

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/013879

APPLICANT: Pivovar Stein, a.s.

79013879

CORRESPONDENT ADDRESS:

Mgr. Jaroslav Guniš
Dúbravská cesta 9
SK-840 05 Bratislava SLOVAKIA

RETURN ADDRESS:

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

MARK: STEIN 1873

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

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 79/013879

INTERNATIONAL REGISTRATION NO. 0857984

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 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

Print: Nov 1, 2005

78086030

DESIGN MARK

Serial Number
78086030

Status
REGISTERED

Word Mark
CIRKER'S ESTABLISHED 1873

Standard Character Mark
No

Registration Number
2582443

Date Registered
2002/08/18

Type of Mark
SERVICE MARK

Register
PRINCIPAL

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

Owner
Cicker's City Center Warehouses, Inc. CORPORATION NEW YORK 444 West
55th Street New York NEW YORK 10019

Goods/Services
Class Status -- ACTIVE. IC 039. US 100 105. G & S: Transportation
and storage services for others, namely, storing and packing goods of
others; transporting goods of others, namely, by moving vans. First
Use: 1999/01/01. First Use In Commerce: 1999/01/01.

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ESTABLISHED 1873"
APART FROM THE MARK AS SHOWN.

Filing Date
2001/08/28

Examining Attorney
DINALLIO, KEVIN

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 trademark examining attorney has reviewed the referenced application, and has determined the following.

Search Results

The Office records have been searched based on the information currently available to the Examining Attorney, 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. However, upon Applicant's response to the following requirements, new issues may arise.

The following requirement(s) must be addressed.

Description of Mark

Applicant must submit a concise description of the mark. 37 C.F.R. §2.37; TMEP §§808 *et seq.* The following is suggested:

The mark consists of a castle on a black background, surrounded by a fanciful border. The mark contains the following wording: "STEIN", "1873" and "{Applicant should state what the remainder of the wording consists of, namely, the wording which appears on either side of the number 1873. This wording is illegible in the mark.}"

Translation of Foreign Wording

Applicant must submit an English translation of all foreign wording in the mark. 37 C.F.R. §2.61(b); TMEP §809. In the present case, the wording which appears on either side of the number 1873 must be translated for the record. The Examining Attorney is unable to provide a suggestion for this translation, as the wording is illegible; however, the following format is suggested: "The English translation of the words "Stein" and {list the words which appears on either side of the number 1873} in the mark are {provide a translation of the wording}."

Disclaimer

The applicant must disclaim the descriptive wording "1873" apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). The wording is merely descriptive because the year presumably represents the year which the Applicant company began doing business.

In further support of this requirement, the examining attorney attaches third-party registrations obtained from the USPTO X-Search database. The registrations all have disclaimers of the descriptive term "1873".

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP §1213.08(a)(i). A properly worded disclaimer should read as follows:



No claim is made to the exclusive right to use 1873 apart from the mark as shown.

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

Identification Of Goods and Services

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1401.04 and 1904.02(b).

The identification of goods and services is unacceptable as indefinite because some of the terms are overly broad so that the goods are vague and/or could fall into a different international class. Suggestions and explanation is incorporated into the identification proposed below. TMEP §1402.01. The applicant may adopt the following identification, if accurate:

Non-alcoholic aperitifs; lemonades; musts; non-alcoholic cocktails ~~mixes~~; ~~Preparations for making~~ essences for the manufacture of ~~http://atlas/netacgi/ - h0http://atlas/netacgi/ - h2~~liqueurs; mineral water ~~(beverages)~~; non-alcoholic beverages, namely, _____ **{Applicant must specify specifically what type of non-alcoholic beverage it offers}**; preparations for making beverages, namely, _____ **{Applicant must specify specifically what type of preparations it offers}**; isotonic beverages; non-alcoholic fruit juice beverages; fruit nectars; fruit juices; beers; powders for effervescing beverages **used in the preparation of soft drinks**; essences for making ~~beverages~~ {specify "mineral waters" or "soft drinks"}; syrups for beverages; Syrups, namely, _____ {indicate type of syrup}; malt beer; soft drinks; table water; aerated water; sherbets ~~(beverages)~~; water ~~(beverages)~~, namely, _____ {indicate type of water, such as still water, spring water, drinking water, etc}; powder and **powders in the form of tablets used in the preparation of carbonated drinks, namely, soft drinks**; vegetable juices ~~(beverages)~~. International Class 32.

