

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

U.S. APPLICATION SERIAL NO. 79251920

MARK: 99.98% 1905

**\*79251920\***

**CORRESPONDENT ADDRESS:**

Svetlana Korolova  
LLC "Lexpatent",  
P.O. Box 418  
220131 Minsk  
BELARUS

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**APPLICANT:** Joint Venture Joint-Stock Company "Konmu ETC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**INTERNATIONAL REGISTRATION NO. 1449924**

**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 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:**

- Disclaimer Requirement
- Mark Description Requirement
- Mark Drawing Requirement
- Translation Requirement

**DISCLAIMER REQUIREMENT**

Applicant must disclaim the following un-registerable components of the mark: (1) the non-Latin characters that transliterate to "NASTOYASHCHY KAKAO POROSHOK" and "99.98 KAKAO PRODUKTOV" because it merely describes applicant's goods; and (2) the non-Latin characters that transliterate to "KONDITERSKAYA FABRIKA 1905" because it merely describes the source or provider of applicant's goods. See 15 U.S.C. §1052(e)(1); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a); TMEP §§1213.03(a), 1213.08(d); see *Bausch & Lomb Optical Co. v. Overseas Fin. & Trading Co.*, 112 USPQ 6, 8 (Comm'r Pats. 1956).

In the application, applicant indicated that the non-Latin characters that transliterate to "KONDITERSKAYA FABRIKA 1905" means "confectionery factory" in English. The attached dictionary evidence from American Heritage Dictionary defines "confectionary" as "sweet preparations" and "factory" is defined as "a building or group of buildings which goods are manufactured". Thus, the wording merely describes the provider of the goods because applicant's cocoa powder is manufactured in a confectionary factory that has been around since 1905.

Terms that describe the provider of a product or service may also be merely descriptive of the product. See *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1301, 102 USPQ2d 1217, 1220 (Fed. Cir. 2012) (affirming Board's finding that NATIONAL CHAMBER was merely descriptive of online service providing directory information for local and state chambers of commerce and business and regulatory data analysis services to promote the interest of businessmen and businesswomen); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001) (holding MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors and shin guards); TMEP §1209.03(q).

In addition, applicant indicated that the non-Latin characters that transliterate to "NASTOYASHCHY KAKAO POROSHOK" and "99.98% KAKAO PRODUKTOV" means "real cocoa powder" and "99.98% cocoa products". Applicant has applied to register the mark for cocoa powder. Thus, the wording is merely descriptive because it informs consumers that the cocoa powder is made from 99.98 percent cocoa and that it is real powder.

Applicant must provide a disclaimer of the un-registrable parts of the applied-for mark even though the mark as a whole appears to be registrable. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). A disclaimer of an un-registrable part of a mark will not affect the mark's appearance. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 979-80, 144 USPQ 433, 433 (C.C.P.A. 1965).

Applicant may respond to this issue by submitting a disclaimer in the following format:

**No claim is made to the exclusive right to use the non-Latin characters that transliterate to “NASTOYASHCHY KAKAO POROSHOK”, “99.98 KAKAO PRODUKTOV”, and “KONDITERSKAYA FABRIKA 1905” apart from the mark as shown.**

For an overview of disclaimers and instructions on how to satisfy this issue using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

### **MARK DESCRIPTION REQUIREMENT**

Applicant must submit a description of the mark, because one was not included in the application. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies all the literal and design elements. *See* 37 C.F.R. §2.37; TMEP §§808.01, 808.02, 808.03(b). In this case, the drawing of the mark is not in standard characters.

The following description is suggested, if accurate: **The mark consists of the non-Latin characters in brown that transliterate to “NASTOYASHCHY KAKAO-POROSHOK KOMMUNARKA 99,98% KAKAO-PRODUKTOV” against a white rectangular background, with a small ornamental design in brown, red and white carrying the non-Latin characters that transliterate to “KONDITERSKAYA ABRIKA KOMMUNARKA 1905” all set against a gray and brown background with a green square at the top of the mark.**

### **MARK DRAWING REQUIREMENT**

The drawing is not acceptable because it will not create a high quality image when reproduced. *See* TMEP §807.04(a). Specifically, the drawing is blurry and the wording at the bottom of the drawing is difficult to read. A clear drawing of the mark is an application requirement. 37 C.F.R. §2.52.

