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Mark: REDBOX IT TONIGHT!

REDBOX IT TONIGHT!

US Serial Number: 85066912

Application Filing Date: Jun. 18, 2010

US Registration Number: 4075951

Registration Date: Dec. 27, 2011

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



DEAD/REGISTRATION/Cancelled/Invalidated

The trademark application was registered, but subsequently it was cancelled or invalidated and removed from the registry.

Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Aug. 03, 2018

Publication Date: Jun. 21, 2011

Date Cancelled: Aug. 03, 2018

Mark Information

Mark Literal Elements: REDBOX IT TONIGHT!

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 2919854, 3082012, 3229436 and others

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Automated retail services, namely, providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: SECTION 8 - CANCELLED

First Use: Feb. 26, 2010

Use in Commerce: Feb. 26, 2010

For: Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: SECTION 8 - CANCELLED

First Use: Feb. 26, 2010

Use in Commerce: Feb. 26, 2010

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Redbox Automated Retail, LLC

Owner Address: Suite 1200
One Tower Lane
Oakbrook Terrace 60181

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: The data cannot be loaded

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James P. Muraff

Docket Number: 19638.15T1

Attorney Primary Email Address: trademarks@ngelaw.com

Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: JAMES P. MURAFF
NEAL, GERBER & EISENBERG LLP
2 N LASALLE ST STE 1700
CHICAGO, ILLINOIS UNITED STATES 60602-4000

Phone: 312-269-8000

Fax: 312-269-1747

Correspondent e-mail: trademarks@ngelaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 03, 2018	CANCELLED SEC. 8 (6-YR)	
Dec. 27, 2016	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Oct. 05, 2016	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Dec. 27, 2011	REGISTERED-PRINCIPAL REGISTER	
Nov. 04, 2011	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Aug. 03, 2011	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Jul. 01, 2011	EXTENSION OF TIME TO OPPOSE RECEIVED	
Jun. 21, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 21, 2011	PUBLISHED FOR OPPOSITION	
May 19, 2011	LAW OFFICE PUBLICATION REVIEW COMPLETED	
May 18, 2011	ASSIGNED TO LIE	
May 04, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 08, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED	
Apr. 07, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Apr. 07, 2011	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 07, 2010	NOTIFICATION OF NON-FINAL ACTION E-MAILED	
Oct. 07, 2010	NON-FINAL ACTION E-MAILED	
Oct. 07, 2010	NON-FINAL ACTION WRITTEN	
Sep. 25, 2010	ASSIGNED TO EXAMINER	

Jun. 24, 2010 NOTICE OF PSEUDO MARK MAILED
Jun. 23, 2010 NEW APPLICATION OFFICE SUPPLIED DATA ENTERED
Jun. 22, 2010 NEW APPLICATION ENTERED

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Dec. 27, 2011

Assignment Abstract Of Title Information

Summary

Total Assignments: 5

Registrant: Redbox Automated Retail, LLC

Assignment 1 of 5

Conveyance: AMENDED AND RESTATED SECURITY AGREEMENT

Reel/Frame: [4590/0957](#)

Pages: 8

Date Recorded: Jul. 26, 2011

Supporting Documents: [assignment-tm-4590-0957.pdf](#)

Assignor

Name: [REDBOX AUTOMATED RETAIL, LLC](#)

Execution Date: Jul. 15, 2011

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Assignee

Name: [BANK OF AMERICA, N.A.](#)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Address: 901 MAIN STREET
MAIL CODE: TX1-492-14-14
DALLAS, TEXAS 75202

Correspondent

Correspondent Name: GAVIN GEORGE

Correspondent Address: HAYNES AND BOONE, LLP
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Domestic Representative - Not Found

Assignment 2 of 5

Conveyance: SECURITY INTEREST

Reel/Frame: [5885/0027](#)

Pages: 8

Date Recorded: Sep. 27, 2016

Supporting Documents: [assignment-tm-5885-0027.pdf](#)

Assignor

Name: [REDBOX AUTOMATED RETAIL, LLC](#)

Execution Date: Sep. 27, 2016

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Assignee

Name: [JEFFERIES FINANCE LLC, AS COLLATERAL AGENT](#)

Legal Entity Type: BANK

State or Country Where Organized: UNITED STATES

Address: 520 MADISON AVENUE
NEW YORK, NEW YORK 10022

Correspondent

Correspondent Name: CORPORATION SERVICE COMPANY

Correspondent Address: 1090 VERMONT AVENUE, NW
WASHINGTON, DC 20005

Domestic Representative - Not Found

Assignment 3 of 5

Conveyance: RELEASE OF INTELLECTUAL PROPERTY SECURITY INTEREST

Reel/Frame: [5885/0636](#)

Pages: 16

Date Recorded: Sep. 27, 2016

Supporting Documents: [assignment-tm-5885-0636.pdf](#)

Assignor

Name: [BANK OF AMERICA, N.A.](#)

Execution Date: Sep. 27, 2016

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Assignee

Name: [REDBOX AUTOMATED RETAIL, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: ONE TOWER LANE, SUITE 900
OAKBROOK TERRACE, ILLINOIS 60181

Correspondent

Correspondent Name: VENISA DARK, HAYNES AND BOONE LLP

Correspondent Address: 2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Domestic Representative - Not Found

Assignment 4 of 5

Conveyance: SECURITY INTEREST

Reel/Frame: [6187/0046](#)

Pages: 7

Date Recorded: Oct. 20, 2017

Supporting Documents: [assignment-tm-6187-0046.pdf](#)

Assignor

Name: [REDBOX AUTOMATED RETAIL LLC](#)

Execution Date: Oct. 20, 2017

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Assignee

Name: [HPS INVESTMENT PARTNERS, LLC, AS COLLATERAL AGENT](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 40 WEST 57TH STREET
NEW YORK, NEW YORK 10019

Correspondent

Correspondent Name: KRISTIN YOHANNAN, ESQ.

Correspondent Address: 1850 K STREET, NW, SUITE 1100
MILBANK, TWEED, HADLEY & MCCLOY, LLP
WASHINGTON, DC 20006

Domestic Representative - Not Found

Assignment 5 of 5

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [7819/0650](#)

Pages: 7

Date Recorded: Aug. 11, 2022

Supporting Documents: [assignment-tm-7819-0650.pdf](#)

Assignor

Name: [JEFFERIES FINANCE LLC, AS COLLATERAL AGENT](#)

Execution Date: Aug. 11, 2022

Legal Entity Type: BANK

State or Country Where Organized: UNITED STATES

Assignee

Name: [REDBOX AUTOMATED RETAIL, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: ONE TOWER LANE
OAKBROOK TERRACE, ILLINOIS 60181

Correspondent

Correspondent Name: EPSTEIN DRANGEL LLP

Correspondent Address: 60 EAST 42ND STREET
SUITE 1250
NEW YORK, NY 10165

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Extension of Time

Proceeding Number: [85066912](#)

Filing Date: Jun 30, 2011

Status: Terminated

Status Date: Nov 04, 2011

Interlocutory Attorney:

Defendant

Name: Redbox Automated Retail, LLC

Correspondent Address: JAMES P. MURAFF
NEAL, GERBER & EISENBERG LLP
2 N LASALLE ST STE 1700
CHICAGO IL UNITED STATES , 60602-4000

Associated marks

Mark	Application Status	Serial Number	Registration Number
REDBOX IT TONIGHT!		85066912	

Potential Opposer(s)

Name: Box.net, Inc.

Correspondent Address: Brian R. Coleman
Perkins Coie, LLP
3150 Porter Drive
Palo Alto CA UNITED STATES , 94304

Correspondent e-mail: coleb@perkinscoie.com

Prosecution History

Entry Number	History Text	Date	Due Date
2	EXTENSION OF TIME GRANTED	Jul 01, 2011	
1	INCOMING - EXT TIME TO OPPOSE FILED	Jun 30, 2011	

From: TMOOfficialNotices@USPTO.GOV
Sent: Tuesday, December 27, 2016 01:06 AM
To: XXXX
Subject: Official USPTO Courtesy Reminder of Required Trademark Registration Maintenance Filing Under Section 8: U.S. Trademark RN 4075951: REDBOX IT TONIGHT!: Docket/Reference No. 19638.15T1

U.S. Serial Number: 85066912
U.S. Registration Number: 4075951
U.S. Registration Date: Dec 27, 2011
Mark: REDBOX IT TONIGHT!
Owner: Redbox Automated Retail, LLC

Dec 27, 2016

**U.S. PATENT AND TRADEMARK OFFICE ("USPTO") COURTESY REMINDER
OF REQUIRED TRADEMARK REGISTRATION MAINTENANCE FILING UNDER SECTION 8**

WARNING: Your trademark registration will be CANCELLED if you do not file the required document below during the specified statutory time period.

The above-identified registration registered on Dec 27, 2011. Therefore, the owner of the registration must file a Declaration of Use and/or Excusable Nonuse under §8 of the Trademark Act anytime between now and Dec 27, 2017. For an additional fee, the owner may file the declaration within the six-month grace period that ends on Jun 27, 2018. See 15 U.S.C. §1058. The current fee for filing a declaration under §8 is \$100 per class, and the additional fee for filing during the six-month grace period is \$100 per class. 37 C.F.R. §2.6.

If the registration meets the requirements of §15 of the Trademark Act, the owner may additionally file an optional Declaration of Incontestability under §15. See 15 U.S.C. §1065. The current fee for filing a declaration under §15 is \$200 per class. 37 C.F.R. §2.6.

