

To: Foamation Inc. (mkeipdocket@michaelbest.com)

Subject: U.S. TRADEMARK APPLICATION NO. 85690391 - 030450-9004

Sent: 2/11/2015 11:11:15 AM

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

<p>U.S. APPLICATION SERIAL NO. 85690391</p> <p>MARK:</p>	<p align="center">*85690391*</p>
<p>CORRESPONDENT ADDRESS: LORI S MEDDINGS MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVE STE 3300 MILWAUKEE, WI 53202-4108</p>	<p align="center">CLICK HERE TO RESPOND TO THIS I http://www.uspto.gov/trademarks/teas/response VIEW YOUR APPLICATION FILE</p>
<p>APPLICANT: Foamation Inc.</p>	
<p>CORRESPONDENT'S REFERENCE/DOCKET NO : 030450-9004 CORRESPONDENT E-MAIL ADDRESS: mkeipdocket@michaelbest.com</p>	

OFFICE ACTION

ISSUE/MAILING DATE: 2/11/2015

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on October 20, 2014.

The following refusals are withdrawn:

- Phantom Mark Refusal under Sections 1 and 45, 15 U.S.C. §§1051, 1127; TMEP §1214.01;
- Multiple Marks Refusal under Sections 15 U.S.C. §§1051, 1127; 37 C.F.R. §2.52; TMEP §807.01 (however, please see advisory)
- Ornamental Refusal under Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127
- Request for Information

For the reasons set forth below, the refusal is now made FINAL under Trademark Act Sections 1, 2, and 45 for failure to function as a trademark as used on the specimen(s) of record. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); see TMEP §1202.02(b)(i).

In addition, the following requirement(s) are now made FINAL: (1) Amended drawing accurately depicting the mark; (2) Amended mark description accurately describing the mark; (3) An acceptable specimen of use. See 37 C.F.R. §2.63(b).

In response to the refusal on the basis that applicant's mark constitutes non-distinctive product design, applicant argues that the mark is not product design but rather, is a "unique combination of color and textured pattern on the surface of its variously configured products." Applicant declined to request amendment to the Supplemental Register and no claim of acquired distinctiveness under Section 2(f) has been made of record. Additionally, applicant did not address the requirement for an amended drawing and an amended mark description and did not address the issue of the non-matching specimen, a requirement that was the subject of the Final refusal of July 7, 2013.

Accordingly, applicant's arguments have been considered and found unpersuasive for the reasons set forth below.

Refusal – Non-Distinctive Product Design

The refusal is now made FINAL because the applied-for mark consists of a nondistinctive product design or nondistinctive features of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); see TMEP §1202.02(b)(i).

A product design can never be inherently distinctive as a matter of law; consumers are aware that such designs are intended to render the goods more useful or appealing rather than identify their source. See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. at 212-13, 54 USPQ2d at 1068-69; *In re Slokevage*, 441 F.3d at 962, 78 USPQ2d at 1399. Thus, consumer predisposition to equate a product design with its

source does not exist. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. at 213, 54 USPQ2d at 1069.

Applicant attached numerous prior registrations to support the view that its mark is analogous to marks that have been previously registered. However, unlike the examples that applicant has provided, applicant's mark constitutes a material composition that is used to form the myriad products in the identification of goods. This is clear from the images in applicant's response on p. 4. *Applicant's Response of 10/20/2014* at p.4. These goods are clearly made from the foam shown as a swatch in the drawing of record and do not appear to be similar to the repeated patterns displayed in the registered marks applicant referenced. The applicant's examples are clearly inapposite in nature to applicant's mark, which is the concept of products made of foam that has been processed to resemble cheese. None of the examples proffered are marks consisting of the material that composes the goods formed to resemble a recognizable substance like cheese. It is also notable that most of these registrations contain 2(f) claims or are allowed onto the Supplemental register.

Not only is applicant's evidence unconvincing, but the contention that the mark is not a configuration of the goods is also unpersuasive. Applicant has characterized its mark as a "unique combination of color and textured pattern on the surface of its variously configured products." *Applicant's Response of 10/20/2014* at p.10. Yet, the evidence of record along with applicant's specimens and images of products (p.4) provided with the response clearly show that the goods are formed or molded from foam whereby air is inserted to create shapes of products that resemble cheese. These are not merely textures applied to goods and are not in any way analogous to the registrations relied upon. The images of applicant's products clearly show that they have a 3 dimensional shape created from the contours created by the random holes in the foam. The unique shape of the resulting products forms the mark, not the material used. Here, each product forms a uniquely different mark. Thus, the drawing clearly indicates product design, which is never inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); see TMEP §1202.02(b)(i).

