

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

**APPLICATION SERIAL NO.** 79110018

**MARK:**

**\*79110018\***

**CORRESPONDENT ADDRESS:**

Obschestvo s ogranichennoy  
otvetstvennos  
"Korporatsiya "Sibirskoe zdorovie"  
ul. Lenina, 48  
RU-630004 Novosibirsk  
RUSSIAN FED.

**CLICK HERE TO RESPOND TO THIS LETTER:**  
[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

**APPLICANT:** Obschestvo s  
ogranichennoy otvetstvennos ETC.

**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. 1109137**

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 referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

### Search

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

### Prior Registration

If applicant is the owner of U.S. Registration No. 4107393, then applicant must submit a claim of ownership. 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

**Applicant is the owner of U.S. Registration Nos. 4107393.**

### Description and Color Location Statement Required

Applicant has submitted a color drawing and provided a color claim, but has not provided a mark description of the literal and design elements that specifies where all the colors appear in those elements. Applications for marks depicted in color must include a description of all the literal and design elements in the mark that specifies where all the colors appear in those elements. 37 C.F.R. §§2.37, 2.52(b)(1); *see* TMEP §807.07(a) *et seq.*

If black, white and/or gray are not being claimed as a color feature of the mark, applicant must state 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). Generic color names must be used to describe the colors in the mark, e.g., magenta, yellow, turquoise. TMEP §807.07(a)(i)-(a)(ii).

Therefore, applicant must provide a description of the literal and design elements in the mark that specifies where all the colors appear in those elements. The following description is suggested, if accurate: **“The mark consists of an apple tree design within a square with rounded corners in dark blue, the tree and apples appear in dark yellow outlined in blue, below the tree line is green and the light blue sky shows through the branches.”** TMEP §807.07(a)(ii).

### The Identification of Goods is Indefinite

Some of the identification of goods and service is indefinite and must be clarified because it is unclear from the current wording exactly what goods are used in conjunction with the mark. *See* TMEP

§1402.01. For example, the cosmetic dyes must be specified, e.g. cosmetic hair dye. The identification of goods and/or services 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/or services and incorporate the parenthetical information into the description. Applicant may adopt the following identification, if accurate (suggested wording appears italicized print):

*After-shave lotions; antiperspirants; aromatic essential oils; bath salts, not for medical purposes; beauty masks; breath freshening sprays; cleansing milk for toilet purposes; cosmetics; cosmetic creams; cosmetic hair dyes; cosmetic make-up kits comprised of \_\_\_\_\_ (indicate specific items, e.g. lipstick, lip gloss); cosmetic pencils; cosmetic preparations for baths; cosmetic preparations for eyelashes; cotton sticks for cosmetic purposes; preparations for slimming purposes; cosmetic preparations for skin care; cotton wool for cosmetic purposes; dental bleaching gels; dentifrices; depilatory preparations; deodorants for personal use; eau de cologne; eyebrow cosmetics; hair dyes; hair lotions; hair spray; hair waving preparations; lotions for cosmetic purposes; make-up powder; make-up removing preparations; mascara; mouth washes, not for medical purposes; nail care preparations; nail polish; oils for cosmetic purposes; perfumery; perfumes; pomades for cosmetic purposes; aromatic potpourri; shampoos; shaving preparations; soap; tissues impregnated with cosmetic lotions; non-medical toiletries; toilet water in Class 3.*