To expedite processing, the owner is encouraged to file through the USPTO's official website using the Trademark Electronic Application System ("TEAS"). Official forms for filing Declarations of Use and/or Excusable Nonuse under §8 and Combined Declarations of Use and Incontestability under §§8 and 15 are available through TEAS at http://www.uspto.gov/trademarks/teas/reg_maintain.jsp.

For information regarding how to record ownership documents such as assignments, name changes and mergers, please see TMEP §503. To expedite recordation, the owner is encouraged to file requests for recordation through the Electronic Trademark Assignment System ("ETAS") at <http://etas.uspto.gov>.

For further information regarding the maintenance of a trademark registration, including future maintenance filings, please consult the USPTO website at <http://www.uspto.gov/trademarks/process/maintain/prfaq.jsp>.

This reminder notice is being sent only as a courtesy to those trademark owners who have authorized e-mail communication and maintain a current e-mail address with the USPTO. Failure by the USPTO to send a reminder or non-receipt of a reminder does not excuse a trademark owner from meeting the statutory obligations for maintaining a trademark registration. If a registration is cancelled and/or expired due to the failure to timely file required maintenance documents, it cannot be reinstated or revived.

To check the status of this registration, go to http://tsdr.uspto.gov/#caseNumber=85066912&caseType=SERIAL_NO&searchType=statusSearch or contact the Trademark Assistance Center at 1-800-786-9199.

Beware of Unofficial Trademark Solicitations: Please be aware that private companies not associated with the USPTO often use trademark registration information from the USPTO's database to mail or e-mail trademark-related solicitations. This is the only official reminder that you will receive from the USPTO about your upcoming required maintenance filing. For additional information about these private solicitations, please visit the USPTO website at http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

In order to be eligible for future e-mail reminders of maintenance filings, please remember to authorize e-mail communication when filing your maintenance documents through TEAS and ensure that you maintain a current e-mail address with the USPTO.

United States of America

United States Patent and Trademark Office

REDBOX IT TONIGHT!

Reg. No. 4,075,951

Registered Dec. 27, 2011

Int. Cls.: 35 and 41

SERVICE MARK

PRINCIPAL REGISTER

REDBOX AUTOMATED RETAIL, LLC (DELAWARE LIMITED LIABILITY COMPANY)
SUITE 1200
ONE TOWER LANE
OAKBROOK TERRACE, IL 60181

FOR: AUTOMATED RETAIL SERVICES, NAMELY, PROVIDING AUTOMATED RETAIL VENDING MACHINES FEATURING DVDS, MOVIES, PRERECORDED ELECTRONIC MEDIA FEATURING ENTERTAINMENT CONTENT, AND VIDEO GAME SOFTWARE FOR PURCHASE; AUTOMATED RETAIL SERVICES, NAMELY, ONLINE RETAIL STORE SERVICES FEATURING DVDS, MOVIES, PRERECORDED ELECTRONIC MEDIA FEATURING ENTERTAINMENT CONTENT, AND VIDEO GAME SOFTWARE FOR PURCHASE, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-26-2010; IN COMMERCE 2-26-2010.

FOR: ENTERTAINMENT RENTAL SERVICES PROVIDED THROUGH AUTOMATED VENDING MACHINES, NAMELY, RENTAL OF DVDS, MOVIES, PRERECORDED ELECTRONIC MEDIA FEATURING ENTERTAINMENT CONTENT, AND VIDEO GAME SOFTWARE; AUTOMATED RENTAL OF DVDS, MOVIES, PRERECORDED ELECTRONIC MEDIA FEATURING ENTERTAINMENT CONTENT, AND VIDEO GAME SOFTWARE, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 2-26-2010; IN COMMERCE 2-26-2010.

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

OWNER OF U.S. REG. NOS. 2,919,854, 3,229,436 AND OTHERS.

SER. NO. 85-066,912, FILED 6-18-2010.

DAVID TOOLEY, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

From: TMOOfficialNotices@USPTO.GOV
Sent: Tuesday, June 21, 2011 00:25 AM
To: XXXX
Subject: Official USPTO Notice of Publication: Serial Number 85066912

NOTICE OF PUBLICATION

Serial Number: 85-066,912
Mark: REDBOX IT TONIGHT!(STANDARD CHARACTER MARK)
International Class(es): 035, 041
Applicant: Redbox Automated Retail, LLC
Attorney Reference Number: 19638.15T1

The mark identified above has been published in the *Trademark Official Gazette* (OG) on Jun 21, 2011. Any party who believes it will be damaged by the registration of the mark may file a notice of opposition (or extension of time therefor) with the Trademark Trial and Appeal Board. If no party files an opposition or extension request within thirty (30) days after the publication date, then within twelve (12) weeks of the publication date a certificate of registration should issue.

On the publication date or shortly thereafter, the applicant should carefully review the information that appears in the OG for accuracy (see steps, *below*). If any information is incorrect, the applicant should immediately email the requested correction to **TMPostPubQuery@uspto.gov**. For general information about this notice, please contact the Trademark Assistance Center at 1-800-786-9199.

1. Click on the following link or paste the URL into an internet browser: http://www.uspto.gov/web/trademarks/tmog/20110621_OG.pdf#page=1
2. Wait for the total OG to download completely (as indicated on bottom of OG page).
3. At the top/side of the displayed page, click wherever the "binoculars" icon appears.
4. Enter in the "search" box the name of the applicant (for individual: last name, first name) or the serial number in this exact format (with hyphen and comma): 85-066,912, e.g.
5. View the retrieved result(s). If multiple results appear in the "results" box, click directly on each "search term" shown in the box to access all separate appearances in the OG.

Trademark Snap Shot Publication & Issue Review Stylesheet
(Table presents the data on Publication & Issue Review Complete)

OVERVIEW

SERIAL NUMBER	85066912	FILING DATE	06/18/2010
REG NUMBER	0000000	REG DATE	N/A
REGISTER	PRINCIPAL	MARK TYPE	SERVICE MARK
INTL REG #	N/A	INTL REG DATE	N/A
TM ATTORNEY	TOOLEY, DAVID E	L.O. ASSIGNED	112

PUB INFORMATION

RUN DATE	05/20/2011		
PUB DATE	06/21/2011		
STATUS	681-PUBLICATION/ISSUE REVIEW COMPLETE		
STATUS DATE	05/19/2011		
LITERAL MARK ELEMENT	REDBOX IT TONIGHT!		
DATE ABANDONED	N/A	DATE CANCELLED	N/A
SECTION 2F	NO	SECTION 2F IN PART	NO
SECTION 8	NO	SECTION 8 IN PART	NO
SECTION 15	NO	REPUB 12C	N/A
RENEWAL FILED	NO	RENEWAL DATE	N/A
DATE AMEND REG	N/A		

FILING BASIS

FILED BASIS		CURRENT BASIS		AMENDED BASIS	
1 (a)	YES	1 (a)	YES	1 (a)	NO
1 (b)	NO	1 (b)	NO	1 (b)	NO
44D	NO	44D	NO	44D	NO
44E	NO	44E	NO	44E	NO
66A	NO	66A	NO		
NO BASIS	NO	NO BASIS	NO		

MARK DATA

STANDARD CHARACTER MARK	YES
LITERAL MARK ELEMENT	REDBOX IT TONIGHT!
MARK DRAWING CODE	4-STANDARD CHARACTER MARK
COLOR DRAWING FLAG	NO

CURRENT OWNER INFORMATION

PARTY TYPE	10-ORIGINAL APPLICANT
------------	-----------------------

NAME	Redbox Automated Retail, LLC
ADDRESS	Suite 1200 One Tower Lane Oakbrook Terrace, IL 60181
ENTITY	16-LTD LIAB CO
CITIZENSHIP	Delaware

GOODS AND SERVICES

INTERNATIONAL CLASS	035
DESCRIPTION TEXT	Automated retail services, namely, providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase
INTERNATIONAL CLASS	041
DESCRIPTION TEXT	Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

GOODS AND SERVICES CLASSIFICATION

INTERNATIONAL CLASS	035	FIRST USE DATE	02/26/2010	FIRST USE IN COMMERCE DATE	02/26/2010	CLASS STATUS	6-ACTIVE
INTERNATIONAL CLASS	041	FIRST USE DATE	02/26/2010	FIRST USE IN COMMERCE DATE	02/26/2010	CLASS STATUS	6-ACTIVE

MISCELLANEOUS INFORMATION/STATEMENTS

CHANGE IN REGISTRATION	NO
PSEUDO MARK	RED BOX IT TONIGHT!
OWNER OF US REG NOS	2919854 3082012 3229436

PROSECUTION HISTORY

DATE	ENT CD	ENT TYPE	DESCRIPTION	ENT NUM
05/19/2011	PREV	O	LAW OFFICE PUBLICATION REVIEW COMPLETED	013
05/18/2011	ALIE	A	ASSIGNED TO LIE	012
05/04/2011	CNSA	O	APPROVED FOR PUB - PRINCIPAL REGISTER	011
04/08/2011	TEME	I	TEAS/EMAIL CORRESPONDENCE ENTERED	010
04/07/2011	CRFA	I	CORRESPONDENCE RECEIVED IN LAW OFFICE	009
04/07/2011	TROA	I	TEAS RESPONSE TO OFFICE ACTION RECEIVED	008
10/07/2010	GNRN	O	NOTIFICATION OF NON-FINAL ACTION E-MAILED	007
10/07/2010	GNRT	F	NON-FINAL ACTION E-MAILED	006
10/07/2010	CNRT	R	NON-FINAL ACTION WRITTEN	005
09/25/2010	DOCK	D	ASSIGNED TO EXAMINER	004
06/24/2010	MPMK	O	NOTICE OF PSEUDO MARK MAILED	003

06/23/2010	NWOS	I	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	002
06/22/2010	NWAP	I	NEW APPLICATION ENTERED IN TRAM	001
CURRENT CORRESPONDENCE INFORMATION				
ATTORNEY			James P. Muraff	
CORRESPONDENCE ADDRESS			JAMES P. MURAFF NEAL, GERBER & EISENBERG LLP 2 N LASALLE ST STE 1700 CHICAGO, IL 60602-4000	
DOMESTIC REPRESENTATIVE			NONE	

REDBOX IT TONIGHT!

