

# **BULKY DOCUMENTS**

(exceeds 300 pages)

**Proceeding/Serial No:** 91161373

**Filed:** 03-20-2006

**Title:** Opposer's Request to Substitute Exhibits to it's Brief in Opposition to Applicant's Notion for Partial Summary Judgment, and, in the alternative, Motion to Reopen.

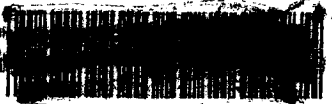
**Part 3 of 3**

# **Incoming Correspondence Routing Sheet**

**To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET**

**Word Mark: BARILLA - AMERICA'S PREFERRED PASTA**

**Serial No: 78136708**



**Mail Date: 11142003**



**Doc. Type: Responses to Office Actions**



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**No Fee**

**RAM Mail Date: 111403**



U.S. Patent and Trademark Office (USPTO)

NOTICE OF ALLOWANCE

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 703-746-3400. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: Mar 15, 2005

G. Franklin Rothwell  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

ATTORNEY  
REFERENCE NUMBER  
  
2778-132

**\*\* IMPORTANT INFORMATION: 6 MONTH DEADLINE \*\***

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at <http://www.uspto.gov/teas/index.html> (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

The following information should be reviewed for accuracy:

SERIAL NUMBER: 78/136708  
MARK: BARILLA - AMERICA'S PREFERRED PASTA  
OWNER: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO                      Section 1(b): YES                      Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

030 - PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

---

ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS



**Drawing Page**

**Serial Number:**

78136708

**Applicant:**

Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PR Italy 43100

**Goods and Services:**

PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

**Mark:**

BARILLA - AMERICA'S PREFERRED PASTA

NO OCR

06-18-2002

\*\*\* User: dspruill \*\*\*

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	39	4	35	14	0:01	"barilla alimentare"[on]
02	1609	N/A	0	0	0:04	*b\$l1r{v}l\$l1{v}*[bi,ti]
03	223	0	223	67	0:11	2 and "030"[cc] not dead[ld]
04	34385	N/A	0	0	0:06	*m{v}r{v}{"ckqx"}a*[bi,ti]
05	1017	N/A	0	0	0:11	*{"fh"}avor{v}t*[bi,ti]
06	8369	N/A	0	0	0:02	*be{"sz"}t*[bi,ti]
07	1530	N/A	0	0	0:01	*pre{"fp"}\$ler*[bi,ti]
08	23850	N/A	0	0	0:04	("1" one*)[bi,ti]
09	1325	N/A	0	0	0:01	*pa{"sz"}ta*[bi,ti]
10	901	N/A	0	0	0:01	4 and (5 6 7 8 9)
11	23	13	10	2	0:01	9 and (5 6 7 8)
12	214	0	214	69	0:10	10 and "030"[cc] not dead[ld]

Session started 10/11/02 9:29:16 AM  
Session finished 10/11/02 9:44:24 AM  
Total search duration 0 minutes 53 seconds  
Session duration 15 minutes 8 seconds

Default NEAR limit= 1 ADJ limit= 1



Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
[www.uspto.gov](http://www.uspto.gov)

Mar 3, 2004

### NOTICE OF PUBLICATION UNDER 12(a)

- |                                      |   |
|--------------------------------------|---|
| 1. Serial No.:<br>78/136,708         | 2. Mark:<br>BARILLA - AMERICA'S PREFERRED PASTA |
| 3. International Class(es):<br>30    |   |
| 4. Publication Date:<br>Mar 23, 2004 | 5. Applicant:<br>Barilla Alimentare S.p.A.      |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: (202) 512-1800

By direction of the Commissioner.

Correspondence Address:

G. Franklin Rothwell  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

TMP&I

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136708

APPLICANT: Barilla Alimentare S.p.A.

CORRESPONDENT ADDRESS:

G. Franklin Rothwell  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

RETURN ADDRESS:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
**ecom112@uspto.gov**

MARK: BARILLA - AMERICA'S PREFERRED PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-132

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/136708

This letter responds to the applicant's communication filed April 15, 2003.

STATUS OF THE APPLICATION

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

REFUSAL

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229

USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, TMEP §1209.03(s):

#### 1209.03(s) Slogans

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

The wording AMERICA'S PREFERRED PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (PREFERRED), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of *selected* excerpts of stories taken from LEXIS/NEXIS® computerized database, listing the terms and PREFERRED PASTA (the examining attorney also attaches selected excerpts of stories featuring the terms AMERICA'S FAVORITE PASTA). See the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2 (e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the term AMERICA'S with other descriptive matter disclaimed. See the attached enclosure.<sup>[1]</sup> Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911

(TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of "AMERICA'S FAVORITE PASTA" is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill  
Trademark Attorney  
Law Office 112  
(703) 308-9112, Ext. 203  
darryl.spruill@uspto.gov  
/Darryl M. Spruill/

#### **RESPONSE GUIDELINES**

The applicant may respond via regular mail to the address listed above, or via e-mail to [Ecom112@uspto.gov](mailto:Ecom112@uspto.gov). In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;
2. send the response to [mailto:ecom112@uspto.gov](mailto:mailto:ecom112@uspto.gov). E-mail sent to any other address will N processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG forma NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to [Comments@uspto.gov](mailto:Comments@uspto.gov).

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

**EVIDENCE**

108B8C

Print Request: Selected Document(s): 1,4,5,7,11,13,15,17,23,25

Time of Request: June 17, 2003 08:32 PM EDT

Number of Lines: 224

Job Number: 1842:0:4166801

Client ID/Project Name:

Research Information:

US Newspapers and Wires

"preferred pasta"

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1 of 25 DOCUMENTS

Copyright 2002 The Honolulu Advertiser (Honolulu, HI)  
All Rights Reserved  
The Honolulu Advertiser (Honolulu, HI)

November 17, 2002 Sunday

**SECTION:** TAB; Pg. 12T

**LENGTH:** 1641 words

**HEADLINE:** HAWAII'S BEST RESTAURANTS

**BYLINE:** Adams Wanda; Gray Matthew, Staff

**BODY:**

...atmosphere.

Menu: The classic Italian American restaurant spread begins with a large pasta menu that allows you to match your **preferred pasta** to a variety of sauces, from pomodoro to bordelaise (there's a helpful illustrated guide to pasta styles on the menu). Other dishes ...

4 of 25 DOCUMENTS

Copyright 2002 New Times Los Angeles, LP  
New Times Los Angeles (California)

April 25, 2002 Thursday

**SECTION:** Dining/Columns

**LENGTH:** 1095 words

**HEADLINE:** The Buddha of Sawtelle  
Japan Bistro Blue Marlin in West L.A.

**BYLINE:** By Stephen Lemons

**BODY:**



...spaghetti, and a delicious eggplant and wild mushroom concoction. There's also a sausage, bacon and vegetable spaghetti we're salivating to try, and a manila clam spaghetti we're longing to shove our snout into one day.

Our **preferred pasta** is the barbecued eel, sansai and wild mushroom spaghetti. The barbecued eel has a sweet taste similar to catfish, we think, and Ikemizu coaxes the flavor out of it by cooking the eel, mushrooms, sansai and De ...

5 of 25 DOCUMENTS

Copyright 2001 The Miami Herald  
All Rights Reserved  
The Miami Herald

December 14, 2001 Friday FINAL EDITION

**SECTION:** WEEKEND; Pg. 36G

**LENGTH:** 911 words

**HEADLINE:** PAMPERED CHEF IS MIAMI LAKES' HIDDEN GEM

**BYLINE:** FABIOLA SANTIAGO, fsantiago@herald.com

**BODY:**

...aglio olio (\$14.95), fresh shrimp sauteed in a very tasty white wine and garlic sauce. That, too, came with linguine, the **preferred pasta** here as it is light and cooked to just the right texture.

**MEATY CHOICES**

The carni section includes an impressive list of meats - from ...

7 of 25 DOCUMENTS

Copyright 2000 Post-Standard, All Rights Reserved.

The Post-Standard (Syracuse, NY)

April 30, 2000 Sunday Final Edition

SECTION: CNY; Pg. AA2

LENGTH: 1008 words

HEADLINE: ADAPTING TO THE WAYS OF AMERICA LINDA YU DOESN'T FORSAKE THE CUISINE OF HER NATIVE TAIWAN

BYLINE: Jim Emmons Staff writer

BODY:

...childhood was different - more wedded to rice-based dishes of southern China. But Yu's parents came from northern China and **preferred pasta**-based dishes.

11 of 25 DOCUMENTS

Copyright 1999 Sun-Sentinel Company  
Sun-Sentinel (Fort Lauderdale, FL)

August 1, 1999, Sunday, Broward Metro EDITION

SECTION: SUNSHINE MAGAZINE, Pg. 24

LENGTH: 1366 words

HEADLINE: CULIANAROS: A GREEK ODYSSEY

BYLINE: BY JUDITH STOCKS

BODY:

...restaurant, Culinaros, in 1997, Vogiatzis spent a lot of time adapting those family recipes to American tastes.

"Americans **preferred pastas** cooked softer," he says, diplomatically, .and heavier sauces."

13 of 25 DOCUMENTS

Copyright 1998 Times Publishing Company  
St. Petersburg Times (Florida)

November 19, 1998, Thursday, 0 South Pinellas Edition

**SECTION:** FOOD; TIDBITS; TASTE; Pg. 6D

**LENGTH:** 584 words

**HEADLINE:** TIDBITS

**BODY:**

...a flat noodle), "losyns" (lasagna) and "papdele." The last name has puzzled historians, though it's clearly pappardelle, still the **preferred pasta** to go with hare in Italy, as it was in 14th century England. English ravioli goes back even a ...

15 of 25 DOCUMENTS

Copyright 1997 The Buffalo News  
Buffalo News (New York)

May 11, 1997, Sunday, FINAL EDITION

**SECTION:** VIEWPOINTS, Pg. 3H

**LENGTH:** 769 words

**HEADLINE:** POLITICS MAY LEAVE DEMOCRATS STARVING

**BYLINE:** Bob McCarthy

**BODY:**

...announced his Republican bid for Hamburg supervisor, some local Dems are looking elsewhere for their weekly ziti fix.

The **preferred pasta** place to please political palates?

A few yards down Seneca Street at DiTondo's -- which, by the way, has never ...

17 of 25 DOCUMENTS

Copyright 1996 Palm Beach Newspaper, Inc.  
Palm Beach Post (Florida)

January 25, 1996, Thursday, FINAL EDITION

**SECTION:** FOOD, Pg. 4FN, KITCHEN COUNSELOR

**LENGTH:** 734 words

**HEADLINE:** CAREFULLY CONTROL HEAT OF PAN WHEN CARAMELIZING SUGAR

**BYLINE:** GHOLAM RAHMAN

**BODY:**

...green paste. Put the paste in a bowl and gradually drip in the oil. Mix well and set aside.

The preferred pasta with pesto is trenette, a long, flat dried pasta. Here is a technique you can use to make the sauce adhere better to the ...

23 of 25 DOCUMENTS

Copyright 1993 St. Louis Post-Dispatch, Inc.  
St. Louis Post-Dispatch (Missouri)

January 4, 1993, MONDAY, FIVE STAR Edition

**SECTION:** FOOD; Pg. 14

**LENGTH:** 419 words

**HEADLINE:** FOODIES REVIEW OF '92

**BODY:**

...puree Roasted or oven-dried tomatoes Romano beans Salsify Sauteed greens Smoked corn Wild mushroom ragouts **Preferred Pastas** Canneloni Lasagne (particularly vegetarian) Noodle pudding or cake Pappardelle Fashionable Fruits Banana Cherry Fig Grilled pineapple ...

25 of 25 DOCUMENTS

Copyright 1988 Newsday, Inc.

