



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

U.S. Application Serial No.: 79/008520  
International Registration No.: 0842268

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 translation/transliteration of the mark, color description of the mark and disclaimer requirements, and entity and citizenship clarification 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 April 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 - 4

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 79/008520

**APPLICANT:** Obchtschestvo s ogranitchennoi; otvetstv ETC.

**CORRESPONDENT ADDRESS:**

Obchtschestvo s ogranitchennoi  
otvetstvennoostiou "Marta-M"  
O.V. Shterz  
P.O. Box 242  
RU-630132 Novosibirsk RUSSIAN FED.

APR 4



**RETURN ADDRESS:**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:**

**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 79/008520

**INTERNATIONAL REGISTRATION NO. 0842268**

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. 15 U.S.C. §1141h(c).

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

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf.

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

- (1) *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.
- (2) *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.

The Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If applicant is not represented by an attorney, applicant may appoint a domestic representative who would receive correspondence from the Office and be served process or notice of proceedings affecting the application. 15 U.S.C. §1141h(d); 37 C.F.R. §2.24.

#### **THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:**

The assigned examining attorney has reviewed the referenced application and determined the following.

##### **Search Result**

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

##### **Entity/Citizenship Omitted**

The applicant must indicate what type of entity is applying, for example, an individual, partnership, corporation or joint venture. 37 C.F.R. §2.32(a)(3); TMEP §803.03 *et seq.* If the applicant is an individual, the applicant must indicate his or her national citizenship for the record. 37 C.F.R. §2.32(a)(3)(i). If the applicant is a corporation or association, the applicant must set forth the state or nation under whose laws the applicant is organized. 37 C.F.R. §2.32(a)(3)(ii). If the applicant is a partnership, the applicant must set forth the state or nation under whose laws the partnership is organized, and the names and citizenship of the general partners. 37 C.F.R. §§2.32(a)(3)(ii) and (iii). TMEP §803.04.

##### **Transliteration and Translation**

Applicant must submit a translation and transliteration of the non-Latin characters in the mark. 37 C.F.R. §2.61(b); TMEP §809. A transliteration is the phonetic spelling, in Latin characters, of the terms in the mark that are in non-Latin characters. The translation of KIRIECHKI appears to be omitted. The following format is suggested: "The non-Latin characters in the mark transliterate to "Sibirskii bereg, novye produkty pitaniia, sukhariki solenye, kiriechki, sukhariki, vypetchen po spetsialnomu retseptu, so vkusom bekona," and this means "Siberian shore, new food products, salted rusks, (INSERT TRANSLATION OF KIRIECHKI), rusks, cooked according to a special recipe, with a bacon taste." in English."

##### **Disclaimer**

The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office can refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g.,

generic). TMEP §1213.03(a). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

A “disclaimer” is thus a written statement that an applicant adds to the application record that states that applicant does not have exclusive rights, separate and apart from the entire mark, to particular wording and/or to a design aspect. The appearance of the applied-for mark does not change.

A disclaimer does *not* physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing.

Applicant must also insert a disclaimer of SIBIRSKII BEREG in the application because the words may be geographically descriptive or descriptive of the goods. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §1213. The words translate to “Siberian shore” and the rusks may derive or originate from the Siberian shores. In addition, the applicant must disclaim the pictorial representation of the rusks appearing in the drawing. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213, 1213.03(a) and 1213.03(c). The goods are rusks.

An accurate pictorial representation of descriptive matter is equivalent to the written expression and, therefore, must be disclaimed pursuant to the same rules applicable to merely descriptive wording. *See, e.g., Thistle Class Association v. Douglass & McLeod, Inc.*, 198 USPQ 504 (TTAB 1978) (thistle design found synonymous to the word “thistle,” which is used in a descriptive sense to designate a class of sailboats).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “SIBIRSKII BEREG” and the pictorial representation of rusks apart from the mark as shown.

*See In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

Please note that this disclaimer would be in addition to the words already disclaimed by the applicant submitted in the original application. The submitted disclaimer statement is accepted.

In addition, the applicant may be required to disclaim KIRIECHKI depending on the translation of the wording. If the wording is descriptive of the goods, the applicant must also disclaim the wording.

Please note that where the translation of non-English wording in the mark demonstrates that the wording is descriptive, deceptively misdescriptive, geographically descriptive, or generic in connection with the identified goods or services, then that wording comprises an unregistrable component of the mark and is subject to a proper disclaimer requirement in the same way that the English version would be subject to a disclaimer. TMEP §1213.08(d). The format for the disclaimer statement must refer to the actual non-English wording that appears in the mark, not the English translation of that wording. TMEP §1213.08(d).

### **Color Description**

Applicant must provide a description of where the colors appear in the mark. 37 C.F.R. §2.52(b)(1). The following description is suggested: “The colors red, white, blue, and brown appear in the words, the colors light red, pink, dark pink, and whitish-pink appear in the bacon design, the colors brown, light

brown, and dark brown appear in the pictorial representation of the rusks, the color dark red appears in the background color, and the color beige appears in the two geometrical designs.

Common color names should be used to describe the colors in the mark, e.g., red, yellow, blue. Exam Guide 01-03, section I.B.1.

#### **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>.

/Alex S. Keam/  
Attorney  
Law Office 114  
Phone: (571) 272-9176 or (703) 255-4823  
Fax for Responses: (571) 273-9114

#### **HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action issued via email you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

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

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending application can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

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