Trademark Snap Shot Publication Stylesheet
(Table presents the data on Publication Approval)

OVERVIEW

SERIAL NUMBER	85066912	FILING DATE	06/18/2010
REG NUMBER	0000000	REG DATE	N/A
REGISTER	PRINCIPAL	MARK TYPE	SERVICE MARK
INTL REG #	N/A	INTL REG DATE	N/A
TM ATTORNEY	TOOLEY, DAVID E	L.O. ASSIGNED	112

PUB INFORMATION

RUN DATE	05/05/2011		
PUB DATE	N/A		
STATUS	680-APPROVED FOR PUBLICATION		
STATUS DATE	05/04/2011		
LITERAL MARK ELEMENT	REDBOX IT TONIGHT!		
DATE ABANDONED	N/A	DATE CANCELLED	N/A
SECTION 2F	NO	SECTION 2F IN PART	NO
SECTION 8	NO	SECTION 8 IN PART	NO
SECTION 15	NO	REPUB 12C	N/A
RENEWAL FILED	NO	RENEWAL DATE	N/A
DATE AMEND REG	N/A		

FILING BASIS

FILED BASIS		CURRENT BASIS		AMENDED BASIS	
1 (a)	YES	1 (a)	YES	1 (a)	NO
1 (b)	NO	1 (b)	NO	1 (b)	NO
44D	NO	44D	NO	44D	NO
44E	NO	44E	NO	44E	NO
66A	NO	66A	NO		
NO BASIS	NO	NO BASIS	NO		

MARK DATA

STANDARD CHARACTER MARK	YES
LITERAL MARK ELEMENT	REDBOX IT TONIGHT!
MARK DRAWING CODE	4-STANDARD CHARACTER MARK
COLOR DRAWING FLAG	NO

CURRENT OWNER INFORMATION

PARTY TYPE	10-ORIGINAL APPLICANT
------------	-----------------------

NAME	Redbox Automated Retail, LLC
ADDRESS	Suite 1200 One Tower Lane Oakbrook Terrace, IL 60181
ENTITY	16-LTD LIAB CO
CITIZENSHIP	Delaware

GOODS AND SERVICES

INTERNATIONAL CLASS	035
DESCRIPTION TEXT	Automated retail services, namely providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase
INTERNATIONAL CLASS	041
DESCRIPTION TEXT	Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

GOODS AND SERVICES CLASSIFICATION

INTERNATIONAL CLASS	035	FIRST USE DATE	02/26/2010	FIRST USE IN COMMERCE DATE	02/26/2010	CLASS STATUS	6-ACTIVE
INTERNATIONAL CLASS	041	FIRST USE DATE	02/26/2010	FIRST USE IN COMMERCE DATE	02/26/2010	CLASS STATUS	6-ACTIVE

MISCELLANEOUS INFORMATION/STATEMENTS

CHANGE IN REGISTRATION	NO
PSEUDO MARK	RED BOX IT TONIGHT!
OWNER OF US REG NOS	2919854 3082012 3229436

PROSECUTION HISTORY

DATE	ENT CD	ENT TYPE	DESCRIPTION	ENT NUM
05/04/2011	CNSA	O	APPROVED FOR PUB - PRINCIPAL REGISTER	011
04/08/2011	TEME	I	TEAS/EMAIL CORRESPONDENCE ENTERED	010
04/07/2011	CRFA	I	CORRESPONDENCE RECEIVED IN LAW OFFICE	009
04/07/2011	TROA	I	TEAS RESPONSE TO OFFICE ACTION RECEIVED	008
10/07/2010	GNRN	O	NOTIFICATION OF NON-FINAL ACTION E-MAILED	007
10/07/2010	GNRT	F	NON-FINAL ACTION E-MAILED	006
10/07/2010	CNRT	R	NON-FINAL ACTION WRITTEN	005
09/25/2010	DOCK	D	ASSIGNED TO EXAMINER	004
06/24/2010	MPMK	O	NOTICE OF PSEUDO MARK MAILED	003
06/23/2010	NWOS	I	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	002
06/22/2010	NWAP	I	NEW APPLICATION ENTERED IN TRAM	001

CURRENT CORRESPONDENCE INFORMATION

ATTORNEY	James P. Muraff
CORRESPONDENCE ADDRESS	JAMES P. MURAFF NEAL, GERBER & EISENBERG LLP 2 N LASALLE ST STE 1700 CHICAGO, IL 60602-4000
DOMESTIC REPRESENTATIVE	NONE

REDBOX IT TONIGHT!

Trademark Snap Shot Amendment & Mail Processing Stylesheet
(Table presents the data on Amendment & Mail Processing Complete)

OVERVIEW

SERIAL NUMBER	85066912	FILING DATE	06/18/2010
REG NUMBER	0000000	REG DATE	N/A
REGISTER	PRINCIPAL	MARK TYPE	SERVICE MARK
INTL REG #	N/A	INTL REG DATE	N/A
TM ATTORNEY	TOOLEY, DAVID E	L.O. ASSIGNED	112

PUB INFORMATION

RUN DATE	04/09/2011		
PUB DATE	N/A		
STATUS	661-RESPONSE AFTER NON-FINAL-ACTION-ENTERED		
STATUS DATE	04/08/2011		
LITERAL MARK ELEMENT	REDBOX IT TONIGHT!		
DATE ABANDONED	N/A	DATE CANCELLED	N/A
SECTION 2F	NO	SECTION 2F IN PART	NO
SECTION 8	NO	SECTION 8 IN PART	NO
SECTION 15	NO	REPUB 12C	N/A
RENEWAL FILED	NO	RENEWAL DATE	N/A
DATE AMEND REG	N/A		

FILING BASIS

FILED BASIS		CURRENT BASIS		AMENDED BASIS	
1 (a)	YES	1 (a)	YES	1 (a)	NO
1 (b)	NO	1 (b)	NO	1 (b)	NO
44D	NO	44D	NO	44D	NO
44E	NO	44E	NO	44E	NO
66A	NO	66A	NO		
NO BASIS	NO	NO BASIS	NO		

MARK DATA

STANDARD CHARACTER MARK	YES
LITERAL MARK ELEMENT	REDBOX IT TONIGHT!
MARK DRAWING CODE	4-STANDARD CHARACTER MARK
COLOR DRAWING FLAG	NO

CURRENT OWNER INFORMATION

PARTY TYPE	10-ORIGINAL APPLICANT
------------	-----------------------

NAME	Redbox Automated Retail, LLC
ADDRESS	Suite 1200 One Tower Lane Oakbrook Terrace, IL 60181
ENTITY	16-LTD LIAB CO
CITIZENSHIP	Delaware

GOODS AND SERVICES

INTERNATIONAL CLASS	035
DESCRIPTION TEXT	Automated retail services, namely providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase
INTERNATIONAL CLASS	041
DESCRIPTION TEXT	Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

GOODS AND SERVICES CLASSIFICATION

INTERNATIONAL CLASS	035	FIRST USE DATE	02/26/2010	FIRST USE IN COMMERCE DATE	02/26/2010	CLASS STATUS	6-ACTIVE
INTERNATIONAL CLASS	041	FIRST USE DATE	02/26/2010	FIRST USE IN COMMERCE DATE	02/26/2010	CLASS STATUS	6-ACTIVE

MISCELLANEOUS INFORMATION/STATEMENTS

CHANGE IN REGISTRATION	NO
PSEUDO MARK	RED BOX IT TONIGHT!
OWNER OF US REG NOS	2919854 3082012 3229436

PROSECUTION HISTORY

DATE	ENT CD	ENT TYPE	DESCRIPTION	ENT NUM
04/08/2011	TEME	I	TEAS/EMAIL CORRESPONDENCE ENTERED	010
04/07/2011	CRFA	I	CORRESPONDENCE RECEIVED IN LAW OFFICE	009
04/07/2011	TROA	I	TEAS RESPONSE TO OFFICE ACTION RECEIVED	008
10/07/2010	GNRN	O	NOTIFICATION OF NON-FINAL ACTION E-MAILED	007
10/07/2010	GNRT	F	NON-FINAL ACTION E-MAILED	006
10/07/2010	CNRT	R	NON-FINAL ACTION WRITTEN	005
09/25/2010	DOCK	D	ASSIGNED TO EXAMINER	004
06/24/2010	MPMK	O	NOTICE OF PSEUDO MARK MAILED	003
06/23/2010	NWOS	I	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	002
06/22/2010	NWAP	I	NEW APPLICATION ENTERED IN TRAM	001

CURRENT CORRESPONDENCE INFORMATION

ATTORNEY	James P. Muraff
CORRESPONDENCE ADDRESS	JAMES P. MURAFF NEAL, GERBER & EISENBERG LLP 2 N LASALLE ST STE 1700 CHICAGO, IL 60602-4000
DOMESTIC REPRESENTATIVE	NONE

REDBOX IT TONIGHT!