Newsday (New York)

August 12, 1988, Friday, CITY EDITION

SECTION: WEEKEND; Pg. 38

LENGTH: 226 words

HEADLINE: TIDBITS: Chicken

BYLINE: Peggy Katalinich

BODY:

...dark-sweet vinegar and rosemary. The calamari is fried tender in a light batter, and the penne with eggplant, mozzarella and tomato is the **preferred pasta**. The only problem with lunch is that the kitchen is still preparing the desserts; stick with fresh fruit and cappuccino.

108B8C

Print Request: Selected Document(s): 5-8,10,13,16

Time of Request: June 17, 2003 08:15 PM EDT

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Research Information:

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5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.  
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

**SECTION:** LIFESTYLE / FOOD; Pg. F06

**LENGTH:** 449 words

**HEADLINE:** SAUCE IT UP, VEGAN STYLE

**COLUMN:** NATURALLY YOURS

**BYLINE:** JAN WOLFF

**BODY:**

...your spaghetti, and if you're a vegan, you may still  
crave a sprinkling of Parmesan now and then. What's left to put on  
America's favorite pasta? Plain old tomato sauce can get tiresome, even  
if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.  
PR Newswire

April 24, 1998, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO FOOD, NATIONAL AND FEATURES EDITORS

**LENGTH:** 301 words

**HEADLINE:** Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998  
**LEXIS-NEXIS Related Topics Full Article Related Topics Overview**

This document contains no targeted Topics.

**DATELINE:** NEW YORK, April 24

**BODY:**

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of **America's favorite pasta** dish is based on consumer research as well as pasta's history in the U.S.," said Julia Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

**SECTION:** FOOD, Pg. J10

**LENGTH:** 475 words

**HEADLINE:** Beard awards nominees

**BODY:**

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, **America's Favorite Pasta**" by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS



Copyright 1995 Sentinel Communications Co.  
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

**SECTION:** FLORIDA; Pg. 18

**LENGTH:** 861 words

**HEADLINE:** FOR YOUNG TASTE BUDS ONLY

**BYLINE:** By Scott Joseph, Sentinel Restaurant Critic

**BODY:**

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for **Americas favorite pasta.**

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.  
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

**SECTION:** FEATURES; Pg. 3E

**LENGTH:** 806 words

**HEADLINE:** AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

**BYLINE:** Michael Storey

**BODY:**

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with **America's favorite pasta-eating cat** going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company, Los Angeles Times All Rights  
Reserved  
Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

**SECTION:** Business; Part D; Page 1; Column 2; Financial Desk

**LENGTH:** 924 words

**HEADLINE:** FARMERS COUNT ON A NEW CASH CROP: PASTA;  
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH DAKOTA  
WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

**BYLINE:** By GREG JOHNSON, TIMES STAFF WRITER

**DATELINE:** IRVINE

**BODY:**

...plant. We can grow it, mill it and send it through the noodle plant."

**Pasta Popularity**

Spaghetti and linguine are America's favorite pasta products, followed by elbows and twists. Dry pasta retail sales by shape in 1993:

Long goods ( ...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;  
Copyright Business First of Louisville Inc. 1985;  
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATeline: Louisville; KY; US

BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while America's favorite pasta may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

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[1] No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.

2778-132  
GFR: rpd

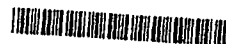


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
)  
Barilla G. E R. Fratelli - ) Examining Attorney:  
Societa Per Azioni ) Darryl M. Spruill  
)  
Serial No. 78/136708 )  
) Trademark Law Office 112  
Filed: June 18, 2002 )  
)  
Mark: BARILLA - AMERICA'S )  
PREFERRED PASTA )

**NOTIFICATION PURSUANT TO 37 C.F.R. § 3.85 AND  
REQUEST FOR ISSUANCE OF  
CERTIFICATE OF REGISTRATION IN NEW NAME**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514



09-10-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #64

Dear Sir:

Applicant wishes to notify the Office that the above-identified applicant has changed its name and address to:

**BARILLA G. E R. FRATELLI - SOCIETÀ PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY**

A request for recordation of the change of name was filed and recorded with the U. S. Patent and Trademark Office on May 18, 2004, at Reel/Frame numbers 002852/0797. Subsequently, an address change was recorded with the U. S. Patent and Trademark Office on August 26, 2004 at Reel/Frame numbers 002923/0924. A copy of the abstract of title is enclosed for your ready reference.

It is requested that the subject application be amended accordingly and that the certificate of registration be issued with Applicant's new name at the appropriate time.

Respectfully submitted,

By

G. F. Rothwell

G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, p.c.  
1425 K Street, N.W. Suite 800  
Washington, D.C. 20005  
Telephone: (202)783-6040

2778-132new.pto



United States Patent and Trademark Office

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Assignments on the Web &gt; Trademark Query

## Trademark Assignment Abstract of Title

## Total Assignments: 2

Serial #: 78136708

Filing Dt: 06/18/2002

Reg #: NONE

Reg. Dt:

Applicant: Barilla Alimentare S.p.A.

Mark: BARILLA - AMERICA'S PREFERRED PASTA

## Assignment: 1

Reel/Frame: 2852/0797

Received: 05/18/2004

Recorded: 05/18/2004

Pages: 3

Conveyance: CHANGE OF NAME

Assignor: BARILLA ALIMENTARE S.P.A.

Exec Dt: 12/24/2003

Entity Type: CORPORATION

Citizenship: ITALY

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO BARILLA 3/A  
PARMA, ITALY

Correspondent: G. FRANKLIN ROTHWELL  
1425 K STREET NW  
SUITE 800  
WASHINGTON, DC 20005

## Assignment: 2

Reel/Frame: 2923/0924

Received: 08/26/2004

Recorded: 08/26/2004

Pages: 4

Conveyance: CHANGE OF ADDRESS

Assignor: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

Exec Dt: 02/12/2004

Entity Type: CORPORATION

Citizenship: ITALY

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY

Correspondent: G. FRANKLIN ROTHWELL  
1425 K STREET NW  
SUITE 800  
WASHINGTON, DC 20005

Search Results as of: 09/10/2004 12:08 PM

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 703-308-9723

Trademark

Serial Number  
(1201)

TRADEMARK

78136708

NEW CASE DELIVERED

OCT 02 2002

LAW OFFICE 101

NEW CASE DELIVERED

SEP 24 2002

LAW OFFICE 101

### PROSECUTION HISTORY

Entry	Date	Initials
1.	OCT - 9, 2002	
2.	OCT 15 2002	
3. <i>Marked</i>	MAY 9 2003	<i>CD</i>
4.	JUN 18 2003	<i>AK</i>
5.		
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30.		

# **Exhibit 16**



774115

# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

July 20, 2005

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE TRADEMARK FILE WRAPPER AND  
CONTENTS OF:**

**TRADEMARK APPLICATION: 78/136,706**

**FILING DATE: June 18, 2002**

**By Authority of the**

**Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office**

*W. Montgomery*  
**W. MONTGOMERY**

**Certifying Officer**



Internet Transmission Date:  
2002/06/18

Serial Number:  
78136706

Filing Date:  
2002/06/18



TRADEMARK APPLICATION

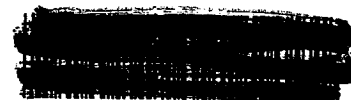
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 133  
RAM ACCOUNTING DATE: 20020619



NO OCR



06-18-2002

<b>DOCUMENT INFORMATION</b>	
<b>TRADEMARK/SERVICEMARK APPLICATION</b>	
<b>VERSION 1.24</b>	
<b>APPLICANT INFORMATION</b>	
NAME	Barilla Alimentare S.p.A.
STREET	Via Mantova 166
CITY	Parma PA
COUNTRY	Italy
ZIP/POSTAL CODE	43100
<b>APPLICANT ENTITY INFORMATION</b>	
CORPORATION: STATE/COUNTRY OF INCORPORATION	Italy
<b>TRADEMARK/SERVICEMARK INFORMATION</b>	
MARK	BARILLA - AMERICA'S #1 PASTA
TYPED FORM	Yes
<b>BASIS FOR FILING AND GOODS/SERVICES INFORMATION</b>	
INTENT TO USE: SECTION 1(b)	Yes
INTERNATIONAL CLASS NUMBER	030
LISTING OF GOODS AND/OR SERVICES	PASTA, PASTA PRODUCTS, SAUCES FOR PASTA
<b>ATTORNEY INFORMATION</b>	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800

78136706

CITY	Washington
STATE	DC
COUNTRY	USA
ZIP/POSTAL CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
ATTORNEY DOCKET NUMBER	2778-126
OTHER APPOINTED ATTORNEY(S)	Robert H. Cameron; Anne M. Sterba
<b>DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT</b>	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800
CITY	Washington
STATE	DC
ZIP CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
<b>FEE INFORMATION</b>	
TOTAL FEES PAID	325
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1

78136706

<b>LAW OFFICE INFORMATION</b>	
E-MAIL ADDRESS FOR CORRESPONDENCE	N/A
<b>SIGNATURE AND OTHER INFORMATION</b>	
SIGNATURE	/Robert H. Cameron/
DATE	06/18/2002
NAME	Robert H. Cameron
TITLE	Attorney for Applicant
<b>MAILING ADDRESS</b>	
LINE	G. Franklin Rothwell, Esq.
LINE	Rothwell, Figg, Ernst & Manbeck, P.C.
LINE	1425 K Street, NW
LINE	Suite 800
LINE	Washington DC 20005
<b>RAM INFORMATION</b>	
RAM SALE NUMBER	133
RAM ACCOUNTING DATE	20020619
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SERIAL NUMBER	78/136706
INTERNET TRANSMISSION DATE	Tuesday, 06-18-2002 16:47:06 EDT
TEAS STAMP	USPTO-12150177130-20020618164722902-78/136706-124de3c7ddbdf84fb36b39936a341f7c902-RAM-133-20020618164622902
E-MAIL ADDRESS FOR	bmanning@rothwellfigg.com

78136706

ACKNOWLEDGMENT

&lt;SERIAL NUMBER&gt; 78136706

&lt;FILING DATE&gt; 06/18/2002

## &lt;DOCUMENT INFORMATION&gt;

&lt;TRADEMARK/SERVICEMARK APPLICATION&gt;

&lt;VERSION 1.24&gt;

## &lt;APPLICANT INFORMATION&gt;

&lt;NAME&gt;

Barilla Alimentare S.p.A.

&lt;STREET&gt;

Via Mantova 166

&lt;CITY&gt;

Parma PA

&lt;COUNTRY&gt;

Italy

&lt;ZIP/POSTAL CODE&gt;

43100

## &lt;APPLICANT ENTITY INFORMATION&gt;

&lt;CORPORATION: STATE/COUNTRY OF INCORPORATION&gt; Italy

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

&lt;MARK&gt; BARILLA - AMERICA'S #1 PASTA

&lt;TYPED FORM&gt; Yes

\* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). \*

## &lt;BASIS FOR FILING AND GOODS/SERVICES INFORMATION&gt;

&lt;INTENT TO USE: SECTION 1(b)&gt; Yes

\* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) \*

&lt;INTERNATIONAL CLASS NUMBER&gt; 030

&lt;LISTING OF GOODS AND/OR SERVICES&gt; PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

## &lt;ATTORNEY INFORMATION&gt;

&lt;NAME&gt;

G. Franklin Rothwell, Esq.

&lt;STREET&gt;

1425 K Street, NW Suite 800

&lt;CITY&gt;

Washington

&lt;STATE&gt;

DC

&lt;COUNTRY&gt;

USA

&lt;ZIP/POSTAL CODE&gt;

20005

&lt;FIRM NAME&gt;

Rothwell, Figg, Ernst &amp; Manbeck, P.C.