-and-

*Adjuvants for medical purposes; albuminous foodstuffs for medical purposes; albuminous preparations for medical purposes; balms for medical purposes; condurango bark for pharmaceutical purposes; bath preparations, medicated; bath salts for medical purposes; biological preparations for medical purposes, namely, for the treatment of \_\_\_\_\_ (indicate specific disorder or disease, e.g. cancer); chemical preparations for medical purposes, namely, for the treatment of \_\_\_\_\_ (indicate specific disorder or disease, e.g. cancer); candy, medicated; decoctions for pharmaceutical purposes, namely, for the treatment of \_\_\_\_\_ (indicate specific disorder or disease, e.g. cancer); dental lacquer; dental mastics; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; dietetic substance, namely, sugar adapted for medical use; digestives for pharmaceutical purposes; drugs for medical purposes, namely, for the treatment of \_\_\_\_\_ (indicate specific disorder or disease, e.g. cancer); non-nutritive edible dietary plant fibers to aid nutrition; enzymes for medical purposes; food for babies; herbs teas for medicinal purposes; liniments; antibacterial lotions for pharmaceutical purposes; medicinal drinks; medicinal hair growth preparations; medicinal herbs; medicinal infusions for the treatment of \_\_\_\_\_ (indicate specific disorder or disease, e.g. cancer); herbal mud packs for medicinal purposes; medicinal oils; medicinal roots; mineral food supplements; mineral enhanced water for medical purposes; mouthwashes for medical purposes; nutritional additives for medical purposes used in foods and dietary substances; pharmaceutical preparations for the treatment of \_\_\_\_\_ (indicate specific disorder or disease, e.g. cancer); sea water for medicinal bathing; sanitary towels; tissues impregnated with pharmaceutical lotions for the treatment of \_\_\_\_\_ (indicate specific disorder or disease, e.g. cancer); vitamin preparations in Class 5*

-and-

*Photo albums; almanacs; bags, namely, envelopes and pouches of paper or plastics, for packaging; booklets and books in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); calendars; catalogues in the field of \_\_\_\_\_ (indicate specific subject, e.g. school supplies); stationery envelopes; forms, printed; graphic prints; greeting cards; pamphlets in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); paper; printed periodicals in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); postcards; posters; printed matter, namely, \_\_\_\_\_ (indicate specific items, e.g. written articles) in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); printed business prospectuses; labels, not of textile; handbook manuals in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); newsletters in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); newspapers in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); blank paper note books; signboards of paper and cardboard; stationery; stationery stickers; printed teaching materials in the field of \_\_\_\_\_ (indicate specific subject, e.g. law); desk sets for writing; writing instruments in Class 16.*

-and-

*Baking powder; bread; bread rolls; buns; cereal-based snack food; cereal preparations, namely, \_\_\_\_\_ (indicate specific items, e.g. energy bars); chewing gum, not for medical purposes; cereal products, namely, confectionary chips for baking; chocolate; chocolate-based beverages; chocolate based beverages with milk; cocoa; cocoa-based beverages; cocoa beverages with milk; cocoa based ingredient in confectionary products; coffee; coffee-based beverages; coffee beverages with milk; condiments, namely, \_\_\_\_\_ (indicate specific items, e.g. pepper sauce); confectionery made of sugar; cooking salt; crackers; edible ices; farinaceous food pastes for human consumption; flour for food; flour-milling products, namely, flour based chips; fruit jelly candy; garden herbs, preserved; gingerbread; gruel, with a milk base, namely, porridge, for food; honey; ice cream; macaroni; malt for human consumption, namely, food purposes; muesli; oat-based food, namely, oat flakes; pancakes; pastries; pizzas; popcorn; propolis [bee glue] for human consumption; puddings; ravioli; rice-based snack food; rusks; sandwiches; seasonings; spices; starch for use in manufacturing food; sugar; sushi; sweetmeats; tarts; tea; tea-based beverages; thickening agents for cooking foodstuffs; vinegar; yeast in Class 30.*

-and-

*Aperitifs, non-alcoholic; beer; cocktails, non-alcoholic; essences for making beverages; fruit juices; fruit nectars, non-alcoholic; isotonic beverages; kvass; non-alcoholic beverages with tea flavor; non-alcoholic fruit extracts used in the preparation of beverages; syrups for beverages; vegetable juices; water beverages in Class 32.* TMEP Section 1402.01.