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85066912
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>REMARKS</u></p> <p>In the Office Action for the above-captioned mark mailed on June 18, 2010, the Examining Attorney preliminarily refused registration on the basis that Applicant's mark, when used in connection with Applicant's services, so resembles the mark in Registration No. 1,554,867 (the "Cited Registration"), as to be likely to confuse, to cause mistake or to deceive consumers. Applicant respectfully disagrees with the Examining Attorney's assertion because at least the differences between the services and goods used in connection with each mark, the care exercised by the respective consumers, and the differences between the respective marks are sufficient to avoid consumer confusion.</p> <p>The Examining Attorney also preliminarily refused registration on the basis that the specimen of record does not function as a service mark, as shown in connection with the services specified in the application. Again, Applicant respectfully disagrees with the Examining Attorney's assertions because the specimen of record shows the mark being used to identify and distinguish Applicant's services—as described in the recitation of services—from those of others. Accordingly, Applicant believes that its mark is ready for registration and respectfully requests that its mark be allowed to proceed to publication on the Principal Register.</p> <p>I. <u>Applicant's Mark is Not Likely to Cause Confusion with the Cited Registration.</u></p> <p>Whether a likelihood of confusion exists depends upon a multitude of factors, including at least the differences between the respective services and goods, the care exercised by consumers in making a purchasing decision, and the differences in the marks themselves. <i>See In re E. I. du Pont de Nemours & Co.</i>, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Applying these factors, it is apparent consumers are not likely to confuse Applicant's mark with the Cited Registration, and Applicant's mark should be allowed to proceed to publication.</p> <p>A. <u>The Distinctions Between the Services and Goods in Connection with which the Marks are used and the Care Exercised by Consumers are Sufficient to Avoid a Likelihood of Confusion.</u></p> <p>The services used in connection with Applicant's mark differ from the goods of the Cited Registration, weighing against a likelihood of confusion. Indeed, where a similar mark is used in connection with different goods or services, confusion is unlikely and marks may co-exist. <i>See</i> TMEP § 1207.01(a)(i); <i>Shen Mfg. Co., Inc. v. Ritz Hotel Ltd.</i>, 393 F.3d 1238, 1245 (Fed. Cir. 2004) (finding no confusion where identical marks were used on cooking classes and kitchen towels). Moreover, it is well-settled that if the goods and services at issue are "not ... marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP §1207.01(a)(i).</p> <p>In this case, the goods of the Cited Registration are toys and games. Specifically, these children's toys, such as puzzle blocks and toy kitchens, are marketed under a Redbox House Mark (as indicated in the registration) and other marks such as "My Precious Baby" and "Tool Tech" to consumers who wish to purchase children's toys. <i>See</i> Exhibit A. In contrast, Applicant offers the rental and sale of movies, DVDs, video game software, and other pre-recorded electronic media through vending machines or online services. Moreover, Applicant has specifically amended this application to recite "video game software" instead of just "games," generally in accordance with the Trademark Examining Attorney's suggestion. Further, Applicant's rental and sale kiosks are located in convenient locations, such as in McDonald's restaurants and 7-Eleven stores, where consumers over 18 years old can complete these automated transactions by credit card. Thus, marketing of the respective goods and services indicates they would not be encountered by consumers who would assume the children's toys of the owner of the Cited Registration and the automated sales and rental services of Applicant would emanate from the same source. This factor, therefore, militates against a likelihood of confusion.</p> <p>Moreover, in purchasing goods such as children's toys and games, consumers seek specific goods and exercise a great deal of care to ensure that they are buying a particular product. <i>See, e.g., E.S. Originals Inc. v. Stride Rite Corp.</i>, 2 U.S.P.Q.2d 1934, 1941 n.14 (S.D.N.Y. 1987) (noting that "[a] child carefully programmed by an effective advertising campaign is most likely to insist on the advertised product and is not likely to accept a substitute"). Therefore, when consumers are encountering the mark of the Cited Registration in the marketplace, they are seeking not just any toy or game; they are seeking out a particular toy or game, typically for their own child. As a result, consumers will not be confused by the services for which Applicant seeks registration and the goods of the Cited Registration. Therefore, Applicant's mark should be allowed to proceed to publication on this basis alone.</p> <p>B. <u>Applicant's Mark has a Distinct Commercial Impression from the Cited Registration.</u></p> <p>In addition, Applicant's mark is significantly different from the Cited Registration in sight, sound and meaning. A mark must be reviewed as whole to determine whether it is likely to confuse, and a confusing similarity determination should not be based on a single component. <i>In re</i></p>	

Hearst Corp., 982 F.2d 493, 494 (Fed. Cir. 1992) (holding that “all components [of a mark] must be given appropriate weight”). Even where marks have common elements, design elements can distinguish two marks and create different commercial impressions. See *In re TSI Brands Inc.*, 67 USPQ2d 1657 (TTAB 2002) (holding that “significant distinguishing design elements” must be considered even where marks have common elements to determine a likelihood of confusion).

Considering the marks at issue under these principles, the Cited Registration should not act as a bar to the registration of Applicant’s mark. The Cited Registration is for “REDBOX” and features a stylized, puffy type with a capital letter “R” that has a smiley-face on it. In addition, the design is reversed white type on a shaded oval background. In contrast, Applicant’s mark is for the phrase, “REDBOX IT TONIGHT!” This immediate difference of the presence of design elements in the Cited Registration, on one hand, and the purely textual form of Applicant’s mark, on the other, serves to bolster each mark’s respective distinct commercial impression. Moreover, Applicant’s mark sounds different when spoken, and evokes in the consumer’s mind Applicant’s other registered marks for “REDBOX.” See Registration Nos. 2,988,869, 3,082,012, 3,229,436, and 2,919,854.

Indeed, these other REDBOX marks owned by Applicant bolster the distinct commercial impression of the instant application. The mark at issue – “REDBOX IT TONIGHT!” – serves to expand Applicant’s already well-established REDBOX brand. Thus, the assertion in the Office Action that “both [marks] include the dominant portion REDBOX” could apply to Applicant’s own other REDBOX registered marks in that the present mark is an extension of Applicant’s already established brand. Thus, these differences sufficiently distinguish the two marks to avoid any likelihood of confusion.

In light of the foregoing, Applicant respectfully requests that the Trademark Office withdraw its objection under Section 2(d) of the Trademark Act because there is no likelihood of confusion between Applicant’s Mark and the Cited Registration. Accordingly, Applicant requests that its Mark be allowed to proceed to publication for registration on the Principal Register.

II. Specimen

Specimens are required because they show the manner in which the mark is seen by the public. In this case, the specimen of record shows the service mark at issue, REDBOX IT TONIGHT!, being used as a source identifier in connection with Applicant’s services.

The Examining Attorney states, without support, that “[c]onsumers are not likely to perceive such use [in the subject line of an email] as a service mark.” On the contrary, technology-savvy consumers, such as those receiving the kind of email shown the specimen are likely to know that the subject line of an email frequently functions as a source identifier, as it does here. Indeed, it is well known that email is a commonly used form of marketing and advertising, and many companies utilize the subject line as a part of that marketing and advertising method. The mark REDBOX IT TONIGHT! is prominently displayed to recipients of the email advertising Applicant’s services, immediately informing them that Applicant is the source of the services identified within the body of the email.

Furthermore, the specimen shows the mark REDBOX IT TONIGHT! in use in connection with Applicant’s services. The body of the email, seen by users in connection with the subject line, describes new movies and provides a link for recipients to “Reserve Online Now.” *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) (stationery specimen showed use of THE NOW GENERATION as a mark for applicant’s advertising or promotional services as well as to identify a licensed advertising campaign, where the recited services were specified in a byline appearing immediately beneath the mark). Like the specimen at issue in *In re Advertising and Marketing Development Inc.*, directly below the subject line, the email provides links for recipients to make use of Applicant’s entertainment rental services and automated rental services by reserving movies for rental or purchase. Accordingly, Applicant respectfully submits that its specimen shows the service mark at issue being used as a source identifier in connection with Applicant’s services.

III. Claim of Ownership

Applicant submits the following claim of ownership:

Applicant is the owner of U.S. Registration Nos. 3082012, 3229436, 2919854 and others.

IV. Amendment of Identification of Services

Applicant submits the following amendment of the identification of its services:

International Class 041: Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

International Class 035: Automated retail services, namely providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase

V. Conclusion

Applicant believes that its mark is ready for publication and therefore respectfully requests that its Application be allowed to proceed to publication on the Principal Register.