<TELEPHONE NUMBER> 202-783-6040  
<FAX NUMBER> 202-783-6031  
<ATTORNEY DOCKET NUMBER> 2778-126  
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

**<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>**

\* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served \*

<NAME> G. Franklin Rothwell, Esq.  
<STREET> 1425 K Street, NW Suite 800  
<CITY> Washington  
<STATE> DC  
<ZIP CODE> 20005  
<FIRM NAME> Rothwell, Figg, Ernst & Manbeck, P.C.  
<TELEPHONE NUMBER> 202-783-6040  
<FAX NUMBER> 202-783-6031

**<FEE INFORMATION>**

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<NUMBER OF CLASSES> 1

**<LAW OFFICE INFORMATION>**

<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

**<SIGNATURE AND OTHER INFORMATION>**

\* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. \*

<SIGNATURE> /Robert H. Cameron/  
<DATE> 06/18/2002

78136706



&lt;NAME&gt;

Robert H. Cameron  
Attorney for Applicant

&lt;TITLE&gt;

## &lt;MAILING ADDRESS&gt;

<LINE> G. Franklin Rothwell, Esq.  
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.  
<LINE> 1425 K Street, NW  
<LINE> Suite 800  
<LINE> Washington DC 20005

## &lt;RAM INFORMATION&gt;

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<RAM ACCOUNTING DATE> 20020619

## &lt;SERIAL NUMBER INFORMATION&gt;

<SERIAL NUMBER> 78/136706  
<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:47:06 EDT  
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E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmannig@rothwellfigg.com

78136706

&lt;SERIAL NUMBER&gt; 78136706

&lt;FILING DATE&gt; 06/18/2002

## &lt;DOCUMENT INFORMATION&gt;

&lt;TRADEMARK/SERVICEMARK APPLICATION&gt;

&lt;VERSION 1.24&gt;

## &lt;APPLICANT INFORMATION&gt;

&lt;NAME&gt;

Barilla Alimentare S.p.A.

&lt;STREET&gt;

Via Mantova 166

&lt;CITY&gt;

Parma PA

&lt;COUNTRY&gt;

Italy

&lt;ZIP/POSTAL CODE&gt;

43100

## &lt;APPLICANT ENTITY INFORMATION&gt;

&lt;CORPORATION: STATE/COUNTRY OF INCORPORATION&gt; Italy

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

&lt;MARK&gt; BARILLA - AMERICA'S #1 PASTA

&lt;TYPED FORM&gt; Yes

\* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). \*

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&lt;LISTING OF GOODS AND/OR SERVICES&gt; PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

## &lt;ATTORNEY INFORMATION&gt;

&lt;NAME&gt;

G. Franklin Rothwell, Esq.

&lt;STREET&gt;

1425 K Street, NW Suite 800

&lt;CITY&gt;

Washington

&lt;STATE&gt;

DC

&lt;COUNTRY&gt;

USA

&lt;ZIP/POSTAL CODE&gt;

20005

&lt;FIRM NAME&gt;

Rothwell, Figg, Ernst &amp; Manbeck, P.C.

&lt;TELEPHONE NUMBER&gt;

202-783-6040

<FAX NUMBER> 202-783-6031  
<ATTORNEY DOCKET NUMBER> 2778-126  
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

**<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>**

\* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served \*

<NAME> G. Franklin Rothwell, Esq.  
<STREET> 1425 K Street, NW Suite 800  
<CITY> Washington  
<STATE> DC  
<ZIP CODE> 20005  
<FIRM NAME> Rothwell, Figg, Ernst & Manbeck, P.C.  
<TELEPHONE NUMBER> 202-783-6040  
<FAX NUMBER> 202-783-6031

**<FEE INFORMATION>**

<TOTAL FEES PAID> 325  
<NUMBER OF CLASSES PAID> 1  
<NUMBER OF CLASSES> 1

**<LAW OFFICE INFORMATION>**

<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

**<SIGNATURE AND OTHER INFORMATION>**

\* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.  
\*

<SIGNATURE> /Robert H. Cameron/  
<DATE> 06/18/2002  
<NAME> Robert H. Cameron  
<TITLE> Attorney for Applicant

78136706

**<MAILING ADDRESS>**

<LINE> G. Franklin Rothwell, Esq.  
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.  
<LINE> 1425 K Street, NW  
<LINE> Suite 800  
<LINE> Washington DC 20005

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<RAM ACCOUNTING DATE> 20020619

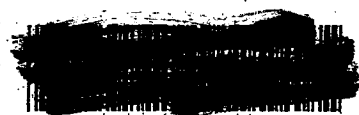
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E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmannig@rothwellfigg.com

Internet Transmission Date:  
2002/06/18

Serial Number:  
78136706

Filing Date:  
2002/06/18



TRADEMARK APPLICATION

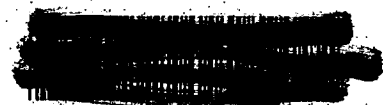
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 133  
RAM ACCOUNTING DATE: 20020619



NO OCR



06-18-2002

May 8, 2003

78136706

2:25 PM

**TYPED DRAWING**

**Serial Number**

78136706

**Filing Date**

Jun 18, 2002

**Status of Application**

RESPONSE AFTER NON-FINAL ACTION - ENTERED

**Register**

PRINCIPAL

**MARK DATA**

**Word Mark**

BARILLA - AMERICA'S #1 PASTA

**Mark Drawing Code**

(1) TYPED DRAWING

**FILING BASIS DATA**

FILED 1(a): NO	CURRENT 1(a): NO	AMENDED 1(a): NO
FILED 1(b): YES	CURRENT 1(b): YES	AMENDED 1(b): NO
FILED 44D : NO	CURRENT 44D : NO	AMENDED 44D : NO
FILED 44E : NO	CURRENT 44E : NO	AMENDED 44E : NO
FILED NO B: NO	CURRENT NO B: NO	

**GOODS AND SERVICES DATA**

**Type of Mark**

TRADEMARK

G & S: Class Status -- ACTIVE. IC 030. US 046. PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

**OWNER DATA**

PARTY TYPE 10 - ENTRY NUMBER 001 - COMPOSED FLAG FALSE

ASSIGNMENT RECORDED: NO

Barilla Alimentare S.p.A.  
CORPORATION

May 8, 2003

78136706

2:25 PM

ITALY  
Via Mantova 166  
Parma PA, ITALY 43100

**OTHER DATA**

**FOREIGN REGISTRATION DATA**

**CORRESPONDENCE DATA**

**Attorney of Record**

G. Franklin Rothwell, Esq.

**Telephone Number**

202-783-6040

**Fax Number**

202-783-6031

**Domestic Representative**

G. Franklin Rothwell, Esq.

**Telephone Number**

202-783-6040

**Fax Number**

202-783-6031

**Correspondence Address**

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

**Telephone Number**

202-783-6040

**Fax Number**

202-783-6031

**Effective Date of Change**

Jun 18, 2002

**Automatic Last Update**

NOT UPDATED

**Attorney Docket Number**

2778-126

**HISTORY OF CORRESPONDENCE CHANGES**

May 8, 2003

78136706

2:25 PM

**PROSECUTION HISTORY**

DATE: 2003/04/15  
COMMUNICATION RECEIVED FROM APPLICANT

DATE: 2003/04/15  
PAPER RECEIVED

DATE: 2002/10/15  
NON-FINAL ACTION MAILED

DATE: 2002/10/08 - PROCEEDING NUMBER: 076731  
ASSIGNED TO EXAMINER

DATE: 2002/10/01 - PROCEEDING NUMBER: 073358  
ASSIGNED TO EXAMINER

DATE: 2002/10/01 - PROCEEDING NUMBER: 076731  
ASSIGNED TO EXAMINER

DATE: 2002/09/28 - PROCEEDING NUMBER: 069249  
ASSIGNED TO EXAMINER

**Examining Attorney**  
SPRUILL, DARRYL  
LAW OFFICE 112



**Drawing Page**

**Serial Number:**  
78136706

**Applicant:**

Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PA Italy 43100




**Goods and Services:**

PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

**Mark:**

BARILLA - AMERICA'S #1 PASTA

  
NO. OCR



06-18-2002

\*\*\* User: dspruill \*\*\* Serial Number: 78057808 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark

AMERICAS FAVORITE PIZZA FEAST

Goods and Services

IC 030. US 046. G & S: Pizza for consumption on or off the premises.  
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

78057808

Filing Date

April 11, 2001

Publication for Opposition Date

January 15, 2002

Registration Number

2558945

Registration Date

April 9, 2002

Owner Name and Address

(REGISTRANT) Domino's Pizza PMC, Inc. CORPORATION MICHIGAN 30 Frank Lloyd  
Wright Drive Ann Arbor MICHIGAN 48106

Prior Registration(s)

1705234;1791773;1825321;AND OTHERS

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA"  
APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Elizabeth F. Janda

\*\*\* Search: 14 \*\*\* Document Number: 2 \*\*\*

\*\* User: dspruill \*\*\* Serial Number: 78039333 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE COOKIE

Goods and Services

IC 030. US 046. G & S: Cookies. FIRST USE: 19980201. FIRST USE IN  
COMMERCE: 19980201

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

78039333

Filing Date

December 14, 2000

Filed ITU

FILED AS ITU

Supplemental Register Date

November 19, 2001

Registration Number

2572410

Registration Date

May 21, 2002

Owner Name and Address

(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE 1105 North  
Market Street, Suite 803 Wilmington DELAWARE 19801

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

2149887

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Live Dead Indicator

LIVE

Attorney of Record

Kathleen J. Gallagher, Esq.

\*\*\* Search: 14 \*\*\* Document Number: 1 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75768708 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE SOUR GUM

Pseudo Mark

AMERICAS FAVORITE SOUR GUM

Goods and Services

IC 030. US 046. G & S: BUBBLE GUM. FIRST USE: 19990615. FIRST USE IN  
COMMERCE: 19990615

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75768708

Filing Date

August 5, 1999

Supplemental Register Date

December 15, 1999

Registration Number

2347915

Registration Date

May 2, 2000

Owner Name and Address

(REGISTRANT) Philadelphia Chewing Gum Corporation CORPORATION  
PENNSYLVANIA Havertown PENNSYLVANIA 190832189

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOUR GUM" APART FROM THE  
MARK AS SHOWN

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Live Dead Indicator

LIVE

Attorney of Record

Harriet E. Perkins

\*\*\* Search: 14 \*\*\* Document Number: 4 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75618178 \*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark

TUMARO'S GOURMET TORTILLAS -- AMERICA'S FAVORITE

Pseudo Mark

TUMAROS GOURMET TORTILLAS AMERICAS FAVORITE

Goods and Services

IC 030. US 046. G & S: tortillas and crepes. FIRST USE: 20000411.  
FIRST USE IN COMMERCE: 20000411

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75618178

Filing Date

January 11, 1999

Filed ITU

FILED AS ITU

Publication for Opposition Date

October 26, 1999

Registration Number

2419870

Registration Date

January 9, 2001

Owner Name and Address

(REGISTRANT) Tumaro's, Inc. CORPORATION CALIFORNIA 5300 Santa Monica  
Boulevard Los Angeles CALIFORNIA 90029

Prior Registration(s)

1893236; 2133513

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GOURMET TORTILLAS -  
AMERICA'S FAVORITE" APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Corrine M. Freeman

\*\*\* Search: 14 \*\*\* Document Number: 5. \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75538444 \*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE

Pseudo Mark

AMERICAS FAVORITE

Goods and Services

IC 030. US 046. G & S: Doughnuts. FIRST USE: 19721003. FIRST USE IN  
COMMERCE: 19721201

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75538444

Filing Date

August 18, 1998

Publication for Opposition Date

April 27, 1999

Registration Number

2263243

Registration Date

July 20, 1999

Owner Name and Address

(REGISTRANT) HDN Development Corporation CORPORATION KENTUCKY 7303  
Turfway Road Florence KENTUCKY 41042

