

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

U.S. APPLICATION SERIAL NO. 79144288

MARK: TRIMEGAVITALS

79144288

CORRESPONDENT ADDRESS:

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APPLICANT: Obschestvo s ogranichennoy; otvetstvenno
ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1196253

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

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.

SUMMARY OF ISSUES that applicant must address:

- Identification of Goods
- Explanation of Mark's Significance Required

SEARCH RESULTS

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).

IDENTIFICATION OF GOODS

INTERNATIONAL CLASS 3

The wording "amber," "balms other than for medical purposes," "cosmetic dyes," "fumigation preparations," "scented water," and "toiletries" in the identification of goods must be clarified because the wording is too broad and could include goods in other international classes. See TMEP §§1402.01, 1402.03.

Also, the identification of goods contains brackets. 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 brackets from the identification of goods and/or incorporate the parenthetical information into the description.

In addition, the word "kits" in the identification of goods is indefinite and must be clarified. See TMEP §§1401.05(a), 1402.01, 1402.03. However, the international classification for the wording "kits" cannot be changed from the classification assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(d). Further, any amendment to the identification must be within the scope of the goods and/or services listed in the request for extension of protection to the United States. See 37 C.F.R. §§2.71(a), 7.25(a); TMEP §§1402.06(b), 1904.02(b). Therefore, applicant must amend the identification to identify more clearly the type of kits and the principal components within International Class 3, the classification assigned by the International Bureau. See TMEP §1401.05(a).

For kits consisting of a group of items that share a common theme, the identification should specify the theme followed by the word "comprising" and a list of the items that make up the kit, setting forth the most dominant items first. Generally, the international class of the kit will be determined by the international class for the majority of items in the kit. Thus, the majority of the items must be classified in International Class 3, if the examining attorney's suggestion accurately reflects the kit's contents.

Applicant may adopt the following identification of goods, if accurate:

Adhesives for cosmetic purposes; after-shave lotions; almond milk for cosmetic purposes; aloe vera preparations for cosmetic purposes; amber **being** perfume; antiperspirant soap; astringents for cosmetic purposes; **body** balms other than for medical purposes; bath salts, not for medical purposes; beauty masks; breath freshening sprays; cakes of toilet soap; cleansing milk for toilet purposes; cosmetics; cosmetic creams; cosmetic dyes **being hair dyes**; cosmetic kits **comprised primarily of preparations for skin care**; cosmetic pencils; cosmetic preparations for baths; cosmetic preparations for eyelashes; cosmetic preparations for skin care; cosmetic preparations for slimming purposes; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; decorative transfers for cosmetic purposes; dentifrices; deodorants for human beings **and** for animals; deodorant soap; depilatories; douching preparations for personal sanitary or deodorant purposes; Eau de Cologne; eyebrow cosmetics; fumigation preparations, **namely**, perfumes; greases for cosmetic purposes; hair colorants; hair lotions; hair spray; hair waving preparations; joss sticks; lip glosses; lipsticks; lotions for cosmetic purposes; make-up; make-up removing preparations; make-up preparations; make-up powder; mascara; massage gels other than for medical purposes; medicated soap; mouth washes, not for medical purposes; nail care preparations; nail polish; neutralizers for permanent waving; oils for cosmetic purposes; oils for perfumes and scents; oils for toilet purposes; perfumery; perfumes; pomades for cosmetic purposes; potpourris; scented **toilet** water; scented wood; shampoos; skin whitening creams; soap; sunscreen preparations; sun-tanning preparations; tissues impregnated with cosmetic lotions; **non-medicated** toiletries; toilet water

INTERNATIONAL CLASS 5

The wording “biological preparations for medical purposes,” “dietary fiber,” “dietetic beverages adapted for medical purposes,” “dietetic substances adapted for medical use,” “enzyme preparations,” “hematogen,” “medical infusions,” “nervines,” “preparations of trace elements for human and animal use,” and “syrups for pharmaceutical purposes” in the identification of goods is indefinite and must be clarified because the nature of the goods is unclear. *See* TMEP §1402.01. Applicant must amend the identification to specify the common commercial name of the goods. If there is no common commercial name, applicant must describe the product and its intended uses. *See id.*

For example, the entries “biological preparations for medical purposes,” “dietary fiber,” “medical infusions,” “nervines,” and “syrups for pharmaceutical purposes” must describe the condition the goods treat. And the entries for “dietetic beverages adapted for medical purposes,” “dietetic substances adapted for medical use,” “enzyme preparations,” “hematogen,” and “preparations of trace elements for human and animal use” must clearly specify the form of the goods, e.g. “herbal teas,” “vitamin supplements,” etc. The examining attorney has made suggested amendments in bold below.

Applicant may adopt the following identification of goods, if accurate:

Albumin dietary supplements; albuminous foodstuffs for medical purposes; albuminous preparations for medical purposes; alginate dietary supplements; aloe vera preparations for pharmaceutical purposes; antioxidant pills; appetite suppressant pills; balms for medical purposes; bath preparations, medicated; biocides; biological preparations for medical purposes, **namely, biological preparations for the treatment of impaired immunity**; by-products of the processing of cereals for dietetic or medical purposes; casein dietary supplements; decoctions for pharmaceutical purposes; diabetic bread adapted for medical use; dietary fiber **to aid digestion**; dietetic beverages, **namely, herbal teas**, adapted for medical purposes; dietetic **sugar substitutes** for medical use; digestives for pharmaceutical purposes; enzyme dietary supplements; enzyme preparations, **namely, enzymes** for medical purposes; flaxseed dietary supplements; flaxseed oil dietary supplements; flour for pharmaceutical purposes; food for babies; glucose dietary supplements; hematogen, **namely, nutritional and dietary supplements formed and packaged as bars**; herbal teas for medicinal purposes; lacteal flour for babies; lecithin dietary supplements; lotions for pharmaceutical purposes; liniments; malted milk beverages for medical purposes; medicinal herbs; medicinal infusions **for treating impaired immunity**; medicinal oils; medicinal roots; medicinal tea; milk ferments for pharmaceutical purposes; mineral food supplements; nervines, **namely, medicinal preparations for the treatment of the nervous system**; nutritional supplements; pharmaceutical preparations for skin care; pollen dietary supplements; preparations of trace elements for human and animal use, **namely, dietary supplements**; propolis dietary supplements; protein dietary supplements; royal jelly dietary supplements; royal jelly for pharmaceutical purposes; slimming pills; syrups for pharmaceutical purposes **for the treatment of indigestion**; vitamin preparations; wheat germ dietary supplements; yeast dietary supplements; yeast for pharmaceutical purposes

An applicant may amend an identification of goods and/or services 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 §1904.02(c)(iv). In an application filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends the identification to a class other than that assigned by the International Bureau, the amendment will not be accepted because it will exceed the scope and those goods and/or services will no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

In addition, in a Section 66(a) application, 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), 1402.01(c). 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); TMEP §§1401.03(d), 1402.01(c).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

EXPLANATION OF MARK’S SIGNIFICANCE REQUIRED

Applicant must specify whether the wording “TRIMEGAVITALS” has any significance in the cosmetic and/or health trade or industry or as applied to the goods and/or services described in the application, or if such wording is a “term of art” within applicant’s industry. *See* 37 C.F.R. §2.61(b); TMEP §814.

Failure to respond to a request for information is an additional ground for refusing registration. *See In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P’ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

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 date on which the USPTO sends this Office action to the International Bureau, 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 §§711, 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 active 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).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those 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. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

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

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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 the Trademark Electronic Application System (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 the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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