

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

U.S. APPLICATION SERIAL NO. 79204626

MARK: INCIA

79204626

CORRESPONDENT ADDRESS:

DERIS PATENT VE MARKA ACENTALIGI A.S.

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APPLICANT: GLOHE BITKISEL ÜRÜNLER SANAYİ VE TİCARET ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1337976

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

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.

SUMMARY OF ISSUES:

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- Prior Filed Application
- Amended Identification of Goods Required
- No Standard Character Claim In Application - Advisory

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the USPTO's database of registered and pending marks and has found no similar registered marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d). However, a mark in a prior-filed pending application may present a bar to registration of applicant's mark.

PRIOR FILED APPLICATION

The filing date of pending U.S. Application Serial No. 79198585 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

AMENDED IDENTIFICATION OF GOODS REQUIRED

The wording "fragrances for personal use (including deodorants for human and animals)" in the identification of goods contains parentheses. Generally, applicants should *not* use parentheses and brackets in identifications in their applications so as to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. See TMEP §1402.12. Therefore, applicant must remove the parentheses from the identification and incorporate the parenthetical information into the description of the goods.

In addition, the wording in the entries listed immediately from the identification of goods is indefinite and must be clarified to clarify the Class 003 nature of the goods. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

- Bleaching preparations
- Detergents
- teeth care preparations
- abrasive products
- pumice stone
- maintenance preparations
- polishes
- care creams

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods from that assigned by the International Bureau of the World Intellectual Property Organization (International Bureau) in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, any modification to this wording must identify goods in International Class 003, the classification assigned by the International Bureau for these goods.

The following substitute wording is suggested, if accurate:

International Class 003: *{specify nature of goods, e.g., **household**}* bleaching and cleaning preparations: detergents **for household use**, laundry bleach, laundry softeners, stain removers, dish-washing preparations; perfumery; cosmetics, fragrances for personal use, including deodorants for human and animals; soaps; **cosmetic** teeth care preparations: dentifrices, tooth polishing and whitening substances, mouth washes, not for medical purposes; abrasive products, **namely, {specify items, or Class 003 nature of products, e.g., **preparations**}; emery cloth, sandpaper, pumice stone **for personal use**, abrasive pastes; polishing and maintenance **in the nature of cleaning** preparations for leather, vinyl, metal and wood: polishes, **namely**, care creams, polishing wax**

Applicant should note that the bolded language above is to indicate the examining attorney's suggestions, and the braces indicate where applicant must insert specific types of goods. The braces should not appear in the amended identification; only the specific goods indicated, as inserted by applicant. Applicant need not amend its identification other than where specified by bold font.

Applicant may amend the identification to clarify or limit the goods, but not to broaden or expand the goods 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 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. 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c).

For assistance with identifying 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.

NO STANDARD CHARACTER CLAIM IN APPLICATION - ADVISORY

The drawing in the Section 66(a) application shows the mark in what appears to be standard characters (i.e., text only with no particular font style, size, or color being claimed). However, no explicit claim to standard characters has been made in the application. A mark registered in standard characters would provide protection of a text mark in any lettering style, size, and color. See 37 C.F.R. §2.52(a); TMEP §807.03(a). Because the application does not include a standard character claim, the USPTO will treat the mark drawing in the Section 66(a) application as a special form drawing, and any registration issuing from this application will be limited to the particular appearance and text style shown in the drawing. See TMEP §§807.03(h),

A mark in the international registration and corresponding U.S. application may meet the USPTO's requirements for a standard character drawing even though no claim to standard characters was included in the application. TMEP §807.03(h). The absence of a standard character claim could be due to the differences in requirements for such claims in different countries.

Thus, if applicant seeks to register the mark in standard characters in the United States, applicant must submit the following two statements:

- (1) **"Under the laws of the country of the basic application and/or registration, the basic application and/or registration includes, and thus the international registration includes, the legal equivalent of a standard character claim."**
- (2) **"The mark consists of standard characters without claim to any particular font style, size, or color."**

See 37 C.F.R. §2.52(a); TMEP §807.03(a), (h).

If applicant does not provide these two statements, the USPTO will consider the mark drawing to be in special form. See TMEP §807.03(h).

RESPONSE GUIDELINES

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. See 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. See 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; see 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a) (1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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

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

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

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at

<http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or 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/trademarks/teas/correspondence.jsp>.