To further illustrate the lack of distinctiveness, attached are more examples showing the common occurrence of cheese shaped products. Specifically, there are the novelty cheese knives that feature handles that look as though they are made of cheese, a cheese knife set in a holder in the shape of a cheese wedge, silicone cell phone holders made to appear composed of cheese as well as a serving plate similarly configured. In addition, please note examples of cheese configurations in goods such as knife blades, an animal hideaway and a wooden cutting board. See *attached Internet evidence*.

This evidence shows that the consumer routinely encounters cheese shaped products and that this configuration is in no way novel or source identifying. Accordingly, the refusal for failure to function because the mark is non-distinctive product design is now made FINAL.

Drawing Requirement Made Final

Applicant has presented a swatch drawing to represent numerous goods are different shapes for a material composition of the goods. In the prior Office action, applicant was required to submit a drawing indicating the shape of the goods. Applicant has declined to do so. Therefore, the requirement for a drawing showing the placement of the mark on the goods is now made FINAL.

For marks consisting of a configuration of the goods or a specific design feature of the goods, the drawing must depict a single three-dimensional view of the goods, showing in solid lines those features that applicant claims as its mark. See 37 C.F.R. §2.52(b)(2); TMEP §§807.10, 1202.02(c)(iv); *In re Minn.*

Mining & Mfg. Co., 335 F.2d 836, 839, 142 USPQ 366, 368-69 (C.C.P.A. 1964). If the mark cannot be adequately depicted in a single rendition, applicant must file a petition to the Director requesting that the requirement to provide a single rendition of the mark be waived. TMEP §807.10.

If the drawing of the mark includes additional matter not claimed as part of the mark (e.g., matter that shows the position or placement of the mark), applicant must depict such matter using broken or dotted lines, here the overall shape of the goods. 37 C.F.R. §2.52(b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §§807.08, 1202.02(c)(i); see *In re Water Gremlin Co.*, 208 USPQ 89, 91 (C.C.P.A. 1980).

Advisory – Drawing Amendment and Potential Multiple Marks Refusal; Disparate Goods

In order to properly capture the nature of the configuration of the mark, the drawing must capture the precise shape of the goods. However, an applicant may apply for only one mark in a single application. 37 C.F.R. §2.52; TMEP §807.01; see, e.g., *In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999); *In re Hayes*, 62 USPQ2d 1443, 1445-46 (TTAB 2002). Therefore, applicant is advised that drawings of each item in the identification of goods will likely raise the issue of multiple marks and the application will likely be refused because applicant will be seeking registration of multiple marks.

In addition, applicant is advised that due to the disparate goods, the mark may be refused as failing to function as a trademark to identify and distinguish all of applicant's goods from those of others, and to indicate the source of applicant's goods. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; see TMEP §1202.02(f)(i).

Slight variations in appearance of a mark comprising a three-dimensional product design may be acceptable if all products in a product line or series have a "consistent overall look" such that (1) the product design conveys a single and continuing commercial impression, and (2) any changes to the product design do not alter its distinctive characteristics. TMEP §1202.02(f)(i); cf. *Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 173, 57 USPQ2d 1125, 1131 (3d Cir. 2000) (quoting *Rose Art Indus., Inc. v. Raymond Geddes & Co.*, 31 F. Supp. 2d 367, 373, 49 USPQ2d 1180, 1184 (D.N.J. 1998), *rev'd on other grounds sub nom. Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 57 USPQ2d 1125 (3d Cir. 2000)) (requiring a party seeking protection under Trademark Act Section 43(a) for unregistered trade dress of a series or line of products to establish a "consistent overall look" for the trade dress of those products).

Amended Mark Description Required – Made Final

In addition to these drawing requirements, applicant must also submit a clear and concise description of the mark that does the following:

- (1) Indicates that the mark is a three-dimensional configuration of the goods or their packaging or of a specific design feature of the goods or packaging;
- (2) Specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark; and
- (3) Specifies any elements which are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.

See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 178 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii).

