

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

U.S. Application Serial No. 79306016

Mark: FIRE & ICE

**Correspondence Address:**

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RUSSIAN FED.

**Applicant:** F&I Beverages AG

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

**Correspondence Email Address:**

## NONFINAL OFFICE ACTION

**International Registration No.** 1579492

### 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 (see <https://www.uspto.gov/trademarks-application-process/abandoned-applications> for information on abandonment). To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database at <https://tsdr.uspto.gov/>, 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).

### INTRODUCTION

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 USPTO DATABASE OF MARKS

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

- **Configuration Mark – Drawing and Description Amendment Requirement**
- **Appointment of U.S. Legal Counsel Requirement**
- **Applicant E-mail Address Requirement**

### CONFIGURATION MARK – DRAWING AND DESCRIPTION AMENDMENT REQUIREMENT

#### Drawing Amendment

For marks consisting of a configuration of the goods or their packaging or a specific design feature of the goods or packaging, the drawing must depict a single three-dimensional view of the goods or packaging, showing in solid lines those features that applicant claims as its mark. See 37 C.F.R. §2.52(b)(2); TMEP §§807.10, 1202.02(c)(iv); *In re Minn. Mining & Mfg. Co.*, 335 F.2d 836, 839, 142 USPQ 366, 368-69 (C.C.P.A. 1964). If the mark cannot be adequately depicted in a single rendition, applicant must file a petition to the Director requesting that the requirement to provide a single rendition of the mark be waived. TMEP §807.10.

Additionally, the drawing of applicant's applied-for three-dimensional mark is not acceptable because it includes functional elements depicted in solid lines rather than broken or dotted lines. See TMEP §1202.02(c)(i)(A). Elements of a mark that are functional are required to be shown in broken or dotted lines. See 37 C.F.R. §2.52(b)(4); *In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980); *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1379-80 (TTAB 2015); TMEP §1202.02(c)(i)(A).

“Functional matter cannot be protected as a trademark.” TMEP §1202.02(a)(iii)(A); *see* 15 U.S.C. §§1052(e)(5), (f), 1091(c), 1064(3), 1115(b)(8). A feature is functional as a matter of law if it is “essential to the use or purpose of the [product]” or “it affects the cost or quality of the [product].” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); TMEP §1202.02(a)(iii)(A).

In the present case, the following elements serve a functional purpose: (1) the shape of the bottle and (2) the shape of the seal. The attached evidence shows that these shapes are commonly used in the industry to package alcoholic beverages, such as those associated with applicant’s mark—e.g. vodka. *See attached Internet evidence of several alcoholic beverages packaged in tall curved bottles with beveled necks and seal bands.* The frequency with which these elements appear in the industry suggests that the shape serves a utilitarian advantage. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982); TMEP §1202.02(a)(v).

For instance, the attached article “Why Your Favorite Booze Bottles Are Shaped the Way They Are. And Why You Should Care” touts the utilitarian advantages of bottles similar to applicant’s—e.g. “If the bottle has a gentle curve in the body that makes it easy to grab off high shelves . . . [T]he beveled neck allows your fingers a resting point to grab and invert the bottles without fumbling it.” *See attached article for additional information.* Moreover, seal bands are frequently used in the food and beverage industry to protect against tampering. *See attached article from Traco Packaging discussing tamper-evident seal bands.*

Therefore, applicant must provide (1) a new drawing of the mark showing the functional elements in broken or dotted lines, and (2) an amended mark description that references the matter in broken or dotted lines and indicates such matter is not claimed as part of the mark. *See* TMEP §1202.02(c)(i)(A), (c)(ii). Applicant must provide the amended drawing regardless of whether the remaining portions of the mark are determined to be registrable. TMEP §1202.02(c)(i)(A).

### **Mark Description Amendment**

As noted above, applicant has applied for a three-dimensional mark; however, applicant did not include a sufficient description of the mark in the application.

