

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

**U.S. Application Serial No.** 79288276

**Mark:** FREDDIE MERCURY

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UNITED KINGDOM

**Applicant:** Mercury Songs Limited

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

**Correspondence Email Address:**

**NONFINAL OFFICE ACTION**

**International Registration No.** 1537570

**Notice of Provisional Full Refusal**

**Deadline for responding.** The USPTO must receive applicant's response **within six months of the "date on which the notification was sent to WIPO (mailing date)"** located on the WIPO cover letter, or the U.S. application will be abandoned. To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database, select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Discussion of provisional full refusal.** This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). *See* 15 U.S.C. §§1141f(a), 1141h(c).

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

**No Likelihood of Confusion**

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

**Goods – Amendment Required**

The identification of goods is partially indefinite because applicant must specify the make-up items in the cosmetic kits and remove the parentheticals which are not permitted in identifications of goods or services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant may amend the identification to clarify or limit the goods and/or services, but not to broaden or expand the goods and/or services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and/or services may not later be reinserted. *See* TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable U.S. Acceptable Identification of Goods and Services Manual. *See* TMEP §1402.04.

Applicant may adopt the following identification, if accurate:

Cosmetics; make-up; **cosmetic kits primarily comprised of \_\_\_\_ (specify e.g. lip stick, eye shadow, blush);** eyeshadow; eyeshadow palettes; eyebrow cosmetics; eyebrow pencils; mascara; eyeliners; cosmetic pencils; lipsticks; lip glosses; lip liner; **non-medicated lip balm;** lipstick cases; make-up primer; foundation; facial concealer; cosmetic powder; skin bronzer; blusher; false eyelashes; false nails; nail varnish; nail care preparations;

glitter for cosmetic purposes; theatrical make-up. *International Class 3.*

### **Consent Required**

Applicant must clarify whether FREDDIE MERCURY in the mark identifies a particular living individual. See 37 C.F.R. §2.61(b); TMEP §§813, 1206.03. The application neither specifies whether the name, portrait, and/or signature in the mark identifies a particular living individual nor includes a written consent. See TMEP §§813.01(a)-(b), 1206.04(a), 1206.05.

In this case, the mark appears to consist of or comprise the name, portrait, and/or signature of a particular famous or historical individual who is deceased. See 37 C.F.R. §2.61(b); TMEP §§813, 1206.03. Specifically, the mark includes the name FREDDIE MERCURY. The examining attorney has attached evidence from the website for Freddie Mercury who passed in 1991.

To register a mark that consists of or comprises the name, portrait, and/or signature of a particular living individual, an applicant must provide a written consent personally signed by the named or shown individual. 15 U.S.C. §1052(c); TMEP §§813, 1206.04(a).

In this case, where it is unclear whether the name, portrait, and/or signature is that of a living individual, applicant must so clarify for the record. Accordingly, if the individual identified in the mark is in fact deceased, applicant should provide the following statement:

**The individual identified in the mark is in fact deceased; accordingly, the name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.**

For an overview of the requirements for names appearing in marks, and instructions on how to satisfy this requirement using the online Trademark Electronic Application System (TEAS) response form, see the [Name/Portrait/Signature of Particular Living Individual in Mark](#) webpage.

Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814.

### **U.S. Counsel Required**

**Applicant must be represented by a U.S.-licensed attorney at the USPTO to respond to or appeal the provisional refusal.** An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented at the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §§2.11(a), 11.14; *Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants & Registrants*, Examination Guide 4-19, at I.A. (Rev. Sept. 2019). An individual applicant's domicile is the place a person resides and intends to be the person's principal home. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. A juristic entity's domicile is the principal place of business; i.e., headquarters, where a juristic entity applicant's senior executives or officers ordinarily direct and control the entity's activities. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. Because applicant is foreign-domiciled, applicant must appoint such a U.S.-licensed attorney qualified to practice under 37 C.F.R. §11.14 as its representative before the application may proceed to registration. 37 C.F.R. §2.11(a). See [Hiring a U.S.-licensed trademark attorney](#) for more information.

