

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

U.S. Application Serial No. 79310888

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Reference/Docket No. N/A

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NONFINAL OFFICE ACTION

International Registration No. 1591317

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).

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 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:

- Clarification of Mark, Description, and Color Claim Required
- Clarification of Position of Mark Required
- Identification of Goods Requirement
- Email Address Required
- U.S.-Licensed Counsel Required

CLARIFICATION OF MARK, DESCRIPTION, AND COLOR CLAIM REQUIRED

The drawing shows a realistic depiction of an object; however it is not clear from the record whether applicant is applying for (1) a two-dimensional design mark that is not trade dress; or (2) a three-dimensional mark that is trade dress for product design (i.e., the configuration or shape of the goods themselves), product packaging (i.e., the container in which the goods are sold), or a specific design feature of the product design or packaging. Thus, applicant must clarify whether the applied-for mark is intended to be a two-dimensional design or a three-dimensional configuration mark. See 37 C.F.R. §2.61(b); TMEP §1202.02(c)(i)-(c)(ii).

If applicant is applying for a two-dimensional design mark, applicant must clarify so for the record, and may amend the description accordingly. See 37 C.F.R. §2.61(b); TMEP §1202.02(c)(i)-(c)(ii).

If applicant is applying for a three-dimensional configuration mark that is trade dress, applicant must amend the description to provide a clear and concise description of the mark that does the following:

- (1) Indicates the mark is a three-dimensional configuration of the product design or packaging, or of a specific design feature of the product design or packaging.
- (2) Specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark.
- (3) Specifies any elements that are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.

See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii).

Applicant has applied for a three-dimensional mark; however, applicant did not include a description of the mark and a color claim in the application. Therefore, applicant must provide a clear, concise, and complete description of the mark that does the following:

- (1) Indicates the mark is a three-dimensional configuration of the goods or packaging or of a specific design feature of the goods or packaging.
- (2) Specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark.
- (3) Specifies any elements that are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.

See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii).

The following is suggested:

The color(s) blue, gold and white is/are claimed as a feature of the mark.

The mark consists of a three-dimensional configuration comprising a vertical blue box with a light blue plain-line patterned design of swifts covering the surface of the packaging, with the white stylized wording “MARTEL” on a dark blue rectangle in the center of the front of the packaging beneath a gold design of a swift in flight facing right. The broken lines in the drawing indicate the placement of the mark on the packaging for the goods. The shape of the box is not claimed as a feature of the mark.

CLARIFICATION OF POSITION OF MARK REQUIRED

Applicant must depict the mark in the drawing to include broken or dotted lines to show the position of the mark on the goods or container. 37 C.F.R. §2.52(b)(4); TMEP §§807.08, 1202.02(c)(i). Applicant must show the mark itself using solid lines. See 37 C.F.R. §§2.52(c), 2.54(e); TMEP §§807.05(c), 807.06(a).

In addition to these drawing requirements, applicant must also submit a clear and concise description of the mark that does the following:

- (1) Indicates the mark is a three-dimensional configuration of the goods or packaging or of a specific design feature of the goods or packaging.
- (2) Specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark.
- (3) Specifies any elements that are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.

See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii).

IDENTIFICATION OF GOODS REQUIREMENT

The following requirement is limited to the specified goods therein.

The identification requires clarification as indicated below. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

The identification of goods contains parentheses. 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 that have been deleted from registrations or in an affidavit of incontestability to indicate goods 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 parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods.

In addition to the above-referenced issues, if applicable, the following wording in the identification of goods for International Class 33 is indefinite because the nature or purpose of the goods must be further specified:

- Alcoholic beverages (with the exception of beers)

See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Suggested amendments to each of the above entries are included below.

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods from that assigned by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, although the goods above may be classified in several international classes, any modification to this wording must identify goods in International Class 33 only, the class specified in the application for these goods. See TMEP §1904.02(c), (c)(ii). Further, although applicant has identified additional classes, in a multiple-class Section 66(a) application, goods may not be transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Applicant may substitute the following wording, if accurate:

Class 33: Alcoholic beverages **except beers** ~~(with the exception of beers)~~

Wording in **bold text** indicates additions. Wording in **bold text**, *in italics*, and *{in brackets}* indicates that applicant must provide additional information. Deleted text is **in bold**, *in italics*, and ~~struck-through~~.

Applicant may amend the identification to clarify or limit the goods and services, but not to broaden or expand the goods and 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 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 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 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.

EMAIL ADDRESS REQUIRED

Applicant must provide applicant's email address, which is a requirement for a complete application. See 37 C.F.R. §2.32(a)(2); TMEP §803.05(b). This email address cannot be identical to the primary correspondence email address of a U.S.-licensed attorney retained to represent applicant in this application. See TMEP §803.05(b).

U.S.-LICENSED COUNSEL REQUIRED

Applicant is required to be represented by a U.S.-licensed attorney to respond to or appeal the provisional refusal because applicant's domicile is located outside of the United States and applicant does not appear to be represented by a qualified U.S. attorney. 37 C.F.R. §2.11(a); TMEP §601.01(a). An applicant whose domicile is located outside of the United States or its territories 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); TMEP §§601, 601.01(a). In this case, applicant's domicile is identified in the application as France. For more information, see the U.S. Counsel webpage at <https://www.uspto.gov/trademark/laws-regulations/trademark-rule-requires-foreign-applicants-and-registrants-have-us> and Hiring a U.S.-licensed trademark attorney webpage at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney>.

To appoint a U.S.-licensed attorney in this application, 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. 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); TMEP §604.01.

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 ESTTAmaintenance 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.