

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

U.S. Application Serial No. 79279037

Mark: CBM GINSENG

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Reference/Docket No. N/A

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NONFINAL OFFICE ACTION

International Registration No. 1515221

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

SUMMARY OF ISSUES:

- Type of Mark Unclear – "Collective, Certificate, or Guarantee Mark"
- Legal Entity Clarification Requirement
- Disclaimer Requirement
- Mark Description Requirement
- Identification Requirement
- Attorney Requirement

TYPE OF MARK UNCLEAR - "COLLECTIVE, CERTIFICATE, OR GUARANTEE MARK"

Clarify type of mark being applied for – collective mark or certification mark. The international registration indicates the type of mark as a "collective, certificate, or guarantee mark." The USPTO does not register guarantee marks. Collective trademarks and collective service marks (collective marks) and certification marks are registrable; however, they are different types of marks with different application requirements. *See generally* 15 U.S.C. §1054; 37 C.F.R. §§2.44-2.45; TMEP §§1302-1303, 1306. Thus, to enable the application to be properly examined, applicant must clarify the type of mark it seeks to register. *See* 37 C.F.R. §2.61(b); TMEP §814. The application requirements for each type of mark are specified further below.

Difference between a collective mark and certification mark. A collective mark is used by the collective organization's members with their goods and/or services to identify and distinguish their goods and/or services from those of non-members. *See* TMEP §1303. A certification mark is used by authorized users with goods or services that possess certain characteristics or meet certain qualifications/standards established by a certifying organization. *See* TMEP §1306.06(a)-(b). Although both collective marks and certification marks are used by more than one party, only the users of collective marks are related to each other through membership in a collective group. TMEP §1306.06(a).

Application requirement for collective marks.

Verified statements. Applicant must submit certain statements (shown below) properly verified by affidavit or declaration under 37 C.F.R. §2.20. *See* 37 C.F.R. §§2.44(a)(4)(v), (b)(2), 2.193(e)(1); TMEP §§804.01(b), 1303.01(a)(v), (b)(ii).

Applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

How to provide these verified statements. After opening the correct TEAS form, answer "yes" to wizard question #9, and follow the instructions within the form for signing. The form will require two signatures: one in the "Declaration Signature" section and one in the "Response Signature" section.

Application requirements for certification marks.

Certification statement. Applicant must submit a certification statement specifying what the applicant will be certifying about the goods or services in the application. See 37 C.F.R. §2.45(a)(4)(v)(A); TMEP §1306.03(a). The certification statement should specify all the characteristics, standards, or other features of the goods and/or services that the mark is intended to certify. TMEP §1306.03(a). The characteristics or features that the mark is intended to certify should be explained in reasonable detail. Terms such as "quality," "mode of manufacture," or "excellence" should not be used without further explanation because they are too broad to accurately identify the characteristics or features intended to be certified. *Id.*

The following format is suggested:

The certification mark, as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify that the goods and/or services provided have {specify}.

Statement that applicant will not engage in production/marketing of the identified goods/services. Applicant must submit the following statement: "Applicant will not engage in the production or marketing of the goods and/or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods and/or services that meet the certification standards of the applicant." 37 C.F.R. §2.45(a)(4)(v)(A); TMEP §1306.03(c).

Verified statements. Applicant must submit certain statements (shown below) properly verified by affidavit or declaration under 37 C.F.R. §2.20. See 37 C.F.R. §§2.45(a)(4)(v)(B), (b)(2), 2.193(e)(1); TMEP §§804.01(b), 1306.02(a)(v), (b)(ii).

Applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date, and that to the best of the signatory's knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

How to provide the certification statement. After opening the correct TEAS form, answer "yes" to TEAS wizard question #3; under the "Additional Statement(s)" section, check the box next to "Miscellaneous Statement;" and enter the certification statement in the text box below.

How to provide the verified statement and the statement about not engaging in production/marketing of the goods/services. After opening the correct TEAS form, answer "yes" to wizard question #9, and follow the instructions within the form for signing. The form will require two signatures: one in the "Declaration Signature" section and one in the "Response Signature" section.

LEGAL ENTITY CLARIFICATION REQUIREMENT

The application identifies applicant as an "Association," which is not acceptable as an entity designation in the United States because there is no clear U.S. equivalent legal entity and the entity designation does not appear in Appendix D of the *Trademark Manual of Examining Procedure*. See TMEP §803.03(j). Applicant must indicate the U.S. equivalent of its legal entity or provide a description of the nature of the foreign entity. See 37 C.F.R. §§2.32(a)(3), 2.61(b); TMEP §803.03(j).

AMENDMENT TO TRANSLITERATION AND TRANSLATION

To permit proper examination of the application, applicant must submit both (1) an English translation of the foreign wording in the mark; and (2) a transliteration (a phonetic spelling of the pronunciation, in Latin characters) of any 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)(9)-(a)(10), 2.61(b); TMEP §809.

The applicant submitted the following transliteration: Chang bai shan ren shen. The applicant must submit a transliteration for each Chinese character separately.

The following format is acceptable for a translation and transliteration statement:

The non-Latin characters in the mark transliterate to "CHANG," "BAI," "SHAN," "REN," and "SHEN" and this translates to "LONG," "WHITE," "HILL," "PEOPLE," and "GINSENG". The combination of these terms means "CHANGBAI MOUNTAIN GINSENG."

TMEP §809.03.

DISCLAIMER REQUIREMENT

Applicant must disclaim the wording "GINSENG" because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or

use of applicant's goods and/or services. See 15 U.S.C. §1052(e)(1); *DuoProSS Meditech Corp. v. Invivo Med.Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a).

