

TTAB

Our Reference: STAC-100-TM

TRADEMARK

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

Applicant: Stacked Wines LLC
Serial Number: 85/129,206
Filing Date: September 14, 2010
International Class Number: 033
Examining Attorney/Law Office: Scott K. Bibb/109
Mark: STACKED, and design

NOTICE OF APPEAL TO THE TRADEMARK TRIAL AND APPEAL BOARD

MAIL STOP TTAB FEES

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Applicant, by and through its attorneys, hereby appeals to the Trademark Trial and Appeal Board from the decision dated May 4, 2012 of the Examining Attorney's final refusal to withdraw his disclaimer requirement and register the above-identified trademark.

The Applicant has also submitted a Request for Reconsideration of this matter to the Examiner (copy attached).

10/25/2012 SWILSON1 00000013 250115 85129206

01 FC:6403 100.00 DA



10-24-2012

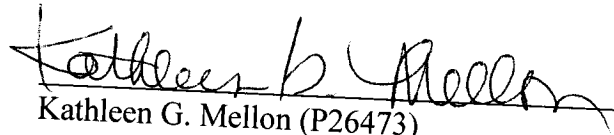
U.S. Patent and Trademark Office #72

85/129,206

October 19, 2012

Please deduct \$100.00 from Deposit Account No. 25-0115 to cover the cost of the appeal.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kathleen G. Mellon". The signature is written in a cursive style and is positioned above the printed name.

Kathleen G. Mellon (P26473)
Attorney and Authorized Agent for Applicant

YOUNG BASILE HANLON &
MACFARLANE, P.C.
3001 W. Big Beaver Rd., Ste. 624
Troy, MI 48084-3107
Telephone: 248-649-3333
Facsimile: 248-649-3338
KGM/jas

Your Request for Reconsideration after Final Action Was Submitted Successfully

Success!

[View/Save E-Receipt as PDF file](#)

We have received your form for serial number **85129206**. You can open and save a PDF version of the filing receipt by clicking on the button, above, and this will serve as your official confirmation copy. We will also separately send an e-mail summary of the form to "smith@youngbasile.com". For electronically submitted forms, the USPTO will not mail an additional paper confirmation.

NOTE: Do **NOT** send a duplicate paper copy of this filing to the USPTO, as it will interfere with the proper processing of the electronic submission.

Thank you.

TEAS Support Team

STAMP: USPTO/RFR-50.77.196.9-20121019133207046845-85129206-490124b0613fe5b92271a346f495456fe-N/A-N/A-20121019131613047171



Trademark Electronic Application System (TEAS) service
U.S. Patent and Trademark Office
Please refer questions or comments to: teas@USPTO.gov

PTO Form 1930 (Rev 9/2007)
 OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85129206
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	

REQUEST FOR RECONSIDERATION

The Examiner has continued his requirement that Applicant disclaim "STACKED" apart from the mark as shown. The Applicant again respectfully requests the Examiner reconsider this requirement. The Examiner states "STACKED" merely describes a feature of the Applicant's goods and therefore, must be disclaimed. The Applicant has filed a Notice of Appeal to the Trademark Trial and Appeal Board regarding this requirement. After review of this Request for Reconsideration, the Applicant believes the Examiner should withdraw this requirement.

The Applicant acknowledges that its wine is currently packaged in vertically arranged wine glasses, however this packaging has been designed to reflect the brand name, not the goods. The Applicant respectfully submits that the Examiner is incorrect when he claims this is a feature of the Applicant's goods (wine) and therefore needs to be disclaimed. It would be different if the Applicant's mark were "FRUITY" or "MELLOW" or "AGED TO PERFECTION" or "OAKY" or some other term involving the taste/character of the actual goods. The mark, STACKED, does not relate to the actual goods (wine) and is arbitrary for wine. The Applicant could appreciate the Examiner's position more perhaps if the goods were identified as "wine in vertically arranged glasses," however, that is not the case. The Applicant has cleverly packaged its wine in a bottle shaped configuration of individual servings. This packaging has nothing to

