

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

U.S. APPLICATION SERIAL NO. 79228905

MARK: CAVIARUS

79228905

CORRESPONDENT ADDRESS:

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http://www.uspto.gov/trademarks/teas/response_form.jsp

APPLICANT: OBSHESTVO S OGRANICHENNOY
OTVETSTVENNOSTI ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1394150

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 "1B-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 issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH OF OFFICE'S DATABASE OF MARKS

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).

SUMMARY OF ISSUES:

- IDENTIFICATION OF GOODS AND SERVICES
- EXPLANATION OF MARK'S SIGNIFICANCE REQUIRED
- ENTITY TYPE AND COUNTRY REQUIRED

IDENTIFICATION OF GOODS AND SERVICES

- The wording "fish-based foodstuffs" in the identification of goods is indefinite and must be clarified because the specific type of the foodstuffs is required. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

- The identification of goods and services contains brackets. 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. 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 brackets from the identification and incorporate any bracketed information into the description of the goods and/or services.

The wording “presentation of goods on communication media, for retail purposes” in the identification of services is indefinite and must be clarified because it must be clear if this is for advertising purposes. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “procurement services for others purchasing goods and services for other businesses” in the identification of services is indefinite and must be clarified because the types of goods and services are required. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant may adopt the following identification, if accurate:

International Class 29

Toasted liver; caviar; fish roe, prepared; isinglass for food; fish, tinned; bouillon concentrates; shrimps, not live; prawns, not live; salmon, not live; shellfish, not live; mussels, not live; lobsters, not live; **fish-based foodstuffs, namely, {indicate type, e.g., fish cakes, etc.}**; crayfish, not live; crustaceans, not live; fish, preserved; fish, not live; salted fish; sardines, not live; fat-containing mixtures for bread slices; oysters, not live; fish fillets; seaweed extracts for food.”

International Class 35

“Import-export agency services; computerized file management; invoicing; demonstration of goods; **commercial information and advice for consumers**; marketing research; business management and organization consultancy; business organization consultancy; business management consultancy; organization of exhibitions for commercial or advertising purposes; organization of trade fairs for commercial or advertising purposes; shop window dressing; provision of an on-line marketplace for buyers and sellers of goods and services; **presentation of goods on communication media, for retail advertising purposes**; sales promotion for others; distribution of samples; on-line advertising on a computer network; procurement services for others, **namely, purchasing goods and services in the field of {indicate type of goods or services, e.g., weapons, office furniture, etc.} for other businesses.**”

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 should note the following additional requirement.

EXPLANATION OF MARK’S SIGNIFICANCE REQUIRED

To permit proper examination of the application, applicant must provide the following information:

- (1) Explain whether the wording in the mark “CAVIARUS” has any meaning or significance in the industry in which the goods and/or services are manufactured/provided, or if such wording is a term of art within applicant’s industry.
- (2) Explain whether this wording identifies a geographic place or has any meaning in a foreign language.
- (3) Submit an English translation of all foreign wording in a mark and a transliteration (the phonetic spelling of the pronunciation, in Latin characters) of all non-Latin characters in a mark. If the wording does not have meaning in a foreign language, applicant should so specify.

The format for an English translation: “**The English translation of the word “CAVIARUS” in the mark is “<>”.**

The format for when there is no English translation or meaning of the transliteration: “**The wording “CAVIARUS” has no meaning in a foreign language.”**

See 37 C.F.R. §§2.32(a)(9)-(a)(10), 2.61(b); TMEP §§809-809.03, 814.

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.

Applicant should note the following additional requirement.

ENTITY TYPE AND COUNTRY REQUIRED

The application does not indicate applicant’s legal entity and citizenship, or state or country of organization or incorporation. Accordingly, applicant must

specify its legal entity and its national citizenship or foreign country of organization or incorporation. See 37 C.F.R. §§2.32(a)(3)(i)-(ii), 2.61(b); TMEP §§803.03, 803.04. This information is required for all U.S. trademark applications, including those filed under Trademark Act Section 66(a). See 37 C.F.R. §7.25(a)-(b); TMEP §1904.02(a).

Acceptable legal entities include an individual, a partnership, a corporation, a joint venture, or the foreign equivalent. See TMEP §§803.03 *et seq.* If applicant's legal entity is an individual, applicant must so specify and provide his or her national citizenship. TMEP §803.03(a). If applicant is a corporation, association, partnership, joint venture, or the foreign equivalent, applicant must so specify and provide the foreign country under whose laws applicant is organized or incorporated. TMEP §803.03(b)-(c). For an association, applicant must also specify whether the association is incorporated or unincorporated, unless the foreign country and the designation or description "association/associazione" appear in Appendix D of the *Trademark Manual of Examining Procedure* (TMEP). TMEP §803.03(c).

If applicant is organized under the laws of a foreign province or geographical region, applicant should specify both the foreign province or geographical region and the foreign country in which the province or region is located. See TMEP §803.04. To provide this information online via the Trademark Electronic Application System (TEAS) Response to Office Action form, applicant must open the response form, answer "Yes" to wizard question number 5, find the "Owner Information" page, and do the following: (1) locate the "Entity Type" heading on that page and select "Other;" (2) locate the "Specify Entity Type" heading and select "Other" under the Foreign Entity option, and enter in the free-text field below both applicant's entity type and the foreign province or geographical region of its organization (e.g., partnership of Victoria); and (3) locate the "State or Country Where Legally Organized" heading and select the appropriate foreign country (e.g., Australia) under the Non-U.S. Entity option.

RESPONSE

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 date on which the USPTO sends this Office action to the International Bureau, 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 §§711, 718.01, 718.02.

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(a)(1), (b)(1).

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/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.