

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

U.S. APPLICATION SERIAL NO. 79221194

MARK:

79221194

CORRESPONDENT ADDRESS:

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ITALY

APPLICANT: EGIDIO GALBANI S.r.l.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1375841

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.

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(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Requirement for a modified description of the mark.
- Requirement for a modified color claim
- Requirement for an acceptable identification of goods.

I. MODIFIED DESCRIPTION OF THE MARK

Applicant must submit an accurate and complete description of the literal and design elements in the mark. 37 C.F.R. §2.37; see TMEP §§808.01, 808.02. The following is suggested, if accurate:

The mark consists of a stylized design of a dark blue, light blue and white table cover featuring an image of a rural landscape, including a detached house, trees, cultivated areas and birds in flight, all in the colors dark blue, light blue and white, in addition to crossing wavy vertical and horizontal lines in the color light blue giving the table cover an impression of continuous movement. A vertically arranged white rectangular band formed by dark blue parallel lines on either side intersects the middle of the table cover and features a white incomplete and blank oval two-thirds of the way up surrounded by a white glow or shadow, followed by a light blue glow or shadow, overlapping the rural landscape.

II. MODIFIED COLOR CLAIM

The color claim does not identify all the colors in the drawing of the mark. Specifically, the following color has been omitted: dark blue (simply stated as “blue” in the color claim; however, “dark blue” is referenced in the description of the mark.) A complete color claim must list *all* the colors appearing in the drawing of the mark. See 37 C.F.R. §2.52(b)(1); TMEP §§807.07(a) *et seq.* If black, white, and/or gray are not being claimed as a color feature of the mark, applicant must exclude these from the color claim and include in the mark description a statement that the colors black, white, and/or gray represent background, outlining, shading and/or transparent areas and are not part of the mark. TMEP §807.07(d).

Based on the foregoing requirements for a complete color claim, applicant must provide a color claim that references all of the colors appearing in the drawing of the mark. See 37 C.F.R. §2.52(b)(1); TMEP §§807.07(a) *et seq.*

The following color claim is suggested: **“The colors dark blue, light blue and white are claimed as a feature of the mark.”**

III. AMENDMENT TO THE IDENTIFICATION OF GOODS

The identification of goods is indefinite and must be clarified because the specific nature of all of the goods offered is not indicated. Please see below in this regard.

International Class 29

“Anchovy” and “dates” are unacceptable in that only *processed* anchovies and *processed* dates are in International Class 29. Moreover, “while” of eggs” is unclear. In this regard, “white of eggs” is acceptable. Furthermore, the “butter” goods do not appear to identify International Class 29 goods, and therefore, must be deleted. [Please note in this regard that “butter” alone is beyond the scope of the identification.] See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Furthermore, the wording “fish-based foodstuffs” is unduly broad. In this regard, “prepared meals consisting primarily of fish” is acceptable. Additionally, the lettering “Am” throughout the identification is unclear and appears unnecessary. Therefore, the indication “Am” should be deleted from the identification. The “buttercream” goods must also be clarified. In this regard, the wording “cream featuring butter”, or “butter substitutes in cream form” is acceptable. The type of “croquettes” offered must also be indicated, for example, fish croquettes. The nature of the “gelatin” offered must also be indicated, i.e. “unflavored and unsweetened gelatins” is acceptable in this regard. The nature of the “kumys” beverage must also be indicated. In this regard, the following is acceptable: “milk beverages, milk predominating, namely, kumys or sour milk.” The specific nature of the “milk of almonds for culinary purposes” must also be indicated, e.g. “almond milk for culinary purposes” is acceptable in this regard. The nature of the “fatty substances for the manufacture of edible fats” must also be clarified. For example, “lard for use in manufacturing edible fats” is acceptable in this regard. The “fat-containing mixtures for bread slices” is also indefinite. In this regard, “edible oils and fats for use on bread slices” is acceptable. Moreover, the wording “coconut oil”, “corn oil” and “sesame oil” is unacceptable without the indication “for food”. Additionally, the nature of the “cream dairy products” offered must be indicated. In this regard, “cream, being dairy products” is acceptable. Likewise, the “milk products” must be clarified, such as “milk products, excluding ice cream, ice milk and frozen yogurt.” Furthermore, the “sausages in batter” must be clarified. In this regard, “battered and fried sausage” is acceptable. The “suet for food” must also be clarified, e.g. as “suet for culinary purposes.” Additionally, the “seeds, prepared” is unacceptable as indefinite as only seeds, not for use as seasonings or flavourings, are in International Class 29. In this regard, “prepared seeds for human consumption, not being seasonings or flavourings” is acceptable. Moreover, the “snail eggs” must be indicated for *human* consumption.

