

Santa Clara University School of Law – Summer 2005

CAMPUS ID: _____ COURSE: _____ PROFESSOR: _____

**THESE EXAMINATION QUESTIONS MUST BE RETURNED AT THE END OF THE
EXAMINATION.
THE STANDARD EXAMINATION RULES GOVERN THIS EXAMINATION.**

Course: Trademarks & Unfair Competition
Professor: Scher
Essay and Multiple Choice (1 blue book)

Date: July 23, 2005
Hours: 3 hours
Open Book (any printed materials, no electronic materials)

PROFESSOR'S INSTRUCTIONS

1. Your exam consists of two fact patterns (“scenarios”) followed by multiple-choice and “short essay” questions. The weight to be given to each numbered question in grading is approximately equal (somewhat more if there are sub-parts). To avoid running out of time, try to complete Scenario One in about 2 hours.
2. **Multiple-Choice Questions.** Please answer the multiple-choice questions directly on the printed Exam by circling or otherwise **clearly** marking your choice.
 - A. To earn credit for a question, you must choose one and only one answer for that question. If you vote for two candidates, your ballot will not be counted.
 - B. If you find that there is no single perfect answer, you should choose the best (“least wrong”) answer. There is no penalty for guessing, but if you can narrow down the choices before guessing, you will improve your chances.
 - C. If you believe that more than one answer might be correct, or that no answers are correct, choose one anyway and use the “Optional Explanation” section to explain the choice you made. A good Optional Explanation may earn you full credit (if I agree with your position) or partial credit (if I decide that your choice was wrong but not completely indefensible), but it will have no effect if you had chosen the correct answer in the first place. Try to use your time to best effect.
3. **Short Essay Questions.** Short essay questions may be answered in a blue book or using the exam software. Please refer to the Q number for clarity. Some of the short essays pose multiple questions, so please read carefully. “Brief” or “Briefly” means one to two paragraphs at the most!
4. **Open Book.** During the Exam, you may consult any printed or handwritten material that **you** brought with you. You may not use any interactive electronic sources, such as the Internet, e-mail or chat. You may not poll the audience or phone a friend.
5. **Sequence of Work.** You may work in any order. However, you should not consider **new facts** introduced in a later question when answering an earlier question.

 **STOP! DO NOT FLIP THIS COVER PAGE UNTIL TOLD TO DO SO BY THE PROCTOR!**

Scenario One

Your firm represents the New Zealand company Kiwi Tour Group (“KTG”). Last November, you filed a United States trademark application on behalf of KTG to register HOBBITQUEST in connection with various travel-related services. A few months ago, the Examining Attorney issued an office action refusing registration. One of the Summer Associates at your firm was assigned to draft a response to the office action, and his “buddy,” a litigation associate, provided feedback. The draft now has come to you for review. The deadline for filing the response is October 4, 2005.

The file contains the following documents:

Office Action dated April 4, 2005 (1 page)

Printout of the TARR Status for the cited application (2 pages)

Printout of two pages from www.hobbittravel.com (4 pages)

(The file is reproduced on the next 7 pages)

Exam Tip:

(1) Read the Office Action carefully; (2) circle or highlight the relevant information on the TARR print-out for quick future reference; (3) skim the website pages briefly; then (4) read through the draft response, jotting notes on anything that comes to mind. The questions that follow will direct your attention back to specific parts of the draft response by line number.

Office Action No. 1

The applicant seeks to register HOBBITQUEST in connection with “organizing, booking, arranging and conducting excursions, day trips, sightseeing tours, holidays, tours and travel.”

The Mark is Merely Descriptive of the Services

Applicant is located in New Zealand and, according to its web site, conducts tours of various locations in New Zealand. Of particular relevance is applicant’s tour of “the rolling countryside of South Waikato to visit the set of ‘Hobbiton’” which was featured in the movie *The Fellowship of the Ring*. The movie tells the story of how nine travelers, including among them four “hobbits,” set out on a quest to destroy the “ring of power.” Applicant’s mark immediately identifies a significant feature or characteristic of its services, that its tours relate to the sets and scenery used in depicting the hobbits’ quest in the movie *The Fellowship of the Ring*. Accordingly, the mark is merely descriptive and must be refused registration. TMEP §1209.

The Mark May Create a Likelihood of Confusion with an Earlier Mark

The Examining Attorney’s search uncovered no registered mark which would bar registration of the applicant’s mark. However, the Examining Attorney provides information on pending Application Serial No. 78/572,111, which may, if it becomes registered, bar registration of applicant’s mark. If the applicant satisfactorily addresses all other issues raised in this action, the Examining Attorney will suspend further processing of the application pending the disposition of Application Serial No. 78/572,111. TMEP §716.02(c).

