

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

U.S. APPLICATION SERIAL NO. 79158910

MARK: ENIGMA BY SIBERIAN HEALTH

79158910

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

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1232192

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-1st 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.

APPLICATION NOT ENTITLED TO REGISTER – EARLIER-FILED APPLICATION

The filing date of pending U.S. Application Serial No. 79149779 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. 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 mark in the referenced application. 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.

IDENTIFICATION REQUIRES AMENDMENT

The identification of goods is unacceptable because certain goods are indefinitely worded. See TMEP §§1402.01, 1402.03(a).

Additionally, 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 and/or services that have been deleted from registrations. See TMEP §1402.12. Parenthetical or bracketed 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)." *Id.*

Therefore, applicant must remove the brackets from the identification of goods and incorporate any parenthetical or bracketed information into the description, or delete the information if unnecessary.

Applicant may amend the identification to list only those items that are within the scope of the goods set forth in the application or within the scope of a previously accepted amendment to the identification. See 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

Applicant may change the wording to the following, if accurate [please note that the current unacceptable entries appear italicized, and suggested wording the applicant must provide appears in bold]:

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; 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; *cosmetic kits* **comprised of [indicate the Class 3 cosmetics comprising the kits, e.g., lipstick, lip gloss, mascara]**; 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 or for animals; deodorant soap; depilatory preparations; douching preparations for personal sanitary or deodorant purposes; eau de Cologne; eyebrow cosmetics; *fumigation preparations in the nature of perfumes for use on the body*; greases for cosmetic purposes; hair dyes; 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; perfumes; perfumery; pomades for cosmetic purposes; potpourris; scented water; scented wood; shampoos; skin whitening creams; soap; sunscreen preparations; sun-tanning preparations cosmetics; tissues impregnated with cosmetic lotions; **non-medicated toiletries**; toilet water.

TMEP §1402.01.

PLEASE NOTE: 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 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>.

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. §§2.62(c), 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.

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>.

/Ronald L. Fairbanks/

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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/>.

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

Print: Mar 11, 2015

79148779

Issue: Apr 7, 2015

DESIGN MARK

Serial Number
79149779

Status
PUBLICATION/ISSUE REVIEW COMPLETE

Word Mark
SIBIRIAN HEALTH

Standard Character Mark
Yes

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Obchtchestvo s ogranichennoi otvetstvennostiou "Korporatsia
"Sibirskoe zdorovie" limited liability company RUSSIAN FED. RU-630004
ul. Lenina, 46, Novosibirsk RUSSIAN FED.

Goods/Services
Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S:
Cosmetic creams; cosmetics; dentifrices; oils for cosmetic purposes;
cleansing milk for toilet purposes; lotions for cosmetic purposes;
make-up kits comprised of lipstick, lip gloss; pomades for cosmetic
purposes; potpourris; cosmetic preparations for baths; sunscreen
preparations; perfumery; non-medicated toiletries; cosmetic
preparations for skin care; soap; tissues impregnated with cosmetic
lotions; shampoo.

Goods/Services
Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S:
Medicated supplements containing albumin for foodstuffs for human
consumption; dietetic foods, namely, crackers, bread adapted for
medical purposes; food for babies; dietetic beverages, namely, tea
adapted for medical purposes; confectionery, medicated; nutritional
food additives for medical purposes in the nature of natural food
extracts derived from vegetables; lacteal flour for babies; hematogen,
namely, nutritional supplements formed and packaged as bars; cod liver
oil; medicinal herbs; albuminous preparations for medical purposes;
vitamin preparations; nutritional supplements for the purpose of
alleviating the symptoms associated with teething; dietetic
substances, namely, fibre and plant and herbal extracts adapted for

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medical use; mineral food-supplements.

Goods/Services

Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050. G & S: Stationery; pamphlets in the field of health and wellness; note books; inkstands; writing materials, namely, pens, paper, pencils; printed matter, namely, books, manuals, newsletters in the field of health and wellness; newspapers; books in the field of health and wellness; booklets in the field of health and wellness; printed teaching materials in the field of health and wellness; credit card imprints, non-electric; bags, envelopes and pouches of paper or plastic, for packaging.

Goods/Services

Class Status -- ACTIVE. IC 029. US 046. G & S: Albumen for culinary purposes; broth; caviar; mushrooms, preserved; broth concentrates; jams; fruits, tinned; vegetables, tinned; fish, tinned; meat, tinned; crustaceans, not live; meat extracts; potato flakes; cheese; frozen fruits; fruit, preserved; crystallized fruits; fruit, stewed; jellies for food; fruit jellies; game, not live; edible fats; edible oils; vegetable juices for cooking; milk; vegetables, preserved; vegetables, cooked; vegetables, dried; marmalade; fat-containing mixtures for bread slices; nuts, prepared; eggs; fish, not live; salted fish; potato chips; soups; milk products excluding ice cream, ice milk and frozen yogurt; fruit pulp; raisins; fruit salads; vegetable salads; sausages; tofu; fruit chips; meat; poultry, not live.

Goods/Services

Class Status -- ACTIVE. IC 032. US 045 046 048. G & S: Whey beverages; non-alcoholic fruit juice beverages; non-alcoholic beverages, namely, carbonated beverages; water beverages; cocktails, non-alcoholic; fruit juices; vegetable juices; lemonades.

Filing Date

2014/05/05

Examining Attorney

LOOK, JEFFREY

SIBERIAN HEALTH