

To: Parodi & Parodi Ltda (bruno@lambertpatentlaw.com)
Subject: TRADEMARK APPLICATION NO. 77202820 - TACHÃO DE UBATUBA - 07-070-FP
Sent: 9/17/2007 2:03:45 PM
Sent As: ECOM116@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/202820

MARK: TACHÃO DE UBATUBA

77202820

CORRESPONDENT ADDRESS:

GARY E. LAMBERT
LAMBERT & ASSOCIATES
92 STATE ST
BOSTON, MA 02109-2004

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Parodi & Parodi Ltda

CORRESPONDENT'S REFERENCE/DOCKET NO :

07-070-FP

CORRESPONDENT E-MAIL ADDRESS:

bruno@lambertpatentlaw.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 9/17/2007

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

Search Results

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

Identification of Goods

The wording of the identification of goods is indefinite and must be clarified because it is too broad and could include goods in other international classes. Further, the identification is unacceptably indefinite because the nature of some of the goods is unclear. TMEP §§1402.01 and 1402.03. Applicant may substitute the following wording, if accurate:

Class 29:

Food additives for non-nutritional purposes for use as a flavoring; fruit concentrates and purees used as ingredients of foods; processed bananas in syrup; processed bananas without added sugar; jams; cheese; unflavored and unsweetened gelatin.

Class 30:

Sweets in the nature of banana flavored candies; banana candy bars; chocolate covered bananas; bread; pastries; flavored and sweetened gelatin.

Class 31:

-
Fresh bananas

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

Classification

-
If applicant adopts the suggested amendment of the goods and/or services, then applicant must amend the classification to International Classes 29, 30 and 31. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §§805 and 1401 *et seq.*

Combined Applications

If applicant prosecutes this application as a combined, or multiple-class application, applicant must comply with each of the following for those goods and/or services based on an intent to use the mark in commerce under Trademark Act Section 1(b):

- (1) Applicant must list the goods and/or services by international class with the classes listed in ascending numerical order; and
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>).

37 C.F.R. §2.86(a)(2); TMEP §§810 and 1403.01.

Disclaimers

-
Applicant must insert a disclaimer of the term “UBATUBA” in the application because it describes the geographic place where the applicant is located and thus, where the goods will likely emanate from. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.08(a)(i).

The following is the accepted standard format for a disclaimer:

No claim is made to the exclusive right to use “UBATUBA” apart from the mark as shown. The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Section 2(e) of the Trademark Act, the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a).

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. A disclaimer does not affect the appearance of the applied-for mark.

Significance of Mark

Applicant must specify whether “TACHAO DE UBATUBA” has any significance in the food trade or industry, any geographical significance, or any meaning in a foreign language. 37 C.F.R. §2.61(b).

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Karen Bracey/
Examining Attorney
Law Office 116

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office Action should be filed using the Office's Response to Office action form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Parodi & Parodi Ltda (bruno@lambertpatentlaw.com)
Subject: TRADEMARK APPLICATION NO. 77202820 - TACHÃO DE UBATUBA - 07-070-FP
Sent: 9/17/2007 2:03:47 PM
Sent As: ECOM116@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 9/17/2007 FOR
APPLICATION SERIAL NO. 77202820

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://portal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77202820&doc_type=OOA&mail_date=20070917 (or copy and paste this URL into the address field of your browser), or visit <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **9/17/2007**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.**