Specimen Refusal – Made Final

The requirement for a matching specimen is now made FINAL. See 37 C.F.R. §2.63(b).

The current specimens fail to show the applied-for mark in the drawing in use in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). Specifically, the specimen presents the mark in specific shapes representing specific products; however, the drawing displays the mark as displays the mark as a pattern of holes in yellow foam.

The drawing shows the mark sought to be registered, and must be a substantially exact representation of the mark as used on or in connection with the goods and/or services, as shown by the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a). Because the mark in the drawing is not a substantially exact representation of the mark on the specimen, applicant has failed to provide the required evidence of use of the applied-for mark in commerce on or in connection with applicant's goods and/or services. See TMEP §807.12(a).

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for goods include tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, and displays associated with the actual goods at their point of sale. See TMEP §§904.03 *et seq.* Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. TMEP §904.03(i).

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a [new drawing of the mark](#) that agrees with the mark on the specimen and, if appropriate, an amendment to the color claim and/or mark description that conforms to the new drawing.
- (2) Submit a different specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark or a substantially exact representation of the mark in the drawing in actual use in commerce for the goods and/or services identified in the application.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/J3.jsp>.

Advisory – File Will Be Returned to the TTAB

Applicant is advised that the file will be returned to the TTAB upon issue of this Subsequent Final and the appeal will resume. TBMP §1209.01; TMEP §715.04(b). Any further request for reconsideration of the application must be made via a request for remand, for which good cause must be shown. *See* TBMP §§1204, 1207.02; TMEP §715.04(b).

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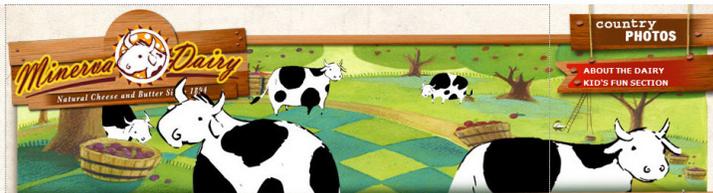
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All informal e-mail communications relevant to this application will be placed in the official application record.

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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Playful Yellow Cheese Handle!

Boska Cheese Knife

The Cheese Knife Cheesy has a playful yellow handle with cheese holes and a stainless steel blade with a fork tip. Serve with semi-hard cheese on any cheese board for a nice and light-hearted presentation. Functional yet fun for enjoying cheese with friends. Makes a unique gift for cheese lovers. Dishwasher safe.

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CHEESE SET CHEESY



DESCRIPTION	USAGE	RECIPE
Cheesy		
<p>The Cheesy cheese set includes a cheese slicer and a cheese grater. With this slicer and grater you can handle any semi-hard to hard cheese. The "cheesy" handles provide a bit of added joy in the kitchen. They also fit comfortably in your hand and are very easy to use. A bonus: they are both dishwasher-friendly.</p>		
<p>In Stock: ✓</p> <p>\$12.99</p> <p>Qty: <input type="text" value="1"/> Add to Cart</p> <p> f t g+ p </p>		

Additional Information

Nr: 357697

Material: Plastic, stainless steel

Type of cheese: For semi hard to very hard cheese





Weight: 0.66 lbs
Dimension: 7,48 x 5,12 x 0,59
Dishwasher: No

More from the Dutch Collection



Cheese Knife Cheesy
\$4.99
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Cheese Set Taste 4 pcs
\$49.99
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PARTY PIC SET CLOG YELLOW



DESCRIPTION | **USAGE** | **RECIPE** | Party Pic Set Clog

Yellow

This fun party pic set includes a wooden clog plus six party picks in the shape of cheese -- perfect for serving cheese cubes and other snacks.

This set is part of the Fun with Cheese Collection, offering a typical Dutch experience to any gathering. Party picks and wooden shoe are dishwasher safe.

In Stock: ✓

\$19.99

Qty: **Add to Cart**

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Additional Information

Nr: 853705

Weight: 0.44 lbs

Dimension: 5.51" x 2.76" x 3.15"

Dishwasher: Yes



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♥ Favourite

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Item Details

★★★★★ (28)

Shipping & Policies

Fun, fun, fun set of cheese knives, depicting a wedge of holey cheese as the stand, and a whole team of six cheeky little mice as the handles.

Each little fellow is in a different position.

Yet another item that I adore, and if it doesn't sell quickly, I'm keeping it ha-ha !!!

