

**United States Patent and Trademark Office (USPTO)**  
**Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 79265015

Mark:

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**Applicant:** FERRERO S.P.A.

**Reference/Docket No. N/A**

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**NONFINAL OFFICE ACTION**

**International Registration No. 1482068**

**Notice of Provisional Full Refusal**

**Deadline for responding.** The USPTO must receive applicant's response **within six months of the "date on which the notification was sent to WIPO (mailing date)"** located on the WIPO cover letter, or the U.S. application will be abandoned. To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database, select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Discussion of provisional full refusal.** This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). *See* 15 U.S.C. §§1141f(a), 1141h(c).

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.

**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**

- Inquiry regarding individual in portrait
- Identification of goods requirement
- Description of the mark required
- Amended color claim required
- U.S. counsel required

**INQUIRY REGARDING INDIVIDUAL IN PORTRAIT**

Applicant must clarify whether the portrait of boy in the mark identifies a particular living individual. *See* 37 C.F.R. §2.61(b); TMEP §§813, 1206.03. In this case, the application neither specifies whether the portrait in the mark identifies a particular living individual nor includes a written consent. *See* TMEP §§813.01(a)-(b), 1206.04(a), 1206.05.

To register a mark that consists of or comprises a portrait or likeness of a particular living individual, an applicant must provide a written consent personally signed by the shown individual. 15 U.S.C. §1052(c); TMEP §§813, 1206.04(a).

**Accordingly, if the portrait or likeness in the mark does not identify a particular living individual**, applicant must submit a statement to that effect (e.g., "The portrait or likeness shown in the mark does not identify a particular living individual.").

**However, if the portrait or likeness in the mark does identify a particular living individual**, applicant must submit both of the following:

- (1) The following **statement**: “The portrait(s) or likeness(es) shown in the mark identifies a living individual(s) whose consent(s) to register is made of record.”
- (2) A **written consent**, personally signed by the pictured individual(s), as follows: “I, <specify name>, consent to the use and registration of my likeness as a trademark and/or service mark with the USPTO.”

Please note that the question of who should sign the consent depends on state or national law. If the minor can validly enter into binding legal obligations, and can sue or be sued, in the state or country in which he or she is domiciled, then the minor may sign the consent. Otherwise, the consent should be signed by a parent or legal guardian, clearly setting forth his or her status as a parent or legal guardian. See TMEP 1206.04(a).

For an overview of the requirements pertaining to portraits or likenesses appearing in marks, and instructions on how to satisfy this requirement online using the Trademark Electronic Application System (TEAS) response form, please go to <http://www.uspto.gov/trademarks/law/consent.jsp>.

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.

## **IDENTIFICATION OF GOODS**

The identification of goods is indefinite and must be clarified because “confectionery” and “chocolate based products” lack the specificity required by the Office. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. The USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and/or services covered by a mark. *In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A.*, 109 USPQ2d 1593, 1597 (TTAB 2014) (citing *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods and/or services in a U.S. application to be specific, definite, clear, accurate, and concise. TMEP §1402.01; see *In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A.*, 109 USPQ2d at 1597-98; *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm’r Pats. 1954).

Specifically, applicant must indicate the type of confectionery (e.g., confectionery made of sugar or frozen confectionery) and specify the type of “chocolate products.” In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. TMEP §1402.03(a); see 37 C.F.R. §2.32(a)(6). If applicant uses indefinite words such as “apparatus,” “components,” “devices,” “materials,” or “parts,” such wording must be followed by “namely,” and a list of each specific product identified by its common commercial or generic name. See TMEP §§1401.05(d), 1402.03(a).

### **Suggested Amendments**

Suggested amendments appear below in bold, explanatory information appears in brackets and should not be part of the identification, and matter to be deleted, if any, is struck through. Please note that these suggestions are illustrative and not exhaustive. Applicant should refer to the Identification Manual referenced below for further guidance and suggestions of acceptable identifications.

