion that the likely meaning of the mark is in the disparaging sense.

Indeed, as demonstrated below, the Examining Attorney's finding that the "likely meaning" of "slant" is an ethnic slur was achieved by refusing even to consider the neutral meanings of the word and by bypassing the actual Application submitted – on which no such finding could be based – and instead building an entire independent record as a predetermined basis for that conclusion. As demonstrated below, both of these approaches were improper.

A. Application of the Relevant Legal Standard for Choosing Among Disparaging or Non-Disparaging Meanings of the words "The Slants"

As the Office Action notes, the first question that must be addressed under Section 2(a) is "What is the **likely meaning** of the matter in question . . ." in light of the circumstances. *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264 (TTAB 2006) (emphasis added). In determining such meaning, the PTO as adjured to consider "**not only** dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace" based on use of the marks "on applicant's identified goods and services" (emphasis added).

The premise of the *Squaw Valley* formulation is that a dictionary definition may well be insufficient authority on which to determine whether a trademark is disparaging meaning; i.e., while not dispositive, dictionary definitions are relevant to the inquiry. Two corollaries follow: (1) where the dictionary definition does not, by itself, support a finding of disparagement, that

fact standing alone favors the Applicant; and (2) if a dictionary, or even the full scope of sources set forth in Squaw Valley, suggest that the trademark is amenable to multiple meanings, the burden is on the PTO to demonstrate why one meaning and not another is the likely meaning.

a. Cases Relied on by the Examining Attorney

The Examining Attorney cited several cases in the Office Action, each of which is materially distinguishable from this case mainly because they involve trademarks whose meanings – based either on their sole or at least dominant definitions, or the facts in the respective applications – could **only** be disparaging:

- In *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010), the subject trademark was KHORAN, for use with alcoholic beverages. This was, unsurprisingly, found to constitute disparagement because Islam prohibits the consumption of alcoholic beverages. There was no neutral interpretation of the mark in juxtaposition with the use.
- *In re Anti-Communist World Freedom Cong., Inc*., 161 USPQ 304 (TTAB 1969) concerned disparagement of a "national symbol" – the hammer-and-sickle symbol of the Soviet Union – whose symbolism was amenable only to that association.
- *In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) concerned the trademark HEEB, a disparaging term for Jews with no other English meaning.
- The trademark in *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264 (TTAB 2006) was SQUAW – an offensive term referring to a female American Indian and meaning nothing else.

- And *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) involved the use of the mark REDSKINS, also regarded as demeaning by American Indians and also lacking any other definition.

In not one of the cases cited by the Examining Attorney was the subject trademark a plain English word, such as "slants," that only **could, but need not,** have a disparaging connotation. Each and every one of them involved a trademark that could only be offensive based on the four corners of the application – the mark itself (i.e., the word or term), the description and the specimens. In extending these cases to the Application, where the registration sought is for a standard English word having multiple meanings and where nothing in the Application provides grounds for finding the use of the term disparaging, the Office Action represents a significant departure from precedent and an unwarranted extension of 15 U.S.C. §1052(a).

Indeed, unlike the various offensive terms cited by the Examining Attorney via case law and otherwise known to have been rejected for registration, the word "slant," in singular or plural form, is the dominant portion of numerous registrations, many of them quite recent.[1] While PTO decisions respecting registration are not precedential, in this case these registrations can hardly be ignored as demonstrations that the word "slant" is in and of itself a registrable term. The Office Action neither demonstrates that the use of the same word as a trademark for "entertainment in the nature of live performances by a musical band" is disparaging, nor that any

[1] These include, for example, the following (see Exhibit A) – there are many more in addition to these:

- SLANTS, Serial Number 85269787 (ITU), published for opposition August 2, 2011
- SLANT, Registration Number 4123704 dated April 10, 2012
- SLANT, Registration Number 3894536 dated December 21, 2010
- SLANT, Registration Number 3437238 dated May 27, 2008
- SLANT, Registration Number 3437230 dated May 27, 2008

other matter found in the Application provides a basis for the Examining Attorney's conclusion regarding the mark's "likely meaning."

Seen this way the Office Action seems to amount to a prohibition against registration by this Applicant *ad hominem* – a ruling that this Applicant is different from others whose "slant" registrations have been allowed, and the implication that if an identical application were filed under a different name, it would have been. Such a result could not be justified by any rule or legal precedent, and in and of itself raises troubling legal questions that need not be addressed in this Response.

b. Definitions of the Word "Slant"

1. Dictionary and other Definitions provided by the Examining Attorney

The Examining Attorney has taken a rule authorizing him to go **beyond** dictionary definitions as permission to **ignore** the most authoritative dictionary definitions entirely. In fact, the Office Action makes no effort even to cite entries from actual dictionaries, with the exception of a reference from the *American Heritage Dictionary* that ignores **three** inoffensive definitions given for the word "slant" and relies on the fourth, slang entry. In doing so, the Examining Attorney proceeded as if seeking an offensive definition to the exclusion of all else, disregarding, without explanation, that fact in the *American Heritage Dictionary*, "Entries containing more than one sense are arranged for the convenience of the reader with the central and often the most commonly sought meaning first."[2] The Examining Attorney did not provide any justification for disregarding the three more common definitions, or in any way address the fact that the word "slant" primarily has an inoffensive meaning.

[2] The American Heritage Dictionary of the English Language website, found at http://ahdictionary.com/word/howtouse.html, last visited May 2, 2012.

To the contrary, in order to "demonstrate" that the fourth-level definition sought to be emphasized by the Examining Attorney is supported by a mass of authority, the Office Action sets forth the results of an extensive, but predetermined and outcome-directed inquiry directed to works that are not dictionaries at all, or certainly not dictionaries as that term was meant by the *Squaw Valley* formulation of "not only dictionary definitions." For example, the Examining Attorney cites a book called *The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United* to elucidate the history of the ethnic slur associated with the word "slant," fully aware that this book is a "dictionary of terms associated with racial discrimination"[3] – guaranteeing that the mere existence of an entry in the book would "prove" a disparaging meaning, and would shed no light on whether the word in question has a non-discriminatory meaning as well.

Most of the other works cited by the Examining Attorney that describe themselves as "dictionaries" also, by their own terms, narrow the field of inquiry so as to exclude standard English definitions of the word in question. Indeed, the Office Action states, "many listings of slang and offensive terms include the word 'slants' and its derivatives such as slanteyes, slanted-eyes, and the pictorial representation as a slur or derogatory." But the Examining Attorney has, it is submitted, done no more than demonstrated a "converse error," which is the logical fallacy of "affirming the consequent" – reversing or confusing the general category with the specific or sub-category. Naturally if one peruses a list of "forbidden words" for a specific word – albeit one that also has a "permissible" use also – the mere confirmation that the word is on that list constitutes a "false positive." The exercise serves only to confirm a preexisting and relatively uncontroversial premise, namely that the word "slant" has a disparaging meaning – much in the way that it has been said a censor will, inevitably, "feed" his own prurient interests if he looks

[3] *Library Journal*, quoted by Amazon.com at the entry for the work found at http://www.amazon.com/The-Color-Words-Encyclopaedic-Dictionary/dp/1877864420, last visited May 2, 2012.

hard enough at the material in question.[4] Such an exercise sheds no light at all on whether that meaning is the dominant one, however, or even close to being dominant, and improperly exempted the Examining Attorney from any explanation as to why the disparaging definition of "slant" was to be inferred from the application over the non-disparaging ones.

Further consideration of the content of the lists and sources relied on by the Examining Attorney, in fact, is illuminating, and further demonstrates their very limited usefulness for the purposes to which they have been put in the Office Action. For example, the Office Action gives, as an additional authority, an anonymous website called the "Racial Slurs Database" found at http://gyral.blackshell.com/names.html. Perusing that list, a user will learn that the following English words are, along with "slants," also presumably "disparaging" and not eligible for trademark registration:

- Apple
- Banana
- Cans
- Beanie
- Brother
- Bumblebee
- Cabdriver
- Canal

These are just a few examples; Applicant has not proceeded beyond the "C's."