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2005-07-18 03:26:48 ET

Serial Number: 78572111

Registration Number: (NOT AVAILABLE)

Mark

HOBBIT TRAVEL

(words only): [HOBBIT TRAVEL](#)

Standard Character claim: [Yes](#)

Current Status: [Newly filed application, not yet assigned to an examining attorney.](#)

Date of Status: [2005-03-07](#)

Filing Date: [2005-02-22](#)

Transformed into a National Application: [No](#)

Registration Date: (DATE NOT AVAILABLE)

Register: [Principal](#)

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [M3D -TMO Law Office 112 - Docket Clerk](#)

Date In Location: [2005-03-08](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Wozniak Travel, Inc.](#)

Address:

[Wozniak Travel, Inc.](#)
[88 South Sixth Street, Suite 640](#)
[Minneapolis, MN 55402](#)
[United States](#)

Legal Entity Type: [Corporation](#)

State or Country of Incorporation: [Minnesota](#)

GOODS AND/OR SERVICES

International Class: [039](#)

[TRAVEL AGENCY SERVICES; NAMELY, ARRANGING AND CONDUCTING TRAVEL TOURS AND VACATION PACKAGES; ARRANGING AIR, LAND AND SEA TRANSPORTATION FOR INDIVIDUALS AND GROUPS; COORDINATING TRAVEL ARRANGEMENTS FOR INDIVIDUALS AND FOR GROUP TOURS; ORGANIZING PACKAGED VACATION AND TRAVEL TOURS](#)

First Use Date: [1976-12-00](#)

First Use in Commerce Date: [1976-12-00](#)

Basis: [1\(a\)](#)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

[2005-03-03 - New Application Entered In Tram](#)

CORRESPONDENCE INFORMATION

Correspondent

[Michael A. Bondi \(Attorney of record\)](#)

[MICHAEL A. BONDI
PATTERSON, THUENTE, SKAAR & CHRISTENSEN,
4800 IDS CENTER 80 SOUTH EIGHTH STREET
MINNEAPOLIS, MN 55402-2100](#)

Phone Number: [\(612\) 349-5740](#)

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|--|------------------------------|--|-------------------------------|--------------------------------|-------------------------------|
| Denver | | Seattle - New York - Los Angeles - San Francisco - Orlando - Ft Myers | | Las Vegas | |
| 1st Person \$99 rt | 2nd Person \$59 rt | 1st Person \$149 rt | 2nd Person \$109 rt | 1st Person \$159 rt | 2nd Person \$119 rt |
| Dallas | | | | San Diego - Phoenix | |
| 1st Person \$109 rt | 2nd Person \$79 rt | | | 1st Person \$169 rt | 2nd Person \$129 rt |
| Travel August 23 - Oct 7. Travel not valid Sept 2, 5, 6. All passengers must travel together. Travel Oct 8 - Nov 18 prices slightly higher, travel not valid Oct 15 - 23. | | | | | |



- All cruises listed include round trip air from MSP!

| | | |
|---|--|---|
| <p style="text-align: center;"> NORWEGIAN</p> <p style="text-align: center;">Dream from \$599</p> <p style="text-align: center;">Balconies from \$899 Oct 15 - Apr 15, 2006 7 nt Caribbean cruise Cozumel - Roatan - Belize - Cancun</p> | <p style="text-align: center;"> Carnival</p> <p style="text-align: center;">Elation from \$699</p> <p style="text-align: center;">Jan 29 - Apr 9, 2006 7 nt Caribbean cruise Progreso - Cozumel - Belize</p> | <p style="text-align: center;"> PRINCESS CRUISES</p> <p style="text-align: center;">Star Princess</p> <p style="text-align: center;">from \$749</p> <p style="text-align: center;">Balconies from \$999 Nov 13 - Apr 9, 2006 7 nt Caribbean cruise Princess Cays - Cozumel - Grand Cayman - Ocho Rios - Montego Bay</p> |
| <p style="text-align: center;"> Carnival</p> <p style="text-align: center;">Valor from \$749</p> <p style="text-align: center;">Balconies from \$949 Nov 13 - Apr 9, 2006 7 nt Caribbean cruise with 2 alternating itineraries Nassau, St Thomas, St Maarten OR Belize, Roatan, Grand Cayman,</p> | <p style="text-align: center;"> NORWEGIAN</p> <p style="text-align: center;">Jewel from \$799</p> <p style="text-align: center;">Balconies from \$999 Jan 29 - Apr 9, 2006 7 nt Caribbean cruise with 2 alternating itineraries. NCL Private Island, Ocho Rios, Grand Cayman, Roatan OR San Juan, Antigua, St Thomas, NCL Private Island</p> | <p style="text-align: center;"> ROYAL CARIBBEAN INTERNATIONAL</p> <p style="text-align: center;">Explorer of the Seas</p> <p style="text-align: center;">from \$849</p> <p style="text-align: center;">Balconies from \$999 Nov 13 - Apr 9, 2006 7 nt Caribbean cruise Aruba, Curacao, St Maarten, St Thomas</p> |
| <p style="text-align: center;"> NORWEGIAN</p> <p style="text-align: center;">Wind Hawaii from: \$1199*</p> <p style="text-align: center;">August 24 - December 28, 2005</p> | | |