International Class 30

The nature of the “coffee flavorings” offered must be indicated, such as “flavored coffee creamer.” The “chocolate beverages with milk” must be indicated as “chocolate-based”, if accurate. Moreover, the nature of the “aromatic preparations for food” offered must also be indicated. For example, “vanilla flavorings for foods” is acceptable in this regard. The nature of the “condiments” offered must also be indicated. For example, “sauces”, or “chili oils being condiments” are acceptable in this regard. The nature of the “confectionery”, “peanut confectionery”, “almond confectionery”, “fruit jellies” confectionery, and “mint for confectionery” offered must also be indicated, such as “candy”, “peanut brittle”, “almond cake”, “fruit jelly” and “candy mints”. The “turmeric” must be indicated as “edible” in nature. Additionally, the nature of the “essences for foodstuffs, except etheric essences and essential oils” offered must be indicated, such as “coffee essences”, if accurate. The specific nature of the “ferments for pastes” offered must also be indicated. For example, “fermented hot pepper paste” is acceptable in this regard. The nature of the “chips” being cereal products must also be indicated, for example, “cereal-based snack chips”. Furthermore, the “gluten prepared as foodstuff” must be further clarified. For example, “maize gluten meal” is acceptable in this regard. The wording “infusions, not medicinal” is also unclear. In this regard, “food flavorings, namely, infused oils, not being essential oils” is acceptable. The specific nature of the “binding agents for ice cream” or edible ices must be indicated, such as starch-based binding agents for ice cream. The nature of the “leaven” must also be indicated, such as “food leavening agents.” The “maltose”, “royal jelly” and “propolis” must be indicated for food purposes. The specific nature of the “cake powder” must also be stated, such as “cake mixes in powder form.” The same is true regarding the “powders for making ice cream.” In this regard, “ice cream mixes in powder form” is acceptable. The “cereal preparations” are also unduly vague. In this regard, “preparations made from cereals, namely, bread and bread mixes” is acceptable. Moreover, the term “vegetal” should be clarified as “vegetable.” The wording “preparations for stiffening whipped cream” is also unclear. In this regard, “starch-based thickeners for whipped cream” is acceptable. The “peppers (seasonings)” must also be clarified. In this regard, “dried chili peppers for use as seasoning” is acceptable. The “linseed for human consumption” must also be clarified as a seasoning, if accurate. Moreover, the “semolina” must be clarified as processed in nature. Additionally, the “vanillin” must be clarified for use as a food flavoring, if accurate. Finally, the “ginger (spice)” must be clarified as a processed spice.

Furthermore, please note that the identification of goods contains parentheses and brackets. Generally, applicants should *not* use parentheses or 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 that have been deleted from registrations or in an affidavit of incontestability to indicate goods not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., "fried tofu pieces (abura-age)." *Id.* Therefore, applicant must remove the parentheses and brackets from the identification and incorporate any parenthetical or bracketed information into the description of the goods.

Suggested id

Specifically, the Applicant may adopt the following identification, in total, if accurate:

“Processed anchovy; preserved peppers, namely, ajvar; white of eggs; albumen for culinary purposes; alginates for culinary purposes; salted meats; aloe vera prepared for human consumption; processed peanuts; spiny lobsters, not live; herrings, not live; bacon; milk beverages, milk predominating; bouillon; soups; fruit peel; Korean beef dish, namely, bulgogi; peanut butter; cocoa butter for food; coconut butter; game, not live; preserved artichokes; meat; preserved meat; pork; caviar; gherkins; prepared meals consisting primarily of fish; preserved onions; arrangements of processed fruit; compote in the nature of cranberry sauce; compotes; bouillon concentrates; tomato paste; shellfish, not live; jams; preserved garlic; tinned meat; tinned fruits; tinned vegetables; tinned fish; mussels, not live; sauerkraut; cream featuring butter; butter substitutes in cream form; eggplant paste; vegetable marrow paste; silkworm chrysalis, for human consumption; fish, chicken and salmon croquettes; crustaceans, not live; processed dates; non-alcoholic eggnog; seaweed extracts for food; meat extracts; preserved soya beans for food; fishmeal for human consumption; preserved beans; liver; milk ferments for culinary purposes; fish fillets; potato flakes; cheese; potato fritters; milk shakes; fruit chips; frozen fruits; preserved fruit; fruit preserved in alcohol; stewed fruit; crystallized fruits; preserved berries; preserved mushrooms; shrimps, not live; prawns, not live; lobsters, not live; crayfish, not live; meat jellies; unflavored and unsweetened gelatins; jellies for food; fruit jellies; edible fats; coconut fat; chickpea paste, namely, hummus; isinglass for food; vegetable soup preparations; milk beverage, namely, kephir; fermented vegetable dish, namely, kimchi; milk beverages, milk predominating, namely, kumys or sour milk; lard; milk; albumin milk; curd; condensed milk; peanut milk for culinary purposes; almond milk for culinary purposes; rice milk for use as a milk substitute; soya milk for use as a milk substitute; powdered milk; lecithin for culinary purposes; preserved vegetables; cooked vegetables; dried vegetables; preserved lentils; fruit salads; vegetable salads; ground almonds; margarine; marmalade; lard for use in manufacturing edible fats; animal marrow for food; edible oils and fats for use on bread slices; vegetable mousses; fish mousses; edible birds' nests; prepared hazelnuts; flavored nuts; candied nuts; desiccated coconut; prepared nuts; edible oils; coconut oil for food; colza oil for food; sunflower oil for food; corn oil for food; palm kernel oil for food; edible bone oil; palm oil for food; linseed oil for culinary purposes; sesame oil for food; olive oil for food; preserved olives; sea-cucumbers, not live; oysters, not live; whipped cream; cream, being dairy products; tomato purée; liver pâté; potato chips; low-fat potato chips; pectin for culinary purposes; fish, not live; preserved fish; salted fish; preserved peas; poultry, not live; pollen prepared as foodstuff; fruit pulp; preparations for making bouillon; preparations for making soup; rennet; charcuterie; milk products, excluding ice cream, ice milk and frozen yogurt; ham; soured milk, namely, prostokvasha; apple puree; fermented baked milk, namely, ryazhenka; salmon, not live; sausages; battered and fried sausage; blood sausage in the nature of black pudding; sardines, not live; prepared sunflower seeds; suet for culinary purposes; prepared seeds for human consumption, not being seasonings or flavourings; whey; smetana, namely, sour cream; fruit-based snack food; pickles; piccalilli; vegetable juices for cooking; tomato juice for cooking; sesame seed paste, namely, tahini; truffles, preserved; tofu; tuna, not live; tripe; yolk of eggs; eggs; snail eggs for human consumption; prepared fish roe; powdered eggs; raisins; toasted laver; clams, not live; yakitori; yogurt; ginger jam” in International Class 29.

