

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/068058

MARK: SUNRISE

79068058

CORRESPONDENT ADDRESS:

Harmsen Utescher
Alter Wall 55
20457 Hamburg
FED REP GERMANY

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Lidl Stiftung & Co.
KG

CORRESPONDENT'S
REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 0638458

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

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can practice before the USPTO** in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state**, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and
- (2) **Canadian agents/attorneys** who represent applicants residing in Canada and who have received reciprocal recognition by the USPTO under 37 C.F.R. §11.14(c).

37 C.F.R. §§11.1, 11.14; TMEP §602.

Foreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys. TMEP §602.06(b). Filing written communications, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. A response signed by an unauthorized foreign

attorney is considered an incomplete response. *See* TMEP §§602.03, 712.03.

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

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.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2134554. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §1207.01 *et seq.* See the enclosed registration.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

Applicant is seeking registration of the proposed mark SUNRISE for “Wines and sparkling wines, beverages containing wine.”

Registrant owns the mark SUNRISE for “wine.”

The marks of the respective parties are identical in sound, spelling, meaning, and commercial impression.

Applicant’s “Wines and sparkling wines” are encompassed by registrant’s goods. Likelihood of confusion is determined on the basis of the goods as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii). In this case, the registrant’s goods are identified broadly. Therefore, it is presumed that the registration encompasses all goods of the type described, including those in applicant’s more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(a)(iii). Applicant’s “beverages containing wine” contain the goods identified by registrant; therefore, the goods are highly similar and flow through the same channels of trade to the same consumers.

Accordingly, registration is refused under §2(d) of the Trademark Act based upon a likelihood of confusion.

Although applicant’s mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

EARLIER-FILED PENDING APPLICATIONS

The filing date of pending Application Serial Nos. 78745499, 77240065, 77240052, 77239902, and 77239213 precedes applicant’s filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant’s

response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Applicant must respond to the requirement set forth below.

IDENTIFICATION OF GOODS

The wording "beverages containing wine" in identification of goods is indefinite and must be clarified. *See* TMEP §1402.01. Applicant must specify the nature of the beverages.

Applicant may adopt the following identification, if accurate:

International Class 033: Wines and sparkling wines, **beverages containing wine in the nature of prepared wine cocktails.**

Identifications of goods can be amended only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. 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.

For assistance with identifying and classifying 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>. *See* TMEP §1402.04.

/Laura A. Hammel/
Trademark Examining Attorney
Law Office 116
(571) 272-8260

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: May 26, 2009

75267742

TYPED DRAWING

Serial Number
75267742

Status
REGISTERED AND RENEWED

Word Mark
SUNRISE

Standard Character Mark
No

Registration Number
2134554

Date Registered
1998/02/03

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
VINA CONCHA Y TORO FOREIGN CORPORATION AVENIDA NUEVA TAJAMAR PISO 15
481 TORRE NORTE, LAS CONDES SANTIAGO CHILE

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: wine. First
Use: 1995/10/13. First Use In Commerce: 1996/01/25.

Filing Date
1997/03/17

Examining Attorney
SPILS, CAROL

Attorney of Record
Keith Barlett

Print: May 26, 2009

77239213

DESIGN MARK

Serial Number
77239213

Status
REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

Word Mark
JOSE CUERVO GOLDEN TEQUILA SUNRISE

Standard Character Mark
Yes

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Tequila Cuervo La Rojena, S.A. de C.V. CORPORATION MEXICO
Circunvalacion Sur #44A, Fraccionamiento Las Puentes, Zapopan Jalisco
Codigo MEXICO 45070

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: Prepared
alcoholic cocktails containing tequila.

Prior Registration(s)
2158372;2974682;3169796;AND OTHERS

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GOLDEN" AND "TEQUILA
SUNRISE" APART FROM THE MARK AS SHOWN.

Name/Portrait Statement
The name "JOSE CUERVO" does not identify a particular living
individual.

Translation Statement
The English translation of the word "CUERVO" in the mark is "crow" or
"raven".