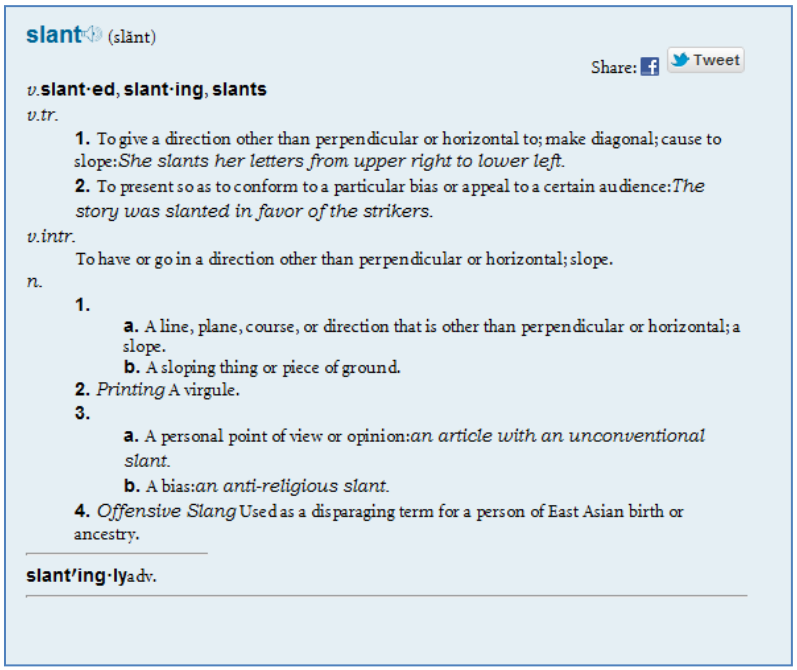
The point of this discursion is to demonstrate that finding a word amenable to numerous meanings on a list of ethnic slurs is of little weight when considering whether it is in fact disparaging. Such lists certainly do not constitute "dictionary definitions." And in and of themselves they reveal nothing about "the relationship of the matter to the other elements in the

[4] The humorist Dick Cavett is quoted as saying, specifically, "Censorship feeds the dirty mind more than the four-letter word itself."

mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services" and should not have been relied on by the Examining Attorney absent any content in the Application suggesting that an ethnic-oriented meaning of the word was the one intended by the Application.

2. Dictionary Definitions not Considered by the Examining Attorney

As noted above, in providing a definition for THE SLANTS, the Examining Attorney relied in part on the *American Heritage Dictionary*, leaping over almost the entire entry in that work defining the word "slant" to find a fourth, slang definition that fit a preconceived notion. It is worthwhile, however, for the record to indicate what, in fact, was overlooked in the body of the Office Action, although it was displayed as a screen capture of that dictionary's entry included in its exhibits, as reproduced below:[5]



slant (slānt)

Share: Tweet

v. **slant·ed, slant·ing, slants**

v.tr.

1. To give a direction other than perpendicular or horizontal to; make diagonal; cause to slope: *She slants her letters from upper right to lower left.*

2. To present so as to conform to a particular bias or appeal to a certain audience: *The story was slanted in favor of the strikers.*

v.intr.

To have or go in a direction other than perpendicular or horizontal; slope.

n.

1.

a. A line, plane, course, or direction that is other than perpendicular or horizontal; a slope.

b. A sloping thing or piece of ground.

2. *Printing* A virgule.

3.

a. A personal point of view or opinion: *an article with an unconventional slant.*

b. A bias: *an anti-religious slant.*

4. *Offensive Slang* Used as a disparaging term for a person of East Asian birth or ancestry.

slant'ing·ly *adv.*

[5] "Slant" in *The American Heritage Dictionary of the English Language*, found at http://ahdictionary.com/word/search.html?q=slant &submit.x=0&submit.y=0 , last visited May 2, 2012.

Applicant respectfully submits that there is nothing in the Application to even suggest that definition number (4), describing the offensive slang on which the Examining Attorney relies in denying registration, is more likely to be the Applicant's intended meaning of the mark than the first three, more common or "central" meanings of the word.[6]

B. Application of the Relevant Legal Standard for Evaluating Disparaging Use to the Pending Application

To justify refusing to register a trademark under the first clause of section 1052(a), the PTO must, in addition to weighing the factors set forth in the last quotation, "consider the mark in the context of the marketplace as applied to **only the goods described** in [the] application for registration." *In re Mavety Media Group Ltd*., 33 F.3d 1367, 1371 (Fed. Cir. 1994) (emphasis added), citing *In re McGinley*, 660 F.2d 481, 485, 211 USPQ 668, 673 (CCPA 1981). It is respectfully submitted that the Examining Attorney overlooked the actual content of the Application, which is devoid of any reference to Asians, to conclude that THE SLANTS must be a reference to Asians.

c. Goods and services described in the application

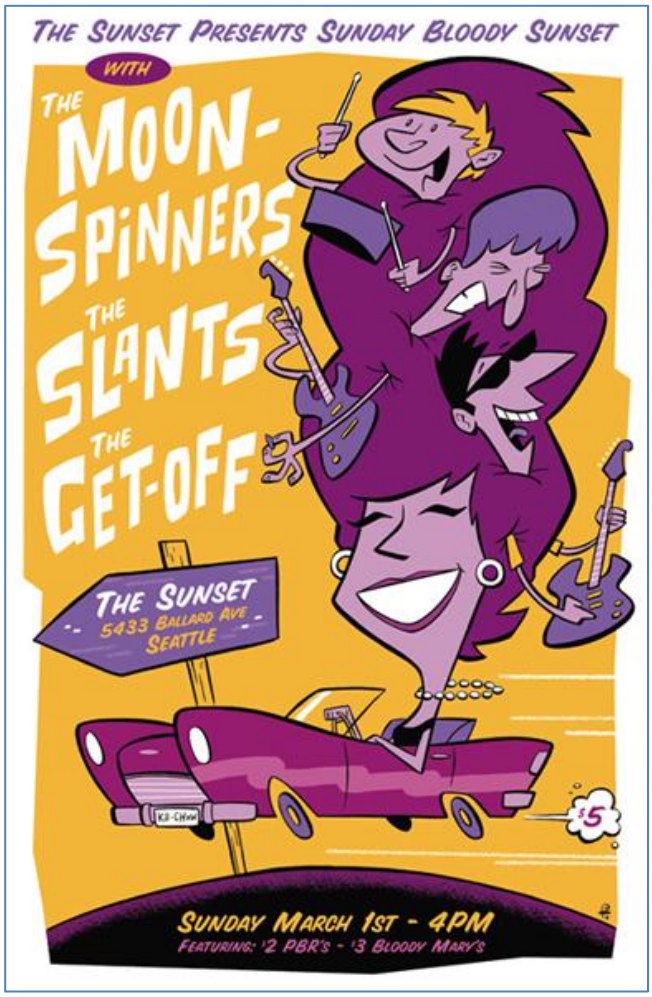
1. Description

The description of goods and services provided in connection with the mark found in the Application is "Entertainment in the nature of live performances by a musical band." Nothing in this description refers to Asians, and cannot, therefore, justify the Examining Attorney's "likely meaning" conclusion.

[6] See also, Oxford English Dictionary, reproduced as Exh. B hereto, showing the ethnic-slang definition of "slant" as the **tenth** out of ten definitions.

2. Specimens

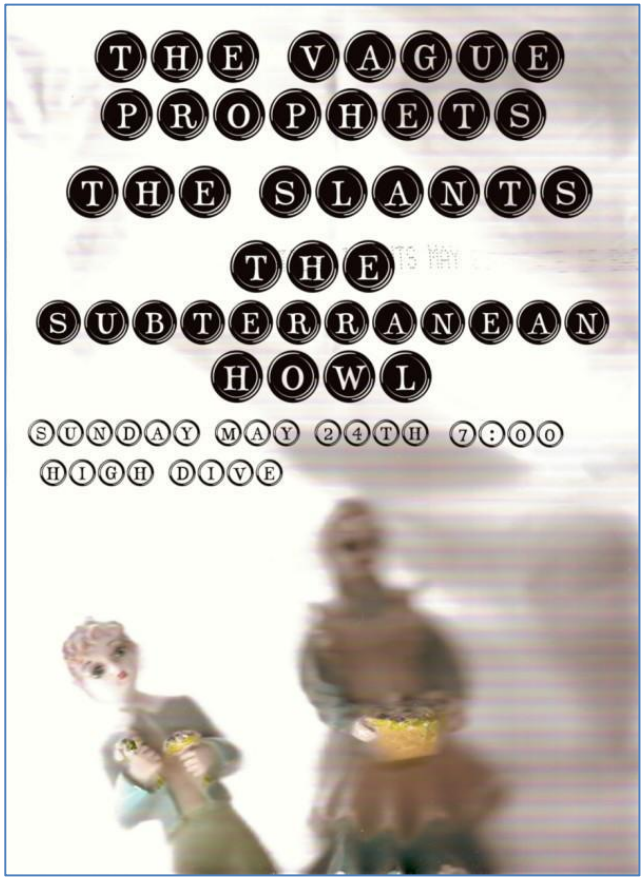
The specimens submitted in support of the Application are three advertisements for the musical band referred to in the description. The Examining Attorney at no time requested additional or replacement specimens. The specimens submitted with the Application, to which the Office Action makes no reference but which are in fact an appropriate basis for the Examining Attorney to consider the Applicant's use of the mark, are reproduced here for convenience.