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

JOHN M HARRINGTON

\*\*\* Search: 14 \*\*\* Document Number: 7 \*\*\*

User: dspruill

\*\*\* Serial Number: 75501805 \*\*\*

10/11/02 10:58:14 AM \*



Mark AMERICA'S FAVORITE FOODS PRESTO

Pseudo Mark AMERICAS FAVORITE FOODS PRESTO

Goods and Services  
IC 030. US 046. G & S: pizza crust mix, garlic sauce and cheddar  
sauce. FIRST USE: 19920217. FIRST USE IN COMMERCE: 19920217

Mark Drawing Code  
(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code  
261702 261707

Serial Number  
75501805

Filing Date  
June 15, 1998

Publication for Opposition Date  
September 21, 1999

Registration Number  
2299622

Registration Date  
December 14, 1999

Owner Name and Address  
(REGISTRANT) OHIO PIZZA PRODUCTS INC. CORPORATION OHIO 1522 Manchester  
Road Dayton OHIO 454490127

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE FOODS"  
APART FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL

Live Dead Indicator

\*\*\* Search: 14 \*\*\* Document Number: 8 \*\*\*

(cont)

\*\*\* User: dspruill \*\*\* Serial Number: 75501805 \*\*\*

LIVE

Attorney of Record  
THEODORE D. LIENESCH

\*\*\* Search: 14 \*\*\* Document Number: 8 \*\*\*



\*\*\* User: dspruill \*\*\* Serial Number: 75470400 \*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark  
AMERICA'S FAVORITE CANDIES

Pseudo Mark  
AMERICAS FAVORITE CANDIES

Goods and Services  
IC 030. US 046. G & S: CANDY NOT INCLUDING JELLY BEANS. FIRST USE:  
19851118. FIRST USE IN COMMERCE: 19851118.

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75470400

Filing Date  
April 20, 1998

Publication for Opposition Date  
November 2, 1999

Registration Number  
2359173

Registration Date  
June 20, 2000

Owner Name and Address  
(REGISTRANT) PROMOTION IN MOTION, INC. CORPORATION DELAWARE 3 REUTEN  
DRIVE CLOSTER NEW JERSEY 07624

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CANDIES" APART FROM THE  
MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)

Live Dead Indicator  
LIVE

Attorney of Record  
RICHARD M GOLDBERG

\*\*\* Search: 14 \*\*\* Document Number: 9 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75447700 \*\*\* 10/11/02 10:58:15 AM \*

[Typed Drawing]

Mark  
BEST PIE IN AMERICA

Goods and Services  
IC 030. US 046. G & S: PIES. FIRST USE: 19970100. FIRST USE IN  
COMMERCE: 19970100

IC 042. US 100 101. G & S: RESTAURANT SERVICES. FIRST USE: 19970100.  
FIRST USE IN COMMERCE: 19970100

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75447700

Filing Date  
March 10, 1998

Supplemental Register Date  
October 14, 1998

Registration Number  
2239993

Registration Date  
April 13, 1999

Owner Name and Address  
(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th.  
Avenue Denver COLORADO 80216

Assignment Recorded  
ASSIGNMENT RECORDED

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PIE" APART FROM THE MARK  
AS SHOWN

Type of Mark  
TRADEMARK. SERVICE MARK

Register  
SUPPLEMENTAL

Live Dead Indicator  
LIVE

Attorney of Record  
SABRINA C STAVISH

\*\*\* Search: 14 \*\*\* Document Number: 10 \*\*\*



Mark

BAKERS SQUARE BEST PIE IN AMERICA

Goods and Services

IC 030. US 046. G & S: pies. FIRST USE: 19970400. FIRST USE IN  
COMMERCE: 19970400

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

010103.260117

Serial Number

75300090

Filing Date

May 29, 1997

Filed ITU

FILED AS ITU

Publication for Opposition Date

October 6, 1998

Registration Number

2213980

Registration Date

December 29, 1998

Owner Name and Address

(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th  
Avenue Denver COLORADO 80216

Assignment Recorded

ASSIGNMENT RECORDED

\*\*\* User: dspruill \*\*\* Serial Number: 75300090 \*\*\*

Prior Registration(s)  
1394236;1394428;1403328;2002503

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEST PIE IN AMERICA"  
APART FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)-IN PART

Live Dead Indicator  
LIVE

Distinctiveness Limitation Statement  
as to "BAKERS"

Attorney of Record  
SABRINA C STAVISH

\*\*\* Search: 14 \*\*\* Document Number: 11 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75265223 \*\*\* 10/11/02 10:58:15 AM \*

[Typed Drawing]

Mark  
AMERICA'S BEST

Pseudo Mark  
AMERICAS BEST

Goods and Services  
IC 030. US 046. G & S: iced coffee-based beverages, namely, unflavored iced coffees and coffees with flavorings including cappuccino, hazelnut, French vanilla, Viennese mocha and original chocolate flavors. FIRST USE: 19930200. FIRST USE IN COMMERCE: 19930200

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75265223

Filing Date  
March 27, 1997

Publication for Opposition Date  
July 21, 1998

Registration Number  
2194941

Registration Date  
October 13, 1998

Owner Name and Address  
(REGISTRANT) America's Best Beverage Company, Inc. CORPORATION FLORIDA 35  
Mason Street Greenwich CONNECTICUT 06830

Assignment Recorded  
ASSIGNMENT RECORDED

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)

Live Dead Indicator  
LIVE

Attorney of Record  
MICHAEL I WOLFSON

\*\*\* Search: 14 \*\*\* Document Number: 12 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75222072 \*\*\* 10/11/02 10:58:16 AM \*

[Typed Drawing]

Mark AMERICA'S FAVORITE CHOCOLATE CHIP COOKIE!

Pseudo Mark  
AMERICAS FAVORITE CHOCOLATE CHIP COOKIE

Goods and Services  
IC 030. US 046. G & S: cookies. FIRST USE: 19960400. FIRST USE IN  
COMMERCE: 19960400

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75222072

Filing Date  
January 8, 1997

Filed ITU  
FILED AS ITU

Supplemental Register Date  
January 20, 1998

Registration Number  
2149887

Registration Date  
April 7, 1998

Owner Name and Address  
(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE One South Wacker  
Drive, Suite 2740 Chicago ILLINOIS 60606

Assignment Recorded  
ASSIGNMENT RECORDED

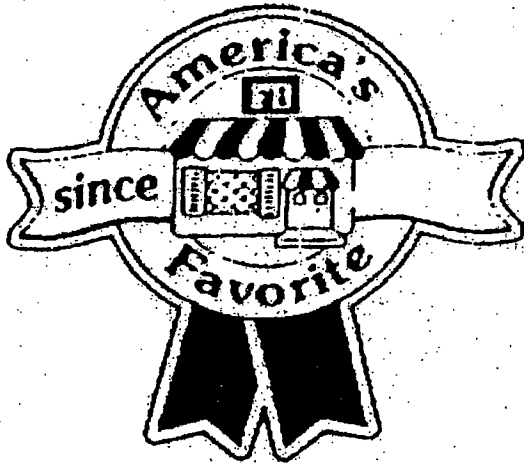
Type of Mark  
TRADEMARK

Register  
SUPPLEMENTAL

Live Dead Indicator  
LIVE

Attorney of Record  
KATHLEEN J GALLAGHER

\*\*\* Search: 14 \*\*\* Document Number: 13 \*\*\*



Mark  
AMERICA'S FAVORITE SINCE FBI

Goods and Services  
IC 030. US 046. G & S: confectionery, namely, candy, caramels,  
marshmallows, marshmallow creme, and fudge. FIRST USE: 19960700. FIRST  
USE IN COMMERCE: 19960700

Mark Drawing Code  
(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code  
070104 240707 240907

Serial Number  
75144931

Filing Date  
August 5, 1996

Publication for Opposition Date  
September 16, 1997

Registration Number  
2119233

Registration Date  
December 9, 1997

Owner Name and Address  
(REGISTRANT) Favorite Brands International, Inc. CORPORATION DELAWARE 75  
Tri State International Lincolnshire ILLINOIS 60069

Assignment Recorded  
ASSIGNMENT RECORDED

Disclaimer Statement

\*\*\* User: dspruill \*\*\* Serial Number: 75144931 \*\*\*

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE SINCE"  
APART FROM THE MARK AS SHOWN

Description of Mark

The mark consists of the design of a canopied building, with the stylized letters "FBI" appearing directly above the building, and the phrase "AMERICA'S FAVORITE SINCE" (followed by a date of origin, which varies from candy to candy), all being enclosed in a banner and seal-with-ribbon design. The lining in the drawing is a feature of the mark, and it is not intended to indicate color.

Type of Mark  
TRADEMARK

Register  
PRINCIPAL

Live Dead Indicator  
LIVE

Attorney of Record  
Paula J. Krasny

\*\*\* Search: 14 \*\*\* Document Number: 14 \*\*\*



\*\*\* User: dspruill \*\*\* Serial Number: 75116367 \*\*\* 10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark  
IT'S AMERICA'S FAVORITE JELLY BEAN

Goods and Services

IC 030. US 046. G & S: jelly beans. FIRST USE: 19890531. FIRST USE  
IN COMMERCE: 19890531

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75116367

Filing Date

June 10, 1996

Publication for Opposition Date

April 15, 1997

Registration Number

2077329

Registration Date

July 8, 1997

Owner Name and Address

(REGISTRANT) HERMAN GOELITZ CANDY CO., INC. CORPORATION CALIFORNIA 2400  
North Watney Way Fairfield CALIFORNIA 94533

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

1604190

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "JELLY BEAN" APART FROM  
THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

JAMES R. CYPHER

\*\*\* Search: 14 \*\*\* Document Number: 15 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75068756 \*\*\* 10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark  
AMERICA'S FAVORITE KETCHUP

Pseudo Mark  
AMERICAS FAVORITE KETCHUP

Goods and Services  
IC 030. US 046. G & S: condiments, namely, ketchup. FIRST USE:  
19920600. FIRST USE IN COMMERCE: 19920600

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75068756

Filing Date  
March 7, 1996

Publication for Opposition Date  
July 1, 1997

Registration Number  
2098790

Registration Date  
September 23, 1997

Owner Name and Address  
(REGISTRANT) H. J. HEINZ COMPANY CORPORATION PENNSYLVANIA 1062 Progress  
Street Pittsburgh PENNSYLVANIA 15212

Assignment Recorded  
ASSIGNMENT RECORDED

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "KETCHUP" APART FROM THE  
MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)

Live Dead Indicator  
LIVE

Attorney of Record  
Dean A. Bierkan

\*\*\* Search: 14 \*\*\* Document Number: 17 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75036522 \*\*\* 10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE SOFT PRETZEL

Goods and Services

IC 030. US 046. G & S: snack foods, namely, soft pretzels. FIRST USE:  
19960300. FIRST USE IN COMMERCE: 19960300

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75036522

Filing Date

December 26, 1995

Filed ITU

FILED AS ITU

Publication for Opposition Date

February 17, 1998

Registration Number

2155994

Registration Date

May 12, 1998

Owner Name and Address

(REGISTRANT) J&J Snack Foods Corp. CORPORATION NEW JERSEY 6000 Central  
Highway Pennsauken NEW JERSEY 08109

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOFT PRETZEL" APART FROM  
THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

J. Rodman Steele, Jr.

\*\*\* Search: 14 \*\*\* Document Number: 18 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75035078 \*\*\* 10/11/02 10:58:18 AM \*

[Typed Drawing]

Mark

AMERICA'S #1 SPICE VALUE

Goods and Services

IC 030. US 046. G & S: spices. FIRST USE: 19950324. FIRST USE IN  
COMMERCE: 19950324

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75035078

Filing Date

December 20, 1995

Publication for Opposition Date

March 11, 1997

Registration Number

2066497

Registration Date

June 3, 1997

Owner Name and Address

(REGISTRANT) ROSE SPICE, INC. CORPORATION DELAWARE 4500 Northchase  
Parkway NE Wilmington DELAWARE 28405

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S #1 SPICE" APART  
FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

WILLIAM J MASON

\*\*\* Search: 14 \*\*\* Document Number: 19 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 74322961 \*\*\* 10/11/02 10:58:18 AM \*

[Typed Drawing]

Mark AMERICA'S FAVORITE HOLIDAY CANDY

Pseudo Mark AMERICAS FAVORITE HOLIDAY CANDY

Goods and Services  
IC 030. US 046. G & S: chocolates and other candy. FIRST USE:  
19921201. FIRST USE IN COMMERCE: 19921201

Mark Drawing Code:  
(1) TYPED DRAWING

Serial Number  
74322961

Filing Date  
October 15, 1992

Filed ITU  
FILED AS ITU

Supplemental Register Date  
December 14, 1993

Registration Number  
1837304

Registration Date  
May 17, 1994

Owner Name and Address  
(REGISTRANT) R. M. PALMER COMPANY CORPORATION PENNSYLVANIA 77 Second  
Avenue West Reading PENNSYLVANIA 19611

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOLIDAY CANDY" APART FROM  
THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
SUPPLEMENTAL

Affidavit Text  
SECT 8 (6-YR).