Respectfully submitted,

/James P. Muraff/

One of the Attorneys for Applicant

James P. Muraff, Esq.
Neal, Gerber & Eisenberg, LLP
2 N. LaSalle Street, Suite 1700
Chicago, Illinois 60602
312.269.8000

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_6385229130-203820003_.exhibit.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT11\IMAGEOUT11\850\669\85066912\xml3\ROA0002.JPG
DESCRIPTION OF EVIDENCE FILE	Exhibit A

GOODS AND/OR SERVICES SECTION (041)(current)

INTERNATIONAL CLASS	041
DESCRIPTION	
Automated retail services, namely providing automated retail vending machines featuring entertainment content, media, DVDs, movies and games, for purchase and rental; automated retail services, namely rental and sale of entertainment content, media, DVDs, movies and games	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 02/26/2010
FIRST USE IN COMMERCE DATE	At least as early as 02/26/2010

GOODS AND/OR SERVICES SECTION (041)(proposed)

INTERNATIONAL CLASS	041
TRACKED TEXT DESCRIPTION	
Automated retail services, namely providing automated retail vending machines featuring entertainment content, media, DVDs, movies and games, for purchase and rental; Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated retail services, namely rental and sale of entertainment content, media, DVDs, movies and games; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software	

FINAL DESCRIPTION

Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 02/26/2010
FIRST USE IN COMMERCE DATE	At least as early as 02/26/2010

GOODS AND/OR SERVICES SECTION (035)(class added)

INTERNATIONAL CLASS	035
DESCRIPTION	
Automated retail services, namely providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 02/26/2010
FIRST USE IN COMMERCE DATE	At least as early as 02/26/2010
"The substitute (or new, if appropriate) specimen(s) was/were in use in	

STATEMENT TYPE	commerce at least as early as the filing date of the application" <i>[for an application based on Section 1(a), Use in Commerce]</i> OR "The substitute (or new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" <i>[for an application based on Section 1(b) Intent-to-Use]</i> .
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPN0-3811514866-203820003_.85066912.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT11\IMAGEOUT11\850\669\85066912\xml3\ROA0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\850\669\85066912\xml3\ROA0004.JPG
SPECIMEN DESCRIPTION	advertisement email
ADDITIONAL STATEMENTS SECTION	
PRIOR REGISTRATION(S)	The applicant claims ownership of U.S. Registration Number(s) 3082012, 3229436, and 2919854.
PAYMENT SECTION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
TOTAL FEES DUE	325
SIGNATURE SECTION	
DECLARATION SIGNATURE	/James P. Muraff/
SIGNATORY'S NAME	James P. Muraff
SIGNATORY'S POSITION	Attorney of Record, Illinois Bar Member
DATE SIGNED	04/07/2011
RESPONSE SIGNATURE	/James P. Muraff/
SIGNATORY'S NAME	James P. Muraff
SIGNATORY'S POSITION	Attorney of Record, Illinois Bar Member
DATE SIGNED	04/07/2011
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Apr 07 20:42:52 EDT 2011
TEAS STAMP	USPTO/ROA-XX.XX.XXX.XXX-2 0110407204252318511-85066 912-480c34dd4493bf1bb582a 546efba192fc-DA-8203-2011 0407203820003819

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **85066912** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

REMARKS

In the Office Action for the above-captioned mark mailed on June 18, 2010, the Examining Attorney preliminarily refused registration on the basis that Applicant's mark, when used in connection with Applicant's services, so resembles the mark in Registration No. 1,554,867 (the "Cited Registration"), as to be likely to confuse, to cause mistake or to deceive consumers. Applicant respectfully disagrees with the Examining Attorney's assertion because at least the differences between the services and goods used in connection with each mark, the care exercised by the respective consumers, and the differences between the respective marks are sufficient to avoid consumer confusion.

The Examining Attorney also preliminarily refused registration on the basis that the specimen of record does not function as a service mark, as shown in connection with the services specified in the application. Again, Applicant respectfully disagrees with the Examining Attorney's assertions because the specimen of record shows the mark being used to identify and distinguish Applicant's services—as described in the recitation of services—from those of others. Accordingly, Applicant believes that its mark is ready for registration and respectfully requests that its mark be allowed to proceed to publication on the Principal Register.

I. Applicant's Mark is Not Likely to Cause Confusion with the Cited Registration.

Whether a likelihood of confusion exists depends upon a multitude of factors, including at least the differences between the respective services and goods, the care exercised by consumers in making a purchasing decision, and the differences in the marks themselves. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Applying these factors, it is apparent consumers are not likely to confuse Applicant's mark with the Cited Registration, and Applicant's mark should be allowed to proceed to publication.

A. The Distinctions Between the Services and Goods in Connection with which the Marks are used and the Care Exercised by Consumers are Sufficient to Avoid a Likelihood of Confusion.

The services used in connection with Applicant's mark differ from the goods of the Cited Registration, weighing against a likelihood of confusion. Indeed, where a similar mark is used in connection with different goods or services, confusion is unlikely and marks may co-exist. *See* TMEP § 1207.01(a)(i); *Shen Mfg. Co., Inc. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245 (Fed. Cir. 2004) (finding no confusion where identical marks were used on cooking classes and kitchen towels). Moreover, it is well-settled that if the goods and services at issue are "not ... marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP §1207.01(a)(i).

In this case, the goods of the Cited Registration are toys and games. Specifically, these children's toys, such as puzzle blocks and toy kitchens, are marketed under a Redbox House Mark (as indicated in the registration) and other marks such as "My Precious Baby" and "Tool Tech" to consumers who wish to purchase children's toys. *See* Exhibit A. In contrast, Applicant offers the rental and sale of movies, DVDs, video game software, and other pre-recorded electronic media through vending machines or online services. Moreover, Applicant has specifically amended this application to recite "video game software" instead of just "games," generally in accordance with the Trademark Examining Attorney's suggestion. Further, Applicant's rental and sale kiosks are located in convenient locations, such as in McDonald's restaurants and 7-Eleven stores, where consumers over 18 years old can complete these automated transactions by credit card. Thus, marketing of the respective goods and services indicates they would not be encountered by consumers who would assume the children's toys of the owner of the Cited Registration and the automated sales and rental services of Applicant would emanate from the same source. This factor, therefore, militates against a likelihood of confusion.

Moreover, in purchasing goods such as children's toys and games, consumers seek specific goods and exercise a great deal of care to ensure that they are buying a particular product. *See, e.g., E.S. Originals Inc. v. Stride Rite Corp.*, 2 U.S.P.Q.2d 1934, 1941 n.14 (S.D.N.Y. 1987) (noting that "[a] child carefully programmed by an effective advertising campaign is most likely to insist on the advertised product and is not likely to accept a substitute"). Therefore, when consumers are encountering the mark of the Cited Registration in the marketplace, they are seeking not just any toy or game; they are seeking out a particular toy or game, typically for their own child. As a result, consumers will not be confused by the services for which Applicant seeks registration and the goods of the Cited Registration. Therefore, Applicant's mark should be allowed to proceed to publication on this basis alone.

B. Applicant's Mark has a Distinct Commercial Impression from the Cited Registration.

In addition, Applicant's mark is significantly different from the Cited Registration in sight, sound and meaning. A mark must be reviewed as whole to determine whether it is likely to confuse, and a confusing similarity determination should not be based on a single component. *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) (holding that "all components [of a mark] must be given appropriate weight"). Even where marks have common elements, design elements can distinguish two marks and create different commercial impressions. *See In re TSI Brands Inc.*, 67 USPQ2d 1657 (TTAB 2002) (holding that "significant distinguishing design elements" must be considered even where marks have common elements to determine a likelihood of confusion).

Considering the marks at issue under these principles, the Cited Registration should not act as a bar to the registration of Applicant's mark. The Cited Registration is for "REDBOX" and features a stylized, puffy type with a capital letter "R" that has a smiley-face on it. In addition, the design is reversed white type on a shaded oval background. In contrast, Applicant's mark is for the phrase, "REDBOX IT TONIGHT!" This immediate difference of the presence of design elements in the Cited Registration, on one hand, and the purely textual form of Applicant's mark, on the other, serves to bolster each mark's respective distinct commercial impression. Moreover, Applicant's mark sounds different when spoken, and evokes in the consumer's mind Applicant's other registered marks for "REDBOX." *See* Registration Nos. 2,988,869, 3,082,012, 3,229,436, and 2,919,854.

Indeed, these other REDBOX marks owned by Applicant bolster the distinct commercial impression of the instant application. The mark at issue – "REDBOX IT TONIGHT!" – serves to expand Applicant's already well-established REDBOX brand. Thus, the assertion in the Office Action that "both [marks] include the dominant portion REDBOX" could apply to Applicant's own other REDBOX registered marks in that the

present mark is an extension of Applicant's already established brand. Thus, these differences sufficiently distinguish the two marks to avoid any likelihood of confusion.

In light of the foregoing, Applicant respectfully requests that the Trademark Office withdraw its objection under Section 2(d) of the Trademark Act because there is no likelihood of confusion between Applicant's Mark and the Cited Registration. Accordingly, Applicant requests that its Mark be allowed to proceed to publication for registration on the Principal Register.

II. Specimen

Specimens are required because they show the manner in which the mark is seen by the public. In this case, the specimen of record shows the service mark at issue, REDBOX IT TONIGHT!, being used as a source identifier in connection with Applicant's services.

The Examining Attorney states, without support, that "[c]onsumers are not likely to perceive such use [in the subject line of an email] as a service mark." On the contrary, technology-savvy consumers, such as those receiving the kind of email shown the specimen are likely to know that the subject line of an email frequently functions as a source identifier, as it does here. Indeed, it is well known that email is a commonly used form of marketing and advertising, and many companies utilize the subject line as a part of that marketing and advertising method. The mark REDBOX IT TONIGHT! is prominently displayed to recipients of the email advertising Applicant's services, immediately informing them that Applicant is the source of the services identified within the body of the email.

Furthermore, the specimen shows the mark REDBOX IT TONIGHT! in use in connection with Applicant's services. The body of the email, seen by users in connection with the subject line, describes new movies and provides a link for recipients to "Reserve Online Now." *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) (stationery specimen showed use of THE NOW GENERATION as a mark for applicant's advertising or promotional services as well as to identify a licensed advertising campaign, where the recited services were specified in a byline appearing immediately beneath the mark). Like the specimen at issue in *In re Advertising and Marketing Development Inc.*, directly below the subject line, the email provides links for recipients to make use of Applicant's entertainment rental services and automated rental services by reserving movies for rental or purchase. Accordingly, Applicant respectfully submits that its specimen shows the service mark at issue being used as a source identifier in connection with Applicant's services.