do with the character of the actual goods but is merely a marketing tool to sell Applicant's product. The goods can, and perhaps will, be sold in other containers/configurations but the actual goods, sought to be protected under this "STACKED" mark, is wine, not the packaging. The Examiner has perused the websites (attached to the Office Action) and has found that, while Applicant's goods are packaged in a particular manner, the Applicant has also made an effort to create an excellent product. One of its partners has extensive experience in creating and making wine and every effort is being made to create products that are remarkable within a reasonable price point. Also, the packaging is not referred to as STACKED packaging but as VINOWARE. The patent pending packaging will be used, licensed and, perhaps, sold under the VINOWARE mark. The wines will always be STACKED wines. This term does not describe an ingredient or a feature of the Applicant's goods (wine). While the goods are currently packaged in a manner that may be "vertically arranged glasses" that does not relate to the goods themselves (wine) as the goods do not have to be packaged in that manner. The goods are STACKED wines in a VINOWARE container.

The cases cited by the Examiner do not support his current position. In the case, In re Oppedahl & Larson LLP, 71 USPQ2D 1370 (CAFC 2004) the mark at issue was PATENTS.COM for computer software for managing and tracking a database of records, namely patent applications and issued patents. Clearly, this mark, PATENTS.COM, describes a database for searching patent records. In the case, In re DIAL-A-MATTRESS Operating Corporation, 57 USPQ2d 1807 (CAFC 2001), the Applicant was trying to register 1-888-M-A-T-T-R-E-S-S as a service mark for telephone shop at home for services in the field of mattresses. The Court found the mark was descriptive as it immediately conveyed the impression that a service relating to mattresses is available by calling the phone number. The Applicant's mark, STACKED, does not convey the impression that wine is involved. A feature of Applicant's goods is not described. The mark may describe the current manner of packaging but not the goods.

Finally, in In re Steelbuilding.com, 75 USPQ2d 1420 (CAFC 2005), the Court found

STEELBUILDING .COM was descriptive for designing metal (steel) buildings with an interactive system. In the case now before the Examiner, the term, STACKED, is not descriptive of the goods (wine). Therefore, the Applicant should not be required to add a disclaimer.

Recently, the Board affirmed the Examining Attorney's requirement for a disclaimer of the term, FRESH, in the case of In re Farr's Fresh, Inc., U.S. Application Serial No. 77/762/425. The situation can be distinguished from the instant case now before the Examiner. In the cited case, the Applicant's mark was FARR'S FRESH as a service mark for frozen dessert store services. The Examiner found a definition of "fresh" was "recently made" and also was used by other third parties in the frozen dessert retail store industry to designate items as newly-made.

The difference between this cited situation and the Applicant's mark is that the mark "FRESH" was an ingredient of the actual goods/services. The goods were newly made and the mark FRESH would always necessarily describe these services. There were even third parties found who used this term for these services. The Applicant's STACKED, and design mark is not an ingredient of the actual goods – (wine), nor are there third parties who use the term STACKED to describe their wine. The Applicant is creating a product (wine) and the packaging in which the product is now sold may utilize the brand name (mark) in the manner of its design, however, this is not a critical element of the goods (wine) as the term FRESH was for the frozen desserts. It would be as if a mark for restaurant services was the DUNGEON and the restaurant would be decorated like a dungeon. This term should not have to be disclaimed for restaurant services.

In the response to the Examiner's first Office Action, the Applicant stated it could find no instance where a mark had to be disclaimed as it related to the packaging but not the goods. The Examiner did not present any cases where this had been done. When searching the database, Applicant did find U.S. Registration No. 3,986,990 for SUPER STACKER (Attachment A). The goods are plastic storage containers for commercial use. Even in this instance, the Registrant did not have to disclaim "STACKER" even though it is fairly clear from the specimens that the

containers “stack” or are containers arranged in a vertical manner. Nevertheless, no disclaimer was required. What if the goods in U.S. Registration No. 3,986,990 were underwear or tools or widgets and the mark SUPER STACKERS was placed on the goods (as the specimen shows).

To require the Applicant in that case to disclaim SUPER STACKERS for widgets or underwear would be ridiculous as requiring a disclaimer of STACKED for wine. As the Applicant set forth in its first office response, it would be as if a mark for clothing was EVERGREEN, with a tree design and the goods were packaged in evergreen shaped boxes, requiring the disclaimer of “EVERGREEN.” Or, for the mark STAR, and design, for work tools and the goods packaged in a box in the shape of a star requiring a disclaimer of “STAR.” In these examples, there should be no disclaimer either. The mark is for the goods and must be on the goods or the packaging containing the goods. The way the package or container is designed is not relevant to the registration of the mark (STACKED) for the goods (wine).