Only a U.S.-licensed attorney can take action on an application on behalf of a foreign-domiciled applicant. 37 C.F.R. §2.11(a). Accordingly, the USPTO will not communicate further with applicant about the application beyond this Office action or permit applicant to make future submissions in this application. And applicant is not authorized to make amendments to the application.

**To appoint or designate a U.S.-licensed attorney.** To appoint an attorney, applicant should submit a completed Trademark Electronic Application System (TEAS) [Change Address or Representation](#) form. The newly-appointed attorney must submit a TEAS [Response to Examining Attorney Office Action](#) form indicating that an appointment of attorney has been made and address all other refusals or requirements in this action, if any. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii).

If the applicant has any questions or needs assistance in responding to this Office action, please call or e-mail the assigned examining attorney.

**How to respond.** [Click to file a response to this nonfinal Office action.](#)

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### **RESPONSE GUIDANCE**

- **Missing the response deadline to this letter will cause the application to abandon.** A response or notice of appeal must be received by the USPTO before **midnight Eastern Time** of the last day of the response period. TEAS and ESTTA maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.

- ~~Responses signed by an unauthorized party~~ are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with ~~legal authority to bind a juristic applicant~~. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find** ~~contact information for the supervisor~~ of the office or unit listed in the signature block.

## BIOGRAPHY



The life of Frederick Bulsara began on the East African island of Zanzibar on September 5, 1946. 25 years later in London under the name of Freddie Mercury he was fronting the now legendary rock group named Queen.



The son of Bomi and Jer Bulsara, Freddie spent the bulk of his childhood in India where he attended St. Peter's boarding school. He began taking piano lessons at the age of seven. No one could foresee where a love of music would take him.



The Bulsara family moved to Middlesex in 1964 and from there Freddie joined up with a blues band called Wreckage while studying graphic design courses at Ealing College of Art. While singing for Wreckage, a fellow student introduced Freddie to Roger Taylor and Brian May, founder members of a band called Smile. Smile metamorphosed into Queen when Freddie joined Roger and Brian as the lead vocalist. The final member of the band, which was to stay together for the next 20 years, was bassist John Deacon, who joined the band on 1st of March 1971.



The immortal operatically styled single 'Bohemian Rhapsody' was released in 1975 and proceeded to the top of the UK charts for 9 weeks. A song that was nearly never released due to its length and unusual style but which Freddie insisted would be played became the instantly recognisable hit. By this time Freddie's unique talents were becoming clear, a voice with a remarkable range and a stage presence that gave Queen its colourful, unpredictable and flamboyant personality.



The rest is rock history. EMI Records and Elektra Records signed the band and in 1973 their debut album 'Queen' was released and hailed as one of the most exciting developments ever in rock music.







Queen was always indisputably run as a democratic organisation. All four members are each responsible for having penned number one singles for the band. This massive writing strength combined with spectacular lights, the faultless sound, a sprinkling of theatricality and Freddie's balletic movements made up Queen on stage and on film.



Their phenomenal success continued around the globe throughout the 80's highlighted in 1985 by their show-stealing and unforgettable performance on stage at Live Aid.



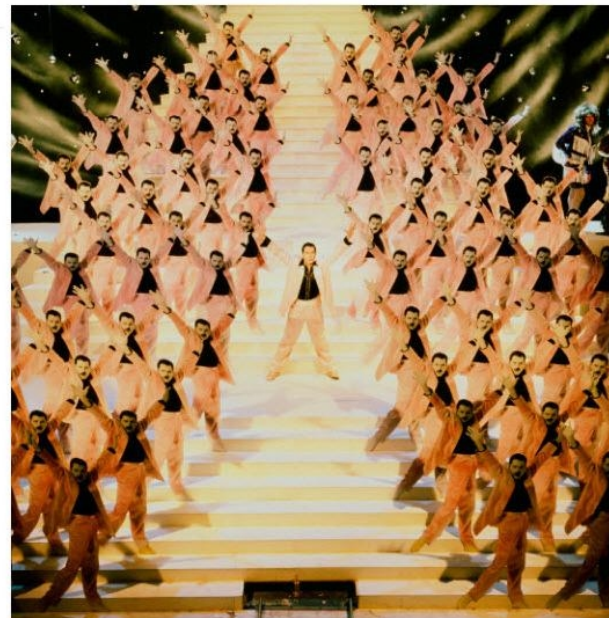
Very soon Queen's popularity extended beyond the shores of the UK as they charted and triumphed around Europe, Japan and the USA where in 1979 they topped the charts with Freddie's song 'Crazy Little Thing Called Love'.



