

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 79104840

MARK: STOLICHNAYA GOLD

79104840

CORRESPONDENT ADDRESS:

ABREMA Agence de Brevets & M;
Ganguillet
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CH-1002 Lausanne
SWITZERLAND

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Spirits International
B.V.

CORRESPONDENT'S

REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 1096274

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 if applicant is not represented by an authorized attorney. *See* 37 C.F.R. §2.193(e)(2)(ii). Otherwise, applicant's authorized attorney must respond on applicant's behalf. *See* 37 C.F.R. §2.193(e)(2)(i). However, **the only attorneys who are authorized to sign responses and 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.
- (2) **Canadian agents/attorneys** who represent applicants located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO.

See 37 C.F.R. §§2.17(e), 2.62(b), 11.1, 11.5(b)(2), 11.14(a), (c); TMEP §§602, 712.03.

Foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO. *See* 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(b). That is, foreign attorneys may not file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal, among other things. *See* 37 C.F.R. §11.5(b)(2); TMEP §§602.03(c), 608.01. If applicant is represented by such a foreign attorney, applicant must respond directly to this provisional refusal Office action. *See* 37 C.F.R. §2.193(e)(2)(ii).

DESIGNATION OF DOMESTIC REPRESENTATIVE:

The USPTO encourages applicants who do not reside in the U.S. to designate a domestic representative upon whom notices or process may be served. 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2); *see* TMEP §610. Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/index.jsp>.

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

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

NO SIMILAR MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2 (d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

Applicant, however, must respond to the following requirements.

CITIZENSHIP OF THE APPLICANT

Applicant must specify its national citizenship or foreign country of organization or incorporation. *See* 37 C.F.R. §§2.32(a)(3)(i)-(ii), 7.25(a)-(b); TMEP §§803.03, 803.04, 1904.02(a). This information is required in all U.S. trademark applications, including those filed under Trademark Act Section 66(a) (also known as "requests for extension of protection of an international registration to the U.S."). *See* 37 C.F.R. §§2.32(a)(3)(i)-(ii), 7.25(a)-(b); TMEP §§803.03, 803.04, 1904.02(a).

If applicant's entity type is an individual, applicant must indicate his or her national citizenship for the record. 37 C.F.R. §2.32(a)(3)(i); TMEP §803.04. If applicant's entity type is a corporation, association, partnership, joint venture, or the foreign equivalent, applicant must set forth the foreign country under whose laws applicant is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii); TMEP §§803.03(b)-(c), 803.04. For an association, applicant must also specify whether the association is incorporated or unincorporated. TMEP §803.03(c).

If applicant is organized under the laws of a foreign province or geographical region, applicant should specify both the foreign province or geographical region and the foreign country in which the province or region is located. *See* TMEP §803.04. To provide this information online via the Trademark Electronic Application System (TEAS) response form, applicant must (1) locate the "Entity Type" heading and select "Other;" (2) locate the "Specify Entity Type" heading and select "Other" under the Foreign Entity option, and enter in the free-text field below both applicant's entity type and the foreign province or geographical region of its organization (e.g., partnership of Victoria); and (3) locate the "State or Country Where Legally Organized" heading and select the appropriate foreign country (e.g., Australia) under the Non-U.S. Entity option. *See id.*

COLOR CLAIM AND LOCATION STATEMENT

The color claim and mark description are incomplete. The color claim does not identify all the colors in the drawing of the mark; and the mark description does not reference all the literal or design elements in the mark and/or it does not reference all the colors in those elements. Specifically, the following colors have been omitted from the color claim: gold and yellow. And the applicant has not provided a color location description.

A complete color claim must reference *all* the colors appearing in the drawing of the mark. *See* 37 C.F.R. §2.52(b)(1); TMEP §§807.07(a) *et seq.* And a complete mark description for a mark depicted in color must identify all the literal and design elements in the mark and specify where the colors appear in those elements. *See* 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §§807.07(a) *et seq.* However, if black, white, and/or gray are not being claimed as a color feature of the mark, applicant must exclude these from the color claim and include in the mark description a statement that the colors black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark. TMEP §807.07(d).

Based on the foregoing requirements for a complete color claim and mark description, applicant must provide a color claim that references all the colors in the mark, and a mark description that identifies all the literal and design elements and specifies where the colors appear in those elements. *See* 37 C.F.R. §2.52(b)(1); TMEP §§807.07(a) *et seq.*

The following color claim and mark description are suggested:

The colors **gold**, red, white, black **and yellow** are claimed as a feature of the mark.

The mark consists of a gold square on a black rectangle with rounded corners. The border of the gold square consists of gold and black dots. At the bottom border there are two yellow bars. Above the design is the wording “STOLICHNAYA” in white on a red rectangle with red and black dots on its left and right edges and the wording “GOLD” in yellow. Above and below the wording are swirl designs in yellow.

IDENTIFICATION OF GOODS

The identification of goods is indefinite and must be clarified. *See* TMEP §1402.01. Applicant must specify the common commercial or generic name for the goods. If there is no common commercial or generic name, applicant must describe the product and intended consumer as well as its main purpose and intended uses.