Live Dead Indicator  
LIVE

Attorney of Record  
John F. McNulty

\*\*\* Search: 14 \*\*\* Document Number: 21 \*\*\*

## America's Favorite Pizza Feast

Mark AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark AMERICAS FAVORITZ PIZZA FEAST

Goods and Services  
IC 030. US 046. G & S: pizza for consumption on or off the premises.  
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code  
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number  
74270458

Filing Date  
April 29, 1992

Filed ITU  
FILED AS ITU

Publication for Opposition Date  
December 15, 1992

Registration Number  
1791773

Registration Date  
September 7, 1993

Owner Name and Address  
(REGISTRANT) Domino's Pizza, Inc. CORPORATION MICHIGAN 30 Frank Lloyd  
Wright Drive P.O. Box 997 Ann Arbor MICHIGAN 481060997

Assignment Recorded  
ASSIGNMENT RECORDED

Prior Registration(s)  
1700700

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA"  
APART FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL

\*\*\* User: dspruill \*\*\* Serial Number: 74270458 \*\*\*

Affidavit Text

SECT 15. SECT 8 (6-YR).

Live Dead Indicator

LIVE

Attorney of Record

JEFFREY P. THENNISCH

\*\*\* User: dspruill \*\*\* Serial Number: 74044195 \*\*\* 10/11/02 10:58:19 AM \*

[Typed Drawing]

Mark

AMERICA'S SNACK FAVORITE

pseudo Mark

americas snack favorite

Goods and Services

IC 030. US 046. G & S: snack cakes. FIRST USE: 19891200. FIRST USE  
IN COMMERCE: 19891200

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

74044195

Filing Date

March 30, 1990

Supplemental Register Date

November 14, 1990

Registration Number

1638019

Registration Date

March 12, 1991

Owner Name and Address

(REGISTRANT) McKee Baking Company CORPORATION TENNESSEE P.O. Box 750  
Collegedale TENNESSEE 37315

(LAST LISTED OWNER) MCKEE FOODS CORPORATION CORPORATION BY CHANGE OF  
NAME FROM TENNESSEE P.O. BOX 750 COLLEGEDALE TENNESSEE 373150750

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

1542109

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Affidavit Text

SECT 8 (6-YR). SECTION 8 (10-YR) 20010618.

Renewal

1ST RENEWAL 20010618

Live Dead Indicator

\*\*\* Search: 14 \*\*\* Document Number: 23 \*\*\*

(cont)



\*\*\* User: dspruill

\*\*\* Serial Number: 74044195 \*\*\*

LIVE

Attorney of Record

DONALD A. KAUL & PATRICIA R. BROWN

\*\*\* Search: 14 \*\*\* Document Number: 23 \*\*\*

**Drawing Page**

**Serial Number:**  
78136706

**Applicant:**

Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PA Italy 43100

**Goods and Services:**

PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

**Mark:**

BARILLA - AMERICA'S #1 PASTA

NO OCR

06-18-2002

# UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136706

OCT 15 2002

APPLICANT: Barilla Alimentare S.p.A.

**CORRESPONDENT ADDRESS:**

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

**RETURN ADDRESS:**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
ecom101@uspto.gov

MARK: BARILLA - AMERICA'S #1 PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-126

CORRESPONDENT EMAIL ADDRESS:

N/A

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

## PRIORITY ACTION

OFFICE SEARCH: 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. Section 1052(d). TMEP section 704.02.

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.** This case will be given priority as an amended case if you respond to the requirements stated below within two months.

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

RE: Serial Number 78/136706

The following issues were discussed in communication with G. Franklin Rothwell on 10/11/02.

**1. IDENTIFICATION OF GOODS -UNACCEPTABLE:**

The identification of goods is indefinite because the applicant uses the wording "products." The identification of goods must be specific. The applicant must amend the identification to specify the common commercial name of the goods or to indicate their nature. The recitation identification must be all-inclusive. The applicant should amend the identification to replace this wording with "namely." The applicant may amend the identification to substitute the following wording, if

accurate: "Pasta, pasta products, namely, [specify the products], sauces for pasta," in International Class 030. 37 C.F.R. Section 2.71(a); TMEP sections 804 and 804.08(c).<sup>1</sup>

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 804.09. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

## **2. DISCLAIMER REQUIREMENT:**

The applicant must disclaim the wording AMERICA'S #1 PASTA in the mark because the wording AMERICA'S is a term having geographical significance combined with #1 a laudatory descriptive term, and PASTA a generic term.

Also, the examining attorney has attached third-party registrations showing the term AMERICA(S) combined with laudatory and generic terms disclaimed. See the attached enclosure. Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Dayco Products-Eagle Motive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP section 1213.09(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use "AMERICA'S #1 PASTA" apart from the mark as shown.



Darryl M. Spruill  
Trademark Attorney  
Law Office 101  
(703) 308-9101, Ext. 170  
darryl.spruill@uspto.gov

<sup>1</sup> Please note that the recommended identification of goods is not exhaustive. The applicant is directed to the Office's searchable database of the Manual of Acceptable Identifications of Goods and Services. The address for this is: <http://www.uspto.gov/web/offices/tac/doc/gsmmanual/>.

**How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>.

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

# Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET

Word Mark: BARILLA - AMERICA'S #1 PASTA

3A

Serial No: 78136706

[REDACTED]

Mail Date: 04152003

[REDACTED]

Doc. Type: Amendments to Response

[REDACTED]

No Fee

RAM Mail Date: 041503

[REDACTED]

RECEIVED

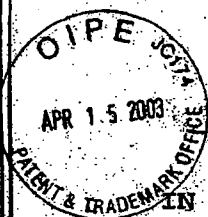
JUN 16 4 10 13

TMO  
LAW OFFICE 112

[Signature]

Examining Attorney: SPRUILL, DARRYL  
Serial Number: 78/136706

2778-126  
GFR:RHC:czb



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Barilla Alimentare S.p.A.

Serial No. 78/136,706

Filed: June 18, 2002

Mark: BARILLA - AMERICA'S #1  
PASTA

Trademark Attorney  
Darryl M. Spruill

Law Office 101

AMENDMENT AND RESPONSE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

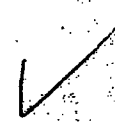
Dear Sir:

Applicant hereby responds to Office Action No. 01 in  
accordance with the headings therein.

IN THE IDENTIFICATION OF GOODS

Kindly amend the identification of goods in the subject  
application as follows:

--PASTA, PASTA PRODUCTS, NAMELY MEALS  
CONSISTING PRIMARILY OF PASTA, MACARONI  
SALAD, PASTA SALAD, SAUCES FOR PASTA in  
International Class 30.--



DISCLAIMER REQUIREMENT

The Office Action has called for Applicant to disclaim the  
wording "AMERICA'S #1 PASTA" apart from the mark as shown. The  
grounds cited are that AMERICA'S has geographical significance,

#1 is a laudatory term and PASTA is a generic term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregistrable components of a mark otherwise registrable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive and does not concede that the term #1 is laudatory in this instance, Applicant respectfully traverses the requirement to disclaim AMERICA'S #1 PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983) ("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA<sup>1</sup>, but obviously creates a commercial impression distinct from that

---

<sup>1</sup> See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.



of its house mark. Professor McCarthy provides an illustrative example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991) ("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S #1 PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S #1 PASTA clearly characterize the well-recognized trademark of Applicant -- in other words, they meld with the

BARILLA registered mark. All of these factors support a determination that Applicant's proposed slogan is a unitary mark. See Dena, 950 F.2d at 1561 (citing TMER § 807.13(a) (rev. 1986)). For the foregoing reasons, Applicant believes that disclaimer of AMERICA'S #1 PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully requested that the subject application be approved for publication.

Respectfully submitted,

By

*Robert H. Cameron*

G. Franklin Rothwell  
Robert H. Cameron  
Attorneys for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

Examining Attorney: SPRUILL, DARRYL

Serial Number: 78/136706

2778-126  
GFR:RHC:czb



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Barilla Alimentare S.p.A. )  
Serial No. 78/136,706 ) Trademark Attorney  
Filed: June 18, 2002 ) Darryl M. Spruill  
Mark: BARILLA - AMERICA'S #1 ) Law Office 101  
PASTA )

**AMENDMENT AND RESPONSE**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Dear Sir:

Applicant hereby responds to Office Action No. 01 in  
accordance with the headings therein.

**IN THE IDENTIFICATION OF GOODS**

Kindly amend the identification of goods in the subject  
application as follows:

--PASTA, PASTA PRODUCTS, NAMELY MEALS  
CONSISTING PRIMARILY OF PASTA, MACARONI  
SALAD, PASTA SALAD, SAUCES FOR PASTA in  
International Class 30.--

**DISCLAIMER REQUIREMENT**

The Office Action has called for Applicant to disclaim the  
wording "AMERICA'S #1 PASTA" apart from the mark as shown. The  
grounds cited are that AMERICA'S has geographical significance,

#1 is a laudatory term and PASTA is a generic term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregistrable components of a mark otherwise registrable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive and does not concede that the term #1 is laudatory in this instance, Applicant respectfully traverses the requirement to disclaim AMERICA'S #1 PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983) ("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA<sup>1</sup>, but obviously creates a commercial impression distinct from that

---

<sup>1</sup>

See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.

of its house mark. Professor McCarthy provides an illustrative example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991) ("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S #1 PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S #1 PASTA clearly characterize the well-recognized trademark of Applicant -- in other words, they meld with the

BARILLA registered mark. All of these factors support a determination that Applicant's proposed slogan is a unitary mark. See Dena, 950 F.2d at 1561 (citing TMEP § 807.13(a) (rev. 1986)). For the foregoing reasons, Applicant believes that disclaimer of AMERICA'S #1 PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully requested that the subject application be approved for publication.

Respectfully submitted,

By Robert H. Cameron  
G. Franklin Rothwell  
Robert H. Cameron  
Attorneys for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

2778-126  
GRF:mec:nlf



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
Barilla Alimentare S.p.A.	)	
	)	
Serial No. 78/136706	)	Trademark Attorney
	)	Darryl M. Spruill
Filed: June 18, 2002	)	
	)	Law Office 112
Mark: BARILLA - AMERICA'S	)	
#1 PASTA	)	

**RESPONSE TO OFFICE ACTION**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003,  
Applicant responds in accordance with the headings therein.