The attached evidence from the Merriam-Webster dictionary demonstrates that "GINSENG" is defined as "a Chinese perennial herb (Panax ginseng synonym P. schinseng of the family Araliaceae, the ginseng family) having five leaflets on each leaf, scarlet berries, and an aromatic root used in herbal medicine especially in eastern Asia." Thus, the wording merely describes applicant's goods because, as applicant's identification indicates, applicant provides "ginseng."

Additionally, as applicant indicates, the non-Latin characters translate to "CHANGBAI MOUNTAIN GINSENG". The attached evidence demonstrates that "CHANGBAI MOUNTAIN GINSENG" is a "traditional medicine commonly found in Northeast China and grows at elevations of 2000 m or higher in the Changbai Mountain Range." Thus, when consumers encounter this wording, in connection with applicant's goods, they will immediately understand that applicant provides this traditional medicine that grows in the Changbai Mountain Range. Accordingly, the non-Latin characters describe the goods.

Non-English wording that is merely descriptive, deceptively misdescriptive, geographically descriptive, generic, or informational in connection with the identified goods and/or services, is an unregistrable component of a mark that is subject to disclaimer. 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). The disclaimer must refer to the non-Latin characters and the transliteration (a phonetic spelling of the pronunciation, in Latin characters); e.g., "the non-Latin characters that transliterate to" CHANGBAI MOUNTAIN GINSENG". TMEP §1213.08(d).

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

No claim is made to the exclusive right to use "GINSENG" and the non-Latin characters that transliterate to "CHANGBAI MOUNTAIN GINSENG" apart from the mark as shown.

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

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); TMEP §1213.01(b).

MARK DESCRIPTION REQUIREMENT

Applicant must submit an amended description of the mark because the current one uses broad, vague language that does not accurately describe the mark. 37 C.F.R. §2.37; see TMEP §§808.01, 808.02. Descriptions must be accurate and identify all the literal and design elements in the mark. See 37 C.F.R. §2.37; TMEP §808.02. In this case, the description is vague because it does not clearly identify each aspect of the mark.

The following description is suggested, if accurate: **The mark consists of a black and white design that resembles clouds and lightning. Below the design are Chinese characters, and below the Chinese characters is the wording "CBM GINSENG".**

IDENTIFICATION REQUIREMENT

Applicant has identified the following goods:

International Class 5: Ginseng

The wording in the identification of goods is indefinite and must be clarified because it does not identify the specific type of ginseng that applicant provides. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: "Ginseng for medicinal use."

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.

ATTORNEY REQUIREMENT

Applicant must be represented by a U.S.-licensed attorney at the USPTO to respond to or appeal the provisional refusal. An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented at the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §§2.11(a), 11.14; *Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants & Registrants*, Examination Guide 4-19, at I.A. (Rev. Sept. 2019). An individual applicant's domicile is the place a person resides and intends to be the person's principal home. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. A juristic entity's domicile is the principal place of business; i.e., headquarters, where a juristic entity applicant's senior executives or officers ordinarily direct and control the entity's activities. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. Because applicant is foreign-domiciled, applicant must appoint such a U.S.-licensed attorney qualified to practice under 37 C.F.R. §11.14 as its representative before the application may proceed to registration. 37 C.F.R. §2.11(a). See [Hiring a U.S.-licensed trademark attorney](#) for more information.

Only a U.S.-licensed attorney can take action on an application on behalf of a foreign-domiciled applicant. 37 C.F.R. §2.11(a). Accordingly, the USPTO will not communicate further with applicant about the application beyond this Office action or permit applicant to make future submissions in this application. And applicant is not authorized to make amendments to the application.

To appoint or designate a U.S.-licensed attorney. To appoint an attorney, applicant should submit a completed Trademark Electronic Application System (TEAS) [Change Address or Representation](#) form. The newly-appointed attorney must submit a TEAS [Response to Examining Attorney Office Action](#) form indicating that an appointment of attorney has been made and address all other refusals or requirements in this action, if any. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii).

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 ESTT [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.



SINCE 1828

GAMES

BROWSE THESAURUS

WORD OF THE DAY

WORDS AT PLAY

LOG IN

REGISTER

SAVED WORDS

ginseng



DICTIONARY

THESAURUS

ginseng

noun

Save Word

gin·seng | \ ˈjin-,senj ˌ-,sɪŋ \

Definition of *ginseng*

- 1 **a** : a Chinese perennial herb (*Panax ginseng* synonym *P. schinseng* of the family Araliaceae, the ginseng family) having five leaflets on each leaf, scarlet berries, and an aromatic root used in herbal medicine especially in eastern Asia
 - b** : any of several plants related to ginseng
especially : a North American herb (*P. quinquefolius*)
- 2 : the root of a ginseng

WORD OF THE DAY

crwth

[See Definitions and Examples »](#)

Chemistry, Medicine · Published in *Molecules* 2017 · DOI: 10.3390/molecules22020237Share This Paper    

Changbai Mountain Ginseng (*Panax ginseng* C.A. Mey) Extract Supplementation Improves Exercise Performance and Energy Utilization and Decreases Fatigue-Associated Parameters in Mice

2

Twitter Mentions

Guo-Dong Ma, Chun-Hui Chiu, ¹ Chi-chang Huang

Changbai Mountain Ginseng (CMG, *Panax ginseng* C.A. Mey) is a traditional medicine commonly found in Northeast China and grows at elevations of 2000 m or higher in the Changbai Mountain Range. CMG, considered to be a "buried treasure medicine", is priced higher than other types of ginseng. However, few studies have demonstrated the effects of CMG supplementation on exercise performance, physical fatigue, and the biochemical profile. The major compound of CMG extract was characterized by...

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