Absolutely excellent condition, although a couple of the knives have been used.

Hand painted and finished.

No makers mark.

Size - 4 inches (10 cm) wide approx. and 4.75 inches (12.2 cm) tall approx.

I also have the matching cracker storage container - see item

<https://www.etsy.com/uk/listing/187723008/vintage-cracker-or-biscuits->

♥ Favourite

Like this item?

Add it to your favourites to revisit it later.



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FOB Price: US \$2.09 - 3.19 / Piece | [Get Latest Price](#)
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Supply Ability: 1000000 Piece/Pieces per Month
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Place of Origin:	Guangdong China (Mainland)	Brand Name:	Leacore	Model Number:	B1600186
Material:	Silicon	Compatible Brand:	Apple iPhones	Color:	Black, Yellow, Pink, Hot Pink, Blue, Gree...
Type:	housing cases, 3d cases, cartoon case	Features:	durable, Shockproof, Water Resistant	Design:	Patterned, cute, Plain
Product:	3d silicone for iphone 5s case	Compatible Model:	For iphone 5/5s	Other Material:	TPU
customized:	Support OEM				

Packaging & Delivery

Business Detail: Transparent photo box, blister, retail box, other

Verified Supplier - Shenzhen Leacore Technology Co., Ltd.
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Experience: Established 2012
Performance: 87.8% Response Rate

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5 Piece/Pieces

Leopard Print Flip cell phone case For iPhone
US \$1.15 - 2.5 / Piece
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Pink leopard print skin rhinestone for iPhone 5/5s
US \$1.15 - 2.5 / Piece



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Quantity: 2 available / 2 sold

Price: **US \$11.99**

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Shipping: **\$1.99** Economy Shipping

Delivery: Estimated between **Tue, Feb. 3** and **Mon, Feb. 16**
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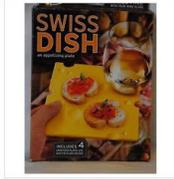
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\$83.00 Buy It Now



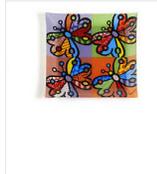
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Min. Order Quantity: 500 Piece/Pieces
Supply Ability: 500,000 Piece/Pieces per Quarter
Port: Xiamen
Payment Terms: LC,TT,Western Union

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Quick Details

Type:	Ornaments	Place of Origin:	Fujian China (Mainland)	Brand Name:	Designcrafts4u
Model Number:	CC0104	Material:	Ceramics	Color:	Assorted
Style:	cute	Use:	Garden Decoration	Feature:	Eco-Friendly
Certificate:	SGS/EN71/REACH	Name:	Ceramic cheese & cracker house small...	Logo Print:	Your logo
MOQ:	500PCS	Package:	1PC/Box	Port:	Xiamen, China

Packaging & Delivery

Packaging Detail: Bulk Packing; Individual Box Packing; Gift Box Packing. Welcome customized requirement as well.
Delivery Detail: 45-55 days. It also depends on products and quantity.

Verified Supplier - Xiamen Designcrafts4u Industrial Co., Ltd.
China (Mainland) | Contact Details
Key Strengths: Assessment Report by Bureau Veritas
Top 3 Markets: North America 29.74%, Oceania 13.97%, Northern Europe 12.30%
Experience: Established 2007, 25 years OEM

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To: Vanessa Chen

Message:

Your message must be between 20-8000 characters

Quantity: Piece/Pieces

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CHEESY KNIFE AMSTERDAM



DESCRIPTION | **USAGE** | **RECIPE** | **Cheesy Knife**

Amsterdam

With the Amsterdam Cheesy Knife you can easily cut the softest cheese. The less contact between knife and cheese, the easier it is to cut. Hence the Swiss cheese pattern on the blade. The ergonomic Soft Grip+ design of the handle provides additional grip and control during cutting. You're in control of the cheese. Super convenient: the combination of plastic and stainless steel makes this knife dishwasher safe.

In Stock: ✔

\$14.99

Qty: [Add to Cart](#)

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Additional Information

Nr: 307413

Material: Stainless steel, plastic, TPE soft plastic

Type of cheese: for soft and semi hard cheese





Weight: 0,15 lbs
Dimension: 3,15 x 0,79 x 11,42
Dishwasher: Yes

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To: Foamation Inc. (mkeipdocket@michaelbest.com)
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