III. Claim of Ownership

Applicant submits the following claim of ownership:

Applicant is the owner of U.S. Registration Nos. 3082012, 3229436, 2919854 and others.

IV. Amendment of Identification of Services

Applicant submits the following amendment of the identification of its services:

International Class 041: Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

International Class 035: Automated retail services, namely providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase

V. Conclusion

Applicant believes that its mark is ready for publication and therefore respectfully requests that its Application be allowed to proceed to publication on the Principal Register.

Respectfully submitted,

/James P. Muraff/

One of the Attorneys for Applicant

James P. Muraff, Esq.
Neal, Gerber & Eisenberg, LLP
2 N. LaSalle Street, Suite 1700
Chicago, Illinois 60602
312.269.8000

EVIDENCE

Evidence in the nature of Exhibit A has been attached.

Original PDF file:

[evi_6385229130-203820003...exhibit.pdf](#)

Converted PDF file(s) (1 page)

Evidence-1

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 041 for Automated retail services, namely providing automated retail vending machines featuring entertainment content, media, DVDs, movies and games, for purchase and rental; automated retail services, namely rental and sale of entertainment content, media, DVDs, movies and games

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 02/26/2010 and first used in commerce at least as early as 02/26/2010, and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Automated retail services, namely providing automated retail vending machines featuring entertainment content, media, DVDs, movies and games, for purchase and rental;~~ Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; ~~automated retail services, namely rental and sale of entertainment content, media, DVDs, movies and games;~~ automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

Class 041 for Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 02/26/2010 and first used in commerce at least as early as 02/26/2010, and is now in use in such commerce.

Applicant hereby adds the following class of goods/services to the application:

New: Class 035 for Automated retail services, namely providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video game software for purchase

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 02/26/2010 and first used in commerce at least as early as 02/26/2010, and is now in use in such commerce.

Applicant hereby submits a specimen for Class 035. The specimen(s) submitted consists of advertisement email.

"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR **"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use"** [for an application based on Section 1(b) Intent-to-Use].

Original PDF file:

[SPN0-3811514866-203820003_85066912.pdf](#)

Converted PDF file(s) (2 pages)

[Specimen File1](#)

[Specimen File2](#)

ADDITIONAL STATEMENTS

Claim of Prior Registration(s)

The applicant claims ownership of U.S. Registration Number(s) 3082012, 3229436, and 2919854.

FEE(S)

Fee(s) in the amount of \$325 is being submitted.

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. 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 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; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /James P. Muraff/ Date: 04/07/2011
Signatory's Name: James P. Muraff
Signatory's Position: Attorney of Record, Illinois Bar Member

Response Signature

Signature: /James P. Muraff/ Date: 04/07/2011
Signatory's Name: James P. Muraff
Signatory's Position: Attorney of Record, Illinois Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

RAM Sale Number: 8203
RAM Accounting Date: 04/08/2011

Serial Number: 85066912
Internet Transmission Date: Thu Apr 07 20:42:52 EDT 2011
TEAS Stamp: USPTO/ROA-XX.XX.XXX.XXX-2011040720425231
8511-85066912-480c34dd4493bf1bb582a546ef
ba192fc-DA-8203-20110407203820003819



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Marianne Hall <ranmarhall2@gmail.com>

Fwd: Redbox It Tonight!

1 message

Marianne Hall <ranmarhall2@gmail.com>
To: "Hall, Marianne A." <mhall@ngelaw.com>

Fri, Feb 26, 2010 at 4:16 PM

----- Forwarded message -----

From: redbox <redbox@e.redbox.com>

Date: Fri, Feb 26, 2010 at 2:36 PM

Subject: Redbox It Tonight!

To: ranmarhall2@gmail.com

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HOW REDBOX
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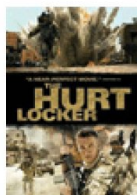
Reserve **Law Abiding Citizen** online and guarantee it's there!



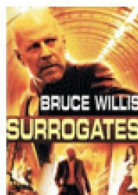
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Cloudy with a
Chance of
Meatballs



The Hurt Locker



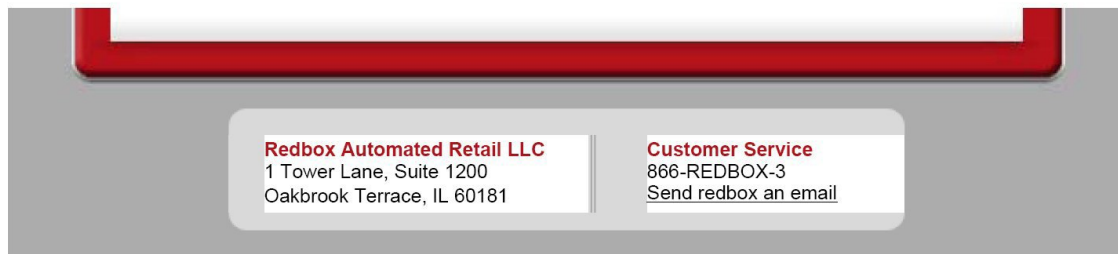
Surrogates



Zombieland



Gamer



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RAM SALE NUMBER: 8203
RAM ACCOUNTING DATE: 20110408

INTERNET TRANSMISSION DATE:
2011/04/07

SERIAL NUMBER:
85/066912

Description	Fee Code	Transaction Date	Fee	Number Of Classes	Total Fees Paid
New App	7001	2011/04/07	325	1	325



Marianne Hall <ranmarhall2@gmail.com>

Fwd: Redbox It Tonight!

1 message

Marianne Hall <ranmarhall2@gmail.com>
To: "Hall, Marianne A." <mhall@ngelaw.com>

Fri, Feb 26, 2010 at 4:16 PM

----- Forwarded message -----

From: redbox <redbox@e.redbox.com>

Date: Fri, Feb 26, 2010 at 2:36 PM

Subject: Redbox It Tonight!

To: ranmarhall2@gmail.com

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Jamie Foxx stars as an assistant DA at the mercy of a frustrated man who decides to take justice into his own hands after a plea bargain sets one of his family's killers free... [read more](#)

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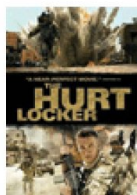
Reserve **Law Abiding Citizen** online and guarantee it's there!



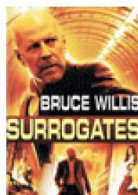
Also check out these hit movies available now...



Cloudy with a
Chance of
Meatballs



The Hurt Locker



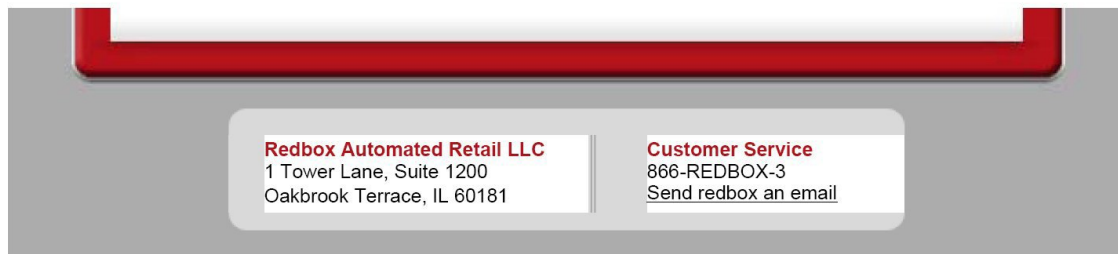
Surrogates



Zombieland



Gamer



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You are subscribed as ranmarhall2@gmail.com. If you do not wish to continue receiving these notices, please [unsubscribe](#).
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To: Redbox Automated Retail, LLC (trademarks@ngelaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85066912 - REDBOX IT TONIGHT! - 19638.15T1
Sent: 10/7/2010 12:09:27 PM
Sent As: ECOM112@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)

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

APPLICATION SERIAL NO. 85066912

MARK: REDBOX IT TONIGHT!

85066912

CORRESPONDENT ADDRESS:

JAMES P. MURAFF
NEAL, GERBER & EISENBERG LLP
2 N LASALLE ST STE 1700
CHICAGO, IL 60602-4000

CLICK HERE TO RESPOND TO THIS LETTER:
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Redbox Automated Retail, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

19638.15T1

CORRESPONDENT E-MAIL ADDRESS:

trademarks@ngelaw.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: 10/7/2010

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

Section 2(d) Refusal – Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 919290. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration as EXHIBIT A.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily

relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the services, and similarity of trade channels of the services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Applicant applied to register REDBOX IT TONIGHT! for “automated retail services, namely providing automated retail vending machines featuring entertainment content, media, DVDs, movies and games, for purchase and rental; automated retail services, namely rental and sale of entertainment content, media, DVDs, movies and games.” The registered mark is REDBOX and design for “housemark for a full line of toys and games.”

Comparison of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. *See* TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *see* TMEP §1207.01(b)(viii), (c)(ii).

Applicant's mark is similar to the registered mark because both include the dominant portion REDBOX.

Applicant's addition of the wording IT TONIGHT! does not obviate this refusal. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

Similarly, registrant's addition of design elements does not overcome this likelihood of confusion. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii).

Therefore, applicant's mark is very similar to the registered mark.