Specimen 1

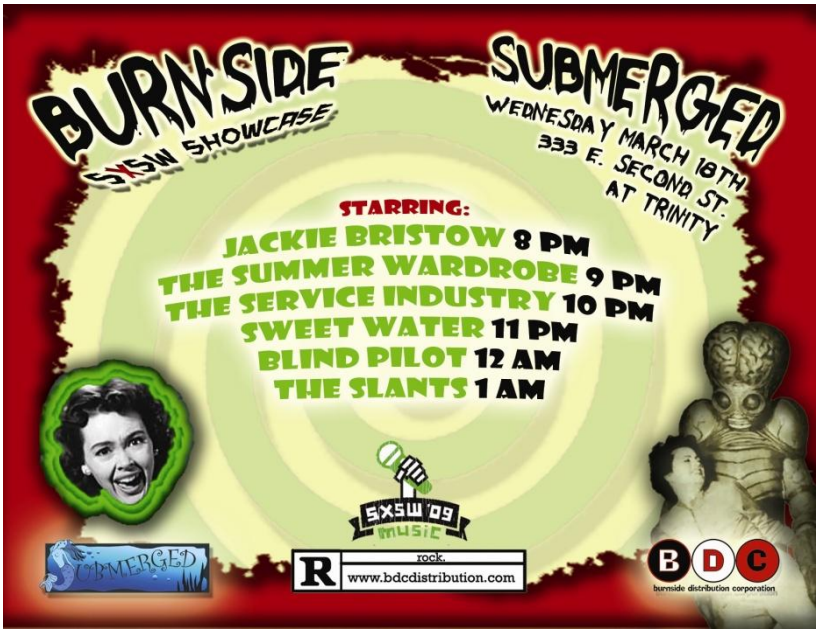
Specimen (1), reproduced at left, displays the names of three musical bands, "The Moon Spinners," "The Slants," and "The Get-Offs," who are to be performing at a venue called The Sunset, located in Seattle, Washington. Four stylized human figures are depicted, three of which are shown playing musical instruments with rock-and-roll–style verve and enthusiasm, and emerging from within the elevated beehive-style hairdo of a fourth, larger, female figure who is driving a 1950's style automobile. None of the characters shown on Specimen (1) could be described as possessing Asian features, either stereotyped or otherwise. Nor could the automobile. No other indicia or associations with Asian persons are present.

Specimen (2), at right, refers to a performance, also by three ensembles including The Slants, at a venue called "High Dive." Unlike Specimen (1), this handbill is "highly conceptual," i.e., it bears no perceivable relation to the bands performing or their names, or high diving, or even to music, entertainment or anything clear at all. It depicts two eerie, doe-eyed female figurines or dolls, one of which is blurry and the other of which is leaning precipitously. Nothing about this hallucinogenic imagery suggests any association with Asians, so, like Specimen (1), there is no ground based on this specimen to find that the use of the mark justifies the Examining Attorney's presumption that the THE SLANTS is being used in its unusual, disparaging sense.



Specimen 2

Finally, Specimen (3), below at left, also promotes a performance by various bands including The Slants. The theme in Specimen (3), as suggested by both the typeface used and the stock photos, is 1950's American science-fiction cinema in the "camp" style. The poster, which utilizes "creepy" typography and graphical style of that era, depicts a "screaming" teenage girl (not evidently Asian) on the left and, on the right, an adult woman (also not evincing Asian features or other indicia of Asian ethnicity) conveying distress apparently arising out of her encounter with the "Metaluna Mutant," the antagonist in the 1955 motion picture, *This Island Earth*. Based on a novel of the same name, in this work the creature's origin is the fictional planet Metaluna,[7] which of course is not in Asia.



Specimen 3

Analysis of the content of this third and final Specimen is consistent with that of the other two, and its purpose is to demonstrate the following: Based on Application actually before the Examining Attorney, including the description and the specimens accepted by the Examining Attorney, and applying the instruction of *Mavety* that a mark be considered "in the context of the marketplace as applied to only the goods described in [the] application for registration," there is no basis for the conclusion in the Office Action that the registration of THE SLANTS would be

[7] "This Island Earth," Wikipedia, found at http://en.wikipedia.org/wiki/This_Island_Earth, last visited on May 2, 2012.

unlawful on the ground that use of the word "slants" as a trademark for musical bands would offend Asians. There is nothing specifically, much less necessarily, "Asian" in the Application, and therefore no basis in the Application for the Examining Attorney's finding as to the mark's "likely meaning."

d. Goods and services described in the Office Action

While the Application itself provides no basis for refusal to register Applicant's THE SLANTS mark on the ground of disparagement, the Office Action relies on various other material that it treats as proof of the Applicant's use of the mark. These are provided as context both for the sense of the word "slant" the Examining Attorney maintains the Applicant means to convey and the reactions that the marks' use has supposedly engendered in the Asian community. It is respectfully submitted, however, that the Examining Attorney's reliance on this material for the first of these two purposes – defining the use of the mark in contradistinction to how it is defined in the Application – is improper.

An examining attorney may refer to outside materials for purposes of assessing whether a mark suspected of being disparaging is regarded as such by the affected group. But such an inquiry properly takes place only after a prima facie determination that the application itself could indeed raise such a suspicion. Put differently, it is not the PTO's practice, nor could it be, to conduct a "disparagement search" on every application – even words that may be known to the Examining Attorney to be contained on supposed lists of "bad words" such as those set forth above – words such as "apple," "cans," or "dyke" – that comes before it. As a threshold matter, the proper approach to such a determination under *In re Mavety*, i.e., the way the PTO determines **what an application is,** is the "context of the marketplace **as applied to only the**

goods described in [the] application." *Id*., 33 F.3d at 1371. See *In Re Hershey*, 6 U.S.P.Q.2d 1470 (TTAB Mar. 10, 1988) (focusing analysis on specimens); *In re Bose Corporation*, 546 F.2d 893, 192 USPQ 213 (CCPA 1976) ("an application for registration must be adjudged in light of the specimens of record").

Here the Office Action makes no reference whatsoever to the "goods [or services] described in the application," meaning the description of goods and services – "Entertainment, namely, live performances by a musical bands" – as illustrated by the specimens analyzed above. Registration was not refused on the ground that the specimen of use does not "evidence an association between the mark and the services specified in the application" pursuant to here under 37 C.F.R. 2.56(b)(2)). No substitute specimen was requested by the Examining Attorney. Rather than request additional evidence or request clarification, the Examining Attorney conducted an independent Internet search and came to his own conclusions concerning that use without any regard for the content of the Application that was refused.

In fact, absent an inquiry based on 37 C.F.R. 2.56(b)(2)), the Lanham Act does **not** mandate inquiry into specific goods or services not shown in the application itself. *In re McGinley*, *supra*, 660 F.2d at 485, 211 USPQ at 673. While TMEP Rule 710.01(b) provides that "Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public," such research refers essentially to evaluation of whether a mark is used descriptively or, as set forth above, whether a mark is generally used by the general public as a disparaging term. But the Examining Attorney did not conclude, from his Internet research, how the **public** uses the Applicant's mark, but supposedly how the Applicant does. But this a not a situation akin to *In re Reed Elsevier Properties Inc*., 482 F.3d 1376, 1378-79 (Fed. Cir. 2007), where such research was justified as

defining "the genus of services at issue," which is not at issue here. Moreover, in *Reed Elsevier*, the information at issue came from the Applicant's own website; hence the Rule provides that "The examining attorney must check applicant's own website for information about the goods/services." But the Office Action in this matter includes no excerpts from the Applicant's website and cites no such material as grounds for the refusal.

