



Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
[www.uspto.gov](http://www.uspto.gov)

U.S. Application Serial No.: 79/004224  
International Registration No.: 0755909

Attached is a PROVISIONAL FULL REFUSAL Office action that applies to all the goods and/or services in the U.S. application identified above application identified above: 15 U.S.C. §1141h(c).

The identification of goods requirement, entity and citizenship clarification and likelihood of confusion refusal applies to all the goods and/or services in the application and therefore comprise a provisional full refusal of the entire application.

**RESPONSE DUE:**

A response to this provisional refusal is due within six (6) months from the mailing date of the Office action, i.e., within six months from 4 January 2005.

**APPLICANT OR ATTORNEY CAN RESPOND TO PROVISIONAL REFUSAL:**

Applicant can respond directly to this provisional refusal Office action, or applicant can hire an attorney to represent itself before the Office and that attorney can respond on applicant's behalf. The Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

NOTE: Attorneys hired to represent an applicant in a trademark matter before the Office must be eligible under 37 C.F.R. §10.14:

*Attorneys residing in the United States* who are in good standing with the bar of any United States court or the highest court of any state, may practice before the Office in trademark matters.  
*A foreign attorney not residing in the United States* who is in good standing before the patent or trademark office of the country in which he or she resides, may practice before the Office in trademark matters only in cases where the patent and trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the Office. Currently, Canadian attorneys are the only foreign attorneys recognized as meeting this criterion. A foreign attorney who meets the requirements of 37 C.F.R. §10.14(c) can only represent parties located in the country in which the foreign attorney resides and practices. TMEP §602.

Please note that non-attorneys are not permitted to practice before the Office except under the very limited circumstances specified in 37 C.F.R. §10.14(b).

Pages enclosed - 7

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 79/004224

JAN 4 2005

**APPLICANT:** Lidl Stiftung & Co. KG

**CORRESPONDENT ADDRESS:**  
Hansmann & Vogeser,  
Patent- und Rechtsanwälte  
Albert-Roßhaupter-Strasse 65  
D-81369 München FED REP GERMANY



**RETURN ADDRESS:**  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:** GOLDPRINCE

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

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

Serial Number 79/004224.

The assigned trademark examining attorney has reviewed the referenced application filed on August 26, 2004, and has determined the following.

**LIKELIHOOD OF CONFUSION**

The examining attorney refuses registration under the Trademark Act, Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods so resembles the mark in U.S. Registration No. 2768938 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP, Sections 1207.01 et seq. (Please see attached registration.)

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion between the applicant's mark and a registered mark. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP Sections 1207.01 et seq.

Applicant has applied to register the mark "GOLDPRINCE." The registered mark is "PRINCE" and design. The marks contain the wording "PRINCE." In this respect, the applicant's mark and that of the registrant are highly similar. Applicant has merely added the laudatory wording "GOLD" and deleted the design from the registered mark of "PRINCE" and design. The mere addition or deletion of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"). TMEP Section 1207.01(b)(iii)

The word GOLD is defined as: Something regarded as having great value or goodness.[1] Laudatory terms, those which attribute quality or excellence to goods or services, are equivalent to other descriptive terms under Trademark Act Section 2(c)(1), 15 U.S.C. Section 1052(c)(1). Combined with the word PRINCE, it would appear that goods bearing the mark "GOLDPRINCE" is from the same source as "PRINCE," but of a higher quality.

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The applicant's goods are identified as "tobacco products." The goods named in the registration comprise "cigarettes." Both marks are used to identify tobacco products. Likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Since the identification of the applicant's goods and/or services is very broad, it is presumed that the application encompasses all goods and/or services of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. TMEP §1207.01(a)(iii).

The same consumers will be exposed to the goods identified with both marks. The similarities among the marks and the goods of the parties are so great as to create a likelihood of confusion.

Accordingly, in view of the highly similar nature of the goods of the parties and the strong similarity of the marks and their commercial impressions, confusion as to the source of the goods is likely under Section 2(d) of the Trademark Act.