Applicant may adopt the following identification, if accurate:

Class 030: Pastries; confectionery **made of sugar**; cocoa; chocolate; chocolate based products, **namely, [specify products, e.g., chocolate confections, chocolate cakes, chocolate candies]**; ice cream

### **Advisory**

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.

## **DESCRIPTION OF THE MARK REQUIRED**

Although applicant submitted a drawing showing the mark in color with a color claim, applicant did not provide the required description that specifies where each color appears in the literal and design elements in the mark. See 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §807.07(a)-(a)(ii). Therefore, applicant must provide this description. See TMEP §807.07(a)(ii).

Generic color names must be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP §807.07(a)(i)-(ii). If black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark, applicant must so specify in the description. See TMEP §807.07(d).

The following description is suggested, if accurate: “**The mark consists of a rectangular design with a faint grey border. At the bottom of the design is a white and blue wavy line that separates a red-orange background below from a white background above. Two white and blue droplets appear below this line on the red-orange background. On the left of the design is a grey outlined glass with white milk. A yellow**

and green flower is next to the glass. A dark brown and light brown candy bar in a red-orange and white wrapper that is partially unwrapped is next to the glass of milk. On the right of the design is partial view of a candy bar in a red-orange and white wrapper. Above the partial candy bar are the hands and head of a boy. The boy has brown hair, pink skin, and eyes in green, black, and white.”

#### AMENDED COLOR CLAIM REQUIRED

Applicant must provide an amended color claim that references all the colors in the drawing of the mark. See 37 C.F.R. §2.52(b)(1); TMEP §§807.07(a) *et seq.* Specifically, the following colors have been omitted: black and blue. 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.*

The following color claim is suggested: “The colors black, blue, red-orange, white, brown, pink, grey, yellow, and green are claimed as a feature of the mark.”

#### U.S. LICENSED COUNSEL REQUIRED

**Applicant must be represented by a U.S.-licensed attorney.** The application record indicates that applicant’s domicile is outside of the United States in Italy, but no attorney who is an active member in good standing of the bar of the highest court of a U.S. State or territory has been appointed to represent the applicant in this matter. All applicants whose permanent legal residence or principal place of business is not within the United States or its territories must be represented by a U.S.-licensed attorney at the USPTO. 37 C.F.R. §§2.2(o), 2.11(a). Thus, applicant is required to be represented by a U.S.-licensed attorney and must appoint one. 37 C.F.R. §2.11(a). This application will not proceed to registration without such appointment and representation. See *id.* See [Hiring a U.S.-licensed trademark attorney](#) for more information.

**To appoint or designate a U.S.-licensed attorney.** To appoint an attorney, applicant should (1) submit a completed Trademark Electronic Application System (TEAS) ~~Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative~~ form and (2) promptly notify the trademark examining attorney that this TEAS form was submitted. Alternatively, if applicant has already retained an attorney, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his other attorney information in the form and sign it as applicant’s attorney. See 37 C.F.R. §2.17(b)(1)(ii).

#### **GUIDANCE ON RESPONDING TO OFFICE ACTION**

**Response guidelines.** For this application to proceed, 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.

#### **INFORMATION REGARDING COMMUNICATIONS WITH TRADEMARK OFFICE**

Please call or email the assigned trademark examining attorney with questions about this Office action. Although the trademark examining attorney cannot provide legal advice or statements about applicant’s rights, the trademark examining attorney can provide applicant with additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06. Although the USPTO does not accept emails as responses to Office actions, emails can be used for informal communications and will be included in the application record. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

**How to respond.** [Click to file a response to this nonfinal Office action](#)

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#### **RESPONSE GUIDANCE**

- **Missing the response deadline to this letter will cause the application to abandon.** A response or notice of appeal must be received by the USPTO before **midnight Eastern Time** of the last day of the response period. TEAS and ESTIA maintenance or ~~unforeseen circumstances~~ could affect an applicant’s ability to timely respond.
- **Responses signed by an unauthorized party** are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with ~~legal authority to bind a juristic applicant~~. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.