

ESTTA Tracking number: **ESTTA388602**

Filing date: **01/15/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196926
Party	Defendant Dorfman-Pacific Co.
Correspondence Address	MICHAEL JAMES CRONEN ZIMMERMAN & CRONEN LLP 1330 BROADWAY, SUITE 710 OAKLAND, CA 94612-2506 UNITED STATES mcronen@zimpatent.com
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Date	01/15/2011
Attachments	CronDecExhD.pdf ( 9 pages )(864307 bytes )

**To:** Dorfman-Pacific Co. ([cj.prescott@verizon.net](mailto:cj.prescott@verizon.net))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77965616 - CAPPELLI STRAWORLD - T-1888  
**Sent:** 6/23/2010 6:15:00 PM  
**Sent As:** ECOM105@USPTO.GOV  
**Attachments:** Attachment - 1  
Attachment - 2  
Attachment - 3  
Attachment - 4

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

**APPLICATION SERIAL NO.** 77965616

**MARK:** CAPPELLI STRAWORLD

**\*77965616\***

**CORRESPONDENT ADDRESS:**

CHARLES J. PRESCOTT  
CHARLES J. PRESCOTT, P.A.  
2033 WOOD ST STE 115  
SARASOTA, FL 34237-7926

**CLICK HERE TO RESPOND TO THIS LETTER:**  
<http://www.uspto.gov/teas/eTEASpageD.htm>

**APPLICANT:** Dorfman-Pacific Co.

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:**

T-1888

**CORRESPONDENT E-MAIL ADDRESS:**

[cj.prescott@verizon.net](mailto:cj.prescott@verizon.net)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 6/23/2010

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.

**SUMMARY OF ISSUES:**

- Loss of TEAS-Plus, \$50.00 fee required
- Translation requirement for the word “Cappelli”
- Disclaimer of “Cappelli”

**NO CONFLICTING 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).

**INFORMALITIES:**

The applicant must respond to the following issues.

**LOSS OF TEAS-PLUS STATUS - \$50.00 FEE REQUIRED:**

Applicant must submit an additional application processing fee of \$50 per class because the application as filed did not meet the TEAS Plus application filing requirements. *See* 37 C.F.R. §§2.6(a)(1)(iv), 2.22(a), (b); TMEP §§819.01 *et seq.*, 819.04. Specifically, the following application filing requirement was not met: a translation of all non-English wording in the mark was not provided;

The additional fee is required even if applicant later corrects these application requirements.

**TRANSLATION REQUIREMENT:**

Applicant must submit an English translation of all foreign wording in the mark. 37 C.F.R. §2.32(a)(9); *see* TMEP §809. In the present case, the wording “**CAPPELLI**” requires translation.

The following translation statement is suggested: “The English translation of **CAPPELLI** in the mark is **HAT**.” TMEP §809.03.

*See attachments.*

**DISCLAIMER OF “CAPPELLI”:**

Applicant must disclaim the descriptive wording “**CAPPELLI**” apart from the mark as shown because it merely describes the fact that applicant sells hats. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). Indeed, the Italian word “cappelli” means “hat.” *See attachments.*

The English translation of non-English wording that is descriptive, deceptively misdescriptive, geographically descriptive, or generic in connection with the identified goods and/or services, is an unregistrable component of the mark. TMEP §1213.08(d); *see Bausch & Lomb Optical Co. v. Overseas Fin. & Trading Co.*, 112 USPQ 6, 8 (Comm'r Pats. 1956). Therefore, it is subject to a proper disclaimer requirement in the same way that the English version of such wording would be subject to a disclaimer. *See* TMEP §§1213.03(a), 1213.08(d).

The format for the disclaimer statement must refer to the actual non-English wording that appears in the mark, not the English translation of that wording. TMEP §1213.08(d). A properly worded disclaimer would thus read as follows:

**No claim is made to the exclusive right to use “CAPPELLI” apart from the mark as shown.**

*See* TMEP §1213.08(a)(i).

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.

/Simon Teng/  
Simon Teng  
Trademark Examining Attorney  
United States Patent Trademark Office  
Law Office 105  
571-272-4930 Telephone

**TO RESPOND TO THIS LETTER:** Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by (1) an individual applicant; (2) someone with legal authority to bind applicant (i.e., a corporate officer, a general partner, all joint applicants); or (3) an authorized attorney, if one is appointed to represent applicant.

**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 Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, 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/teas/eTEASpageE.htm>.



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# cappelli

**Italian** [[edit](#)]

**Noun** [[edit](#)]

**cappelli** m

1. Plural form of [cappello](#).

Category: Italian plurals

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## cappello

**Italian** [\[edit\]](#)

**Noun** [\[edit\]](#)

**cappello** *m* (plural *cappelli*)

1. 

**Anagrams** [\[edit\]](#)

- » [coppella](#)

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## **IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION**

**Your trademark application (Serial No. 77965616) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on 6/23/2010 to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:**

1. Read the Office letter by clicking on this [link](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77965616&doc_type=OOA&)  
[http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77965616&doc\\_type=OOA&](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77965616&doc_type=OOA&)

**OR** go to <http://tmportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact [TDR@uspto.gov](mailto:TDR@uspto.gov).

**PLEASE NOTE:** The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. Contact the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. Respond within 6 months, calculated from 6/23/2010 (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) [Response to Office Action form](#). If you have difficulty using TEAS, contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

### **ALERT:**

**Failure to file any required response by the applicable deadline will result in the ABANDONMENT (loss) of your application.**

**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.**