**DISCLAIMER**

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use  
"AMERICA'S #1 PASTA" apart from the mark as  
shown.--

**REMARKS**

Since this appears to be the only outstanding matter at  
issue, it appears this application is in condition to be  
approved for publication.



11-14-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #11

Serial No.: 78/136,706  
Mark: BARILLA - AMERICA'S #1 PASTA  
Attorney Docket No.: 2778-126

Respectfully submitted,

Barilla Alimentare S.p.A.

By: G. F. Rothwell  
G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202)783-6040



2778-126  
GFR: rpd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of )  
)  
Barilla G. E R. Fratelli - ) Examining Attorney:  
Societa Per Azioni ) Darryl M. Spruill  
)  
Serial No. 78/136706 )  
) Trademark Law Office 112  
Filed: June 18, 2002 )  
)  
Mark: BARILLA - AMERICA'S )  
#1 PASTA )

**NOTIFICATION PURSUANT TO 37 C.F.R. § 3.85 AND  
REQUEST FOR ISSUANCE OF  
CERTIFICATE OF REGISTRATION IN NEW NAME**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514



09-10-2004

U.S. Patent & TMO/TM Mail Rpt Dt #64

Dear Sir:

Applicant wishes to notify the Office that the above-identified applicant has changed its name and address to:

**BARILLA G. E R. FRATELLI - SOCIETÀ PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY**

A request for recordation of the change of name was filed and recorded with the U. S. Patent and Trademark Office on May 18, 2004, at Reel/Frame numbers 002852/0797. Subsequently, an address change was recorded with the U. S. Patent and Trademark Office on August 26, 2004 at Reel/Frame numbers 002923/0924. A copy of the abstract of title is enclosed for your ready reference.

It is requested that the subject application be amended accordingly and that the certificate of registration be issued with Applicant's new name and address at the appropriate time.

Respectfully submitted,

By

G. F. Rothwell

G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, p.c.  
1425 K Street, N.W. Suite 800  
Washington, D.C. 20005  
Telephone: (202) 783-6040



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## Assignments on the Web &gt; Trademark Query

## Trademark Assignment Abstract of Title

## Total Assignments: 2

Serial #: 78136706

Filing Dt: 06/18/2002

Reg #: NONE

Reg. Dt:

Applicant: Barilla Alimentare S.p.A.

Mark: BARILLA - AMERICA'S #1 PASTA

## Assignment: 1

Reel/Frame: 2852/0797

Received: 05/18/2004

Recorded: 05/18/2004

Pages: 3

Conveyance: CHANGE OF NAME

Assignor: BARILLA ALIMENTARE S.P.A.

Exec Dt: 12/24/2003

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO BARILLA 3/A  
PARMA, ITALY

Entity Type: CORPORATION  
Citizenship: ITALY

Correspondent: G. FRANKLIN ROTHWELL

1425 K STREET NW

SUITE 800

WASHINGTON, DC 20005

## Assignment: 2

Reel/Frame: 2923/0924

Received: 08/26/2004

Recorded: 08/26/2004

Pages: 4

Conveyance: CHANGE OF ADDRESS

Assignor: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

Exec Dt: 02/12/2004

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY

Entity Type: CORPORATION  
Citizenship: ITALY

Correspondent: G. FRANKLIN ROTHWELL

1425 K STREET NW

SUITE 800

WASHINGTON, DC 20005

Search Results as of: 09/10/2004 12:11 PM

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 703-308-9723

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136706

APPLICANT: Barilla Alimentare S.p.A.

CORRESPONDENT ADDRESS:

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

RETURN ADDRESS:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
**ecom112@uspto.gov**

MARK: BARILLA - AMERICA'S #1 PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-126

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/136706

This letter responds to the applicant's communication filed April 15, 2003.

STATUS OF THE APPLICATION

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

REFUSAL

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229

USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, TMEP §1209.03(s):

#### 1209.03(s) Slogans

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

The wording AMERICA'S #1 PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (#1), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of *selected* excerpts of stories taken from LEXIS/NEXIS® computerized database, listing the terms **Number 1 PASTA (the examining attorney also attaches selected excerpts of stories featuring the terms AMERICA'S FAVORITE PASTA)**. See the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2 (e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the term AMERICA'S with other descriptive matter disclaimed. See the attached enclosure.<sup>[1]</sup> Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R.*

Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of "AMERICA'S #1 PASTA" is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b), 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill  
Trademark Attorney  
Law Office 112  
(703) 308-9112, Ext. 203  
darryl.spruill@uspto.gov  
/Darryl M. Spruill/

#### **RESPONSE GUIDELINES**

The applicant may respond via regular mail to the address listed above, or via e-mail to [Ecom112@uspto.gov](mailto:Ecom112@uspto.gov). In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;
2. send the response to [mailto:ecom112@uspto.gov](mailto:mailto:ecom112@uspto.gov). E-mail sent to any other address will not be processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG format. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to [Comments@uspto.gov](mailto:Comments@uspto.gov).

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless

specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

**EVIDENCE**

108B8C

Print Request: Selected Document(s): 1,2,6,9,11

Time of Request: June 17, 2003 08:45 PM EDT

Number of Lines: 112

Job Number: 1842:0:4167348

Client ID/Project Name:

Research Information:

US Newspapers and Wires

"number 1 pasta"

Send to: SPRUILL, DARRYL  
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MAILBOX 314  
ARLINGTON, VIRGINIA 22202-4600

1 of 12 DOCUMENTS

Copyright 2001 Business Wire, Inc.  
Business Wire

July 30, 2001, Monday

**DISTRIBUTION:** Business Editors

**LENGTH:** 444 words

**HEADLINE:** Borden Foods Announces Sale of Pasta Businesses to New World Pasta

**DATELINE:** COLUMBUS, Ohio, July 30, 2001

**BODY:**

...known, regional favorites -- holding number one or number two positions in the majority of the markets in which they are sold. Already the **number one pasta** brand in Canada, Catelli(R) leads the market in differentiated pasta items including the Healthy Harvest line of ...

2 of 12 DOCUMENTS

Copyright 1999 PR Newswire Association, Inc.  
PR Newswire

November 19, 1999, Friday

**SECTION:** FINANCIAL NEWS

**DISTRIBUTION:** TO BUSINESS AND FOOD EDITORS

**LENGTH:** 591 words

**HEADLINE:** QFC and Golden Grain Mission Pasta's Seventh Annual Pasta Drive for Northwest Harvest Breaks Previous Donation Records;  
Thousands of Washington State Families Receive the Staple in Time For The Holidays

**DATELINE:** BELLEVUE, Wash., Nov. 19

**BODY:**

...information about donations, please call 206-625-0755 or 800-722-6924.  
Golden Grain/Mission Pasta is the **number one pasta** brand in the Seattle marketplace. The Golden Grain Company also manufactures Rice-A-Roni, Pasta Roni and Near East ...



6 of 12 DOCUMENTS

Copyright 1998 New Times Inc.  
Denver Westword (Colorado)

June 25, 1998, Thursday

**SECTION:** Best Of

**LENGTH:** 23344 words

**HEADLINE:** Best of Denver 1998;  
Food and Drink

**BODY:**

...a light version bolstered by ricotta--but also comes married to a hearty Bolognese that's thicker than the usual red, as well as a medium-thick white-wine sauce enhanced with mushrooms and garlic. The **number-one** pasta on the roster, though, is Felese's signature dish of butter-soft chicken tossed with artichokes, peas and sun-dried tomatoes on farfalle, all in a rich, creamy white-wine sauce. When we ...

9 of 12 DOCUMENTS

Copyright 1995 PR Newswire Association, Inc.  
PR Newswire

July 10, 1995, Monday

**SECTION:** Financial News

**DISTRIBUTION:** TO BUSINESS AND FOOD EDITORS

**LENGTH:** 292 words

**HEADLINE:** CAMPBELL NAMES MARGEOTES/FERTITTA & PARTNERS, INC. TO HANDLE

BARILLA PASTA SAUCE ADVERTISING IN U.S.

**BODY:**

...announced this week that Margeotes/Fertitta & Partners, Inc. has been named to handle advertising for the launch of Barilla Pasta Sauce -- Italy's **number one** pasta sauce -- into the U.S. sauce market. Billings were not disclosed.

11 of 12 DOCUMENTS

Copyright 1994 PR Newswire Association, Inc.  
PR Newswire

November 18, 1994, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO BUSINESS EDITOR

**LENGTH:** 359 words

**HEADLINE:** QUAKER OATS COMPANY ACQUIRES NUMBER-ONE BRAZILIAN PASTA MANUFACTURER FROM BORDEN

**DATELINE:** CHICAGO, Nov. 18

**BODY:**

...over the prior year.

With annual sales of approximately \$75 million, Adria has a broad line of premium pasta products and the **number-one** pasta market share in Brazil. Its products are sold under the brand names Adria, Italianissimo, Soltinho and Raineri. Adria products are ...

108B8C

Print Request: Selected Document(s): 5-8,10,13,16

Time of Request: June 17, 2003 08:15 PM EDT

Number of Lines: 159

Job Number: 1842:0:4165955

Client ID/Project Name:

Research Information:

US Newspapers and Wires

"america! favorite! pasta"

Send to: SPRUILL, DARRYL

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5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.  
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

**SECTION:** LIFESTYLE / FOOD; Pg. F06

**LENGTH:** 449 words

**HEADLINE:** SAUCE IT UP, VEGAN STYLE

**COLUMN:** NATURALLY YOURS

**BYLINE:** JAN WOLFF

**BODY:**

...your spaghetti, and if you're a vegan, you may still  
crave a sprinkling of Parmesan now and then. What's left to put on  
America's favorite pasta? Plain old tomato sauce can get tiresome, even  
if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.  
PR Newswire

April 24, 1998, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO FOOD, NATIONAL AND FEATURES EDITORS

**LENGTH:** 301 words

**HEADLINE:** Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998  
**LEXIS-NEXIS Related Topics Full Article Related Topics Overview**

This document contains no targeted Topics.

**DATELINE:** NEW YORK, April 24

**BODY:**

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of **America's favorite pasta** dish is based on consumer research as well as pasta's history in the U.S.," said Julia Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

**SECTION:** FOOD, Pg. J10

**LENGTH:** 475 words

**HEADLINE:** Beard awards nominees

**BODY:**

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, **America's Favorite Pasta**" by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.  
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

**SECTION:** FLORIDA; Pg. 18

**LENGTH:** 861 words

**HEADLINE:** FOR YOUNG TASTE BUDS ONLY

**BYLINE:** By Scott Joseph, Sentinel Restaurant Critic

**BODY:**

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for **Americas favorite pasta.**

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.  
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

**SECTION:** FEATURES; Pg. 3E

**LENGTH:** 806 words

**HEADLINE:** AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

**BYLINE:** Michael Storey

**BODY:**

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with **America's favorite pasta-eating cat** going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company; Los Angeles Times All Rights  
Reserved  
Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

**SECTION:** Business; Part D; Page 1; Column 2; Financial Desk

**LENGTH:** 924 words

**HEADLINE:** FARMERS COUNT ON A NEW CASH CROP: PASTA;  
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH DAKOTA  
WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

**BYLINE:** By GREG JOHNSON, TIMES STAFF WRITER

**DATELINE:** IRVINE

**BODY:**

...plant. We can grow it, mill it and send it through the noodle plant."

**Pasta Popularity**

Spaghetti and linguine are America's favorite pasta products, followed by elbows and twists. Dry  
pasta retail sales by shape in 1993:  
Long goods ( ...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;  
Copyright Business First of Louisville Inc. 1985;  
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATETIME: Louisville; KY; US

BODY:

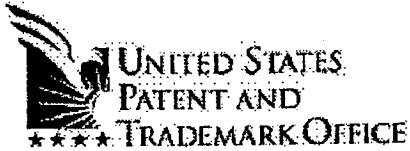
...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while America's favorite pasta may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

---

[1] No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.





Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
www.uspto.gov

Mar 3, 2004

## NOTICE OF PUBLICATION UNDER 12(a)

- |                                      |  |
|--------------------------------------|--|
| 1. Serial No.:<br>78/136,706         | 2. Mark:<br>BARILLA - AMERICA'S #1 PASTA   |
| 3. International Class(es):<br>30    |  |
| 4. Publication Date:<br>Mar 23, 2004 | 5. Applicant:<br>Barilla Alimentare S.p.A. |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: (202) 512-1800

By direction of the Commissioner.

---

Correspondence Address:

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

TMP&I

U.S. Patent and Trademark Office (USPTO)

NOTICE OF ALLOWANCE

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 703-746-3400. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: Mar 15, 2005

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

ATTORNEY  
REFERENCE NUMBER

2778-126

**\*\* IMPORTANT INFORMATION: 6 MONTH DEADLINE \*\***

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at <http://www.uspto.gov/teas/index.html> (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

The following information should be reviewed for accuracy:

SERIAL NUMBER: 78/136706  
MARK: BARILLA - AMERICA'S #1 PASTA  
OWNER: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO

Section 1(b): YES

Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

030 - PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD,  
PASTA SALAD, SAUCES FOR PASTA

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

---

ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS

\*\*\* User: dspruill \*\*\*

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	39	4	35	14	0:01	"barilla alimentare"[on]
02	1609	N/A	0	0	0:04	*b\$l{r{v}l\$l{v}*[bi,ti]
03	223	0	223	67	0:11	2 and "030"[cc] not dead[ld]
04	34385	N/A	0	0	0:06	*m{v}r{v}{"ckqx"}a*[bi,ti]
05	1017	N/A	0	0	0:11	*{"fh"}avor{v}t*[bi,ti]
06	8369	N/A	0	0	0:02	*be{"sz"}t*[bi,ti]
07	1530	N/A	0	0	0:01	*pre{"fp"}\$ler*[bi,ti]
08	23850	N/A	0	0	0:04	("1" one*)[bi,ti]
09	1325	N/A	0	0	0:01	*pa{"sz"}ta*[bi,ti]
10	901	N/A	0	0	0:01	4 and (5 6 7 8 9)
11	23	13	10	2	0:01	9 and (5 6 7 8)
12	214	0	214	69	0:10	10 and "030"[cc] not dead[ld]

Session started 10/11/02 9:29:16 AM

Session finished 10/11/02 9:44:24 AM

Total search duration 0 minutes 53 seconds

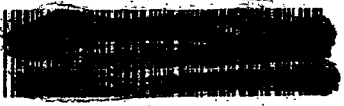
Session duration 15 minutes 8 seconds

Default NEAR limit= 1 ADJ limit= 1

# **Incoming Correspondence Routing Sheet**

**To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET**

**Word Mark: BARILLA - AMERICA'S #1 PASTA**

**Serial No: 78136706**  


**Mail Date: 11142003**  


**Doc. Type: Responses to Office Actions**  


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**No Fee**

**RAM Mail Date: 111403**  


2778-126  
GRF:mec:nlf



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )

Barilla Alimentare S.p.A. )

Serial No. 78/136706 )

Filed: June 18, 2002 )

Mark: BARILLA - AMERICA'S  
#1 PASTA )

Trademark Attorney  
Darryl M. Spruill

Law Office 112

RECEIVED  
2003 DEC -3 A 11:58  
TMED  
LAW OFFICE 112

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003,  
Applicant responds in accordance with the headings therein.

DISCLAIMER

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use  
"AMERICA'S #1 PASTA" apart from the mark as  
shown.--

REMARKS

Since this appears to be the only outstanding matter at  
issue, it appears this application is in condition to be  
approved for publication.



11-14-2003

U.S. Patent & TMO/TM Mail Rpt Dt #11

Serial No.: 78/136,706  
Mark: BARILLA - AMERICA'S #1 PASTA  
Attorney Docket No.: 2778-126

Respectfully submitted,

Barilla Alimentare S.p.A.

By: G. F. Rothwell  
G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/136706

**APPLICANT:** Barilla Alimentare S.p.A.

JUN 18 2003

**CORRESPONDENT ADDRESS:**

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

**RETURN ADDRESS:**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
ecom112@uspto.gov

**MARK:** BARILLA - AMERICA'S #1 PASTA

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 2778-126

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

**RE:** Serial Number 78/136706

This letter responds to the applicant's communication filed April 15, 2003.

**STATUS OF THE APPLICATION**

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.



**REFUSAL**

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, TMEP §1209.03(s):

**1209.03(s) Slogans**

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

The wording AMERICA'S #1 PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (#1), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of selected excerpts of stories taken from LEXIS/NEXIS® computerized database, listing the terms Number 1 PASTA (the examining attorney also attaches selected excerpts of stories featuring the terms AMERICA'S FAVORITE PASTA). See the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Business Wire July 30, 2001, Monday

Also, the examining attorney previously provided third-party registrations showing the term **AMERICA'S** with other descriptive matter disclaimed. See the attached enclosure.<sup>1</sup> Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of "**AMERICA'S #1 PASTA**" is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill  
Trademark Attorney  
Law Office 112  
(703) 308-9112, Ext. 203  
darryl.spruill@uspto.gov  
/Darryl M. Spruill/

#### **RESPONSE GUIDELINES**

The applicant may respond via regular mail to the address listed above, or via e-mail to [Ecom112@uspto.gov](mailto:Ecom112@uspto.gov). In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;

<sup>1</sup> No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.

2. send the response to <mailto:ecom112@uspto.gov>. E-mail sent to any other address will NOT be processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG format only. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the Office action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to [Comments@uspto.gov](mailto:Comments@uspto.gov).

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

**EVIDENCE**

108B8C

Print Request: Selected Document(s): 1, 2, 6, 9, 11

Time of Request: June 17, 2003 08:45 PM EDT

Number of Lines: 112

Job Number: 1842:0:4167348

Business Wire July 30, 2001, Monday

Client ID/Project Name:  
Research Information:  
US Newspapers and Wires  
"number 1 pasta"

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MAILBOX 314  
ARLINGTON, VIRGINIA 22202-4600

1 of 12 DOCUMENTS

Copyright 2001 Business Wire, Inc.  
Business Wire

July 30, 2001, Monday

**DISTRIBUTION:** Business Editors

**LENGTH:** 444 words

**HEADLINE:** Borden Foods Announces Sale of Pasta Businesses to New World Pasta

**DATELINE:** COLUMBUS, Ohio, July 30, 2001

**BODY:**

...known, regional favorites -- holding number one or number two positions in the majority of the markets in which they are sold. Already the **number one pasta** brand in Canada, Catelli(R) leads the market in differentiated pasta items including the Healthy Harvest line of ...

2 of 12 DOCUMENTS

Copyright 1999 PR Newswire Association, Inc.  
PR Newswire

November 19, 1999, Friday

**SECTION: FINANCIAL NEWS**

**DISTRIBUTION: TO BUSINESS AND FOOD EDITORS**

**LENGTH: 591 words**

**HEADLINE: QFC and Golden Grain Mission Pasta's Seventh Annual Pasta Drive for Northwest Harvest Breaks Previous Donation Records;**  
**Thousands of Washington State Families Receive the Staple in Time For The Holidays**

**DATELINE: BELLEVUE, Wash., Nov. 19**

**BODY:**

...information about donations, please call 206-625-0755 or 800-722-6924.

Golden Grain/Mission Pasta is the **number one** pasta brand in the Seattle marketplace. The Golden Grain Company also manufactures Rice-A-Roni, Pasta Roni and Near East ...

6 of 12 DOCUMENTS

Copyright 1998 New Times Inc.  
Denver Westword (Colorado)

June 25, 1998, Thursday

**SECTION: Best Of**

**LENGTH: 23344 words**

**HEADLINE: Best of Denver 1998;**  
**Food and Drink**

**BODY:**

...a light version bolstered by ricotta--but also comes married to a hearty Bolognese that's thicker than the usual red, as well as a medium-thick white-wine sauce enhanced with mushrooms and garlic. The **number-one** pasta on the roster, though, is Felese's signature dish of butter-soft chicken tossed with artichokes, peas and sun-dried tomatoes on farfalle, all in a rich, creamy white-wine sauce. When we ...

PR Newswire, July 10, 1995

9 of 12 DOCUMENTS

Copyright 1995 PR Newswire Association, Inc.  
PR Newswire

July 10, 1995, Monday

**SECTION:** Financial News

**DISTRIBUTION:** TO BUSINESS AND FOOD EDITORS

**LENGTH:** 292 words

**HEADLINE:** CAMPBELL NAMES MARGEOTES/FERTITTA & PARTNERS, INC. TO  
HANDLE BARILLA PASTA SAUCE ADVERTISING IN U.S.

**BODY:**

...announced this week that Margeotes/Fertitta & Partners, Inc. has been named to handle advertising for the launch of Barilla Pasta Sauce -- Italy's number one pasta sauce -- into the U.S. sauce market. Billings were not disclosed.

11 of 12 DOCUMENTS

Copyright 1994 PR Newswire Association, Inc.  
PR Newswire

November 18, 1994, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO BUSINESS EDITOR

**LENGTH:** 359 words

**HEADLINE:** QUAKER OATS COMPANY ACQUIRES NUMBER-ONE BRAZILIAN PASTA MANUFACTURER FROM BORDEN

**DATELINE:** CHICAGO, Nov. 18

**BODY:**

...over the prior year.

With annual sales of approximately \$75 million, Adria has a broad line of premium pasta products and the number-one pasta market share in Brazil. Its products are sold under the brand names Adria, Italianissimo, Soltinho and Raineri. Adria products are ...

108B8C

Print Request: Selected Document(s): 5-8, 10, 13, 16

Time of Request: June 17, 2003 08:15 PM EDT

Number of Lines: 159

Job Number: 1842:0:4165955

Client ID/Project Name:

Research Information:

US Newspapers and Wires

"america! favorite! pasta"

Send to: SPRUILL, DARRYL

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ARLINGTON, VIRGINIA 22202-4600

5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.  
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

**SECTION:** LIFESTYLE / FOOD; Pg. F06

**LENGTH:** 449 words

**HEADLINE:** SAUCE IT UP, VEGAN STYLE

**COLUMN:** NATURALLY YOURS

**BYLINE:** JAN WOLFF

**BODY:**

...your spaghetti, and if you're a vegan, you may still  
crave a sprinkling of Parmesan now and then. What's left to put on  
America's favorite pasta? Plain old tomato sauce can get tiresome, even  
if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.  
PR Newswire

April 24, 1998, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO FOOD, NATIONAL AND FEATURES EDITORS

**LENGTH:** 301 words



**HEADLINE:** Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998  
LEXIS-NEXIS Related Topics Full Article Related Topics Overview

This document contains no targeted Topics.

**DATELINE:** NEW YORK, April 24

**BODY:**

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of America's favorite pasta dish is based on consumer research as well as pasta's history in the U.S.," said Julia Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

**SECTION:** FOOD, Pg. J10

**LENGTH:** 475 words

**HEADLINE:** Beard awards nominees

**BODY:**

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, America's Favorite Pasta" by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.  
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

Orlando Sentinel Tribune, January 22, 1995

**SECTION:** FLORIDA; Pg. 18

**LENGTH:** 861 words

**HEADLINE:** FOR YOUNG TASTE BUDS ONLY

**BYLINE:** By Scott Joseph, Sentinel Restaurant Critic

**BODY:**

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for Americas favorite pasta.

