

To: Parodi and Parodi Ltda (bruno@lambertpatentlaw.com)
Subject: TRADEMARK APPLICATION NO. 77202931 - TACHÃO DE UBATUBA DO - 07-071-FP
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/202931

MARK: TACHÃO DE UBATUBA DO

77202931

CORRESPONDENT ADDRESS:

GARY E. LAMBERT
LAMBERT AND ASSOCIATES
92 STATE ST STE 200
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 and Parodi Ltda

CORRESPONDENT'S REFERENCE/DOCKET NO :

07-071-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: 9/22/2007

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

NO CONFLICTING MARKS NOTED

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

IDENTIFICATION OF GOODS

The applicant's goods are: Food additives for non-nutritional purposes for use as a flavoring, ingredient or filler such as banana sweets and fruits in syrup for banana candy bars, chocolate covered banana sweets, banana without sugar added, jams, breads, pastries, cheeses and gelatins.

The phrase "such as banana sweets and fruits in syrup for banana candy bars, chocolate covered banana sweets, banana without sugar added

jams, breads, pastries, cheeses and gelatins” must be amended to clarify that it is a flavoring, ingredient and filler in banana sweets, fruits in syrup, banana flavored candy bars, chocolate covered banana sweets, banana candy without sugar added, jams, breads, pastries, cheeses and gelatins.

If accurate, the applicant may amend to “Food additives for non-nutritional purposes for use as a flavoring in banana sweets, fruits in syrup, banana flavored candy bars, chocolate covered banana sweets, banana candy without sugar added, jams, breads, pastries, cheeses and gelatins” in International Class 30.

The phrase “food additives for non-nutritional purposes for use as an ingredient” must be amended to clarify the ingredient. If accurate, the applicant may amend to “fatty acids for use as a food additive in banana sweets, fruits in syrup, banana flavored candy bars, chocolate covered banana sweets, banana candy without sugar added, jams, breads, pastries, cheeses and gelatins” in International Class 1.

Likewise, the phrase “food additives for non-nutritional purposes for use as a filler” must be amended to specify the food additive that is a filler and has no nutritional value. For instance, the applicant may amend to “fatty acids for use as a food additive for non-nutritional purposes in banana sweets, fruits in syrup, banana flavored candy bars, chocolate covered banana sweets, banana candy without sugar added, jams, breads, pastries, cheeses and gelatins” in International Class 1.

Applicant must amend the identification of goods to specify the common commercial or generic name for the goods. If there is no common commercial or generic name for the product, then applicant must describe the product and intended consumer as well as its main purpose and intended uses. TMEP §1402.01.

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/netathtml/tidm.html>.

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

MULTI-CLASS APPLICATIONS

If the applicant prosecutes this application as a combined, or multiple-class, application, the applicant must comply with each of the following.

- (1) The applicant must list the goods/services by international class with the classes listed in ascending numerical order. TMEP §1403.01.
- (2) The applicant must submit a filing fee for each international class of goods/services not covered by the fee already paid. 37 C.F.R. §§2.6(a)(1) and 2.86(a); TMEP §§810.01 and 1403.01.

The filing fee for adding classes to an application is as follows:

- (1) \$325 per class, when the fees are submitted with a response filed online via the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>; and
- (2) \$375 per class, when the fees are submitted with a paper response.

37 C.F.R. §§2.6(a)(i) and (ii); TMEP §810.

DISCLAIMER

The applicant must insert a disclaimer of “UBATUBA” and “DOCES ARTESANAIS” and “DESDE 1977” in the application. The term UBATUBA refers to a city in Brazil. The applicant’s website shows that the goods come from UBATUBA. The term DOCES ARTESANAIS means ARTISANAL CANDIES. Artisanal candies refers to candies that are made by using traditional methods and in limited quantities. Please see the attached dictionary definitions. DESDE 1977 means SINCE 1977 and is descriptive of the length of time that the partnership has been around. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.08(a)(i). If translated non-English wording must be disclaimed, the actual non-English wording should be disclaimed, not the English translation. TMEP Section 1213.08(d).

The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office can refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a portion of a mark which, 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). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

A “disclaimer” is thus a written statement that an applicant adds to the application record that states that applicant does not have exclusive rights, separate and apart from the entire mark, to particular wording and/or to a design aspect. The appearance of the applied-for mark does not change.

A disclaimer does not remove the disclaimed matter from the mark. It is simply a statement that the applicant does *not* claim exclusive rights in the disclaimed wording or design apart from the mark as shown in the drawing.