Alcoholic beverages ~~(except beers)~~, namely, _____ {specify specific alcoholic beverages sold}; liqueurs; aperitifs; **brandy**, namely, eaux-de-vie; gin ~~(eaux de vie)~~; kirsch; **prepared alcoholic** cocktails; distilled beverages, namely, _____ {specify specific distilled beverages sold}; cognac ~~(French brandy)~~; **distilled** spirits; hydromel; alcoholic beverages containing fruit; rum; champagnes; wine; vodka; whisky. International Class 33.

Restaurants; coffee shops; cocktail lounge services. International Class 43.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

For assistance with identifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>.

Entity Type and Citizenship Must be Provided

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 §§803.03 *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).

S. David Sterkin
Trademark Attorney
U.S. Patent and Trademark Office
Law Office 110
(571) 272-5494

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 has been 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 applications 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.

DESIGN MARK

Serial Number
72172524

Status
EXPIRED

Word Mark
SEILER'S OF NEW ENGLAND CATERERS SINCE 1873

Standard Character Mark
No

Registration Number
0817474

Date Registered
1966/10/25

Type of Mark
TRADEMARK

Register
PRINCIPAL

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

Owner
H. J. SEILER CO., INC., THE CORPORATION MASSACHUSETTS 110 NORWAY ST.
BOSTON 15 MASSACHUSETTS

Goods/Services
Class Status -- EXPIRED. IC 029 030. US 046. G & S: FROZEN FOODS-NAMELY, CLAM CHOWDER, FISH CHOWDER, CHICKEN CROQUETTES, SHRIMP CROQUETTES, CLAM CROQUETTES, SCALLOP AND LOBSTER CROQUETTES, HADDOCK AU GRATIN, MACARONI AND CHEESE, ENGLISH MUFFINS, ICE CREAM; FRESH BAKERY PRODUCTS-NAMELY, ENGLISH MUFFINS AND SCOTCH MUFFINS; AND CANNED PRODUCTS-NAMELY, CLAM CHOWDER. First Use: 1947/10/00. 1873 AS TO THE MARK "SEILER'S". First Use In Commerce: 1947/10/00.

Disclaimer Statement
APPLICANT DISCLAIMS THE WORDS "CATERERS SINCE 1873," "OF NEW ENGLAND," AND THE MAP REPRESENTATION OF THE NEW ENGLAND AREA.

Limiting/Clipping Statement
THE LINES IN THE DRAWING IS AN ACTUAL PART OF THE MARK AND DOES NOT REPRESENT COLOR

Section 2f Statement

Print: Nov 1, 2005

72172524

2(F) ENTIRE MARK

Filing Date
1963/07/05

Examining Attorney
UNKNOWN



Print: Nov 1, 2005 72236416

DESIGN MARK

Serial Number
72236416

Status
EXPIRED

Word Mark
RETAILERS COMMERCIAL AGENCY, INC. 1873

Standard Character Mark
No

Registration Number
0538546

Date Registered
1967/11/07

Type of Mark
SERVICE MARK

Register
PRINCIPAL

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

Owner
RETAIL CREDIT COMPANY CORPORATION GEORGIA P.O. BOX 4081 ATLANTA, GA.

Goods/Services
Class Status -- EXPIRED. IC 035. US 101. G & S: CONDUCTING INVESTIGATIONS AND REPORTING ON INDIVIDUALS AND BUSINESS CONCERNS CONCERNING THE CREDIT, CHARACTER AND FINANCES IN CONNECTION WITH CREDIT AND EMPLOYMENT TRANSACTIONS. First Use: 1964/10/00. First Use In Commerce: 1964/10/00.

Prior Registration(s)
0523614

Disclaimer Statement
THE DATE "1873" AND ALL WORDING APPEARING ON THE DRAWING ARE DISCLAIMED APART FROM THE MARK AS SHOWN.