“Vinegar; beer vinegar; sea water for cooking; gluten additives for culinary purposes; condiment in the nature of minced garlic; seaweed for use as a condiment; oat-based food; starch for food; aniseed; star aniseed; seasonings; flavored coffee creamer; food flavorings, other than essential oils; vanilla flavorings for culinary purposes; flavorings, other than essential oils, for beverages; flavorings, other than essential oils, for cakes; crushed oats; husked oats; stuffed buns, namely, baozi; high-protein cereal bars; cereal bars; confectionery, namely, liquorice in stick form; cocoa-based beverages; coffee-based beverages; chocolate-based beverages; tea-based beverages; cocoa beverages with milk; chocolate-based beverages with milk; bicarbonate of soda for cooking purposes, namely, baking soda; cookies; malt biscuits; petit-beurre biscuits; candy, namely, sweetmeats; buns; puddings; rice pudding; burritos; cocoa; coffee; coffee beverages with milk; unroasted coffee; spice, namely, cinnamon; capers; candy, namely, caramels; peppermint sweets; edible paper; edible rice paper; cheeseburger sandwiches; spices, namely, cloves; condiments, namely, chow-chow; condiments, namely, chutneys; waffles; chicory-based coffee substitute; chocolate; aromatic preparations for food, namely, vanilla flavorings for food, and food flavourings, other than essential oils, and seasonings; condiments, namely, sauces and chili oils; candy; peanut confectionery, namely, peanut brittle; almond cake; pralines; sauces, namely, fruit coulis; crackers; cream of tartar for culinary purposes; custard; pancakes; pastries, namely, macaroons; edible turmeric; spice, namely, curry powder; semolina, namely, couscous; chocolate decorations for cakes; cakes; natural sweeteners; confectionery for decorating Christmas trees; preserved garden herbs for use as seasonings; coffee essences; malt extract for food; bean meal; wheat flour; corn flour; nut flours; barley meal; mustard meal; soya flour; tapioca flour; hominy; flour; potato flour; fermented hot pepper paste; oat flakes; processed cereal-based snack chips; corn flakes; groats for human food; flowers or leaves for use as tea substitutes; pies; confectionery, namely, fondants; ice cream; edible ices; fruit jelly candy; ham glaze; wheat germ for human consumption; ice, natural or artificial; ice for refreshment; gimhap in the nature of a Korean rice dish; cake frosting; glucose for culinary purposes; gluten prepared as foodstuff, namely, maize gluten meal; chewing gum; corn, milled; corn, roasted; popcorn; halvah; dough; food flavorings, namely, infused oils, not being essential oils; spring rolls; thickening agents for cooking foodstuffs; stuffed dumplings, namely, jiaozi; sauce, namely, ketchup; starch-based binding agents for ice cream and sausage; yeast; baking powder; food leavening agents; confectionery, namely, liquorice; macaroni; mayonnaise; malt for food purposes for human consumption; maltose for food; marinades; marzipan; molasses for food; candy mints; honey; batter mixes for okonomiyaki, namely, batter mixes for Japanese savory pancakes; chocolate mousses; confectionery, namely, dessert mousses; muesli; allspice; chocolate-coated nuts; nutmegs; okonomiyaki in the nature of Japanese savory pancakes; crushed barley; husked barley; bread; rusks; unleavened

bread; breadcrumbs; bread rolls; gingerbread; *royal jelly for food purposes*; almond paste; rice pulp for culinary purposes; *condiment, namely, soya bean paste*; pastry dough; cake dough; pasta; pastries; *confectionery, namely, pastilles*; *cakes, namely, petits fours*; meat pies; noodle-based prepared meals; pâtés en croûte; *dumplings stuffed with meat, namely, pelmeni*; pepper; *sauce, namely, pesto sauce*; pizzas; *cake mixes in powder form*; *ice cream mixes in powder form*; *preparations made from cereals, namely, bread and bread mixes*; *vegetable preparations for use as coffee substitutes*; meat tenderizers, for household purposes; *starch-based thickeners for whipped cream*; *propolis for food purposes*; quiches; *condiment, namely, relish*; Japanese noodle-based dish, *namely, ramen*; ravioli; rice; sago; cooking salt; celery salt; salt for preserving foodstuffs; tomato sauce; soya sauce; *condiments, namely, sauces*; dressings for salad; pasta sauce; sandwiches; *dried chili peppers for use as seasonings*; golden syrup; *linseed for use as a seasoning for human consumption*; oatmeal; *processed semolina*; hominy grits; mustard; cereal-based snack food; rice-based snack food; *confectionery ices, namely, sherbet ices*; spaghetti; spices; artificial coffee; meat gravies; sushi; tabbouleh; tacos; noodles; tapioca; tea; iced tea; tarts; rice cakes; tortillas; *vanillin for use as a food flavoring*; *stuffed dumplings, namely, vareniki*; *noodles, namely, vermicelli*; *confectionery ices, namely, frozen yogurt*; *saffron for use as a food seasoning*; *powdered spice, namely, ginger*; candy decorations for cakes; sugar; candy; palm sugar” **in International Class 30.**

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 (International Bureau); and the classification of goods 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 transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

SEARCH RESULTS

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

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_forms.jsp. 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/>.

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