Additionally, the identification of goods contains parentheses. Generally, parentheses and brackets should *not* be used in identifications. Parenthetical information is permitted in identifications only 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 of the identification, e.g., “obi (Japanese sash).” TMEP §1402.12.

Therefore, applicant must remove the parentheses from the identification of goods and incorporate the parenthetical information into the description.

Applicant may adopt the following identification, if accurate:

“Beer; mineral and aerated waters and other non-alcoholic drinks, **namely, ___{specify by common commercial name, e.g. energy drinks, soft drinks, cola drinks}**; fruit drinks and fruit

juices; syrups, **concentrates and powders** for making beverages” in International Class 032.

“Alcoholic beverages **except beer**” in International Class 033.

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods and/or services from that assigned by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and/or services from one existing international class to another. 37 C.F.R. §2.85(d); *see* TMEP §§1402.07(a), 1904.02(c).

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/netathtml/tidm.html>. *See* TMEP §1402.04.

An applicant may amend an identification of goods 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 *et seq.*

ENGLISH TRANSLATION REQUIRED

Applicant must submit an English translation of all foreign wording in the mark. 37 C.F.R. §2.32(a)(9); *see* TMEP §809. In the present case, the wording “STOLICHNAYA” requires translation.

The following translation statement is suggested:

The English translation of “STOLICHNAYA” in the mark is “capital”.

TMEP §809.03.

CLAIM OF OWNERSHIP OF REGISTRATIONS

If applicant owns U.S. Registration Nos. 0865462, 1291454, 2455605 and others, then applicant must submit for the application record a claim of ownership of these registrations. *See* 37 C.F.R. §2.36; TMEP §812. See the attached copies of the registrations. *See* TMEP §812.

Applicant may use the following format to claim ownership of these registrations:

Applicant is the owner of U.S. Registration Nos. 0865462, 1291454, 2455605 and others.

RESPONSE GUIDELINES

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

If applicant does not respond to this Office action within six months of the issue/mailling date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R.

§§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. Where the application has been abandoned for failure to respond to an Office action, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to live status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Robert J. Struck/
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp.

Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: Feb 2, 2012 72269237

TYPED DRAWING

Serial Number
72269237

Status
REGISTERED AND RENEWED

Word Mark
STOLICHNAYA

Standard Character Mark
No

Registration Number
0865462

Date Registered
1969/02/25

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
SPIRITS INTERNATIONAL B.V. PRIVATE LIMITED LIABILITY COMPANY
NETHERLANDS 7, Rue Nicolas Bove STRASSEN LUXEMBOURG L-1445

Goods/Services
Class Status -- ACTIVE. IC 033. US 049. G & S: VODKA. First Use:
1944/05/09. First Use In Commerce: 1946/00/00.

Translation Statement
THE ENGLISH TRANSLATION OF THE MARK "STOLICHNAYA" IS "CAPITAL"
(MEANING MAIN CITY)

Filing Date
1967/04/14

Examining Attorney
UNKNOWN

Attorney of Record
Bingham B. Leverich, Esq.

Print: Feb 2, 2012 73435314

TYPED DRAWING

Serial Number
73435314

Status
REGISTERED AND RENEWED

Word Mark
STOLICHNAYA

Standard Character Mark
No

Registration Number
1291454

Date Registered
1984/08/21

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
SPIRITS INTERNATIONAL B.V. PRIVATE LIMITED LIABILITY COMPANY
NETHERLANDS 1A, RUE THOMAS EDISON STRASSEN LUXEMBOURG L-1445

Goods/Services
Class Status -- ACTIVE. IC 033. US 049. G & S: Vodka. First Use:
1944/05/05. First Use In Commerce: 1967/04/14.

Prior Registration(s)
0865462;1244735

Translation Statement
THE ENGLISH-LANGUAGE TRANSLATION OF THE MARK "STOLICHNAYA" IS
"CAPITAL", MEANING MAIN CITY.

Filing Date
1983/07/20

Examining Attorney
UNKNOWN

Attorney of Record

Print: Feb 2, 2012

73435314

Bingham B. Leverich, Esq.

Print: Feb 2, 2012

75184282

DESIGN MARK

Serial Number
75184282

Status
REGISTERED AND RENEWED

Word Mark
STOLICHNAYA GOLD

Standard Character Mark
No

Registration Number
2455605

Date Registered
2001/05/29

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
SPIRITS INTERNATIONAL B.V. PRIVATE LIMITED LIABILITY COMPANY
NETHERLANDS 7, rue Nicholas Bove Luxembourg LUXEMBOURG L1253

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: vodka. First
Use: 1997/03/00. First Use In Commerce: 1997/03/00.

Prior Registration(s)
1244735;1251454

Translation Statement
The English translation of "STOLICHNAYA" is "capital".

Filing Date
1996/10/21

Examining Attorney
SHANAHAN, WILLIAM P.

Attorney of Record
Marie A. Lavalleye, Esq.

STOLICHNAYA GOLD