Nor is there any reason that proper examination procedure would encourage such adventures. Disregard of the description of goods and specimens accompanying an application, as took place here, in favor of an independent research project undermines the concept of a trademark registration application as a *prima facie* "closed system" per opinions such as *In re Mavety*, *In Re Hershey* and *In re Bose Corporation*. A "free-form" approach to examination would also test the dubious proposition that Internet claims about a given applicant's use of a given mark at a given time is entitled to more evidentiary weight than the Applicant's own description of goods and services, even without a showing of inadequacy or fraud. This is especially true where, as here, the culling of Internet searches is unaccompanied by any accounting with respect to search results discarded as well as those submitted.

If the Examining Attorney had reason to believe that Application was incomplete, he could have made a request for more information or even a rejection premised on the inadequacy of the specimen as proof of the mark's use under 37 C.F.R. 2.56(b)(2), which he did not. Yet in fact, as demonstrated above, there is no legitimate springboard for such a request or ruling. Nothing in the Application suggests that the specimens are incomplete, inaccurate or otherwise want supplementation.

Rejecting the Application based on other proceedings or independent research, however, is not an appropriate alternative; nor is arriving at a predetermined result without regard for the

record. Yet by all indications, these considerations – and not the Application itself – form the basis for the refusal embodied by the Office Action.

II. CONCLUSION

In light of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw his refusal to register Applicant's mark and publish Applicant's mark on the Principal Register.

Respectfully submitted,

Simon Shiao Tam

By: _____
Ronald D. Coleman

GOETZ FITZPATRICK, LLP
One Penn Plaza, 44th Floor
New York, New York 10119
(212) 695-8100

Attorneys for Applicant

Dated: May 29, 2012

EXHIBIT A

From: TMOfficialNotices@USPTO.GOV
Sent: Tuesday, September 27, 2011 00:10 AM
To: triciadeutsch@gmail.com
Subject: Trademark Serial Number 85269787: Official USPTO Notice of Allowance

NOTICE OF ALLOWANCE (NOA)

ISSUE DATE: Sep 27, 2011

Serial Number: 85-269,787
Mark: SLANTS(STANDARD CHARACTER MARK)
Attorney Reference Number: 111-13

No opposition was filed for this published application. The issue date of this NOA establishes the due date for the filing of a Statement of Use (SOU) or a Request for Extension of Time to file a Statement of Use (Extension Request). WARNING: An SOU that meets all legal requirements must be filed before a registration certificate can issue. Please read below for important information regarding the applicant's pending six (6) month deadline.

SIX (6)-MONTH DEADLINE: Applicant has six (6) MONTHS from the NOA issue date to file either:

- An SOU, if the applicant is using the mark in commerce (required even if the applicant was using the mark at the time of filing the application, if use basis was not specified originally); **OR**
- An Extension Request, if the applicant is not yet using the mark in commerce. If an Extension Request is filed, a new request must be filed every six (6) months until the SOU is filed. The applicant may file a total of five (5) extension requests. **WARNING:** An SOU may **not** be filed more than thirty-six (36) months from when the NOA issued. The deadline for filing is always calculated from the issue date of the NOA.

How to file SOU and/or Extension Request:
Use the Trademark Electronic Application System (TEAS). Do **NOT** reply to this e-mail, as e-mailed filings will **NOT** be processed. Both the SOU and Extension Request have many legal requirements, including fees and verified statements; therefore, please use the USPTO forms available online at http://www.uspto.gov/teas/index.html (under the "INTENT-TO-USE (ITU) FORMS" category) to avoid the possible omission of required information. If you have questions about this notice, please contact the Trademark Assistance Center at 1-800-786-9199.

For information on how to (1) divide an application; (2) delete goods/services (or entire class) with a Section 1(b) basis; or (3) change filing basis, see http://www.uspto.gov/trademarks/basics/MoreInfo_SOU_EXT.jsp.

FAILURE TO FILE A REQUIRED DOCUMENT OUTLINED ABOVE DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF THIS APPLICATION.

REVIEW APPLICATION INFORMATION FOR ACCURACY

If you believe this NOA should not have issued or correction of the information shown below is needed, you must submit a request to the Intent-to-Use Unit. Please use the "Post-Publication Amendment" form under the "POST-PUBLICATION/POST NOTICE OF ALLOWANCE (NOA) FORMS" category, available at http://www.uspto.gov/teas/index.html. Do **NOT** reply to this e-mail, as e-mailed filings will NOT be processed.

Serial Number:	85-269,787
Mark:	SLANTS(STANDARD CHARACTER MARK)
Attorney Reference Number:	111-13
Owner:	Project Miracle, LLC 3601 East Marlette Ave Paradise Valley , ARIZONA 85253
Correspondence Address:	MARK A. CARLINO LAW OFFICE OF MARK A. CARLINO, P.C. 28150 N ALMA SCHOOL PKWY STE 103 PMB 617 SCOTTSDALE, AZ 85262-8049

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO Section 1(b): YES Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

025 - Baby bibs not of paper; Beachwear; Children's headwear; Coats; Dresses; Footwear; Gloves; Head wear; Hosiery; Infant wear; Infants' shoes and boots; Lingerie; Neckwear; Pajamas; Robes; Scarves; Shapewear, namely, body shapers, body suits, bras, and girdles; Shirts; Shoes; Shorts; Slacks; Sleepwear; Slippers; Sweat pants; Sweat shirts; Sweaters; Swimwear; T-shirts; Undergarments; Women's athletic tops with built-in bras -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED.

Fraudulent statements may result in registration being cancelled: Applicants must ensure that statements made in filings to the USPTO are accurate, as inaccuracies may result in the cancellation of any issued trademark registration. The lack of a bona fide intention to use the mark with ALL goods and/or services listed in an application or the lack of actual use on all goods and/or services for which use is claimed could jeopardize the validity of the registration, possibly resulting in its cancellation.

Additional information: For information on filing and maintenance requirements for U.S. trademark applications and registrations and required fees, please consult the USPTO website at www.uspto.gov or call the Trademark Assistance Center at 1-800-786-9199.

Checking status: To check the status of an application, go to http://tarr.uspto.gov. Please check the status of any application at least every three (3) months after the application filing date.

United States of America
United States Patent and Trademark Office

SLANT

Reg. No. 4,123,704

Registered Apr. 10, 2012

Int. Cl.: 28

TRADEMARK

PRINCIPAL REGISTER

GLOBE INTERNATIONAL NOMINEES PTY LTD (AUSTRALIA AN AUSTRALIAN COMPANY LIMITED BY SHARES)
1 FENNELL STREET
PORT MELBOURNE VIC 3207
AUSTRALIA

FOR: SKATEBOARDS, SKATEBOARD WHEELS SOLD BOTH SEPARATELY AND TOGETHER WITH THE SKATEBOARD AS A UNIT, SKATEBOARD HARDWARE AND PARTS THEREFOR, NAMELY, TRUCKS, BEARINGS, MOUNTING HARDWARE, DECKS, GRIP TAPE, AND RISER PADS; WATER SKIS; SURF SKIS; SKIS; EDGES OF SKIS; SCRAPERS FOR SKIS; SKI BINDINGS; SOLE COVERINGS FOR SKIS; WAX FOR SKIS; SURFBOARDS; SURFBOARD LEASHES; BAGS ESPECIALLY DESIGNED FOR SKIS AND SURFBOARDS; BODY BOARDS; WAKE BOARDS; SNOW BOARDS; SAILBOARDS; HARNESS FOR SAILBOARDS; MASTS FOR SAILBOARDS; ICE SKATES; ROLLER SKATES; TOYS, NAMELY, BOBBLE HEAD DOLLS, ACTION FIGURES, MINIATURE SKATEBOARD FOR USE AS TOYS, MINIATURE SURFBOARDS FOR USE AS TOYS; PLAY ARTICLES FOR SWIMMING POOLS, NAMELY, BALLS, RINGS FOR DIVING, PLASTIC TOY TORPEDOES, ARM FLOATS FOR RECREATIONAL USE AND WATER TOYS; BOARD GAMES; HAND HELD ELECTRONIC UNITS FOR PLAYING ELECTRONIC GAMES OTHER THAN THOSE ADAPTED FOR USE WITH AN EXTERNAL DISPLAY SCREEN OR MONITOR; PARLOUR GAMES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF INTERNATIONAL REGISTRATION 1077517 DATED 2-9-2011, EXPIRES 2-9-2021.