The following cases explain the disclaimer requirement more fully: *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983); *In re EBS Data Processing, Inc.*, 212 USPQ 964 (TTAB 1981); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “UBATUBA” and “DOCES ARTESANAIS” and “DESDE 1977” apart from the mark as shown.

See *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

TRANSLATION

The applicant must submit an English translation of all foreign wording in the mark. 37 C.F.R. Section 2.61(b); TMEP section 809. The following is a properly worded translation:

The English translation of TACHO DE UBATUBA is LARGE BOWL FROM UBATUBA. The English translation of DOCES ARTESANAIS is ARTISANAL CANDIES. The English translation of DESDE 1977 is SINCE 1977.

AMENDMENT TO COLOR CLAIM AND COLOR DESCRIPTION

Applicant has submitted a color drawing, a color claim and a color location statement. However, the color claim and color location statement must be amended to accurately describe all the colors. Applications for color marks must include both a list of all the colors that are claimed as a feature of the mark and a description of where each and every color appear in the mark. 37 C.F.R. §2.52(b)(1); TMEP §807.07 *et seq.* Common color names should be used to describe the colors in the mark, e.g., magenta, yellow, turquoise. TMEP §807.07(a)(ii).

In the instant case, the applicant has not described the peach color that appears in the bowl. Moreover, the applicant has not stated that the spoon contains dark brick red and white accents and the applicant has not described the colors in the words DOCES ARTESANAIS and DESDE 1977.

Applicant may amend the statements as follows, if accurate::

- (1) Color claim: **“The colors dark brick red, gold, violet red, peach and white are claimed as a feature of the mark”** ; and
- (2) Color location statement: **“The mark consists of a basically circular logo including an outer ring comprising a dark brick red, a golden ring inside said outer ring; an interior violet red background within which is positioned the terms TACHAO de UBATUBA in white and also a dark brick red bowl including a golden substance with peach swirls and a violet red spoon with dark brick red and white accents lodged within said substance, below which is a golden sash including the violet red terms Doces Artesanais, and underneath said sash exists the terms Desde 1977 in the color white.”**

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Tanya L. Amos/
Trademark Examining Attorney
Law Office 113
571-272-9423 Telephone
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1-800-786-9199 Trademark Assistance

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.

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Ubatuba

From Wikipedia, the free encyclopedia

Ubatuba is a [Brazilian](#) city, located on the southeast coast of this country, in the state of [São Paulo](#). The population in 2003 was 76,847, its density was 107.93 hab/km² and the area is 712 km².

Ubatuba is linked with the Rodovia Longitudinal or the [BR-101](#) and is also located east of [São Paulo](#) and east/north/east of [Santos](#) and west of [Rio de Janeiro](#). The city lies near the [Tropic of Capricorn](#).

The urban area is mainly concentrated with the Atlantic, the valley areas and the urban area, much of the land mainly to the north are forested and mountainous and forms a part of the [Serra do Mar](#) mountains. It covers 83% of the land as well as the [Serra do Mar State Park](#) and rarely has connecting roads through the mountain range.

A marine park was created under [Projeto Tamar](#) (Project Tamar) to protect the [sea turtles](#). It's an important touristic city, receiving tourists from many parts of Brazil. Ubatuba features over 70 beaches, some of these are Maranduba, Lázaro, Itamambuca, Vermelha, Grande, Enseada, Perequê, Saco da Ribeira and many more. Ubatuba also features an island named [Anchieta](#) named after [José de Anchieta](#) and is also a preserved area as well since [March 22nd, 1977](#).

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History

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The origin of the name comes from the [Tupi words](#) *uyba*(arrows or canoes) and *tuba* (many). Ubatuba was the place where the Portuguese signed the first treaty of peace of the Americas with the Tupinamba Indians (The Treaty of Peace of Yperoig - Tratado de Paz de Iperoig), a treaty that kept Brazil in Portuguese hands, with only one language and one faith (catholicism). Back in the 16th century the Tupinamba families had been put into slavery by the Portuguese for working in sugar cane plantations along the Southern Shores, in the surroundings of

Statistics	
State:	São Paulo
Metropolitan Regions:	Taubaté (capital)
Founded:	28, October 1637
Area:	712 km²
Population:	76,847 (2004) Ranked 74th
Population density:	107.93hab/km²
Elevation:	3
Postal code:	11680-000
Area/distance code:	(00)55-12
Website:	www.ubatuba.sp.gov.br

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