The wording “oils for toilet purposes, preparations of trace elements for human and animal use; aromatic preparations for food; groats for human food;” in the identification of goods is indefinite. The applicant should indicate this item by the common commercial name or indicate the nature and purpose of the item that is properly classified in the original class identified for the goods.

Generally, a trademark examining attorney will recommend language to replace unacceptable wording in identifications of goods and/or services. TMEP §1402.01(e). However, the trademark examining attorney is unable to suggest alternative wording because the nature of the following

wording in International Class 16 is unclear and does not appear to describe any goods and/or services in that class: “credit card imprints, non-electric.” See TMEP §§1401.03(d), 1402.01(e).

Applicant must amend this wording to clarify the identification. However, 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). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and/or services from one existing class to another. 37 C.F.R. §2.85(d); see TMEP §§1402.07(a), 1904.02(c).

Accordingly, any amendment must identify goods and/or services within the original International Class identified only. See TMEP §§1402.01(c), 1402.07(a). Such an amendment would be compared to the original identification and the international class in the application as filed to ensure that it does not broaden the scope of the original identification. See TMEP §§1402.07(a), 1904.02(c). Identifications may be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07(a).

In the alternative, applicant may wish to delete the unacceptable wording from the identification. However, once an application has been expressly amended to delete goods and/or services, those items may not be later re-inserted. TMEP §1402.07(e).

Applicant may also submit a request to correct the identification in the international registration. Such a request must be filed with the International Bureau in accordance with the requirements of the Common Regulations under the Madrid Agreement and Protocol. See TMEP §1906.01(f).

Requests for correction and notices of correction are not considered responsive to an Office action issued by the USPTO. Applicant must file a complete response within six months of the date of issuance of the Office action to avoid abandonment of the U.S. application. See 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03.

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.

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 §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirement 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.

/Jason F. Turner/  
Examining Attorney  
Law Office 108  
(571) 272-9353  
(571) 273-9108 (Fax for Official Responses)  
[jason.turner@uspto.gov](mailto:jason.turner@uspto.gov) (See a

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](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](mailto: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: Mar 24, 2012

78100213

**DESIGN MARK**

**Serial Number**  
79100213

**Status**  
REGISTERED

**Registration Number**  
4107393

**Date Registered**  
2012/03/06

**Type of Mark**  
TRADEMARK

**Register**  
PRINCIPAL

**Mark Drawing Code**  
(2) DESIGN ONLY

**Owner**  
Obshchestvo s ogranichennoi otvetstvennostiou "Korporatsia  
"Sibirskoe zdorovie" Soci  t     responsabilit   limit  e RUSSIAN FED.  
RU-630004 ul. Lenina, 48, Novosibirsk, RUSSIAN FED.

**Goods/Services**  
Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050.  
G & S: Posters; almanacs; stationery; stickers; pamphlets in the  
field of promotion of active dietary supplements and skin care  
products; calendars; note books; greeting cards; postcards; cardboard  
articles, namely, card board packaging; catalogues providing  
information about active dietary supplements and skin care products;  
newsletters in the field of promotion of active dietary supplements  
and skin care products; graphic prints; signboards of paper or  
cardboard; envelopes; labels, not of textile, namely, adhesive labels;  
forms, printed; writing instruments; newspapers; books in the field of  
health promotion; booklets in the field of health promotion; manuals  
in the field of usage of active dietary supplements and skin care  
products; writing cased sets comprising writing instruments; paper;  
periodicals in the field of health promotion; prospectuses in the  
field of health promotion; bags, envelopes and pouches of paper or  
plastics, for packaging.

**Description of Mark**  
The mark consists of the following: a large fruit-bearing apple tree  
lined in light brown over white.

**Colors Claimed**

**Print: Mar 24, 2012**

**78100213**

The color(s) light brown, white is/are claimed as a feature of the mark.

**Filing Date**  
2011/06/10

**Examining Attorney**  
FAIRBANKS, RON