The following mark description format is suggested, if accurate:

**The mark consists of a three-dimensional configuration of a bottle with the outline of the bottle and seal band in broken lines used only to show placement of the mark and the shape of the bottle and seal band are not claimed as feature of the mark. The body of the bottle is white and features the wording “FIRE & ICE” with “FIRE” and “ICE” in dark blue stylized font, and the “&” in red stylized font. Above the wording “FIRE & ICE” is the imagery of a mountain landscape with three snow-capped peaks in shades of white and dark blue, a glacier lake in dark blue, with the reflection of the three peaks in white in the water; and hills with snow in shades of white and dark blue at the base of the lake and two birds in dark blue flying above the mountains. The seal band of the bottle is in dark blue and also features the wording “FIRE & ICE” with “FIRE” and “ICE” in white stylized font and the “&” in red stylized font printed along the bottom edge and beneath a single white line piping the circumference of the seal band and white zigzag formations above the line depicting the peaks of snow-capped mountains.**

*See* TMEP §1202.02(c)(ii).

### **Advisory – Nondistinctive Configuration of Packaging**

Applicant is advised that if applicant does not amend the drawing to remove the nondistinctive and functional elements, registration may be refused on the ground that the applied-for mark is a nondistinctive configuration of packaging for the goods that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593 (C.C.P.A. 1967); *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138 (C.C.P.A. 1960); *In re J. Kinderman & Sons, Inc.*, 46 USPQ2d 1253 (TTAB 1998); TMEP §1202.02(b)(ii), (d).

That said, amending the mark in line with the requirements outlined above will resolve this issue.

### **APPOINTMENT OF U.S. LEGAL COUNSEL REQUIREMENT**

An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented 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 at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-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.

To appoint an attorney, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at <https://teas.uspto.gov/www/cor/car>. The newly-appointed attorney must submit a TEAS Response to Examining Attorney Office Action form at

<https://teas.uspto.gov/office/roa/> 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).

### **APPLICANT EMAIL ADDRESS REQUIREMENT**

Applicant must provide applicant's email address, which is a requirement for a complete application. See 37 C.F.R. §2.32(a)(2); *Mandatory Electronic Filing & Specimen Requirements*, Examination Guide 1-20, at III.A. (Rev. Feb. 2020). Applicant's email address cannot be identical to the listed primary correspondence email address of any attorney retained to represent applicant in this application. See Examination Guide 1-20, at III.A.

### **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.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are 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 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.



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## Why Your Favorite Booze Bottles Are Shaped the Way They Are. And Why You Should Care.



Written by Brad Japhe | Published 08/07/17



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Premium Beat

<https://www.liquor.com/articles/bottle-shape/>





Image: monticello

The bottle your booze comes in is so much more than mere receptacle. Often, it represents a stunning piece of ornamentation, bordering on art. But its most important aspect might be how it interacts with the hand. After all, a bottle's primary purpose is to be held and poured.

If you've never considered this, well, you've probably never been a bartender. It turns out there are good reasons for why your favorite flagons are shaped the way they are.

"If the bottle has a gentle curve in the body, that makes it easy to grab off high shelves," says Joel Caruso of Pizzeria Ortica, in Costa Mesa, California. "If you have it in your well, the beveled neck allows your fingers a resting point to grab and invert the bottles without fumbling it. To have the bottle balanced on the back of your hand, between your fingers, getting eye level to the pour, is one of the most natural feelings you can get behind the bar."



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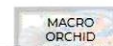


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More rounded shapes are commonplace in the categories of rum, whiskey and, particularly, cognac, where showmanship is a hallmark. Hennessy's iconic X.O bottle is frequently a centerpiece behind the bar. When inverted during the pour, it's meant to evoke a cluster of grapes.

"Most recently, [we] released a limited-edition bottle, featuring a unique design that includes striations and an overall corrugated relief, reimagining the grapes and vine in a progressive style," says Maurice Hennessy, an eighth-generation member of the first family of cognac.



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Hennessy, an eighth-generation member of the first family of cognac. The new elements regard practicality with the same reverence as presentation.



Still, you won't find too many bartenders working speed pours with expensive cognac. When it comes to pure efficiency, neck design is paramount, meaning that some bartender favorites are hardly what you'd expect.