DESIGN MARK

Serial Number

79198585

Status

NON-FINAL ACTION - MAILED

Word Mark

INSIUM

Standard Character Mark

Yes

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

DI LENARDO COSMETICS s.r.l. Società a responsabilità limitata ITALY
Via Gemona, 98 I-33100 Udine ITALY

Goods/Services

Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S:
Essential oils and aromatic extracts; toiletries; distilled oils for
beauty care; essential oils; emulsified essential oils; blended
essential oils; natural essential oils; essential oils for
aromatherapy use; essential oils for use in the manufacture of scented
products; essential oils for use in manufacturing processes; essential
oils for personal use; essential oils of plant origin; natural oils
for cosmetic purposes; aromatherapy oil; oils for perfumes and scents;
scented oils; perfume oils for the manufacture of cosmetic
preparations; body cleaning and beauty care preparations; perfumery
and fragrances; seaweed for cosmetology; aloe vera preparations for
cosmetic purposes; cotton sticks for cosmetic purposes; cosmetics;
cosmetics and cosmetic preparations; non-medicated cosmetics;
cosmetics for personal use; cosmetics in the form of oils; cuticle
cream; massage creams, not medicated; cleaner for cosmetic brushes;
make-up pads of cotton wool; aloe vera gel for cosmetic purposes;
massage gels other than for medical purposes; chalk for cosmetic use;
greases for cosmetic purposes; henna cosmetic dye; lacquer for
cosmetic purposes; massage oils and lotions; perfumed lotions toilet
preparations; perfumed body lotions toilet preparations; oils for
toilet purposes; cosmetic kits; mineral oils cosmetic; massage oils;
massage oils, not medicated; cotton wool for cosmetic purposes;
impregnated cloths for cosmetic use; foot smoothing stones; pumice

stones for use on the body; cotton balls for cosmetic purposes; abrasive preparations for use on the body; cosmetic preparations for use as aids to slimming; cosmetic preparations for nail drying; cosmetic preparations for body care; cosmetic preparations for slimming purposes; gel nail removers; facial preparations; non-medicated toiletries; sanitary preparations being toiletries; baby care products (non-medicated -); pedicure preparations; cuticle removers; cuticle conditioners; paper hand towels impregnated with cosmetics; impregnated cleaning pads impregnated with cosmetics; impregnated cleaning pads impregnated with toilet preparations; moist wipes impregnated with a cosmetic lotion; spirit gum for cosmetic use; cleansing milk for toilet purposes; cosmetic moisturisers; sun bronzers; cosmetic soaps; self-tanning preparations cosmetics; sun protecting creams cosmetics; suntan lotion cosmetics; sun block preparations; self tanning creams cosmetic; cosmetics for the use on the hair; moisturising concentrates cosmetic; beauty care cosmetics; night creams cosmetics; cosmetics for use on the skin; eye make-up; colour cosmetics for the eyes; cosmetic preparations for eyelashes; eyebrow cosmetics; sun-tanning gels; colour cosmetics for the skin; body cream; facial cleansers cosmetic; skin masks cosmetics; cosmetics in the form of lotions; cosmetics in the form of eye shadow; cosmetic hair regrowth inhibiting preparations; cosmetic oils for the epidermis; cosmetics in the form of creams; cosmetic preparations for baths; skin conditioners; facial scrubs cosmetic; skin whitening preparations cosmetic; cosmetic preparations for skin care; cosmetics for use in the treatment of wrinkled skin; sun blocking lipsticks cosmetics; cosmetics for the treatment of dry skin; cosmetics for protecting the skin from sunburn; cosmetic preparations for the hair and scalp; cosmetic products in the form of aerosols for skincare; beauty lotions; beauty serums; beauty masks; facial masks; conditioning creams; beauty balm creams.

Goods/Services

Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S: Hygienic preparations and articles; absorbent articles for personal hygiene; lubricant gels for personal use; silicone-based personal lubricants; hygienic lubricants; water-based personal lubricants; personal sexual lubricants; nail sanitizing preparations; feminine hygiene products; sanitary towels; air deodorizing and air purifying preparations; odour absorbing materials; preparations for the neutralising of odours; air purifying preparations; deodorants for clothing and textiles; deodorising room sprays.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: Cosmetic treatment for the hair; cosmetic make-up services; cosmetic treatment for the face; cosmetic treatment for the body; consultancy services relating to cosmetics; application of cosmetic products to the face; application of cosmetic products to the body; cosmetic facial and body treatment services; cosmetic treatment services for the body, face and hair; cosmetic treatment; human hygiene and beauty care; human

healthcare services; advisory services relating to beauty treatment; beauty consultancy; consultancy provided via the internet in the field of body and beauty care; consultancy in the field of body and beauty care; providing information about beauty; providing information relating to beauty salon services; hygienic and beauty care; skin care salons; skin tanning service for humans for cosmetic purposes; beauty care for human beings; tanning salon and solarium services; consultation services relating to skin care; consultation services in the field of make-up; on-line make-up consultation services; make-up consultation services provided on-line or in-person; body waxing services for the human body; beauty care services provided by a health spa; beauty salons; hairdressing; manicure and pedicure services; permanent hair removal and reduction services; make-up services; permanent makeup services; visagists' services; services for the care of the skin; hygienic care for human beings.

Filing Date

2016/07/12

Examining Attorney

ERVIN, INGA

INSIUM