SER. NO. 79-097,513, FILED 2-9-2011.

FRED CARL, EXAMINING ATTORNEY

David J. Kappos

Director of the United States Patent and Trademark Office

United States of America
United States Patent and Trademark Office

SLANT

Reg. No. 3,894,536

Registered Dec. 21, 2010

Int. Cl.: 41

SERVICE MARK

PRINCIPAL REGISTER

KEARNEY, VICTOR (UNITED STATES INDIVIDUAL)
P.O. BOX 11094
ZEPHYR COVE, NV 89448

FOR: MOTION PICTURE FILM PRODUCTION; PRODUCTION AND DISTRIBUTION OF MOTION PICTURES; PRODUCTION OF RADIO OR TELEVISION PROGRAMS; PRODUCTION OF VIDEO DISCS FOR OTHERS; PUBLICATION OF TEXTS, BOOKS, MAGAZINES AND OTHER PRINTED MATTER; PUBLISHING OF ELECTRONIC PUBLICATIONS, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 3-1-2009; IN COMMERCE 3-1-2009.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-678,006, FILED 2-25-2009.

JEFF DEFORD, EXAMINING ATTORNEY

David J. Kappos

Director of the United States Patent and Trademark Office

Int. Cl.: 21

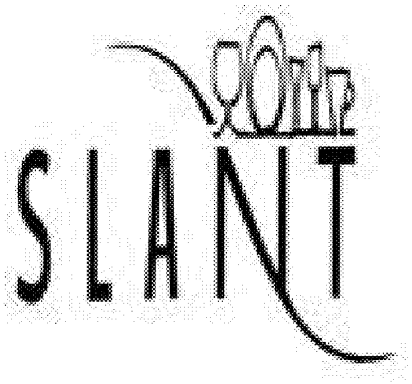
Prior U.S. Cls.: 2, 13, 23, 29, 30, 33, 40, and 50

United States Patent and Trademark Office

Reg. No. 3,437,238

Registered May 27, 2008

TRADEMARK
PRINCIPAL REGISTER



FORMATION, INC. (CALIFORNIA CORPORATION)
1000 CHERRY AVENUE
SUITE 140
SAN BRUNO, CA 94066

FOR: SERVINGWARE FOR SERVING FOOD, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 11-15-2007; IN COMMERCE 11-15-2007.

SN 77-138,100, FILED 3-22-2007.

ARETHA SOMERVILLE, EXAMINING ATTORNEY

Int. Cl.: 21

Prior U.S. Cls.: 2, 13, 23, 29, 30, 33, 40, and 50

United States Patent and Trademark Office

Reg. No. 3,437,230

Registered May 27, 2008

TRADEMARK
PRINCIPAL REGISTER

SLANT

FORMATION, INC. (CALIFORNIA CORPORATION)
950 TOWER LANE, SUITE 900
FOSTER CITY, CA 94404

FOR: SERVING WARE FOR SERVING FOOD, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 11-15-2007; IN COMMERCE 11-15-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-136,294, FILED 3-21-2007.

ARETHA SOMERVILLE, EXAMINING ATTORNEY

slant, *n.*[1]

Pronunciation: /slɑːnt/ /-æ-/

Forms: Also 16, *Sc.*18 **slaunt**.

Etymology: Connected with SLANT *adv.* and *adj.*, SLANT *v.* See also SLENT *n.*[1]

1.

a. The slope *of* a hill, piece of ground, etc.; a sloping stretch of ground; an inclined plane or surface.

1655 T. MOFFETT & C. BENNET *Healths Improvem.* iii. 18 The best situation of a house or city, is upon the slaunt of a southwest hill.

1728 H. PEMBERTON *View Sir I. Newton's Philos.* 84 If this globe be drawn along the slant DF, less force will be required to raise it, than if it were lifted directly up.

1757 J. H. GROSE *Voy. E.-Indies* vii. 92 Returning then to the foot of the hill, you ascend an easy slant.

1802 C. FINDLATER *Agric. Surv. Peebles* 41 Above it, lying against the slaunt of the roof, is the *skelf*, or frame, containing shelves.

1838 W. H. PRESCOTT *Hist. Reign Ferdinand & Isabella* (1846) II. xiv. 41 Ferdinand..kept along the southern slant of the coast as far as Almeria.

1860 J. W. WARTER *Sea-board & Down* II. 33 His dog..brought back some stray sheep to the sunny side of the slant.

b. A small surface, a short line, having an oblique position or direction.

?1711 J. PETIVER *Gazophylacii* X. Table 98 Luzone Olive Whelk, with white Slants and Spots.

1787 T. BEST *Conc. Treat. Angling* (ed. 2) 10 First cut the pieces with a slope, or slant,..and then spread a thin layer of shoemaker's wax over the slants.

1873 R. BROWNING *Red Cotton Night-cap Country* II. 122 Each pullet-egg Of diamond, slipping flame from fifty slants.

c. A sloping beam or ray *of* light.

1856 DICKENS *Little Dorrit* (1857) I. v. 40 Pale slants of light from the yard above.

1862 G. W. THORNBURY *Life Turner* I. 20 Crimson fog-suns and misty slants of sunshine.

1864 DICKENS *Our Mutual Friend* (1865) I. I. i. 2 A slant of light from the setting sun.

d. *Mining*. (See quot. 1881.)

1881 *Trans. Amer. Inst. Mining Engineers* **9** 176 *Slant*, a heading driven diagonally between the dip and the strike of a coal-seam; also called a *run*.

1892 *Pall Mall Gaz.* 27 Aug. 5/1 He succeeded in penetrating the mine a hundred yards into the main slant.

e. *Typogr.* = OBLIQUE *adj.* 4, SOLIDUS *n.*[1] 2. Used esp. of either of a pair of lines enclosing the representation of a linguistic (esp. phonemic) element.

1962 *Gen. Systems* VII. 299/2 Its mate is suffixed with a slant (virgule), thus: 4006 How to Silence. 4006/ How to Sound.

1964 E. PALMER tr. A. Martinet *Elem. Gen. Ling.* i. 24 This [*sc.* a significans] we represent between slants (/ž e mal a la tet/, /ž e mal/, /mal/).

1972 R. R. K. HARTMANN & F. C. STORK *Dict. Lang. & Linguistics* 172/1 Phonemic transcription is usually written between slants, e.g. /haus/.

2. A course or movement in an oblique direction.

1712 E. Cooke *Voy. S. Sea* 313 Kept plying to Windward not far from the Land, sometimes making good Slants.
1889 T. E. Brown *Manx Witch* 2 Lek didn want The Pazon to know her, and made a slant.

3.

a. Slope, inclination, obliquity. ***on the slant***, aslant, obliquely. Also ***on a slant***.

1817 H. T. Colebrooke *Algebra Hindus* 97 Where the length of the cavity, owing to the slant of the sides, is measured [etc.].
1880 'M. Twain' *Tramp Abroad* 258 The slant of a ladder that leans against a house.
1884 Queen Victoria *More Leaves* 97 Not a bad road, but on the steeper side of the hill, and quite on the slant.
1951 E. Paul *Springtime in Paris* xv. 286 Busse..leaped quickly, hit the lower level of the street pavement on a slant, and almost turned his ankle.
1957 D. Lessing *Going Home* ii. 35 The night was magnificent; the Southern Cross on a slant overhead.

b. *Microbiol.* A sloping surface of culture medium, usu. prepared by letting it solidify in a sloping test-tube, and used for the culture of micro-organisms. Cf. slope *n.*[1] 3a.