Comparison of the Services

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE “21” CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER

IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

Applicant's services are related to the registered services because applicant rents and sells games that could be identical to the registered games. The same companies often sell their own branded games from their own retail outlets. See attached EXHIBIT B Internet evidence from FAO Schwartz, Melissa and Doug, and Toys R Us showing each company's own brands being sold in its own store.

Therefore, applicant's services are highly related to the registered services.

Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Since the marks are similar and the services are related, there is a likelihood of confusion as to the source of applicant's services. Therefore, applicant's mark is not entitled to registration.

Specimen Refused—Fails to Function as a Service Mark

Registration is refused because the applied-for mark, as used on the specimen of record, does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; see *In re Moody's Investors Serv., Inc.*, 13 USPQ2d 2043 (TTAB 1989); *In re The Signal Cos.*, 228 USPQ 956 (TTAB 1986); *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984); TMEP §§904.07(b), 1301.02 *et seq.*

The specimen of record, along with any other relevant evidence of record, is reviewed to determine whether an applied-for mark is being used as a service mark. *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998). Not every word, design, symbol or slogan used in the advertising or performance of services functions as a mark, even though it may have been adopted with the intent to do so. See TMEP §1301.02. A designation cannot be registered unless purchasers would be likely to regard it as a source-indicator for the services. *Id.*; see *In re Moody's Investors Serv. Inc.*, 13 USPQ2d 2043, 2047-49 (TTAB 1989).

The applied-for mark, as shown on the specimen, does not function as a service mark because it appears in the subject and forwarded lines of an email. Consumers are not likely to perceive such use as an indicator of source.

Applicant may respond to this refusal by submitting the following:

- (1) A substitute specimen showing the mark in use in commerce for the services specified in the application; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The substitute specimen was in use in commerce at least as early as the filing date of the application.”** 37 C.F.R. §2.59(a); TMEP §904.05; see 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the sale or advertising of the services. See TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), and the refusal will be withdrawn. See TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. See 15 U.S.C. §1051(c), (d); 37 C.F.R. §§2.76, 2.88; TMEP §1103. If the same specimen is submitted with an allegation of use, the same refusal will issue.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); see 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. Applicant must respond to the requirements set forth below.

Specimen Does Not Show Use of Mark with Specified Services

The specimen is not acceptable because it does not show the applied-for mark used in connection with any of the services specified in the application. An application must include a specimen showing the applied-for mark in use in commerce for each class of services based on Section 1(a) in the application. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56; TMEP §§904, 904.07(a), 1301.04.

In this case, the specimen shows an email about movies, but it does not clearly indicate what services it provides. Specifically, it does not indicate that it sells or rents anything. For instance, it may be a service for third parties provided to reserve movies at the stores of others. Therefore, the specimen does not show use with the specified services.

Therefore, applicant must submit the following:

- (1) A substitute specimen showing use of the mark for each class of services specified in the application; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**The specimen was in use in commerce at least as early as the filing date of the application.**” 37 C.F.R. §2.59(a); TMEP §904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c).

Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the sale or advertising of the services. TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the Section 1(a) filing basis (use in commerce) to Section 1(b) (intent to use basis), for which no specimen is required. However, should applicant amend the basis to Section 1(b), registration cannot be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. 15 U.S.C. §1051(c); 37 C.F.R. §§2.76, 2.88; TMEP Chapter 1100.

In order to amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.**” 15 U.S.C. §1051(b); 37 C.F.R. §§2.34(a)(2), 2.35(b)(1); TMEP §806.03(c).

Pending a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark or service mark for the identified goods or services. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56; TMEP §§904, 904.07(a).

Ownership of Prior Registrations

If applicant is the owner of U.S. Registration Nos. 3082012, 3229436, 2919854, and others, then applicant must submit a claim of ownership. *See* 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

Applicant is the owner of U.S. Registration Nos. 3082012, 3229436, 2919854, and others.

Identification of Services

The identification of services is indefinite and must be clarified because it includes services in multiple classes and ambiguous language. *See* TMEP §1402.01. Applicant may adopt the following identification, if accurate:

Class 35: Automated retail services, namely, providing automated retail vending machines featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and games for purchase; automated retail services, namely, online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and games for purchase.

Class 41: Entertainment rental services provided through automated vending machines, namely, rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and games; automated rental of DVDs, movies, prerecorded electronic media featuring entertainment content, and games.

Identifications of services can be amended only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include services that are not within the scope of the services set forth in the present identification.

For assistance with identifying and classifying services in trademark applications, please see the online searchable *Manual of Acceptable*

Identifications of Goods and Services at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04.

For an application with more than one international class, called a “multiple-class application,” an applicant must meet all of the requirements below for those international classes based on use in commerce:

- (1) LIST GOODS/SERVICES BY INTERNATIONAL CLASS: Applicant must list the goods/services by international class;
- (2) PROVIDE FEES FOR ALL INTERNATIONAL CLASSES: Applicant must submit an application filing fee for each international class of services not covered by the fee(s) already paid (confirm current fee information at <http://www.uspto.gov>, click on “View Fee Schedule” under the column titled “Trademarks”); and
- (3) SUBMIT REQUIRED STATEMENTS AND EVIDENCE: For each international class of services, applicant must also submit the following:
 - (a) DATES OF USE: Dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class. The dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application.;
 - (b) SPECIMEN: One specimen showing the mark in use in commerce for each international class of services. Applicant must have used the specimen in commerce at least as early as the filing date of the application. If a single specimen supports multiple international classes, applicant should indicate which classes the specimen supports. Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the goods at their point of sale. See TMEP §§904.03 *et seq.* Examples of specimens for services are signs, photographs, brochures, website printouts, or advertisements that show the mark used in the actual sale or advertising of the services. See TMEP §§1301.04 *et seq.*;
 - (c) STATEMENT: The following statement: “**The specimen was in use in commerce on or in connection with the services listed in the application at least as early as the filing date of the application.**”; and
 - (d) VERIFICATION: Applicant must verify the statements in 3(a) and 3(c) (above) in an affidavit or signed declaration under 37 C.F.R. §2.20. Verification is not required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, and (2) the original specimens are acceptable for the added class(es).

See 15 U.S.C. §§1051(a), 1112, 1127; 37 C.F.R. §§2.32(a)(5), 2.34(a)(1), 2.56(a), 2.71(c), 2.86(a), 2.193(e)(1); TMEP §§1403.01, 1403.02(c).

Sample Declaration

The following is a properly worded “declaration” under 37 C.F.R. §2.20. This declaration must be personally signed and dated by a person authorized under 37 C.F.R. §2.193(e)(1). TMEP §804.01(b).

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

Contacting the Examining Attorney

If applicant has any questions concerning the above action, it is encouraged to contact the examining attorney at the number listed below.

/DETJr/
David E. Tooley, Jr.

Trademark Examining Attorney
Law Office 112
phone: (571) 272-8206
fax: (571) 273-8206

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/mailling date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

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>.

EXHIBIT A

Print: Oct 7, 2010

73690802

DESIGN MARK

Serial Number

73690802

Status

REGISTERED AND RENEWED

Word Mark

REDBOX

Standard Character Mark

No

Registration Number

1554867

Date Registered

1989/09/05

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

RED BOX TOY FACTORY LIMITED HONG KONG MANDARIN PLAZA, 902 TOWER B
TSMHATSUI EAST, KOWLOON HONG KONG

Goods/Services

Class Status -- ACTIVE. IC 028. US 022. G & S: HOUSEMARK FOR A
FULL LINE OF TOYS AND GAMES. First Use: 1985/09/04. First Use In
Commerce: 1985/10/00.

Prior Registration(s)

0919290

Filing Date

1987/10/20

Examining Attorney

UNKNOWN

Attorney of Record

ROBERT R. PRIDDY



EXHIBIT B



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CATEGORY

[Board Games \(3\)](#)

[Puzzles \(2\)](#)

GENDER

[Boys \(5\)](#)

[Girls \(5\)](#)

AGE

[3 & 4 Years \(1\)](#)

[5-7 Years \(4\)](#)

[8-11 Years \(4\)](#)

[12-14 Years \(3\)](#)

ITEMS: 1-5 of 5

PAGE: [PREV](#) [1](#)

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Big Kids (3)

PRICE

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\$75 - \$100 (1)



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ITEMS: 1-5 of 5

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5-7 Years
8-11 Years
12-14 Years
Big Kids

Brand

 Ceaco
Imaginarium
Pavilion

Character/Theme

 Disney Fairies
Disney Pixar's Cars the Movie
Disney Princess

Price

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\$10 - \$20
\$20 - \$30

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To: Redbox Automated Retail, LLC (trademarks@ngelaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85066912 - REDBOX IT TONIGHT! - 19638.15T1
Sent: 10/7/2010 12:09:30 PM
Sent As: ECOM112@USPTO.GOV
Attachments:

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 10/7/2010 FOR
SERIAL NO. 85066912**

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 10/7/2010 (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.