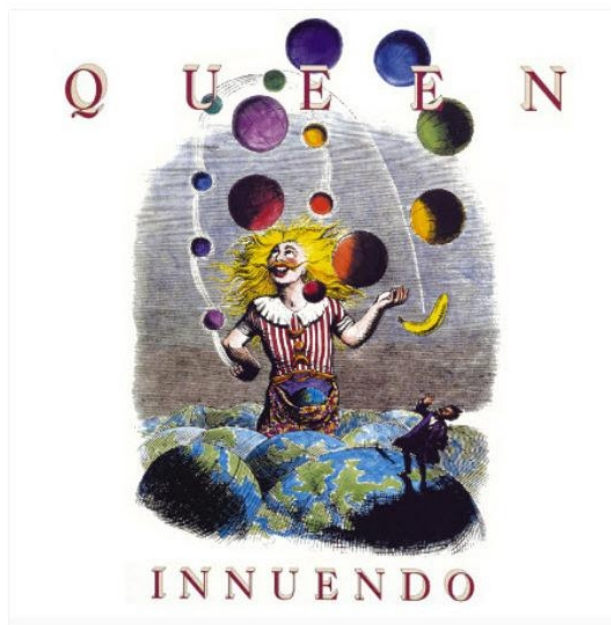
Through Freddie's ability to project himself and the band's music and image to the four corners of 70,000 seater venues they became known as the prime developers of stadium rock, a reputation perpetuated by their pioneering tactics in South America where in 1981 they performed to 231,000 fans in Sao Paulo, a world record at the time. They also became known as the key innovators of pop videos as their catalogue of 3-minute clips became more and more adventurous in style, size and content.



His first major collaboration outside Queen was with Dave Clark for the recording of London's West End musical Time, in 1986. This was followed in 1987 with the realisation of one of Freddie's long-term dreams; to record with the world revered opera diva Montserrat Caballé. The LP's title song, 'Barcelona' went on to become an anthem for Señora Caballé's home city and the theme for the Olympics in 1992.



In the mid 80's, Freddie started concentrating on his solo career, which was to run in tandem with Queen ("the mothership") for several albums commencing with the 1985 release of 'Mr. Bad Guy'. Freddie's much loved sense of self-parody reached a zenith with his cover version of The Platter's song 'The Great Pretender' in 1987, the video of which recorded him descending a sweeping staircase among acres of identical cardboard cutouts of himself.

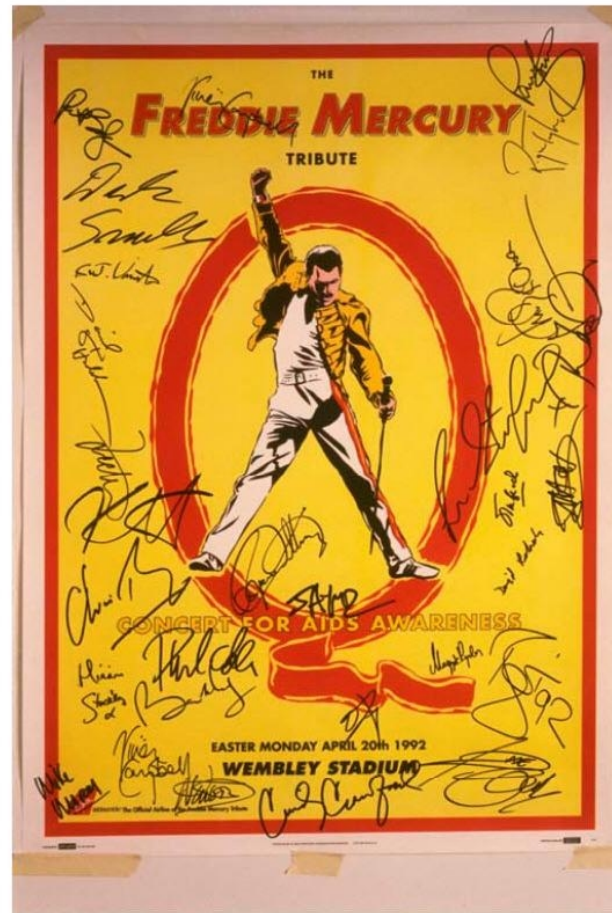


While most publicly recognised as the front man to one of the most progressive rock bands of the 70's, Freddie defied the stereotype. A taste for venturing into new territories – a trait that was to have a marked influence on the direction Queen would take – took Freddie to explore his