Filing Date
2007/07/26

Examining Attorney

Print: May 26, 2009

77238213

MCNORROW, RONALD

Attorney of Record
Lawrence E. Abelman

JOSE CUERVO GOLDEN TEQUILA
SUNRISE

Print: May 26, 2009

77238902

DESIGN MARK

Serial Number
77238902

Status
REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

Word Mark
JOSE CUERVO GOLDEN TEQUILA SUNRISE

Standard Character Mark
Yes

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Tequila Cuervo La Rojena, S.A. de C.V. CORPORATION MEXICO
Circunvalacion Sur #44A, Fraccionamiento Las Puentes, Zapopan Jalisco
Codigo MEXICO 45070

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: Prepared
alcoholic cocktails containing tequila.

Prior Registration(s)
2158372;2974682;3169796;AND OTHERS

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GOLDEN" AND "TEQUILA
SUNRISE" APART FROM THE MARK AS SHOWN.

Name/Portrait Statement
The name "JOSE CUERVO" does not identify a particular living
individual.

Translation Statement
The English translation of the word "CUERVO" in the mark is "crow" or
"raven".

Filing Date
2007/07/26

Examining Attorney

Print: May 26, 2009

77238902

MCNORROW, RONALD

Attorney of Record
Lawrence E. Abelman

JOSE CUERVO GOLDEN TEQUILA
SUNRIZE

Print: May 26, 2009

77240052

DESIGN MARK

Serial Number
77240052

Status
FIRST EXTENSION - GRANTED

Word Mark
JOSE CUERVO GOLDEN SUNRISE

Standard Character Mark
Yes

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Tequila Cuervo La Rojena, S.A. de C.V. CORPORATION MEXICO
Circunvalacion Sur #44A, Fraccionamiento Las Puentes, Zapopan Jalisco
Codigo MEXICO 45070

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: Prepared
alcoholic cocktails containing tequila.

Prior Registration(s)
2158372;2974682;3169796;AND OTHERS

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

Name/Portrait Statement
The name "JOSE CUERVO" does not identify a particular living
individual.

Translation Statement
The English translation of the word "CUERVO" in the mark is "crow" or
"raven".

Filing Date
2007/07/26

Examining Attorney

Print: May 26, 2009

77240052

TWOHIG, SHANNON

Attorney of Record
Lawrence E. Abelman

JOSE CUERVO GOLDEN SUNRISE

Print: May 26, 2009

77240065

DESIGN MARK

Serial Number
77240065

Status
FIRST EXTENSION - GRANTED

Word Mark
JOSE CUERVO GOLDEN SUNRISE

Standard Character Mark
Yes

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Tequila Cuervo La Rojena, S.A. de C.V. CORPORATION MEXICO
Circunvalacion Sur #44A, Fraccionamiento Las Puentes, Zapopan Jalisco
Codigo MEXICO 45070

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: Prepared
alcoholic cocktails containing tequila.

Prior Registration(s)
2158372;2974682;3169796;AND OTHERS

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

Name/Portrait Statement
The name "JOSE CUERVO" does not identify a particular living
individual.

Translation Statement
The English translation of the word "CUERVO" in the mark is "crow" or
"raven".

Filing Date
2007/07/26

Examining Attorney

Print: May 26, 2009

77240065

TWOHIG, SHANNON

Attorney of Record
Lawrence E. Abelman

JOSE CUERVO GOLDEN SUNRIZE

Print: May 26, 2009

76745489

DESIGN MARK

Serial Number
76745489

Status
SU - FINAL REFUSAL - MAILED

Word Mark
MISTY SUNRISE

Standard Character Mark
Yes

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Brown-Forman Corporation CORPORATION DELAWARE 850 Dixie Highway
Louisville KENTUCKY 40210

Goods/Services
Class Status -- ACTIVE, IC 033. US 047 049. G & S: Alcoholic
beverages, namely, Canadian whisky. First Use: 2008/01/31. First Use
In Commerce: 2008/01/31.

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

Filing Date
2005/11/02

Examining Attorney
CLARKE, AISHA

Attorney of Record
David S. Gooder

MISTY SUNRISE