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| Packages from \$188 Westward Ho \$188 El Cortez \$198 Lady Luck \$203 Plaza Las Vegas \$207 | Air Only from \$129 Fitzgeralds \$213 Gold Coast \$243 Stardust \$249 MGM Grand \$428 |
|--|--|
| RT airfare, 3nts hotel, based on dbl occupancy | |

| |
|--|
| |
| Honolulu from \$799 Kona from \$888 Maui from \$889 Kauai from \$1084 |
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|----------------------|----------|----------|---------------|-------------------------|----------|----------|---------------|
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| Mazatlan from | \$269 | \$438 | \$634 | Ixtapa from | \$349 | \$599 | \$940 |
| Puerto Vallarta from | \$269 | \$486 | \$625 | Los Cabos from | \$349 | \$684 | \$915 |
| Cancun from | \$279 | \$497 | \$669 | Jamaica from | \$359 | \$785 | \$899 |
| Riviera Maya from | \$279 | \$1111 | \$1111 | Dominican Republic from | \$439 | \$857 | \$857 |
| Manzanillo from | \$299 | \$627 | \$627 | Aruba from | \$449 | \$972 | \$1599 |

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 All Prices are subject to availability and subject to change. Airfare Specials are based on travel from Minneapolis. Cruise prices do not include port charges of up to \$226 per person based on a 7 day Caribbean Cruise. Packages based on double occupancy & are per person. All prices quoted are per person. Prices do not include taxes and fees up to \$82 for Mexican destinations and up to \$100 for Caribbean destinations. Passenger facility charges of up to \$4 each way for domestic departures, Hawaii taxes and fees of up to \$13, segment fees of \$3 per segment per person for domestic departures are not included. September 11th security fee of up to \$10 per person and US security surcharges up to \$15 per person not included.

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26 involves “hobbits,” fictional beings who inhabited a fictional Middle
27 Earth. And the story also involves a quest undertaken by four hobbits,
28 along with two men, one elf, one dwarf, and one wizard, to destroy a ring.
29 As is apparent from the Examining Attorney’s argument, the connection
30 between hobbits (and others) undertaking a quest in a fictitious Middle
31 Earth, on the one hand, and a tour of present day New Zealand, on the
32 other, is tenuous and indirect. This “piecing together” of information to
33 derive meaning is the hallmark of a *suggestive* rather than a *descriptive*
34 mark.

35 Are you maybe giving this theory too much credence
36 here? How many Americans even know that the film was
37 made in NZ? Our fellow countrymen are notoriously ill-
38 informed about geography, and I’m sure a lot of people
39 would think it was made in Europe. People who know
40 anything about the books know they were written by a
41 Brit.

42 I think you should try to put the burden on the Examiner
43 to show that most people associate Middle Earth with New
44 Zealand, otherwise, our client should get the mark.

45 Third, the mark should be considered ambiguous due to the
46 multiple meanings of the word “hobbit.” In addition to the storybook
47 characters referenced by the Examining Attorney, there have been
48 numerous news reports during the past year regarding the discovery of a
49 specimen of a short species of human, dubbed “the hobbit,” on the
50 Indonesian island of Flores. See Exhibit 1 (articles TBD). Accordingly,
51 consumers encountering the HOBBITQUEST mark may well interpret it as
52 suggesting an archaeological expedition. The Federal Circuit and TTAB
53 have ruled that a word or phrase capable of multiple interpretations
54 cannot convey the kind of “immediate” information necessary to be
55 refused registration as merely descriptive.

56 Fourth, the mark should be deemed suggestive due to its peculiar
57 and ungrammatical structure, which forces readers to perform additional
58 “mental processing” in order to derive its significance. The mark
59 HOBBITQUEST might equally be thought to refer to a quest *by* a hobbit,
60 or a quest *to find* a hobbit. What the mark does *not* immediately convey is
61 the notion of a quest by nine travelers, four of which are hobbits, in a
62 literary work, much less a sightseeing tour of present day New Zealand.

63 For all of these reasons, applicant’s mark should be considered
64 suggestive rather than descriptive, and the Examining Attorney should
65 withdraw the refusal of registration.

66 Nice work! An unfair comp case I handled a while back
67 leads me to suggest a couple more arguments. The first
68 is that competitors in the field of conducting tours in New
69 Zealand do not use the mark HOBBITQUEST in connection
70 with their services. A little Googling shows that various
71 companies offer “middle earth” and “fellowship” and “Lord
72 of the Rings” tours, but I didn’t find anyone using
73 HOBBITQUEST. Maybe the client can give a declaration?
74 Second, you would want to argue that competitors do not
75 *need* to use HOBBITQUEST. In other words, there are
76 plenty of ways to brand this type of service without using
77 that phrase. In a court case, this could help avoid an
78 injunction, so I can’t help but think it will help win over
79 the Examiner.

80 ***Citation of Pending Application.*** The Examining Attorney
81 reported that she might refuse registration of applicant’s HOBBITQUEST
82 mark if the pending application for HOBBIT TRAVEL (the “111
83 application”) were to mature to registration. For the reasons that follow,
84 there is no likelihood of confusion between the two marks, and therefore

85 applicant's mark should be approved for publication without awaiting the
86 disposition of the 111 application.

87 First, in comparing the marks, there is a significant difference in
88 appearance, sound, meaning, and overall commercial impression. In
89 particular, the words QUEST and TRAVEL contain almost no overlap of
90 letters, and sound nothing like one another. While the word "travel"
91 blandly refers to movement from one place to another, the term "quest"
92 calls to mind bold adventures, with or without a long journey. The marks
93 could not be more different.