Filing Date
1966/01/13

Examining Attorney
UNKNOWN



DESIGN MARK

Serial Number
72244062

Status
REGISTERED AND RENEWED

Word Mark
SEILER'S OF NEW ENGLAND CATERERS SINCE 1873

Standard Character Mark
No

Registration Number
0836853

Date Registered
1967/10/10

Type of Mark
SERVICE MARK

Register
PRINCIPAL

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

Owner
SEILER CORPORATION, THE CORPORATION MASSACHUSETTS 153 SECOND AVE.
WALTHAM MASSACHUSETTS 02254

Goods/Services
Class Status -- ACTIVE. IC 042. US 100. G & S: FOOD CATERING
SERVICES. First Use: 1953/04/00. 1873 AS TO THE WORD "SEILER'S"..
First Use In Commerce: 1956/04/00.

Prior Registration(s)
0817474;0823022

Disclaimer Statement
NO REGISTRATION RIGHTS ARE CLAIMED FOR THE WORDS "CATERERS SINCE
1873," "OF NEW ENGLAND," AND THE MAP REPRESENTATION APART FROM THE
MARK SHOWN IN THE DRAWING, BUT THE APPLICANT WAIVES NONE OF ITS COMMON
LAW RIGHTS IN THE MARK SHOWN IN THE DRAWING OR ANY FEATURE THEREOF.

Filing Date
1966/04/22

Examining Attorney

Print: Nov 1, 2005

72244062

UNKNOWN

Attorney of Record

SAMUELS, GAUTHIER, STEVENS & KEOHE



Print: Nov 1, 2005 73112100

DESIGN MARK

Serial Number
73112100

Status
REGISTERED AND RENEWED

Word Mark
LEVI STRAUSS & CO. SAN FRANCISCO, CAL. ORIGINAL RIVETED QUALITY
CLOTHING. XX TRADE MARK PATENDED MAY 20, 1873

Standard Character Mark
No

Registration Number
1095986

Date Registered
1978/01/11

Type of Mark
TRADEMARK

Register
PRINCIPAL

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

Owner
LEVI STRAUSS & CO. CORPORATION DELAWARE 1155 BATTERY STREET SAN
FRANCISCO CALIFORNIA 94111

Goods/Services
Class Status -- ACTIVE. IC 019. US 003. G & S: LUGGAGE-NAMELY,
BACK PACKS, BRIEF CASES, TRAVEL KITS, SHOULDER BAGS, AND PURSES.
First Use: 1973/09/30. First Use In Commerce: 1973/09/30.

Goods/Services
Class Status -- ACTIVE. IC 025. US 039. G & S: CAPS AND VISORS.
First Use: 1974/02/28. First Use In Commerce: 1974/02/28.

Goods/Services
Class Status -- SECTION 8 - CLASS(ES) IN MULT. CL. REG.. IC 028. US
022 023 038 050. G & S: [TENNIS BAGS]. First Use: 1973/09/30.
First Use In Commerce: 1973/09/30.

Prior Registration(s)
0523665;1030033

Print: Nov 1, 2005

73112100

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SAN FRANCISCO, CAL."; "ORIGINAL RIVETED"; "QUALITY CLOTHING XX"; AND "TRADE MARK"; AND "PATENTED MAY 20, 1873" APART FROM THE MARK AS SHOWN.

Filing Date

1977/01/12

Examining Attorney

UNKNOWN

Attorney of Record

KAREN S FRANK

LEVI STRAUSS & CO.
SAN FRANCISCO, CAL.

ORIGINAL RIVETED
QUALITY CLOTHING XX



Print: Nov 1, 2005 74141381

DESIGN MARK

Serial Number
74141381

Status
CANCELLED - SECTION 8

Word Mark
HEINEKEN EST. 1873

Standard Character Mark
No

Registration Number
1684605

Date Registered
1992/04/28

Type of Mark
TRADEMARK

Register
PRINCIPAL

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

Owner
Heineken Brouwerijen B.V. PRIVATE LIMITED COMPANY NETHERLANDS 2e
Weteringplantsoen 21 1017 2D Amsterdam NETHERLANDS

Goods/Services
Class Status -- SECTION 8 - ENTIRE REGISTRATION. IC 032. US 048. G
& S: beers. First Use: 1989/11/00. First Use In Commerce:
1989/11/00.

Prior Registration(s)
0767954;AND OTHERS

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "EST. 1873" APART FROM
THE MARK AS SHOWN.