1899 T. Bowhill *Man. Bacteriol. Technique* ii. 60 Take three freshly prepared tubes of oblique surface agar-agar—usually called 'agar-slants'—with plenty of water of condensation in the bottom.
1924 *Jrnl. Bacteriol.* **9** 398 Loops were transferred, at intervals up to four hours, to agar slants, and these were incubated overnight.
1949 *Amer. Jrnl. Path.* **25** 7 Growth on plated media, while not unlike that on slants, was somewhat slower.
1972 *Sci. Amer.* Sept. 187/1 Dried yeast is typically sealed in an airtight envelope filled with nitrogen. Cultures can be perpetuated by inoculating slants of fresh nutrient agar under sterile conditions every 90 days.

4. *techn.*

a. A receptacle having a sloping bottom in which paint-brushes are placed in order to keep them moist.

1875 Field & Davidson *Gram. Colouring* 168 The brushes..may be dipped in nut-oil and laid in a tin slant until wanted again.
*c*1896 *Rowney's Price List* 20 Oil Slant and Smutch Pan.

b. A slab having shallow sloping compartments or depressions for water-colours.

1897 *Army & Navy Stores List* 817 Round China Slants and Basins.

5. *dial.* and *U.S.* A sly hit or sarcasm.
Occurs much earlier in the form slent *n.*[1]

1825 J. T. Brockett *Gloss. North Country Words*, *Slant*, sly jokes, or petty lies.
1828–32 Webster *Amer. Dict. Eng. Lang.*, *Slant*, an oblique reflection or gibe; a sarcastic remark. (In vulgar use.)
1856 H. B. Stowe *Dred* I. xxi. 274 Had the slant fallen upon himself, personally, Old Tiff would probably have given a jolly crow.
1897 W. D. Howells *Landlord Lion's Head* 94 Whitwell felt an ironical slant in the words.

6. *slang*. An occasion, chance, opportunity; also, an opportunity of going somewhere.

1837 *Fraser's Mag.* **16** 49, I boldly entered myself on board a privateer, with the determination of playing them a slippery trick the very first slant I had.
1859 K. Cornwallis *Panorama New World* I. 140 It was n't any wonder, when we did get a slant into town, if we took a drop too much.
1868 H. Woodruff *Trotting Horse* iii. 58, I have known many that will be always watching slants to get an extra quart of oats for their colts.

7. *Austral. slang.* (See quot. 1897.)

1897 P. Warung *Tales Old Regime* 217 Pedder had got tired of things in general, and had organized that movement which was popularly known in Norfolk Island and Port Arthur as a 'slant', that is, he had planned a murder or a mutiny on purpose to obtain a trial in Hobart or Sydney.

8. A way of regarding something, a point of view or 'angle'; an interpretation; a bias. orig. *U.S.*

1905 *N.Y. Evening Post* 28 Jan. 5 The titles of articles on this subject bear an extremely pessimistic slant.
1927 C. Connolly *Let.* 26 Jan. in *Romantic Friendship* (1975) 230 The slant at which I write betrays an unbearable optimism.
1935 M. M. Atwater *Murder in Midsummer* xv. 138 Mentally he was going over his 'story'..to change the slant of some of the phrases.
1948 *Sunday Pictorial* 18 July 12/3 A new and intriguing slant on the Borgias by Nigel Balchin.
1965 *Amer. N. & Q.* Mar. 99/2 The book has a pro-Galvão slant showing the man as a romantic hero.
1973 J. Wood *North Beat* ii. 19 New slant—timing the lunch-hour, eh? When did we have that one before?

9. *U.S. colloq.* A glance, look.

1911 E. Ferber *Dawn O'Hara* viii. 109 You're supposed t'take a slant at th'things an' make up your mind w'at you want.
1934 R. Chandler in *Black Mask* Oct. 28/1 The prowl car takes a slant down it [*sc.* the old road] now and then looking for petting parties.

10. *U.S. slang* (*depreciative* and *offensive*). A person with slanting eyes, *spec.* one of Oriental descent. Cf. ***slant-eye*** *n.* at slant *adv.* and *adj.* Special uses 1b.

1942 L. V. Berrey & M. Van den Bark *Amer. Thes. Slang* §385/19 Oriental..*slant*.
1969 *Time* 5 Dec. 26/1 To the G.I. the Vietnamese..is a 'gook', 'dink', 'slope' or 'slant'.
1976 M. Machlin *Pipeline* vii. 79 And the fuckin' Eskimo slants are tryin' to get the rest of it.
1978 J. Gores *Gone, no Forwarding* (1979) 191 He took me back to the slant broad... A slant or a Buddha-head.

Additions series 1993-7

Amer. Football. *(a)* An attacking play in which the ball-carrier moves into the line of scrimmage at an oblique angle. *(b)* In full, ***slant-in***. A pass pattern in which a receiver runs diagonally towards the goal-line from the line of scrimmage.

[1927 G. S. Warner *Football for Coaches & Players* 143 (*caption*) 10 precedes 11, the ball carrier, in a driving, slanting tandem, hitting between E and F. For a sure gain of a few yards this is a better play than A-3.]
1947 D. X. Bible *Championship Football* iv. 33 Straight-ahead plunges and slants are direct plays.
1953 C. C. Caldwell *Mod. Football for Spectator* vii. 142 Slant charge. In this type of charge, the defensive lineman moves obliquely across the line of scrimmage.
1957 *Encycl. Brit.* IX. 478/2 Reverses..are even more important in the double wing formation than they are in the single wing, but slants and plunges also are effective.

1982 S. B. Flexner *Listening to Amer.* 243 Stanford during his own long career, refined the single wing at Pitt and combined it with his own *unbalanced line* and *slant plays*.

1988 L. Wilson *Amer. Football* ii. 29/1 If you are running a slant-in, look for the ball over your inside shoulder.

slant, n.1
Second edition, 1989; online version March 2011. <http://www.oed.com.proxy.lib.duke.edu/Entry/181334>; accessed 22 April 2011. Earlier version first published in *New English Dictionary*, 1911.

To:	Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A
Sent:	6/20/2012 5:32:17 PM
Sent As:	ECOM102@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:
RONALD COLEMAN

GOETZ FITZPATRICK LLP

1 PENN PLZ STE 4401

NEW YORK, NY 10119-0196

CLICK HERE TO RESPOND TO THIS LETTE

http://www.uspto.gov/trademarks/teas/response_forms.j

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/20/2012

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on May 29, 2012.

By way of background, an Office action was issued on January 6, 2012, refusing registration under Section 2(a) as disparaging. Applicant's response argued against the refusal. Applicant's arguments have been considered and are found unpersuasive.

Accordingly, the refusal under Trademark Act Section 2(a) is now made **FINAL** for the reasons set forth below. *See* 15 U.S.C. §1052(a); 37 C.F.R. §2.64(a).

SECTION 2(A) – MARK IS DISPARAGING

The refusal of registration because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols is maintained and made FINAL. Trademark Act Section 2(a), 15 U.S.C. §1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd* , 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding "no error in the TTAB's articulation of [the Section 2(a)] test for disparagement"), *remanded on other grounds*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd* , 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); TMEP §§1203.03, 1203.03(c).

The thrust of applicant's argument is that the application on its face and four-corners, fails to provide a basis for the conclusion that the likely meaning of the mark is disparaging.[1]
See Applicant's response brief. Applicant's framing of the question and permissible evidence is misplaced. As is plainly stated in *In re Squaw Valley*, the test looks not only at dictionary definitions, any other elements in the mark, and the nature of the goods/services, but also at **the manner in which the mark is used in the marketplace in connection with the goods and/or services.** *In re Squaw Valley Dev.*, 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP §1203.03(c). Thus, a proper consideration of the application is to determine how the mark would be perceived based upon how it is used in the marketplace. To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive opposition and cancellation proceedings by affected

third-parties.[2]

Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self-described as being composed of members of Asian descent. *See* attachments to first Office action on bands name and makeup (for instance, thelsants.com/about_f.html; www.asianreproter.com/arts/2009/30-slants.htm). Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark – as the name of an all Asian-American band. Further, applicant (and his fellow band members) have repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating: "I was trying to think of things that people **associate with Asians.** Obviously, one of the first things people say is that we have slanted eyes. I thought, what a great way to reclaim that stereotype…." *See* Rock Band to Trademark Office: Our Name is Not Disparaging to Asians, NW Asian Weekly (attached to the first Office action). In fact, the evidence shows applicant chose the name THE SLANTS for the band specifically **because** of the Asian connection. *See e.g.*, A Common Ground for a Controversial Band, THE ASIAN REPORT, attached to first Office action ("**For the band, the name was a way to reclaim a racial slur and to assert Asian pride**.") Thus, the evidence is overwhelming that applicant chose the mark fully aware of the connection to the racial slur. There is no evidence of record to indicate that any meaning other than the offensive meaning is applicable to the instant application.

