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

U.S. APPLICATION SERIAL NO. 79213546

MARK: CHEF CLUB

79213546

CORRESPONDENT ADDRESS:

 ${\bf MOOSE\ CREATIVE\ MANAGEMENT\ PTY\ LTD}$

29 Grange Rd

CHELTENHAM VIC 3192

AUSTRALIA

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspro.gov/trademarks/teas/response_forms.jsp

APPLICANT: Moose Creative Pty Ltd

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1358414

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-1rst 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.

PRIOR-FILED APPLICATIONS

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, marks in prior-filed pending applications may present a bar to registration of applicant's mark.

The filing dates of pending U.S. Application Serial Nos. 87278126 and 87278220 precede applicant's filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). 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 applications.

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 marks in the referenced applications. 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.

IDENTIFICATION OF GOODS AND SERVICES INDEFINITE - 016, 028, 041.

The wording in the identification of goods and services is indefinite and must be clarified. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

In a Trademark Act Section 66(a) application, classification of services may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods and/or services transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Therefore, any modification to this wording must identify goods\services in the respective class specified in the application for these services.

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

009

The identification of goods in International Class 009 is acceptable.

<u>016</u>

The wording "paper craft materials; printed matter; materials for drawing, drawing materials; artists' materials; modelling materials; writing materials; printed patterns" is indefinite.

See suggested wording in bold below.

The following substitute wording is suggested, if accurate:

"Adhesive for paper for household purposes; art paper; craft paper; drawing paper; paper; paper crafts materials, namely, (specify common commercial name of materials within 016); cardboard; erasers; printed matter, namely, (indicate form of goods, e.g. leaflets, brochures, _(specify subject matter or field); printing blocks; children's paint-boxes; materials for drawing, booklets, etc.) in the field of (specify common commercial name of (specify common commercial name of goods within 016); drawing materials, namely, goods within 016); artists' materials, namely, (specify common commercial name of goods within 016); modelling materials, namely, (specify common commercial name of goods within 016); writing materials, namely, (specify common commercial name of goods within 016); adhesive stickers; gums being adhesives for stationery or household purposes; pastes for stationery or household purposes; stickers being decalcomanias; stickers being stationery; coloured liquids for use in childrens' crafts; craft kits for painting/posters; craft kits for papier mache model construction; art materials being paint boxes for use in schools; adhesive backed films being stationery for use as decorative trim, adhesive backed films for stationery purposes; stationery; stationery for children's educational activities; stationery for children's playing activities; printed stickers; modelling clay; moulds for modelling clays being artists' materials; printed patterns for _____(indicate purpose of patterns, e.g. for making clothes, for embroidery, etc.); printed patterns for costumes; boxes of paints for use by children; children's painting sets; booklets relating to games; printed matter for use with board games; trading cards other than for games; toy modelling dough." 016

028

The wording "craft toys sold complete; craft toys sold in kit form; children's toys; kits of parts sold complete for constructing miniature toys; kits of parts sold complete for constructing toys; kits of parts sold complete for the assembly of toys; kits of parts sold complete for the construction of toys; model toys or playthings; toys; toys being for sale in kit form; toys sold in kit form; games; toys adapted for educational purposes; games for children; educational playthings; toys adapted for educational purposes; games for children" is indefinite.

See suggested wording in bold below.

The following substitute wording is suggested, if accurate:

""Craft kits for games and playthings, namely, toy model hobby craft kits for construction toy model buildings, vehicles, action figures and pretend food; _(indicate the common commercial name of the toys); craft toys sold in kit form for craft toys sold complete for making making (indicate the common commercial name of the toys); action figures being toys or playthings; action toys; children's toys, namely, (specify common commercial name of toys, e.g. dolls, action figures, etc.); figurines being toys; kits of parts sold complete for constructing miniature toys in the nature of (specify nature of toys, e.g. toy cars, toy buildings, etc.); kits of parts sold complete for constructing toys in the nature of (specify nature of toys, e.g. toy cars, toy buildings, etc.); kits of parts sold complete for the assembly of (specify nature of toys, e.g. toy cars, toy buildings, etc.); kits of parts sold complete for the construction of toys in the (specify nature of toys, e.g. toy cars, toy buildings, etc.); model toys or playthings in the nature of (specify nature of "playthings"); toys, namely, (specify common commercial name of toys within 028, e.g. dolls, doll houses, toy cars, etc.); toys being for (specify common commercial name of toys within 028, e.g. dolls, doll houses, toy cars, etc.); toys sold in kit form, sale in kit form, namely, (specify common commercial name of toys within 028, e.g. dolls, doll houses, toy cars, etc.); kits of parts sold complete for constructing toy models; kits of parts sold complete for making toy model cars; kits of parts sold complete for making toy models; toy model kits; toy models; card games; games, namely, _____(specify common commercial name of games); games adapted for use with an external display scr monitor; games adapted for use with dot matrix liquid crystal displays; tactile educational games being playthings; trading cards being card games; (specify common commercial name of games); games adapted for use with an external display screen or (specify common commercial name of playthings); electronic playthings, namely, educational playthings, namely, commercial name of playthings); playthings, namely,_ _(specify common commercial name of playthings); model toys; toys adapted for (specify common commercial name of toys); construction toys; plush toys; toy dolls; toy figures; toy furniture; educational purposes, namely, toy playsets; board games; games for children, namely,_ ___(specify common commercial name of games); hand held computer games; hand held electronic games; miniatures for use in games; models for use with hobby games; dolls' furniture; dolls' houses; furniture for dolls' houses." 028