Therefore, applicant must submit a new drawing showing a clear depiction of the mark. All lines must be clean, sharp and solid, and not fine or crowded. 37 C.F.R. §§2.53(c), 2.54(e); TMEP §§807.05(c), 807.06(a). Additionally, the USPTO will not accept a new drawing in which there are amendments or changes that would materially alter the applied-for mark. 37 C.F.R. §2.72; *see* TMEP §§807.13 *et seq.*, 807.14 *et seq.*

For more information about drawings and instructions on how to submit a drawing, see the [Drawing webpage](#).

### **TRANSLATION REQUIREMENT**

To permit proper examination of the application, applicant must submit a transliteration (a phonetic spelling of the pronunciation, in Latin characters) of the non-Latin characters in the mark, with either an English translation of the corresponding non-English transliterated wording or a statement that the transliterated term has no meaning in a foreign language. *See* 37 C.F.R. §§2.32(a)(10), 2.61(b); TMEP §809.

If the transliterated wording has an English translation, applicant should use the following format, if accurate: **The non-Latin characters in the mark transliterate to “Nastoyashchy Kakao-poroshok Kommyhapka 99,98% Kakao-Produktov, Konditerskaya Fabrika Kommyhapka 1905” and this means “Real Cocoa Powder Communard, 99,98% Cocoa-Products Confectionery Factory Communard 1905” in English.** TMEP §809.03.

### **RESPONSE GUIDELINES**

For this application to proceed further, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see [“Responding to Office Actions”](#) and the informational video [“Response to Office Action”](#) for more information and tips on responding.

**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>.

/Marcya Betts/  
Examining Attorney  
Law Office 106  
(571) 272-4913  
[Marcya.Betts@uspto.gov](mailto:Marcya.Betts@uspto.gov)

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**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](mailto: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>.



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The Usage Panel is a group of nearly 200 prominent scholars, creative writers, journalists, diplomats, and others in occupations requiring mastery of language. Annual surveys have gauged the acceptability of

## con·fec·tion·ary (kən-fĕk shə-nĕr'ē)

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n. pl. **con·fec·tion·ar·ies**

1. A confectioner's shop; a confectionery.
2. **Sweet preparations;** confections.
3. Obsolete A confectioner.

**con·fec tion·ar'y** *adj.*

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## fac-to-ry (făk tō-rē)

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n. pl. **fac-to-ries**

1.
  - a. A building or group of buildings in which goods are manufactured; a plant.
  - b. See **factory ship**.
2. A business establishment for commercial agents or factors in a foreign country.
3. The source of prolific production: a rock group that was a hit-tune factory; a motel that served as an illegal drug factory.

[Late Latin *factōria*, oil press, mill, and Medieval Latin *factōria*, establishment for factors, both from Latin *factor*, factor; see **FACTOR**.]

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какао-продуктов
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Поиск

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общ. cocoa products (Международное соглашение по какао 2010 *ABelonogov*)

какао-продуктов: 7 фраз в 4 тематиках

Макаров	3
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3

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Translation of Kakao-poroshok



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какао-порошок

Поиск Eng

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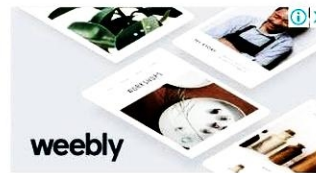
кул. coco powder (*Yu kovali*)  
пищ. cocoa solids (*@ndreas*)  
рекл. cocoa powder

какао-порошок: 39 фраз в 6 тематиках

Кулинария	3	Реклама	1
Макаров	23	Таможенная деятельность	2
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Eng

**кондитерская фабрика**

**общ.** confectionary; confectionery factory (max UK hits *Alexander Demidov*); confectionery works (more UK hits *Alexander Demidov*); pastry factory (more common than "confectionery" in the US, I believe *Liv Bliss*); candy factory (*Вадим Александров*)

**Макаров** confectionery plant; confectionery producing plant

**тех.** confectionary producing plant; confectionery; confectionary plant

кондитерская фабрика: 9 фраз в 3 тематиках

Макаров	3	Техника	3
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*ист.* Communist  
*фр.* communard

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