Applicant's other arguments are equally misplaced. Applicant argues that the dictionaries referenced are not "actual" dictionaries. This statement is incredulous on its face. Specialized dictionaries are no less "actual" dictionaries than generalized dictionaries. In fact, many of the dictionaries and reference materials are published by large scale publishing houses, such as Harper Collins. Further, that applicant cleverly chose specimens that avoided associations with Asians or Asian culture is not evidence that the mark is not used in a way to conjure up the derogatory meaning and to be disparaging to Asians. The evidence attached to the first Office action is overwhelming that the applied-for mark is used in connection with an Asian-American band, performing Chinatown Dance music, and that the name was chosen in clear recognition of the offensive meaning of the term in connection with Asians. *See* attachments to First Office action. Further, the evidence shows that the applied-for mark was chosen expressly because of its association with Asians, perhaps in an attempt to reclaim the term. *See e.g.*, Despite Name, Band Aims for Diverse Dance Rock, THE OREGONIAN ("For our band, we're not just Chinese, we're not just Vietnamese, we're kind of a pan Asian band that celebrates all the different Asian cultures out there….Everyone in the band really loves the fact that we can try and empower Asian Americans and say, 'you know what? We are slant. Who cares? We're proud of that.'").

The evidence of record shows that the likely meaning of the mark, in light not only of the application, but also the "manner in which the mark is used in the marketplace," is the disparaging term regarding the shape of the eyes of certain persons of Asian descent, and that the term remains disparaging to the Asian and Asian-American communities.

Accordingly, the refusal of registration under Section 2(a) is maintained and made FINAL.

RESPONSE OPTIONS TO FINAL OFFICE ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this

final Office action by:

(1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or

(2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of $100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is $100. 37 C.F.R. §2.6(a)(15).

GENERAL INFORMATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must

continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

/Mark Shiner/

Trademark Examining Attorney

Law Office 102

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

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[1] Notably, this is not applicant's first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. *See* application under Serial No. 77952263 and selected documents from that file, attached hereto and incorporated by reference. It is worth mentioning that applicant appears to have reversed course on its arguments for registrability, arguing in the prior application that ***because*** the applied-for mark was being used by Asian-Americans as a self-descriptor, it could not be disparaging, while in this case arguing that there is no indication in the application that the mark is in any way associated with Asians or Asian-Americans.

[2] Applicant's argument that the Office is limited to the four-corners of the application in determining the disparaging nature of the mark is too clever by half. Were applicant's theory correct, any smart applicant (or smart attorney) could easily draft an identification of goods and services that skates around any mention of a group or persons associated with a particular term, while at the same time, using the mark in such a way as to associate the mark with the disparaged group.

To:	Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A
Sent:	6/20/2012 5:32:18 PM
Sent As:	ECOM102@USPTO.GOV
Attachments:	

IMPORTANT NOTICE REGARDING YOUR

U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION HAS ISSUED ON 6/20/2012 FOR

SERIAL NO. 85472044

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this **link** **or** go to **http://portal.uspto.gov/external/portal/tow** and enter the application serial number to **access** the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable **response time period**. Your response deadline will be calculated from **6/20/2012** (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System Response Form.

HELP: For *technical* assistance in accessing the Office action, please e-mail

TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon Shiao Tam Mark: THE SLANTS Serial No.: 85472044 Filing Date: March 5, 2010	Examining Attorney: Mark Shiner Law Office: 102

RESPONSE TO OFFICE ACTION DATED JUNE 20, 2012

Applicant submits this response to the Office Action dated June 20, 2012, in which the Examining Attorney reaffirms the refusal to register of Applicant's standard character mark on the grounds that the mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a). In response, Applicant respectfully submits the following:

I. THE EXAMINING ATTORNEY HAS APPLIED A NOVEL PER SE RULE AGAINST REGISTRATION OF "THE SLANTS" BY THIS APPLICANT THAT IS NOT SUPPORTABLE BY EXISTING LAW OR PUBLIC POLICY.

In his response to the initial Office Action, Applicant acknowledged that, where an application, on its face, raises a question of disparagement under 15 U.S.C. §1052(a), an examining attorney may acquire and consider materials from outside the application in order to assess whether such a mark is regarded as such by the affected group as used. The second Office Action disregards this acknowledgement, however, as well as Applicant's related discussion of *In re Mavety Media Group Ltd*., 33 F.3d 1367, 1371 (Fed. Cir. 1994), stating as follows:

> [A] proper consideration of the application is to determine how the mark would be perceived based upon how it is used in the marketplace. To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive opposition and cancellation proceedings by affected third-parties.
>
> Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self described as being composed of members of Asian descent. . . .Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark – **as the name of an all Asian-American band**. Further, applicant (and his fellow band members) has repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating . . .
>
> [FN 1] Notably, this is not applicant's first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. . . .

Office Action at 2 (emphasis added). The arrangement of these excerpts appears to reveal the underlying basis for the refusal: While nothing disparaging about the use of THE SLANTS is presented in the application, **this particular** applicant is not entitled to a registration because he and his "all Asian-American band" have, in the past, used the mark in manner deemed disparaging. Under this standard, no application by this Applicant for THE SLANTS can overcome the stain of Applicant's use of that mark in connection with services provided by what is revealed – by Internet articles and a previous application – to have been an all Asian-American band.

This seems, perhaps, to be a novel extension of *res judicata* to the trademark registration process. Of course, merely because the same person applies for registration of a trademark superficially like one for which he was previously denied registration does not mean that *res judicata* bars a similar new application by the same applicant. *Sheffield-King Milling Co. v. Theopold-Reid Co.*, 269 F. 716 (D.C. Cir. 1921). Here, while the

applications are different, the trademark is, admittedly, not merely superficially similar, but the same. But it is not the sameness of the **mark** in the two applications on which the Examining Attorney relies in refusing registration. It is the sameness of the **Applicant**. The refusal here is not based on the trademark being a "bad word"; "slant" is a word with multiple meanings, of which the ethnic slur on which the refusal is purportedly based is attenuated, to say the least.[1] The refusal, rather, is based on Applicant's past "bad use" and presumptively bad intention respecting this neutral word, as indicated by material from outside the Application.

This appears to amount to a res judicata–like rule barring registration of this mark by this Applicant for all time. Concomitantly, because the Examining Attorney's rationale for refusal is the external record of Simon Shiao Tam's use of the mark – the goods and services described in the actual Application being, per the Office Action, of little relevance – anyone else on earth who submitted the identical application for THE SLANTS could expect registration to be allowed. This result would be a surprising reading of 15 U.S.C. §1052(a).

Applicant acknowledges that a "No SLANTS Trademark for Simon Tam" rule may be preferable to other disparagement-based rationales that might seem more "flexible" but which would raise even more problems. For example, the Office Action eliminates any consideration of the possibility, consistent with the proof of use in the Application, that Applicant's use of THE SLANTS at the time of the application is different from the "disparaging" manner in which he used it in the past. An Examining

[1] Indeed, Applicant's response to the first Office Action demonstrated that a trademark such as THE SLANTS, in contrast to the famously disparaging marks consisting of derisive ethnic slurs, should be registered if its primary meaning is non-disparaging. The Office Action makes no serious attempt at rebutting this showing. (See Section II.)

Attorney cannot be expected to determine, whether based on the four corners of the application or dogged Internet surfing, the quality and extent to which an applicant has repented of past trademark "misuse." Hence a "one strike and you're out" approach has a certain elegance to it.