*** User:dtooley ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	49265	N/A	0	0	0:01	*red*[bi,ti]
02	14373	N/A	0	0	0:02	*bo{"ckqx"}*[bi,ti]
03	54264	N/A	0	0	0:04	*n{"iy"}{"gh"0:2}t*[bi,ti]
04	656	N/A	0	0	0:01	1 and (2 3)
05	101	N/A	0	0	0:01	2 and 3
06	367	N/A	0	0	0:01	(4 5) not dead [ld]
07	258	N/A	0	0	0:03	6 and "041"[cc]
08	54	0	54	44	0:01	(1 and 2) not dead [ld]
09	242	0	242	218	0:01	7 not 8
10	0	0	0	0	0:01	"Redbox Automated Retail"[gs]
11	20	2	7	5	0:02	"Redbox Automated Retail"[on]

Session started 10/7/2010 10:30:49 AM

Session finished 10/7/2010 10:41:19 AM

Total search duration 0 minutes 18 seconds

Session duration 10 minutes 30 seconds

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Sent to TICRS as Serial Number: 85066912

From: TMDesignCodeComments
Sent: Thursday, June 24, 2010 00:13 AM
To: XXXX
Subject: Notice of Pseudo Mark for Serial Number: 85066912
ATTORNEY REFERENCE NUMBER: 19638.15T1

The USPTO may assign pseudo marks, as appropriate, to new applications to assist in searching the USPTO database for conflicting marks. They have no legal significance and will not appear on the registration certificate.

A PSEUDO MARK may be assigned to marks that include words, numbers, compound words, symbols, or acronyms that can have alternative spellings or meanings. For example, if the mark comprises the words 'YOU ARE' surrounded by a design of a box, the pseudo mark field in the USPTO database would display the mark as 'YOU ARE SQUARE'. A mark filed as 'URGR8' would receive a pseudo mark of 'YOU ARE GREAT'.

Response to this notice is not required; however, to suggest additions or changes to the pseudo mark assigned to your mark, please e-mail TMDesignCodeComments@USPTO.GOV. You **must** reference your application serial number within your request. The USPTO will review the proposal and update the record, if appropriate. For questions, please call 1-800-786-9199 to speak to a Customer Service representative.

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Pseudo marks assigned to the referenced serial number are listed below.

PSEUDO MARK:

RED BOX IT TONIGHT!

Trademark/Service Mark Application, Principal Register

Serial Number: 85066912

Filing Date: 06/18/2010

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85066912
MARK INFORMATION	
*MARK	REDBOX IT TONIGHT!
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	REDBOX IT TONIGHT!
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	Redbox Automated Retail, LLC
INTERNAL ADDRESS	Suite 1200
*STREET	One Tower Lane
*CITY	Oakbrook Terrace
*STATE (Required for U.S. applicants)	Illinois
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	60181
EMAIL ADDRESS	XXXX
LEGAL ENTITY INFORMATION	
TYPE	limited liability company
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Delaware
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	041
*IDENTIFICATION	Automated retail services, namely providing automated retail vending machines featuring entertainment content, media, DVDs, movies and games, for purchase and rental; automated retail services, namely rental and sale of entertainment content, media, DVDs, movies and games.
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 02/26/2010
FIRST USE IN COMMERCE DATE	At least as early as 02/26/2010

SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	spec-3811514866-000636683_._EmailSpecimen15T1.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT10\IMAGEOUT10\850\669\85066912\xml1\APP0003.JPG
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SPECIMEN DESCRIPTION	advertisement email
ATTORNEY INFORMATION	
NAME	James P. Muraff
ATTORNEY DOCKET NUMBER	19638.15T1
FIRM NAME	Neal, Gerber & Eisenberg LLP
INTERNAL ADDRESS	Two North LaSalle Street, Suite 1700
STREET	c/o Trademark Administrator
CITY	Chicago
STATE	Illinois
COUNTRY	United States
ZIP/POSTAL CODE	60602
PHONE	312-269-8000
FAX	312-269-1747
EMAIL ADDRESS	trademarks@ngelaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	all other attorneys of the firm
CORRESPONDENCE INFORMATION	
NAME	James P. Muraff
FIRM NAME	Neal, Gerber & Eisenberg LLP
INTERNAL ADDRESS	Two North LaSalle Street, Suite 1700
STREET	c/o Trademark Administrator
CITY	Chicago
STATE	Illinois
COUNTRY	United States
ZIP/POSTAL CODE	60602
PHONE	312-269-8000
FAX	312-269-1747
EMAIL ADDRESS	trademarks@ngelaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325

*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/Frederick W. Stein/
SIGNATORY'S NAME	Frederick W. Stein
SIGNATORY'S POSITION	Vice President and General Counsel
DATE SIGNED	06/18/2010

Trademark/Service Mark Application, Principal Register

Serial Number: 85066912

Filing Date: 06/18/2010

To the Commissioner for Trademarks:

MARK: REDBOX IT TONIGHT! (Standard Characters, see [mark](#))

The literal element of the mark consists of REDBOX IT TONIGHT!.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Redbox Automated Retail, LLC, a limited liability company legally organized under the laws of Delaware, having an address of
Suite 1200,
One Tower Lane
Oakbrook Terrace, Illinois 60181
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:

International Class 041: Automated retail services, namely providing automated retail vending machines featuring entertainment content, media, DVDs, movies and games, for purchase and rental; automated retail services, namely rental and sale of entertainment content, media, DVDs, movies and games.

In International Class 041, the mark was first used at least as early as 02/26/2010, and first used in commerce at least as early as 02/26/2010, 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) advertisement email.

Original PDF file:

[spec-3811514866-000636683_.EmailSpecimen15T1.pdf](#)

Converted PDF file(s) (2 pages)

[Specimen File1](#)

[Specimen File2](#)

The applicant's current Attorney Information:

James P. Muraff and all other attorneys of the firm of Neal, Gerber & Eisenberg LLP

Two North LaSalle Street, Suite 1700
c/o Trademark Administrator
Chicago, Illinois 60602
United States

The attorney docket/reference number is 19638.15T1.

The applicant's current Correspondence Information:

James P. Muraff
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street, Suite 1700
c/o Trademark Administrator
Chicago, Illinois 60602
312-269-8000(phone)
312-269-1747(fax)
trademarks@ngelaw.com (authorized)

A fee payment in the amount of \$325 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: /Frederick W. Stein/ Date Signed: 06/18/2010

Signatory's Name: Frederick W. Stein

Signatory's Position: Vice President and General Counsel

RAM Sale Number: 5969

RAM Accounting Date: 06/21/2010

Serial Number: 85066912

Internet Transmission Date: Fri Jun 18 20:37:18 EDT 2010

TEAS Stamp: USPTO/BAS-XX.XXX.XXX.XX-2010061820371876

1069-85066912-46023ca198caaf7aafd978238e

1b748b9-DA-5969-20100618000636683409

REDBOX IT TONIGHT!



Marianne Hall <ranmarhall2@gmail.com>

Fwd: Redbox It Tonight!

1 message

Marianne Hall <ranmarhall2@gmail.com>
To: "Hall, Marianne A." <mhall@ngelaw.com>

Fri, Feb 26, 2010 at 4:16 PM

----- Forwarded message -----

From: redbox <redbox@e.redbox.com>

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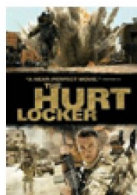
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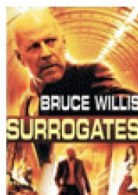
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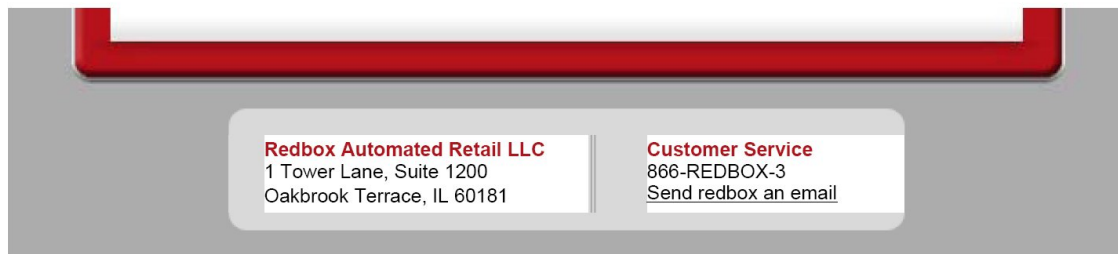
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REDBOX IT TONIGHT!



Marianne Hall <ranmarhall2@gmail.com>

Fwd: Redbox It Tonight!

1 message

Marianne Hall <ranmarhall2@gmail.com>
To: "Hall, Marianne A." <mhall@ngelaw.com>

Fri, Feb 26, 2010 at 4:16 PM

----- Forwarded message -----
From: redbox <redbox@e.redbox.com>
Date: Fri, Feb 26, 2010 at 2:36 PM
Subject: Redbox It Tonight!
To: ranmarhall2@gmail.com

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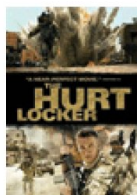
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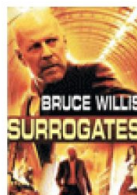
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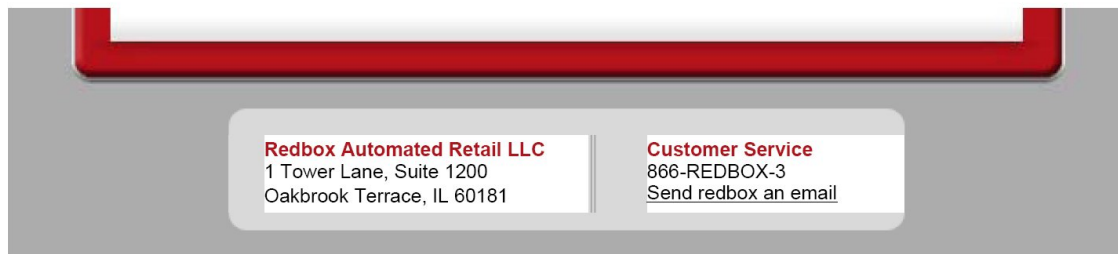
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