94 | I think it's common to argue the "strength" factor next.
95 | Shouldn't we point out that TRAVEL is a generic term in
96 | relation to the earlier applicant's travel agency services?

97 Second, there is no overlap between the parties' goods. The
98 applicant draws the Examining Attorney's attention to the amendment of
99 its recitation of services to "conducting sightseeing tours in New
100 Zealand." To "conduct," in the context of sightseeing tours, means "to
101 lead" or "to guide"; it is somewhat synonymous with the word "to
102 accompany." While the 111 application mentions "conducting travel
103 tours," this phrase should be understood in its full context: "travel agency
104 services; namely, arranging and conducting travel tours and vacation
105 packages." The fact is, travel agents do not "lead" or "guide" or
106 "accompany" tours — they sell them on behalf of others. Inasmuch as the
107 entire wording must be interpreted in a sensible manner, the Examining
108 Attorney should disregard the phrase "and conducting" in the 111
109 application.

110 Furthermore, the use of HOBBIT TRAVEL is, in fact, limited to
111 travel arrangements in the United States, Mexico, the Caribbean and
112 Europe. See Exhibit 2 (website printout in file). New Zealand, located to
113 the South of Australia, is about the furthest habitable point on Earth from

114 the destinations booked by the HOBBIT TRAVEL agency. Accordingly,
115 the Examining Attorney should not stretch the recitation of services in the
116 111 application to reach “sightseeing tours in New Zealand.” Instead, the
117 Examining Attorney should resolve any uncertainty about the scope and
118 use of the earlier applicant’s mark by approving this application for
119 publication, and letting the public decide whether to file an opposition.

120 | A trip to New Zealand from the United States costs
121 | several thousand dollars and may be a once-in-a-lifetime
122 | journey. Shouldn’t we make the argument that
123 | purchasers will exercise a high degree of care in choosing
124 | a tour so that they can make sure they are spending their
125 | vacation time and dollars wisely? I’m fairly certain this is
126 | a valid argument under the LOC test used in the Federal
127 | Circuit these days.

128 | Third, the two companies have used their respective marks
129 | simultaneously for several years without any actual confusion.

130 | For all of these reasons, the Examining Attorney should withdraw
131 | the citation and approve this application for publication.

132 | Congratulations! Now, don’t let your next four weeks
133 | with the business department dull your fighting spirit. ;-)

- Q1. Consider the first argument in response to the descriptiveness rejection (lines 16-19). Briefly describe the most glaring reason that this argument must fail.
Please answer in a blue book or in the exam software, referring to Q1.
- Q2. Consider the second argument in response to the descriptiveness rejection (lines 20-34). How good are the prospects for success in overcoming the refusal of registration based on this argument?
- A. Very good, because the “imagination test” is sanctioned by the TMEP as the appropriate test to differentiate a suggestive mark from a merely descriptive one.
 - B. Not very good, because applicant’s recitation of services is broad enough to cover tours of Hobbiton, and no mental gymnastics are required with respect to at least that subset of services.
 - C. Very good, because relevant consumers planning a trip rely on “real world” information about the destination, rather than works of fiction.
 - D. Not very good, because pervasive media hype about the Lord of the Rings trilogy would cause relevant consumers to draw the connection pretty quickly, if not actually immediately.
 - E. It depends on whether KTG’s sightseeing tours reenact any of the scenes from the movie, rather than on the scope of services in the application.

Optional Explanation for Q2:

- Q3.** Consider the comment on the second descriptiveness argument (lines 35-44). Assuming that you were only able to submit evidence of (i) Americans' general ignorance of geography and (ii) author J.R.R. Tolkien's nationality, how much might the litigation associate's suggested argument help in overcoming the descriptiveness refusal (when combined with or added on to the Summer Associate's argument)?
- A.** A good deal, since the Examining Attorney has the burden of proof to "connect the dots," and this evidence would increase the pressure on the Examining Attorney to come forward with actual evidence of the awareness of relevant consumers that the films were shot in New Zealand.
 - B.** Hardly, because customers will eventually reach the pages on applicant's web site making the direct connection between the shooting of the Lord of the Rings films and the sightseeing tours.
 - C.** A good deal, because consumers will not perceive a descriptive meaning if the connection is "remote or obscure," by analogy to the analysis of marks containing geographic elements.
 - D.** Hardly, since the portion of the public that is relevant for purposes of the descriptiveness analysis would be limited to those evaluating sightseeing tours in New Zealand.
 - E.** It would backfire and solidify the refusal, because the Examining Attorney could then show that the special features included on the DVD revealed the location.

Optional Explanation for Q3:

Q4. Suppose that in your efforts to strengthen the argument discussed in Q3 that your research uncovers some news stories along the following lines: about five years ago, some University researchers set out to debunk the claim of several industry unions that moving production out of the United States to Toronto, Vancouver, Sydney, and other locations with lower labor costs, would damage the appearance of authenticity in American films. 1,132 citizens were polled at random and asked to identify certain locations in the popular films *Titanic* (1997), *As Good as It Gets* (1997), *Primary Colors* (1998), *Being John Malkovich* (1999), *Boys Don't Cry* (1999), and *Erin Brockovich* (2000). Respondents accepted the authenticity of interior locations 100% of the time, and of exterior locations 93% of the time, regardless of their actual locations. Does this evidence disprove the Examining Attorney's implicit assertion that relevant consumers will equate Middle Earth with New Zealand?

