

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

U.S. APPLICATION SERIAL NO. 79158222 MARK: ZHIVINKA	 *79158222*
CORRESPONDENT ADDRESS: O.V. Shterz P.O. box 242 RU-630132 Novosibirsk RUSSIAN FED.	CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp -
APPLICANT: Gorokhovskaya Tatyana Germanovna	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS:	

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1230691

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."

The referenced application has been reviewed by the assigned trademark examining attorney.

SEARCH OF OFFICE'S DATABASE OF 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).

However, 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 following issues discussed in this provisional full refusal:

- 1.) Identification of goods amendment required; and
- 2.) Translation of mark required;

Applicant must respond timely and completely to these two issues. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65 (a); TMEP §§711, 718.03.

IDENTIFICATION OF GOODS AMENDMENT REQUIRED

The USPTO has the discretion to determine the degree of particularity needed to clearly identify goods covered by a mark. *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1597 (TTAB 2014) (citing *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods in a U.S. application to be specific, definite, clear, accurate, and concise. TMEP §1402.01; *see In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d at 1597-98; *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm'r Pats. 1954). For this reason, applicant must amend the identification of goods for the reasons indicated below. *See generally* TMEP §§1402.01, 1402.03.

- The wording “balms other than for medical purposes” must indicate the purpose or use of the balms (e.g., skin, hair, lip).
- The wording “cosmetic dyes” must indicate the type of dyes being offered (e.g., beard, hair).
- The wording “cosmetic kits” is too broad. 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. Because the present application was filed under the Trademark Act Section 66(a), the majority of the items must be classified in International Class 3 and cannot be classified in another international class. *See* TMEP §1401.05(a).
- The wording “oils for toilet purposes” is unclear as to the goods being offered.
- The wording “scented water” is too broad and includes goods in other international classes. For example, “scented water for flavoring beverages” is classified in International Class 30, and “scented water for making beverages” is classified in International Class 32.
- The wording “sunscreen preparations” and “toiletries” is too broad and could include medicated goods in International Class 5.
- The identification of goods contains brackets. Generally, parentheses and brackets should *not* be used in identifications because the USPTO generally uses these punctuation marks to indicate goods that have been deleted from registrations. *See* TMEP §1402.12. Therefore, applicant must remove the brackets from the identification of goods and incorporate any bracketed information into the description or delete the bracketed information if unnecessary (as long as the deletion does not broaden the scope of the original identification).

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

Class 3: Adhesives for cosmetic purposes; after-shave lotions; almond milk for cosmetic purposes; aloe vera preparations for cosmetic purposes; amber **perfume**; antiperspirant soap; astringents for cosmetic purposes; balms other than for medical purposes **for use on {indicate nature of balms, e.g., hair, skin, lips}**; 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 **for {indicate purpose, e.g., hair, beards}; make-up kits comprised of cosmetics**; 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; deodorant soap; depilatories; douching preparations for personal sanitary or deodorant purposes **{toiletries}**; eau de cologne; eyebrow cosmetics; fumigation preparations **in the nature of 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 preparations; make-up powder; make-up removing preparations; 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 **{fragrances}**; scented **toilet** water; scented wood; shampoos; skin whitening creams; soap; **cosmetic** sunscreen preparations; **cosmetic** sun-tanning preparations; tissues impregnated with cosmetic lotions; **non-medicated** toiletries; toilet water

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

Please note that once goods are expressly deleted by amendment, they may not be reinserted at a later point in prosecution. *See* TMEP §§1402.06(a), 1402.07(e). Similarly, once an identification has been limited, it cannot be expanded later. *See id.*; *see also In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V. Et Associes*, 21 USPQ2d 1628 (Comm’r Pats. 1991).

Moreover, 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 an 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 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 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).

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

ENGLISH TRANSLATION REQUIRED

Applicant must submit an English translation of the mark. 37 C.F.R. §2.32(a)(9); TMEP §809. The word "ZHIVINKA" is the transliteration of the Russian word живинка. Google Translate, <https://translate.google.com/#ru/en/%D0%B6%D0%B8%D0%B2%D0%B8%D0%BD%D0%BA%D0%B0>. This word means creativity and liveliness in the eyes. See, e.g., Diclib.com, http://www.diclib.com/cgi-bin/d.cgi?p=%D0%B6%D0%B8%D0%B2%D0%B8%D0%BD%D0%BA%D0%B0&page=search&l=en&base=&prefbase=&newinput=1&st=&diff_examples=1&category=cat1#VLasvk1OWck.

The following translation statement is suggested, if accurate:

The English translation of the word "ZHIVINKA" in the mark is "creativity" and "liveliness in the eyes".

TMEP §809.03.

RESPONSE REQUIRED

For this application to proceed toward registration, applicant must explicitly address each requirement raised in this Office action by setting 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 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).

E-mail communications will not be accepted as responses to Office actions; **therefore, do not respond to this Office action by e-mail**. To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/trademarks/teas/index.jsp>. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available at http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp and email technical questions to TEAS@uspto.gov. Please wait 48-72 hours from the issue/mailling date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application.

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>.

For questions about the Office action itself, please contact the assigned trademark examining attorney. All informal communications relevant to this application will be placed in the official application record.

/Andrew Leaser/
Trademark Examining Attorney
Law Office 117
(571) 272-1911
andrew.leaser@uspto.gov

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/>.

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

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Толковый словарь Ефремовой

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живинка

Examples

ж. разг.
1) Живое, творческое начало в чем-л.
2) Блеск, живость (в глазах).

VA Beach Vacation Package

3 Nights in a 1 Bdrm Condo w/ Full Kitchen for \$59 - Not Per

The text was found in the following dictionaries:

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Блеск, живость (в глазах)

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