Filing Date
1991/02/14

Examining Attorney
NASH, LAURA

Print: Nov 1, 2005

74141381

Attorney of Record
H. John Caspaign



Print: Nov 1, 2005

74495648

DESIGN MARK

Serial Number
74495648

Status
REGISTERED AND RENEWED

Word Mark
GOEBEL BEER QUALITY SINCE 1873 NATURALLY LIGHT GOLDEN LAGER

Standard Character Mark
No

Registration Number
1877866

Date Registered
1995/02/07

Type of Mark
TRADEMARK

Register
PRINCIPAL

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

Owner
PABST BREWING COMPANY CORPORATION DELAWARE P. O. BOX 1661 SAN ANTONIO TEXAS 78296

Goods/Services
Class Status -- ACTIVE. IC 032. US 048. G & S: beer. First Use: 1982/10/00. First Use In Commerce: 1982/10/00.

Prior Registration(s)
1208834

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "QUALITY SINCE 1873", "BEER" and "NATURALLY LIGHT GOLDEN LAGER" APART FROM THE MARK AS SHOWN.

Lining/Stippling Statement
The lining is a feature of the mark and is not intended to indicate color.

Filing Date
1994/03/01

Print: Nov 1, 2005

74485648

Examining Attorney
BUCHANAN WILL, NORA



Print: Nov 1, 2005 74582853

DESIGN MARK

Serial Number
74582853

Status
SECTION 8 & 15--ACCEPTED AND ACKNOWLEDGED

Word Mark
TONE'S QUALITY SINCE 1873

Standard Character Mark
No

Registration Number
1975570

Date Registered
1996/05/28

Type of Mark
TRADEMARK

Register
PRINCIPAL

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

Owner
TONE BROTHERS, INC. CORPORATION IOWA 921 98TH AVENUE OAKLAND
CALIFORNIA 94603

Goods/Services
Class Status -- ACTIVE. IC 029. US 046. G & S: salad toppings in
the nature of bacon chips and dehydrated vegetables. First Use:
1993/05/10. First Use In Commerce: 1993/05/10.

Goods/Services
Class Status -- ACTIVE. IC 030. US 046. G & S: spices, seasonings,
pure food extracts used as food flavorings, imitation food flavorings,
edible or candy cake decorations, sauce and gravy mixes. First Use:
1993/05/10. First Use In Commerce: 1993/05/10.

Goods/Services
Class Status -- ACTIVE. IC 002. US 006 011 016. G & S: food colors
for domestic and institutional use. First Use: 1993/05/10. First Use
In Commerce: 1993/05/10.

Prior Registration(s)
0772509;0773259;AND OTHERS

Print: Nov 1, 2005

74582853

Disclaimer Statement

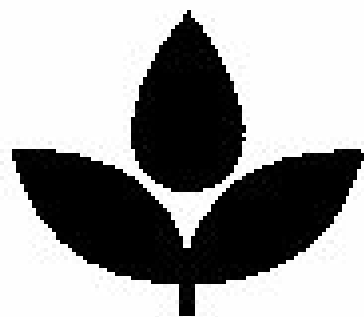
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "QUALITY SINCE 1873"
APART FROM THE MARK AS SHOWN.

Filing Date

1994/10/06

Examining Attorney

SHARPER, SAMUEL E.



Tone's
QUALITY SINCE 1873

Print: Nov 1, 2005

75233488

DESIGN MARK

Serial Number
75233488

Status
REGISTERED

Word Mark
CATTO'S RARE OLD SCOTTISH HIGHLAND WHISKY 1861 JAMES CATTO PARIS 1873
LONDON 1884

Standard Character Mark
No

Registration Number
2357925

Date Registered
2000/06/13

Type of Mark
TRADEMARK

Register
PRINCIPAL

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

Owner
JAMES CATTO & COMPANY LIMITED COMPANY UNITED KINGDOM Moffat Distillery
Airdrie, ML6 8PL SCOTLAND

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: Scotch whiskey.
First Use: 1864/00/00. First Use In Commerce: 1966/00/00.

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "RARE OLD SCOTTISH
HIGHLAND WHISKY 1861" APART FROM THE MARK AS SHOWN.

Lining/Stippling Statement
The lining in the drawing is for shading purposes only. The stippling
in the drawing is for shading purposes only.

Filing Date
1997/01/30

Examining Attorney
MULLEN, MARK T.

Print: Nov 1, 2005

75233488

Attorney of Record
H. JOHN CAMPAIGN

CATTOL'S

RARE OLD SCOTTISH

Highland Whisky

1851