- A. Yes, the remaining 7% is just noise.
- B. No, there is no "authentic" Middle Earth to compare, so this poll would give invalid results if it were run for *Fellowship of the Ring*.
- C. Yes, it tends to suggest that moviegoers accept what they're told in the film, and the *Fellowship of the Ring* does not refer to New Zealand.
- D. No, even if viewers accept that New Zealand looks like what they imagine Middle Earth looked like, they might know full well where it was shot.
- E. Because a survey constitutes hearsay evidence, this article would not even be considered.

Optional Explanation for Q4:

Q5. Consider the third argument in response to the descriptiveness rejection (lines 45-55). Which of the following would be necessary to give this argument a chance to succeed?

- I. Evidence that this scientific discovery was widely reported, so that it would be plausible that relevant consumers might think of this “hobbit” in addition to the ones in the Lord of the Rings.
 - II. Evidence that there are at least one or two more “hobbit” skeletons to be excavated, so that it would be plausible that one might undertake an archaeological “quest” to do so.
 - III. Revising the recitation of services to cover lands where this new species of humans might be found.
- A. Both I and II.
 - B. Both II and III.
 - C. Both I and III.
 - D. I, II, and III.
 - E. None of the above.

Optional Explanation for Q5:

- Q6.** Consider the fourth argument in response to the descriptiveness rejection (lines 56-62). Let's assume that you cite the TTAB's decision in the case involving ZEROSURGE for surge suppressors, which supports the argument that an ungrammatical construction can render a mark suggestive. Is the argument likely to be persuasive?
- A.** Not really, because HOBBITQUEST is readily dissected into its parts and interpreted from there.
 - B.** Yes, the dictionary defines a quest as a search, so an analogy to the puzzling phrase HOBBITSEARCH would show that a little extra thinking would be needed to process the terms out of order.
 - C.** Not really, because consumers would either have one of the listed interpretations or the other, and not get bogged down in choosing.
 - D.** Maybe, but more evidence and/or argument would need to be presented as to why it was such an unusual or incorrect usage in order to make the argument work.
 - E.** Never, because it is not listed as a factor to consider in the TMEP.

Optional Explanation for Q6:

**Q7. Consider the comment following the descriptiveness arguments (lines 66-79).
What impact are these arguments likely to have on the Examining Attorney?**

- A. A significant impact, because the first film in the Lord of the Rings trilogy was released in the Fall of 2001, so there has been ample opportunity for third parties to use HOBBITQUEST, and their failure to do so proves that the phrase is not necessary to compete.**
- B. Very little, because even if the applicant was the first or is the only present user of the mark, that does not render it distinctive.**
- C. A significant impact, if KTG can persuade some of its competitors to submit declarations in support of its having obtained secondary meaning in the mark.**
- D. Very little, because others must have the right to make fair use of a descriptive mark.**
- E. None, because it is not listed as a factor to consider in the TMEP.**

Optional Explanation for Q7:

Q8. The draft response does not make any argument that combining “HOBBIT” and “QUEST” creates a mark that is “incongruous” or has a “double entendre.” Does the reasoning behind allowing registration of the following marks—which combine words that are not themselves distinctive in relation to the goods or services—apply to the compound mark HOBBITQUEST? Briefly explain why or why not. (Answer here or, if you prefer, in a blue book or in the exam software, in which case you should refer to Q8(1), Q8(2) and Q8(3), respectively.)

(1) MOUSE SEED

(2) LA YOGURT

(3) SUGAR & SPICE

Q9. Arguing that a mark is not descriptive always involves some degree of risk that the Examining Attorney will, in a second office action, refuse registration on the ground that the mark is deceptively misdescriptive under Lanham Act §2(e)(1). What arguments, if changed or added, would reduce this risk?

- I.** Stop denying that the phrase merely describes *some* sightseeing tours of New Zealand.
- II.** In a footnote, point out that movie viewers know hobbits do not actually exist, so relevant consumers would not believe that there are tours where they can find and see actual living hobbits.
- III.** In a footnote, point out that New Zealand is brimming with beautiful natural and cultural attractions, so the inclusion or exclusion of purported “hobbit” content from a particular tour package would not materially affect a consumer’s decision to purchase it.

- A.** I only.
- B.** II only.
- C.** III only.
- D.** I and II together, but not III.
- E.** II and III together, but not I.
- F.** None of the above.

Optional Explanation for Q9:

Q10. Consider the first argument in response to the potential likelihood of confusion rejection (lines 87-93). In what way(s) is this argument flawed?

- I. It admits that, at least in some cases, a quest involves travel, and therefore admits that the marks are legally identical.
 - II. It simply ignores half of the mark and, as a result, fails to explain why the marks are different when considered as a whole.
 - III. It analyzes the meaning of the words travel and quest “out of context,” rather than in relation to the services listed in the applications.
- A. Both I and II.
 - B. Both II and III.
 - C. Both I and III.
 - D. I, II, and III.
 - E. None of the above.