"Bacardi Carta Blanca, for me, is the best," according to Aki Wang, of Taipei's award-winning Indulge Experimental Bistro. "The shape, size and weight are all reasonable, and the height of the neck makes it quite comfortable to hold."





## Belvedere Vodka

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Craving, made with triple distilled vodka and made with natural flavors, our line up includes berries, citrus, indulgent, tropical, and classic fruity. Simply mix with soda or add to your favorite cocktail to enjoy the clean, refreshing taste of Smirnoff.

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## Tamper-Evident Bands for Maximum Safety



## Tamper-Evident Bands for Maximum Safety

One of the most popular trends in packaging today is the use of tamper-evident neck bands. Manufacturers use them most commonly in pharmaceutical, food and beverage products, and heat shrinkable tamper-evident seals offer several benefits. Let's look at some of the top reasons why tamper-evident bands continue to be a foundation in packaging methods.

### Security

Tamper-evident seals firstly serve as a way of protecting consumer safety. Tamper-evident banding is a requirement for many products, especially pharmaceutical because it greatly increases the integrity of a product. This came about initially because of multiple incidents in Chicago, Illinois, in 1982, where bottles of the brand pain reliever, Tylenol, had been tampered with cyanide. Seven people died as a result of the tampering. Later, additional "copy-cat" attacks in other places in the United States expedited manufacturers efforts to protect their products and the consumers. Johnson & Johnson, owner of Tylenol, reintroduced capsules in a new, triple-sealed package which included a sealed heat shrink band around the neck. Banding prevents opening of the product without detection since it can't be resealed once it's open. This means the product remains untouched since production or bottled without contamination. The incidents inspired the pharmaceutical, food, and other consumer product industries to develop tamper-resistant packaging and improved quality control methods.

### Consumer Confidence

If tamper-evident seals enhance consumer safety, then seeing these bands will make products more appealing to consumers at the point of purchase. Customers want to know that a product is sterile and untouched. This tamper-evident banding gives them a peace of mind, especially when choosing between brands. Unlike an inner seal hidden by a cap, the consumer can immediately tell by a neck band if the product has been opened or not. Consumers can rest assured that the product they are choosing hasn't been touch or tampered with since it was packaged.

### Packaging Enhancement

Another way that tamper-evident bands help improve products is by helping to secure the lid of the package to its container. This additionally helps maintain freshness or to prevent accidental mishaps in which the lid separates from the



Another way that tamper-evident bands help improve products is by helping to secure the lid of the package to its container. This additionally helps maintain freshness or to prevent accidental mishaps in which the lid separates from the container. Tamper-evident seals can also extend down the neck of bottles where it will hide the fill line. Fill line coverage compensates for the differences in liquid filling machines and container volumes, especially glass. Product brands don't want to give consumers the idea that bottles can be "under filled" due to variability. Other enhancements on the neck band include surface area for graphics and marketing design elements such as colors and logos, increasing package appeal.



## Why Should I Use Tamper-Evident Packaging?

You sell your products to generate revenue for your company, so the safety of your products for the consumer is important to the life of your brand. Your product must survive shipping from your facility to being placed on the shelf, and then after placement, many different people will potentially handle the package. This makes safety a priority. During shipment, tamper-evident seals will help keep your package from opening, reducing the chance of damaged goods. On the shelf, having a durable, safely sealed package is also one of many appeals to consumers. A tamper-evident seal shows that a manufacturer cares for the safety of those who buy their products which will in turn build consumer confidence and loyalty.



As mentioned earlier in the case from Chicago, if someone intends to harm others and targets your products, a tamper-evident package will help stop a similar tragedy from occurring again and keep your products from being compromised.

## Traco Packaging Manufactures Tamper-Evident Bands

If you need tamper-evident bands, Traco Packaging can help you. Try a sample to ensure exact fit—no surprises! Enjoy the largest selection of sizes in the industry coupled with quick response time for custom runs, rush orders, or just-in-time deliveries. Custom manufactured to meet the most stringent customer specifications. Tolerances meet or exceed all industry standards.

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By Traco Marketing | September 23rd, 2019 | Article, Packaging | 0 Comments