<u>041</u>

The wording "Entertainment and educational services; providing of training; sporting and cultural activities; production or distribution of television programs, video recordings, motion picture films and videotape films, webisodes and online videos not downloadable, and sound recordings; providing online electronic publications not downloadable; live entertainment; musical entertainment services; organisation and conducting of dance, music and other entertainment festivals; organisation of competitions; organisation of entertainment events" is indefinite.

Additionally, the word "or" in "production or distribution of television programs" suggests that it could be either, but that it isn't necessarily both. If it isn't both, both shouldn't be listed, and if it is both, "and" is accurate."

An application must specify, in an explicit manner, the particular goods or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. See 15 U.S.C. §1051(a)(2), (b)(2); 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Generally, the terminology

"and/or" and "or" is not sufficiently explicit language in identifications because it is not clear whether applicant is using the mark, or intends to use the mark, on all the identified goods or services. See TMEP §1402.03(a).

For example, "modems and/or computer monitors" could refer to "modems or computer monitors" and is unclear which goods applicant intends to identify. Therefore, applicant should replace "and/or" with "and" in the identification of goods or services, if appropriate, or rewrite the identification with the "and/or" deleted and the goods or services specified using definite and unambiguous language.

The wording "other" in the identification of services is indefinite and must be clarified by (1) specifying the common commercial or generic name for these services, or (2) deleting this wording. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03(a). This wording is an open-ended "catch-all" word or phrase (e.g., "etc.," "and other similar services," "and related services") that is not acceptable because it fails to identify specific services. See TMEP §1402.03(a).

In an identification, an applicant must use the common commercial or generic name for the services, be specific and all-inclusive, and avoid using indefinite words or phrases. TMEP §§1402.01, 1402.03(a). Further, applicant may amend the identification to list only those items that are within the scope of the services set forth in the initial application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §§1402.06 et seq., 1402.07. Scope is generally determined by the ordinary meaning of the wording in the identification. TMEP §1402.07(a).

See suggested wording in bold below.

The following substitute wording is suggested, if accurate:

Entertainment and educational services, namely, ____(Specify common commercial name of entertainment services, e.g. organizing social entertainment events, conducting live musical concerts, etc. Indicate specific mode of instructions, e.g. classes, seminars, conferences, workshops, etc. and indicate the subject matter or fields of education activity, e.g. math, science, etc.); providing of training namely, ____(specify nature/subject matter, e.g. animal training, business training, meditation training, etc.); organizing sporting and cultural activities; production and distribution of television programs, video recordings, motion picture films and videotape films, webisodes and online videos not downloadable, and sound recordings; provision of online computer games via interactive websites; publication of books, magazines and journals; publication of electronic books, magazines and journals online; publication of multimedia material online; providing online electronic publications not downloadable, namely, ____(indicate specific nature of publications, e.g. books, magazines, brochures, etc.) in the field of _____(indicate subject matter of the publication); live entertainment, namely, _____(indicate nature of performances, e.g., plays, concerts, dance performances, etc.); musical entertainment services in the nature of _____(specify nature of other entertainment festivals); organisation and conducting of dance, music and other entertainment festivals, namely, _____(specify nature of other entertainment events, e.g. concerts, plays, social entertainment events, sporting events, etc.)." 041

Where possible, the examining attorney has provided guidelines to assist the applicant in amending the existing identification of goods and services.

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).

RESPONSE GUIDELINES

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options specified in this Office action for responding to a refusal and should consider those options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see "Responding to Office Actions" on the USPTO's website.

If applicant does not respond to this Office action within six months of the issue/mailing date, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§718.01, 718.02. Additionally, the USPTO will not refund the application filing fee, which is a required processing fee. *See* 37 C.F.R. §§2.6(a)(1)(i)-(iv), 2.209(a); TMEP §405.04.

When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. See 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and may be filed online via the Trademark Electronic Application System (TEAS) with a \$100 fee. See 37 C.F.R. §§2.6(a)(15)(ii), 2.66(b)(1).