#### APPLICANT MAY RESPOND

Although the examining attorney has refused registration, the applicant may respond to the refusal to

register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

### **PRIORITY DATE**

Applicant has claimed a right of priority within the meaning of Article 4 of the Paris Convention. The date of international registration or the date of the recordal of the subsequent designation requesting an extension of protection to the United States (June 18, 2004), however, is later than 6 months after the date of the first regular national filing (January 26, 2001), therefore the priority is invalid. Section 67 of the Trademark Act, 15 U.S.C. §1141g; Madrid Protocol Article 4(2).

### **LEGAL NATURE, LEGAL NATURE: PLACE INCORPORATED OMITTED**

Applicant must specify its entity type and citizenship. For example, an applicant can apply as an individual, a partnership, a corporation or a joint venture. 37 C.F.R. §2.32(a)(3); TMEP §§802.03 *et seq.* If applicant is an individual, then applicant must indicate his or her national citizenship for the record. 37 C.F.R. §2.32(a)(3)(i). If applicant is a corporation or association, then applicant must set forth the U.S. state or country (for foreign applicants only) under whose laws applicant is organized. 37 C.F.R. §2.32(a)(3)(ii). If applicant is a partnership or joint venture, then applicant must list the names and the national citizenship or the U.S. state or country (for foreign applicants only) of organization or incorporation of all the general partners or joint venturers, as well as specify the state or country under whose laws the partnership or joint venture is organized. 37 C.F.R. §§2.32(a)(3)(ii) and (iii).

### **IDENTIFICATION OF GOODS**

The identification of goods is unacceptable as indefinite. The applicant must amend the identification to specify and list out the common commercial name of the tobacco products, e.g., cigars, cigarettes, chewing tobacco, etc.... If there is no common commercial name, the applicant must describe the product and its intended uses. TMEP §1402.01. The applicant may wish to consult the on-line identification manual on the USPTO homepage for acceptable common names of goods and services; and classification therefor. <http://www.uspto.gov/web/offices/tac/doc/gsmmanual/>

The applicant may amend to adopt the following if accurate:

"Tobacco products, namely, \_\_\_\_\_ (*specify common commercial name of goods*).” International class 034

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

### **NOTICE: TRADEMARK OPERATION RELOCATION**

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

**Commissioner for Trademarks**

**P.O. Box 1451  
Alexandria, VA 22313-1451**

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at <http://www.uspto.gov/teas/index.html>.

/gy/  
Gretta Yao  
Attorney  
United States Patent and Trademark Office  
Law Office 105  
571-272-9313

**How to respond to this Office Action:**

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm> and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) **CANNOT** currently be filed via TEAS.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

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[1]The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

**Print: Dec 23, 2004**

**76423653**

**DESIGN MARK**

**Serial Number**

76423653

**Status**

REGISTERED

**Word Mark**

PRINCE

**Standard Character Mark**

No

**Registration Number**

2768938

**Date Registered**

2003/09/30

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

House of Prince A/S CORPORATION DENMARK Tobaksvejen 4 2860 Soborg  
DENMARK

**Goods/Services**

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S:  
cigarettes.

**Foreign Country Name**

DENMARK

**Foreign Priority**

FOREIGN PRIORITY CLAIMED

**Foreign Application Number**

VA200200360

**Foreign Filing Date**

2002/01/28

**Foreign Registration Number**

VR200201015

**Print: Dec 23, 2004**

**76423653**

**Foreign Registration Date**

2002/03/21

**Foreign Expiration Date**

2012/03/21

**Lining/Stippling Statement**

The stippling shown in the drawing is intended to indicate shading and is not a feature of the mark.

**Description of Mark**

The mark consists of the word "PRINCE" between a crown and shaded band. Beneath the band appears a leaf design above a second crown and the word "PRINCE".

**Filing Date**

2002/06/20

**Examining Attorney**

FLETCHER, TRACY

**Attorney of Record**

MARY A. MOY



# PRINCE



OF  
PRINCE