Optional Explanation for Q10:

- Q11.** Consider the comment after the first likelihood of confusion argument (lines 94-96). It would be easy to demonstrate that “travel” is a generic term in relation to the earlier applicant’s travel agency services. Would making this argument help or hurt KTG’s effort to overcome the potential refusal?
- A.** Help, because a weak mark is given the narrowest scope of protection.
 - B.** Hurt, because the non-generic element them would become “dominant,” and that would make the overall comparison less favorable to KTG.
 - C.** Help, because if HOBBIT is descriptive, then the entire HOBBIT TRAVEL mark consists of unprotectable elements and, assuming there is no incongruity or double meaning to the phrase as a whole, it can be disregarded by the Examining Attorney.
 - D.** Hurt, because the Examining Attorney then would argue that quest, too, is generic, which could have negative implications in later litigation to enforce rights in KTG’s mark.
 - E.** Neither — the strength of a mark is not listed in TMEP §1207.01 as part of the limited six factor likelihood of confusion test applied in trademark prosecution, so it would be ignored.

Optional Explanation for Q11:

Q12. Consider the second argument in response to the potential likelihood of confusion rejection (lines 97-109). What do you see as the problem(s) with this argument?

- I. The Examining Attorney can consider a wide range of evidence in determining the meaning of the services in an earlier application, but disregarding a phrase deemed to be incorrect would conflict with her obligation to maximize protection for the earlier mark.
 - II. The services normally provided under the rubric of “travel agency services” is a question of fact, so there is a lack of evidentiary support for the argument in the current draft.
 - III. Even if the phrase “and conducting” were disregarded as requested, the change from overlapping services to related services cannot, under the TMEP and applicable law, have any effect on the likelihood of confusion analysis.
- A. Both I and II.
 - B. Both II and III.
 - C. Both I and III.
 - D. I, II, and III.
 - E. None of the above.

Optional Explanation for Q12:

Q13. Consider the “furthermore” argument in response to the potential likelihood of confusion rejection (lines 110-119). Assume that the facts stated in the argument about the actual use of HOBBIT TRAVEL are true, and forgive the slight exaggeration about the distance between those destinations and New Zealand. Why is the Examining Attorney nevertheless likely to reject this argument?

- I. The 111 application does not need to be “stretched” to cover New Zealand because it contains no geographic limitations.
 - II. Arguments based on lack of use of a cited mark in connection with some or all of the services belong in a TTAB or court proceeding, and will not be decided in the examination process.
 - III. The three year presumption of abandonment doesn’t start running until the earlier mark becomes registered, so the non-use argument is simply premature.
- A. I only.
 - B. II only.
 - C. III only.
 - D. I and II together, but not III.
 - E. II and III together, but not I.
 - F. None of the above.

Optional Explanation for Q13:

Q14. Continuing the scenarios of Q12-Q13, your legal research reveals a potential basis on which to challenge the 111 application: an opposition alleging fraud on the PTO. Your client KTG would have to prove the following elements with clear and convincing evidence: (1) the statement in the 111 application that the HOBBIT TRAVEL mark is in use in connection with all of the listed services was either (a) literally false or (b) contained a willful omission; (2) the false statement or willful omission is material because the PTO would have acted differently had the true or complete information been filed; and (3) the applicant knew (or should have known) that the statement was false. Might such an opposition aid in responding to the pending office action?

- I. The failure to specify North and Central America, the Caribbean and Europe was *not* fraudulent, because a travel agency's use of a mark depends not on the number of destinations booked, but the locations of its customers.
 - II. If an investigation proves that HOBBIT TRAVEL was not used in connection with "conducting tours" at the time of filing, then that false statement *was* fraudulent because the PTO could not grant registration without a sworn allegation of use for all of the services.
- A. Only I is correct, so No.
 - B. Only II is correct, so Yes, *if* the application is published for opposition in the very near future.
 - C. Both I and II are correct, so Yes, to some extent, *if* the application is published for opposition in the very near future.
 - D. No, because even if the mark had not been used for "conducting tours," TMEP §806.03(c) would have allowed the Examining Attorney to convert those goods to an "intent to use" basis upon request before publication.
 - E. None of the above.

Optional Explanation for Q14:

- Q15.** Consider the comment before the third likelihood of confusion argument (lines 120-127). It would be easy to demonstrate the long flight time and high airfare involved in traveling to and from New Zealand. Supported by that evidence, would this proposed argument about purchaser care play a significant role in the Examining Attorney’s likelihood of confusion analysis in this case?
- A.** Yes, the exercise of care by purchasers is one of the six likelihood of confusion factors that made the short list in TMEP §1207.01.
 - B.** Yes, if the argument is also supported by evidence showing that people carefully research overseas vacation packages before purchasing them.
 - C.** No, the website at www.hobbittravel.com constantly emphasizes “low fares,” so even if KTG charges high prices, there could be reverse confusion among customers using HOBBIT TRAVEL services.
 - D.** No, unless both applications are amended to refer to expensive tours.
 - E.** Frankly, it is impossible to say because the balancing test is very subjective.