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a qualified U.S. attorney specializing in trademark matters to represent applicant in this process and provide legal advice. Although the undersigned trademark examining attorney is permitted to help an applicant understand the contents of an Office action as well as the application process in general, no USPTO attorney or staff is permitted to give an applicant legal advice or statements about an applicant's legal rights. TMEP §§705.02, 709.06. For attorney referral information, applicant may consult the <u>American Bar Association's Consumers' Guide to Legal Help</u> or an online directory of legal professionals, such as <u>FindLaw®</u>. The USPTO, however, may not assist an applicant in the selection of a private attorney. 37 C.F.R. §2.11.

Please note that foreign attorneys, other than authorized Canadian 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. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(c).

The <u>only</u> attorneys who may practice before the USPTO in trademark matters are as follows:

- (1) Attorneys 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; and
- (2) Canadian agents/attorneys who represent applicants located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO.

See 37 C.F.R. §§2.17(a), (e), 11.1, 11.14(a), (c); TMEP §602.

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/comespondence.jsp.

Gretta Yao

/gy/

Attorney

United States Patent & Trademark Office

Law Office 118

Gretta.Yao@uspto.gov

571.272.9313

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.isp. Please wait 48-72 hours from the issue/mailing 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/traderrarks/teas/correspondence_jsp.



DESIGN MARK

Serial Number

87278126

Status

NON-FINAL ACTION - MAILED

Word Mark

CHEFS CLUB

Standard Character Mark

Yes

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Chefs Club U.S.A., Inc. CORPORATION DELAWARE 96 Spring Street, 6th Floor New York NEW YORK 10012

Goods/Services

Class Status -- ACTIVE. IC 030. US 046. G & S: Pasta, spices, sauces, condiments.

Goods/Services

Class Status -- ACTIVE. IC 032. US 045 046 048. G & S: Non-alcoholic beverages.

Goods/Services

Class Status -- ACTIVE. IC 033. US 047 049. G & S: Wine; alcoholic beverages.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Providing a website featuring information in the fields of food, beverages, cooking, and entertainment; Providing information in the field of food, beverages, cooking, and entertainment; Providing online store services featuring food and beverage products; Retail grocery stores; Retail online grocery stores.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Entertainment services in the nature of development, creation, production, distribution, and post-production of television shows

featuring cooking, food, restaurants, chefs, and entertainment; Providing on-line information in the field of television and video entertainment featuring cooking, food, restaurants, chefs and entertainment via the Internet; Providing a website featuring entertainment information in the field(s) of food, beverages, cooking, and entertainment; Entertainment services, namely, the provision of continuing programs and shows featuring instructional and entertainment programming, delivered by television, satellite, and the Internet; Entertainment services, namely, an ongoing series featuring topics related to cooking, food, beverages and culinary instruction and entertainment provided through television, webcasts and the Internet.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant services; bar services.

Filing Date

2016/12/22

Examining Attorney

HSU, FONG

Attorney of Record

Kristine M. Young

CHES CLUB

DESIGN MARK

Serial Number

87278220

Status

NON-FINAL ACTION - MAILED

Word Mark

CC CHEFS CLUB

Standard Character Mark

No

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

Chefs Club U.S.A., Inc. CORPORATION DELAWARE 96 Spring Street, 6th Floor New York NEW YORK 10012

Goods/Services

Class Status -- ACTIVE. IC 030. US 046. G & S: Pasta, spices, sauces, condiments.

Goods/Services

Class Status -- ACTIVE. IC 032. US 045 046 048. G & S: Non-alcoholic beverages.

Goods/Services

Class Status -- ACTIVE. IC 033. US 047 049. G & S: Wine; alcoholic beverages.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Providing a website featuring information in the fields of food, beverages, cooking, and entertainment; Providing information in the field of food, beverages, cooking, and entertainment; Providing online store services featuring food and beverage products; Retail grocery stores; Retail online grocery stores.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Entertainment services in the nature of development, creation, production, distribution, and post-production of television shows

featuring cooking, food, restaurants, chefs, and entertainment; Providing on-line information in the field of television and video entertainment featuring cooking, food, restaurants, chefs and entertainment via the Internet; Providing a website featuring entertainment information in the field(s) of food, beverages, cooking, and entertainment; Entertainment services, namely, the provision of continuing programs and shows featuring instructional and entertainment programming, delivered by television, satellite, and the Internet; Entertainment services, namely, an ongoing series featuring topics related to cooking, food, beverages and culinary instruction and entertainment provided through television, webcasts and the Internet.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant services; bar services.

Description of Mark

The mark consists of a design with two interlocking "C"s that, together, form a single three-dimensional "C." The words CHEFS CLUB appear in bolded letters below the three-dimensional "C" design.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2016/12/22

Examining Attorney

HSU, FONG

Attorney of Record

Kristine M. Young