Freddie returned to the studios to record 'Innuendo' with Queen in 1990.

influence on the direction Queen would take – took Freddie to explore his interests in a wide spectrum of the arts, particularly in the areas of ballet, opera and theatre, even taking a participating role: in October 1977 the sell-out audience of a charity gala at the London Coliseum organised by Royal Ballet Principal dance Wayne Eagling received the surprise of an unannounced appearance by a silver-sequined leotard-clad Freddie performing an intricate routine choreographed for him by Eagling. In 1987 he made a one-night appearance in Dave Clarke's Time at the Dominion Theatre, although legend has it Freddie occasionally turned up at the theatre to support friend Clarke's musical, one night selling ice-creams in the stalls! Freddie would have loved the fact that The Dominion now plays host to the band's phenomenally successful musical We Will Rock You which has now held the Dominion stage nearly seven years longer than Time's two year run.



On November 24th, 1991, Freddie's struggle against AIDS ended when he passed away just over 24 hours after he had publicly announced he had the disease. Musicians and fans from all over the world paid their highest respects as the passing of rock's most innovative, flamboyant ambassador signified the end of an era at the Freddie Mercury Tribute Concert at Wembley Stadium on April 20, 1992 which gave birth to the Mercury



Freddie Mercury, who majored in stardom while giving new meaning to the word showmanship, left a legacy of songs, which will never lose their stature as classics to live on forever. Some of the most poignant of these were immortalised on the Queen album 'Made In Heaven' released in November 1995. The sleeve of the album shows a view from Freddie's Montreux home.



Wembley Stadium on April 20, 1992 which gave birth to the Mercury Phoenix Trust, the AIDS charity set up in Freddie's memory by the remaining members of Queen and Freddie's Executor, Jim Beach.



Despite twenty years having passed since Freddie lost his life to HIV complications, he remains in the minds of millions throughout the world as one of the greatest artists we will ever see. In September 2010 (coincidentally, around Freddie's 64th birthday) a poll carried out among rock fans saw him named the Greatest Rock Legend Of All Time, beating Elvis Presley to claim the title, and ahead of David Bowie, Jon Bon Jovi, Jimi Hendrix and Ozzy Osbourne.



Taking it one stage further, Freddie's 65th birthday, September 5, 2011 was celebrated with a major party in London in aid of The Mercury Phoenix Trust, hosted by Queen's Brian May and Roger Taylor.



September 5, 2010 saw The Mercury Phoenix Trust launch 'Freddie For A Day', a major annual initiative designed to celebrate Freddie's life each year on his birthday and to support the on-going work of the Trust. The project encourages fans to dress as Freddie for a day and in doing so raise funds for MPT through sponsorship. No one could have imagined the extraordinary response which resulted, with fans from 24 countries around the world, from Argentina to Ukraine, seizing on the idea to pay their own special tribute to Freddie.

Some sent pictures strutting their stuff at home, singing into a microphone in their bedroom. Others took the plunge and spent the whole day as Freddie, including one US enthusiast who dressed herself as 'Slightly Mad' Freddie and then spent her day at the local mall and then at Columbus Zoo in Ohio with a penguin and a gorilla. Another took a TGV trip from France to Switzerland dressed in a harlequin leotard. The stories of extraordinary and fun days spent come in their hundreds, and as a result, Freddie For A Day is now an annual event.





Freddie Mercury would have been 70 this September and as part of the celebrations a Mercury Phoenix Trust produced fan party will be held in his honour near Lake Geneva, Montreux.



A major Hollywood movie about Freddie and Queen, produced by GK Films, Robert de Niro's Tribeca Productions and Queen Films is expected to start shooting shortly.

Thank you Freddie, for continuing to bring us joy..

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