Optional Explanation for Q15:

Q16. Consider the third argument in response to the potential likelihood of confusion rejection (lines 128-129). Assume that this is expanded to explain that both companies operate on the internet, that HOBBITQUEST sightseeing tours also are sold by independent travel agents in various U.S. cities, and that KTG has never received any inquiries evidencing consumer confusion. Why is the Examining Attorney nevertheless likely to reject this argument?

- I. It is not possible to obtain a complete picture of whether there have been incidents of “actual confusion” without hearing from the owner of the 111 application, and the PTO has no procedure for obtaining that information.
 - II. Past experience reflects a narrower geographic usage of HOBBIT TRAVEL than the 111 application describes, and the Examining Attorney needs to consider whether confusion is likely if HOBBIT TRAVEL is used to the full extent of its recited services.
 - III. The Examining Attorney must decide whether there is a likelihood of confusion in the future, and past coexistence is irrelevant because as consumers’ memories of the Lord of the Rings trilogy fade, they will find the similarity of the marks much more striking.
- A. Both I and II.
 - B. Both II and III.
 - C. Both I and III.
 - D. I, II, and III.
 - E. None of the above.

Optional Explanation for Q16:

Scenario Two

Fast forward to September 2006 as you begin your second year at Silicon Valley's newest law firm, formed with a focus on interactive and online entertainment.

Suddenly you receive an email message from a potential new client:

Hi, I need a lawyer. Let me give you the background. My name is Sam, and back in the Summer of 2004, around the time of the last episode of Friends, I was grieving. Sure, there would be syndication, but I loved those guys, and I really wanted to stay with them and be part of their lives after the show ended. The problem was, where would they go from there? I decided to set up a web log (blog) where I could converse with other people like me about the possibilities. After trying out a whole lot of possible domain names, I settled on FriendsReunion.tv, and also registered FriendsReunion under .net, .org, and .info, which all point to the same site. I couldn't get the .com, though; it was registered by a British dating company.

Anyway, the site has been a huge success. It went from a hobby for me and a few "friends" (ha ha) to a national phenomenon. Once my hosting fees reached \$50 per month, I started accepting advertising. It was really important that the site be free to users. But the ads really didn't bring in enough to cover the costs, so I had to start hooking up with other services. A lot of this was pretty dumb stuff like bobble-head dolls of the characters, but some was better, like some travel companies offering Friends' Tours of New York City, and a photo studio inserting you into a still image from the show. These were fun, and a small percentage of the sales helped with the costs. I haven't made any money from the site per se, but I was able

to substantially upgrade my computers, servers, and other “stuff” associated with the site using the proceeds of these partnerships.

So now comes the “problem.” I just got a surprise offer from Wenner, the publishers of “Us” magazine, to buy out my site for \$250,000. They want me to continue writing for them five hours per week for six months (no problem, I’d blog that much anyway), but I also have to sign this complicated paperwork that seems to say I have lots of rights that I’ve never even thought about. For example, there’s a “warranty” that I own “all intellectual property rights in the FriendsReunion mark.” I never filed a trademark. And this: “indemnify, defend, and hold harmless BUYER against any and all claims based on trademark, trade name, domain name, publicity, celebrity, privacy, or other rights or theories, arising out of or related to the site as presently designed, for three (3) years from the EFFECTIVE DATE.” This seems to say that if anyone sues them, I have to pay, and long after I leave their employ. I guess they are offering me a lot of money, but do you think it might be a mistake to sign this? I look forward to hearing from you.

You have a lot to think about before replying. You look up the Friends television program, and discover that it was produced by Warner Brothers Television, which has common ownership with the publishers of People magazine, a direct competitor of Us Weekly. It seems pretty reasonable to expect that when Wenner takes over the site, there might be trouble. Next, you need to check out the site and work through a few theories of potential liability and defenses.

Q17. The home page of Sam’s site features a picture of New York City with the phrase “Where are they now?” Under the picture is this text: “Welcome to <http://www.FriendsReunion.tv/>, the blog where fans of the Friends get to decide what happens to Monica, Chandler, Joey, Rachel, Ross and Phoebe. Come on in!” The site’s “About” page describes Sam’s reasons for starting the blog, and why the site has to have advertising. All of the page titles that appear in the browser’s window title area read “Where are they now? The Blog.” There don’t appear to be any other references to the phrase FriendsReunion on the site. How concerned should Sam be about giving a warranty of ownership of rights in the FriendsReunion mark?

- A. Hardly, because the site is active, so the mark clearly has not been abandoned.
- B. Very, because the mark was never registered, so ownership will not be presumed.
- C. Hardly, because registering a domain name automatically constitutes use in interstate commerce.
- D. Very, because the use made of FriendsReunion on the site is not likely to be deemed use as a trademark.
- E. Hardly, because the top level domain (.tv) will be disregarded in any comparison of marks.

Optional Explanation for Q17:

Q18. The FriendsReunion.tv site features a wide graphic across the top of every page with the tag line “Where are your Friends, and what are they up to?” positioned above navigational buttons bearing the names of the six main characters in the program. The font used in the tag line matches the one used in the program’s logo, but the presentation of the word Friends, while larger than the other text, is not the same as the program’s logo because there are no “dots” between the letters. At the bottom of each page is a copyright notice, and the notation “Unofficial site not affiliated with or sponsored by anyone connected with the show.” How concerned should Sam be about a trademark infringement claim being brought by Time Warner Entertainment either now, or after the acquisition?