This requirement is not only unnecessary, but is prejudicial to the Applicant. The Examiner is imposing a disclaimer requirement on the Applicant which has no relationship to the actual goods (wine). This requirement may adversely affect Applicant’s rights in the future and 15 U.S.C. § 1056(b) states this cannot be done. In the May 4, 2012 Office Action, the Examiner responds to Applicant’s concerns on page 4 with the statement:

“However, a disclaimer does not physically remove the disclaimed matter from the mark, but rather is a written statement that Applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing. TMEP §§1213, 1213.10.”

This may be okay if the goods were stacked wine glasses but they are not. The goods are wines. If the Applicant has to disclaim “STACKED,” it would allow others to claim they could use STACKED for wine. The Applicant would not have a claim for infringement of its mark by users of the disclaimed portion. See WWP, Inc. v. Wounded Warriors, Inc., 88 USPQ2d 1045

(D. Ct. Neb. 2008). The Applicant selected this arbitrary term for wine and to require a disclaimer because of the manner of current packaging is highly unfair and very prejudicial to the Applicant. As stated in the first response, another party is free to use “stacked containers,” “stacked bottles,” “vertically stacked wine glasses” or other versions of “stacked” to describe their packaging, however, another party should never be able to use STACKED to refer to actual wine as this is the Applicant’s trademark for such goods. To require such a disclaimer would enable others to use the arbitrary term STACKED for wines. This is patently unfair.

The Applicant respectfully submits the Examiner is incorrect in his requiring a disclaimer of STACKED as this term does not describe one significant (nor even one insignificant) function, attribute or property of WINE. Others can/do sell wine in individual servings or stacked glasses but others should not be able to refer to the goods (wine) as STACKED wine.

There is no question that the Applicant is selling quality wine for a reasonable price and also has packaged this wine in a unique, patent pending manner. The packaging is separate from the wine and, as noted previously, this packaging is being sold/licensed to others under the VINOWARE mark (not the STACKED, and design mark).

The mark STACKED is not a generic term for wine. The mark STACKED is not a descriptive term for wine. The mark STACKED, and design, functions as a trademark for wine. A disclaimer of STACKED would be a concession that the term disclaimed is merely descriptive of the goods (wine) (see McCarthy on Trademarks 19:65 at Pg. 19-216 and 19-217) which is not accurate. The Applicant will therefore be prejudiced by entry of this disclaimer as others will be able to use this mark on wines and Applicant will have no recourse. 15 U.S.C. §1056(b) states this cannot be done. Others may use “stacked” to describe their packaging but others should not be able to use this term for wine. Requiring a disclaimer in this instance is unwarranted and severely prejudicial to this Applicant.

Therefore, Applicant respectfully requests the Examiner withdraw this requirement and allow

Applicant's mark to proceed to registration.

EVIDENCE SECTION

**EVIDENCE
FILE NAME(S)**

evi_50771969-131613047 .
STAC100TM AttachmentA_20121019_00023735 .pdf

DESCRIPTION OF EVIDENCE FILE

a U.S. Registration and specimens for said registration

SIGNATURE SECTION

RESPONSE SIGNATURE

/Kathleen G. Mellon/

SIGNATORY'S NAME

Kathleen G. Mellon

SIGNATORY'S POSITION

Authorized Attorney and Agent for Applicant

SIGNATORY'S PHONE NUMBER

2448-649-3333

DATE SIGNED

10/19/2012

AUTHORIZED SIGNATORY

YES

**CONCURRENT APPEAL NOTICE
FILED**

NO

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

Serial Number: 85129206

Class # 1

Evidence: evi_50771969-131613047 . STAC100TM AttachmentA 20121019_00023735 .pdf

[Back](#)

United States of America

United States Patent and Trademark Office

SUPER STACKER

Reg. No. 3,986,990

Registered June 28, 2011

Int. Cls.: 20 and 21

TRADEMARK

PRINCIPAL REGISTER

ADVANTUS, CORP. (FLORIDA CORPORATION)
SUITE 203
10556 N. PORT WASHINGTON ROAD
MEQUON, WI 53092

FOR: PLASTIC STORAGE CONTAINERS FOR COMMERCIAL OR INDUSTRIAL USE, IN CLASS 20 (U.S. CLS. 2, 13, 22, 25, 32 AND 50).