A per se rule of refusal for any registration of THE SLANTS by Applicant may also avoid an even more troubling outcome, considering that the refusal is based on Applicant's use of the mark in connection with an "all Asian-American" band. Section 1052(a) is silent as to just how many Asians it takes to make a "Slant" unregistrable, but a per se rule prohibiting registration by Simon Tam has the virtue of absolving the Commissioner of Trademarks from involvement with questions such as:

- How many Asian-American members of The Slants should be replaced with non-Asians to secure the racial composition the Lanham Act requires before a registration may issue?
- Is use of THE SLANTS by an all Asian-American band disparaging under 15 U.S.C. §1052(a) only if the band members are "full blooded" Asian-Americans, or is use of the mark by "mixed race" musicians also a bar to registration?[2]

Because under the rationale of the refusal the past disparaging conduct of Applicant, i.e., his use of THE SLANTS while being Asian, is forever outcome-determinative, the Commissioner can defer such strict delineation of which trademark registrations may be

[2] Naturally there is no solution in this regard for Applicant himself, who cannot change his own ethnic identity. By analogy, however, based on the Office Action, it may be the case that Applicant could reduce the disparaging nature of his own inherently Asian use of THE SLANTS by utilizing fewer "Asian" icons and symbols in his performances and promotion of the band. Because, however, the refusal is premised on unacceptable conduct by Applicant that has already occurred and been made a matter of record, this, too, is a judgment that the Patent and Trademark Office need not involve itself with.

allowed, and which refused, based on the ethnic eligibility of an applicant or others with whom he uses the mark in commerce.

Similarly, Applicant acknowledges that problem inherent in the possibility that, once in the possession of a registration for THE SLANTS, Applicant might just go ahead and hire Asian musicians to join The Slants again, thus offending the racial strictures of the Lanham Act. A bright-line rule forbidding registration of THE SLANTS by this Applicant, no matter how inoffensive his use of the mark at present, also avoids the possibility that Applicant might get a registration and then revert to a level of Asian-themed artistic expression prohibited by 15 U.S.C. §1052(a).[3]

Applicant submits, however, that none of the foregoing "problems" involving how this particular applicant makes use of this mark, and with whom, need be addressed at all by the Commissioner of Trademarks if the Examining Attorney will take stock of the implications of this refusal and reconsider whether 15 U.S.C. §1052(a) bars Applicant from registering the word "slant" as his band's trademark. As the above, largely tongue in cheek, is meant to suggest, the reasoning of the Office Action is premised entirely on outside evidence of Applicant's aggressively Asian-themed artistic and commercial identity as used in the past with the mark. As a corollary, an applicant with no Asian aspect to its identity whatsoever would be allowed registration on the same exact Application, unless "slants" is to be regarded in and of itself – **without reference to a specific applicant** – as a bona fide term of ethnic disparagement with no redeeming registrable qualities.

[3] The question raised by a bona fide assignment of such a registration, along with the goodwill in the mark, by a non-disparaging registrant to a third party – or even Applicant himself – who might not sufficiently abide the racial-content parameters the Office Action finds in 15 U.S.C. §1052(a) remains, however, unresolved by the Applicant-specific approach relied on by the Examining Attorney.

As set forth below, however, neither the first nor the second Office Action demonstrates that THE SLANTS is an inherently offensive ethnic slur. For this reason, the ethnic identity of the Applicant, and the extent to which he associates in his use of the mark with other Asians or the degree to which he makes use of his own cultural heritage, should be of no relevance whatsoever in the consideration of this registration application, and the registration should be allowed.

II. THE EXAMINING ATTORNEY HAS NOT ADEQUATELY ADDRESSED APPLICANT'S FACTUAL DEMONSTRATION THAT IN ITS OWN RIGHT, "THE SLANTS" IS A TERM THAT IS AMENABLE TO AND COMMONLY ASSOCIATED WITH NEUTRAL, NON-DISPARAGING USES.

The premise of the previous section is that, unlike other ethnic-slur refusals to register on which the Office Action relies as precedent, here the refusal is based not on the trademark being inherently disparaging, but on " disparaging use" presumed, improperly, to be an inherent characteristic of the Applicant. The Office Action claims, however, that the mark is in fact inherently offensive to Asians. It is submitted, however, that the Examining Attorney has not demonstrated the factual validity of that proposition as required under the TMEP.

The initial Office Action cited several decisions upholding refusals of known ethnic slurs, determined to be such either by the marks' dominant meanings or based on evidence contained in the respective applications. Here, in contrast, the Office Action has "imported" one specific applicant's **use** of an otherwise neutral word, "slants," as grounds for a determination despite the lack of disparaging use of the mark in the Application, Applicant's use of the term is necessarily disparaging and not entitled to allowance. Applicant noted the absence of precedent for such an analysis. The Office

Action declines the invitation, or challenge, by the Applicant to demonstrate that the TTAB or the courts have upheld a refusal based solely on external evidence concerning, not communal reaction to a term in general, but to **a given Applicant's** historic use of a mark. Instead, rather ironically, the second Office Action repeats the argument *ad hominem*, i.e., that any use of the mark THE SLANTS by this Applicant is per se scandalous, because **his** use of the mark in circumstances not reflected in the Application but relied on as grounds for refusal in a previous application has been deemed offensive by third parties. It is submitted that this approach to determining whether a mark is disparaging is not supported by the law.

The second Office Action fails to seriously address its reliance on the dubious authority of "special dictionaries" by demonstrating that they are recognized or accepted as reliable reference works by academia, the bench or any other objective and authoritative source. The entire response to Applicant's four pages of closely-reasoned analysis on this topic is as follows:

> Applicant argues that the dictionaries referenced are not "actual" dictionaries. This statement is incredulous on its face [*sic*]. Specialized dictionaries are no less "actual" dictionaries than generalized dictionaries. In fact, many of the dictionaries and reference materials are published by large scale publishing houses, such as Harper Collins.

Applicant's argument, it is submitted, was not at all as facile as the above characterization suggests, and the Examining Attorney should not be incredulous about it all. In fact, the second Office Action ignores Applicant's overwhelming proof of contrary dictionary definitions, and indeed fails to address its own glaring failure to comply with TMEP Rule 710.01 in so ignoring them.[4] And it makes no attempt to

[4] "In appropriate cases, the examining attorney may also present evidence that may appear contrary to the USPTO's position, with an appropriate explanation as to why this evidence was not considered

address the fact, noted by Applicant, that even the definition of "slant" in the one **standard** dictionary on which the Office Action does rely does not define "slant" as an ethnic slur until its **fourth** definition.

Significantly, the Examining Attorney also declines to make any effort to rebut the problem inherent in the use of lists or "special dictionaries" cataloguing supposed ethnic slurs which, by definition, can only "confirm" the claim that "slant" is an ethnic slur ("affirming the consequent"). Again, finding that a word is listed in such a collection provides no insight at all into whether the disparaging sense of the word – whether the word is "slant," "banana," "bumblebee" or "cabdriver" (all found in the source on which the Office Action relies) – is the word's primary, or even one of its primary, senses as commonly understood. The Office Action does not provide authority for the dubious suggestion that a work is entitled to deference as a source of "dictionary definitions" under the TMEP merely because it was published by a "large scale publishing house."

III. CONCLUSION

In light of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw his refusal to register Applicant's mark and publish Applicant's mark on the Principal Register.

Respectfully submitted,

Simon Shiao Tam

By: 
Ronald D. Coleman

GOETZ FITZPATRICK, LLP

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controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture if there is an appeal. *Cf. In re Federated Department Stores Inc*., 3 USPQ2d 1541, 1542 n.2 (TTAB 1987)." TMEP Rule 710.01.

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Dated: December 10, 2012

To:	Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A - Request for Reconsideration Denied - Return to TTAB
Sent:	12/20/2012 12:16:06 PM
Sent As:	ECOM102@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:
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GENERAL TRADEMARK INFORMATIO
http://www.uspto.gov/trademarks/index.jsp

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO :
N/A
CORRESPONDENT E-MAIL ADDRESS:
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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 12/20/2012

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The Section 2(a) refusal made final in the Office action dated June 20, 2012, is maintained and continues to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

/Mark Shiner/
Trademark Examining Attorney
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Electronic System for Trademark Trials and Appeals

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Application Serial No.	85472044
Applicant	Tam, Simon Shiao

Notice of Appeal

Notice is hereby given that Tam, Simon Shiao appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 85472044.

Applicant has filed a request for reconsideration of the refusal to register, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following class of goods/services:

- Class 041. First Use: 2006/11/15 First Use In Commerce: 2006/11/15
  All goods and services in the class are appealed, namely: Entertainment in the nature of live performances by a musical band

Respectfully submitted,
/s/
12/10/2012

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