- A. Very, because Wenner might change the site to more blatantly mimic the Friends program logo, and they’ll surely try to squeeze that under the indemnity clause somehow.
- B. Hardly, because the tag line graphic meets the *New Kids* requirement to use the minimum similarity needed to “call to mind” the television program.
- C. Very, because there are other ways to “call to mind” the television program without adopting any of the stylization of its logo.
- D. Hardly, because the use is descriptive in nature, and therefore within the scope of *KP Permanent Make-up*.
- E. Very, because the use of any well known mark inevitably creates a likelihood of consumer perception of false endorsement.

Optional Explanation for Q18:

Q19. You investigate the site at <http://www.FriendsReunion.com/> and discover that it promotes a dating service and provides a link to a sister site. In fact, if you do nothing, your browser proceeds to the sister site after fifteen seconds. Both sites are based in the United Kingdom, and as far as you can tell, the services are oriented toward arranging dates only in the U.K. Also, FriendsReunion does not appear anywhere on the second site. How concerned should Sam be about a statutory or common law trademark infringement claim being brought by the registrant of FriendsReunion.com either now, or after the acquisition?

- A. Very, because the site is available to U.S. users, even if its services would only be used to arrange dates in the U.K.
- B. Very, because registering a domain name automatically constitutes use in interstate commerce and may give rise to *in rem* jurisdiction.
- C. Very, because Sam was aware of the earlier registration of FriendsReunion.com, and therefore is a willful infringer.
- D. Hardly, because the top level domains (.com and .tv) are so different, that no court would find the domain names similar overall.
- E. Hardly, because the use made of FriendsReunion in the FriendsReunion.com domain name and on the corresponding site is not likely to be deemed use as a trademark.

Optional Explanation for Q19:

- Q20.** The site features individual blogs for each of the six main characters of Friends. At the top of each blog page, under the standard graphic, is a two column presentation about the character. On the left is a flattering photo of the actor, which is not attributed to any specific source. On the right is a brief summary of some of the character's main traits, as well as a few story points about where the character's development left off two years ago. There is no mention of any biographical details about the actors, just the characters. Further to the right, outside the blog's main border, is a "tombstone" style (tall) advertisement that changes when the page is reloaded. How concerned should Sam be about a statutory or common law "right of publicity" claim being brought either now, or after the acquisition by one or more of the actors?
- A.** Hardly, because the blog uses the photo merely to identify a character in an old television program, and not in advertising or on a product for sale.
 - B.** Very, because the site already is generating surplus advertising and partnership revenues, and is likely to generate much more in the future given Wenner's marketing clout.
 - C.** Hardly, because the actors' rights are preempted by the Copyright Act when their photos are publicity shots supplied by the program's producer.
 - D.** Very, because especially in the Ninth Circuit when interpreting California law, common law protection is constantly expanding to protect new forms of identity (e.g., *Midler; White*).
 - E.** Hardly, because more and more courts are finding that a compelling First Amendment argument will excuse even a commercial use of a celebrity's likeness (e.g., *Cardtoons; Jireh Publishing*).

Optional Explanation for Q20:

Q21. You retrieve selected pages from the old May 2004 NBC web site using the Internet Archive. At that time, NBC linked from its Friends pages to at least eight “fan sites” and allowed users to comment and vote on those sites on NBC’s own site. At this point, it is impossible to determine whether there might have been any oral or written agreement between the site owners and anyone connected with the television program. How might these research results affect your advice about Sam’s site?

- I. The show’s producers and the actors clearly do not object to third party sites that depict them in a favorable manner, promoting the program and the actors’ careers.
 - II. While fan sites helped build loyalty to the program during its run, there is no way to predict the attitudes of the show’s producers and the actors to fan sites that continue to exist today.
 - III. Allowing so many sites to flourish without strict control constitutes “naked licensing” and undermines any claims of infringement of trademark or of the right of publicity.
- A. I only.
 - B. II only.
 - C. III only.
 - D. I and III.
 - E. II and III.
 - F. None of the above.

Optional Explanation for Q21:

Q22. If Sam’s site really has become a “national phenomenon,” then if Time Warner Entertainment (“TWE”) objected to the blog they should have contacted Sam by now. It is reasonable to assume that at least some other Friends-related sites on the web also are operating without any formal permission. If research were to bear that out, how might it affect your advice about Sam’s possible defenses to a trademark infringement claim?

- I. TWE has voluntarily abandoned all rights in the FRIENDS mark by declaring that it would not make any new episodes of the show.
 - II. TWE has involuntarily abandoned rights in the FRIENDS mark, with respect to internet “fan sites,” by failing to “police” use of its mark in that market.
 - III. TWE’s inaction has given rise to the equitable defenses of “laches” and “acquiescence” with respect to Sam’s activities as they stand today, but not with respect to an infringement claim against new activities undertaken by Wenner in the future.
- A. I and II are potentially viable, but not III.
 - B. I and III are potentially viable, but not II.
 - C. II and III are potentially viable, but not I.
 - D. Only III is viable, because courts are so reluctant to find an abandonment.
 - E. None of the above.

Optional Explanation for Q22:

END OF EXAM