FIRST USE 3-31-2011; IN COMMERCE 3-31-2011.

FOR: PLASTIC STORAGE CONTAINERS FOR HOUSEHOLD USE, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 3-31-2011; IN COMMERCE 3-31-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SUPER", APART FROM THE MARK AS SHOWN.

SN 85-044,741, FILED 5-21-2010.

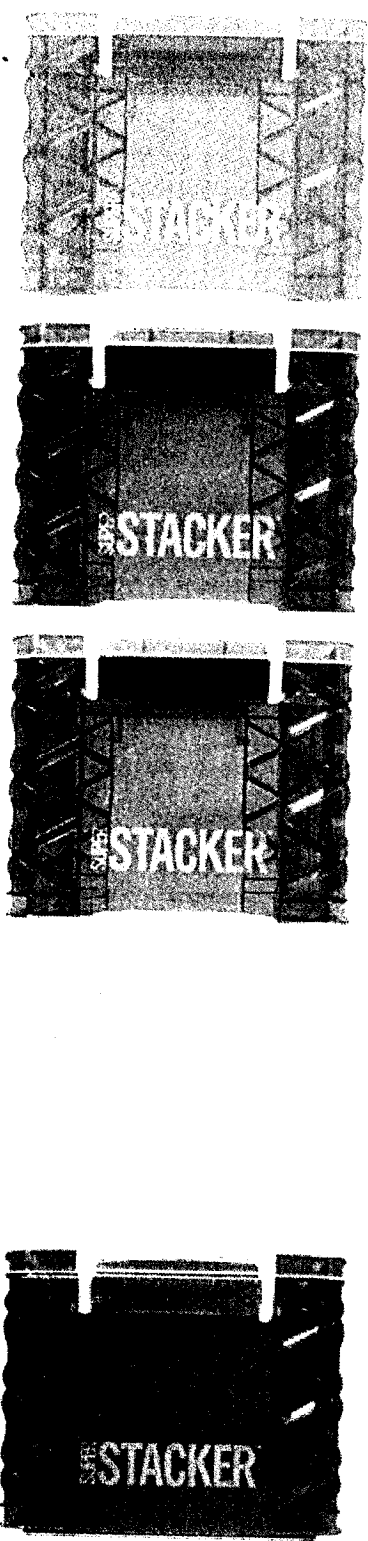
MARY I. SPARROW, EXAMINING ATTORNEY



A handwritten mark resembling the letter 'A', consisting of a vertical line on the left, a vertical line on the right, and a horizontal line across the middle, with a diagonal line from the top left to the bottom right.

David J. Kapp

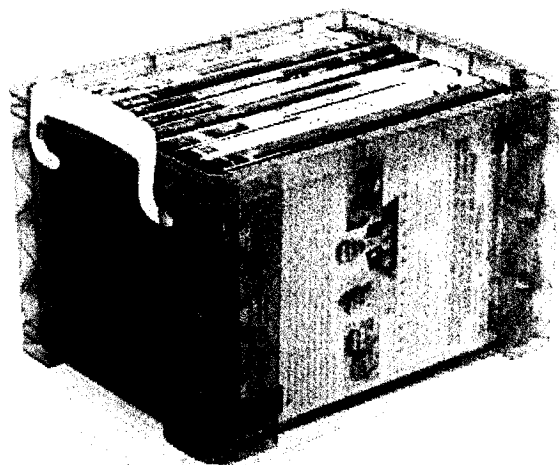
Director of the United States Patent and Trademark Office



SUPER STACKER™

IDEAL FOR STORING:

- Media (DVDs, Video Games, CDs)**
- School Supplies**
- Craft Supplies**
- Greeting Cards & Envelopes**
- Office Supplies**
- Toiletries**
- Car Clutter**
- Kitchen Items**
- Hardware**
- And More!**



Advantus Corp. • Jacksonville, FL 32223 USA • Made in China • www.advantus.com