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.  
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

**SECTION:** FEATURES; Pg. 3E

**LENGTH:** 806 words

**HEADLINE:** AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

**BYLINE:** Michael Storey

**BODY:**

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with America's favorite pasta-eating cat going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

Los Angeles Times, September 7, 1994

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company; Los Angeles Times All  
Rights Reserved  
Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

**SECTION:** Business; Part D; Page 1; Column 2; Financial Desk

**LENGTH:** 924 words

**HEADLINE:** FARMERS COUNT ON A NEW CASH CROP: PASTA;  
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH  
DAKOTA WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

**BYLINE:** By GREG JOHNSON, TIMES STAFF WRITER

**DATELINE:** IRVINE

**BODY:**

...plant. We can grow it, mill it and send it through the noodle plant."

Pasta Popularity

Spaghetti and linguine are America's favorite pasta products, followed by elbows and twists.  
Dry pasta retail sales by shape in 1993:  
Long goods ( ...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;  
Copyright Business First of Louisville Inc. 1985;  
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATELINE: Louisville; KY; US

BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while America's favorite pasta may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

# TIN REMARK EXAMINATION WORKSHEET

☒ AMENDMENT STAGE

☐ NO CHANGE

☐ PUBLICATION/REGISTRATION STAGE

Name: Lorri White L.O. 112

Serial No. 781 136706

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

## Legal Instrument Examiner (LIE)

	Amended	Data Element	
Class Data	<input checked="" type="checkbox"/>	<input type="checkbox"/> Prime/International Class	<input checked="" type="checkbox"/> Goods and Services
		<input type="checkbox"/> First Use Date	<input type="checkbox"/> First Use in Commerce Date
		<input type="checkbox"/> In Another Form	<input type="checkbox"/> Certification
		<input type="checkbox"/> 1b	
Mark Data		<input type="checkbox"/> Word Mark	<input type="checkbox"/> Pseudo Mark
		<input type="checkbox"/> Mark Drawing Code	<input type="checkbox"/> Design Search Code
		<input type="checkbox"/> Scan Sub Drawing	
Misc. Mark Data		<input type="checkbox"/> Mark Description	<input type="checkbox"/> Disclaimer
		<input type="checkbox"/> Lining/Stippling	<input type="checkbox"/> Name/Portrait/Consent
		<input type="checkbox"/> Translation	
Section 2(f)		<input type="checkbox"/> Section 2(f) Entire Mark	
		<input type="checkbox"/> Section 2(f) Limitation Statement	<input type="checkbox"/> Section 2(f) in Part
		<input type="checkbox"/> Amended Register	<input type="checkbox"/> Amended Register Date
Foreign Reg. Data		<input type="checkbox"/> Foreign Country	<input type="checkbox"/> 44(d)
		<input type="checkbox"/> Foreign Application Number	<input type="checkbox"/> Foreign Application Filing Date
		<input checked="" type="checkbox"/> Foreign Registration Number	<input type="checkbox"/> Foreign Registration Date
		<input type="checkbox"/> Foreign Registration Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Number
		<input type="checkbox"/> Foreign Reg. Renewal Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Date
Owner Data		<input type="checkbox"/> Owner Name	<input type="checkbox"/> DBA/AKA/TA
		<input type="checkbox"/> Address 1	<input type="checkbox"/> Address 2
		<input type="checkbox"/> City	<input type="checkbox"/> State
		<input type="checkbox"/> Zip Code	
		<input type="checkbox"/> Citizenship	<input type="checkbox"/> Entity
		<input type="checkbox"/> Entity Statement	<input type="checkbox"/> Composed of
		<input type="checkbox"/> Assignment(s)/Name Change	
Amd/Corr Restr.		<input type="checkbox"/> Concurrent Use	
Prior U.S. Reg.		<input type="checkbox"/> Prior Registration	
Correspondence		<input type="checkbox"/> Attorney	<input type="checkbox"/> Domestic Representative
		<input type="checkbox"/> Attorney Docket Number	
		<input type="checkbox"/> Correspondence Firm Name/Address	

I certify that all corrections have been entered in accordance with text editing guidelines.

Lorri White  
LIE

5/ 2 /2003  
DATE

Other:

Trademark

RECEIVED

Serial Number

TRADEMARK

OFFICE

OFFICE

71156756

RECEIVED

RECEIVED

LA 6/18/07

### PROSECUTION HISTORY

LA 6/18/07

Entry

Date

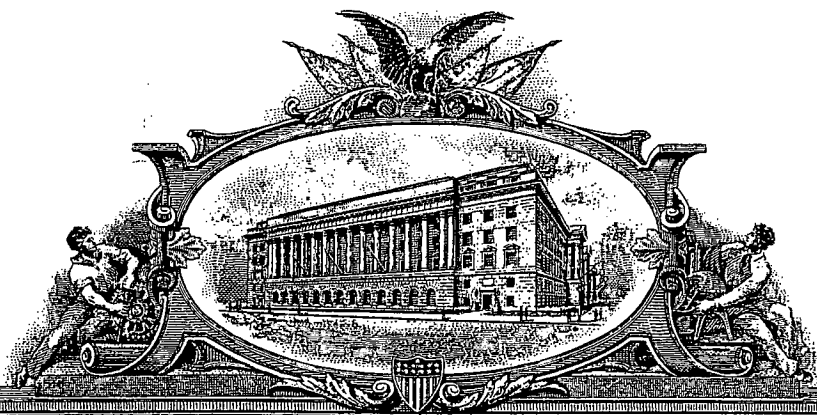
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1			05-19-2007	
2			06-11-2007	
3		06-19-2007	06-11-2007	
4			06-11-2007	
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26				
27				
28				
29				
30				

☐ See inside of this box additional entries

# **Exhibit 17**

774115



# THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

July 25, 2005

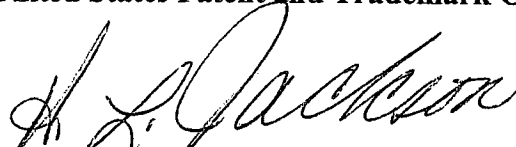
THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE TRADEMARK FILE WRAPPER AND  
CONTENTS OF:

TRADEMARK APPLICATION: 78/136,701

FILING DATE: *June 18, 2002*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office



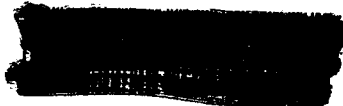
  
H. L. JACKSON  
Certifying Officer



Internet Transmission Date:  
2002/06/18

Serial Number:  
78136701

Filing Date:  
2002/06/18

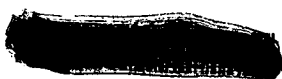


TRADEMARK APPLICATION

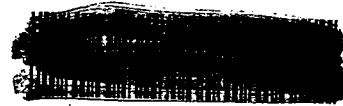
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 122  
RAM ACCOUNTING DATE: 20020619



NO OCR



06-18-2002

&lt;SERIAL NUMBER&gt; 78136701

&lt;FILING DATE&gt; 06/18/2002

## &lt;DOCUMENT INFORMATION&gt;

&lt;TRADEMARK/SERVICEMARK APPLICATION&gt;

&lt;VERSION 1.24&gt;

## &lt;APPLICANT INFORMATION&gt;

&lt;NAME&gt;

Barilla Alimentare S.p.A.

&lt;STREET&gt;

Via Mantova 166

&lt;CITY&gt;

Parma PR

&lt;COUNTRY&gt;

Italy

&lt;ZIP/POSTAL CODE&gt;

43100

## &lt;APPLICANT ENTITY INFORMATION&gt;

&lt;CORPORATION: STATE/COUNTRY OF INCORPORATION&gt; Italy

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

&lt;MARK&gt; BARILLA - AMERICA'S BEST PASTA

&lt;TYPED FORM&gt; Yes

\* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). \*

## &lt;BASIS FOR FILING AND GOODS/SERVICES INFORMATION&gt;

&lt;INTENT TO USE: SECTION 1(b)&gt; Yes

\* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) \*

&lt;INTERNATIONAL CLASS NUMBER&gt; 030

&lt;LISTING OF GOODS AND/OR SERVICES&gt; PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

## &lt;ATTORNEY INFORMATION&gt;

&lt;NAME&gt;

G. Franklin Rothwell, Esq.

&lt;STREET&gt;

1425 K Street, NW Suite 800

&lt;CITY&gt;

Washington

&lt;STATE&gt;

DC

&lt;COUNTRY&gt;

USA

&lt;ZIP/POSTAL CODE&gt;

20005

&lt;FIRM NAME&gt;

Rothwell, Figg, Ernst &amp; Manbeck, P.C.

&lt;TELEPHONE NUMBER&gt;

202-783-6040

<FAX NUMBER> 202-783-6031  
<ATTORNEY DOCKET NUMBER> 2778-128  
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

**<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>**

\* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served \*

<NAME> G. Franklin Rothwell, Esq.  
<STREET> 1425 K Street, NW Suite 800  
<CITY> Washington  
<STATE> DC  
<ZIP CODE> 20005  
<FIRM NAME> Rothwell, Figg, Ernst & Manbeck, P.C.  
<TELEPHONE NUMBER> 202-783-6040  
<FAX NUMBER> 202-783-6031

**<FEE INFORMATION>**

<TOTAL FEES PAID> 325  
<NUMBER OF CLASSES PAID> 1  
<NUMBER OF CLASSES> 1

**<LAW OFFICE INFORMATION>**

<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

**<SIGNATURE AND OTHER INFORMATION>**

\* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

\*  
<SIGNATURE> /Robert H. Cameron/  
<DATE> 06/18/2002  
<NAME> Robert H. Cameron  
<TITLE> Attorney for Applicant

**<MAILING ADDRESS>**

<LINE> G. Franklin Rothwell, Esq.  
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.  
<LINE> 1425 K Street, NW Suite 800  
<LINE> Washington DC 20005

**<RAM INFORMATION>**

<RAM SALE NUMBER> 122  
<RAM ACCOUNTING DATE> 20020619

**<SERIAL NUMBER INFORMATION>**

<SERIAL NUMBER> 78/136701  
<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:36:18 EDT  
<TEAS STAMP>  
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124e0249a8338c1d8f28003cf12cf55ea-RAM-122-20020618163522437  
E-MAIL ADDRESS FOR ACKNOWLEDGMENT> [bmanning@rothwellfigg.com](mailto:bmanning@rothwellfigg.com)

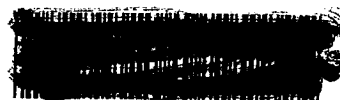
**Drawing Page**

**Serial Number:**

78136701

**Applicant:**

Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PR Italy 43100



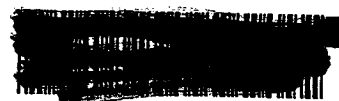
**Goods and Services:**

PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

**Mark:**

BARILLA - AMERICA'S BEST PASTA

NO OCR



06-18-2002

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136701

APPLICANT: Barilla Alimentare S.p.A.

OCT 15 2002

OCT 15 2002

CORRESPONDENT ADDRESS:

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW Suite 800  
Washington DC 20005

RETURN ADDRESS:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
ecom101@uspto.gov

MARK: BARILLA - AMERICA'S BEST PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-128

CORRESPONDENT EMAIL ADDRESS:

N/A

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

PRIORITY ACTION

OFFICE SEARCH: 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. Section 1052(d). TMEP section 704.02.

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE. This case will be given priority as an amended case if you respond to the requirements stated below within two months.

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

RE: Serial Number 78/136701

The following issues were discussed in communication with G. Franklin Rothwell on 10/11/02.

1. IDENTIFICATION OF GOODS -UNACCEPTABLE:

The identification of goods is indefinite because the applicant uses the wording "products." The identification of goods must be specific. The applicant must amend the identification to specify the common commercial name of the goods or to indicate their nature. The recitation identification must be all-inclusive. The applicant should amend the identification to replace this wording with "namely." The applicant may amend the identification to substitute the following wording, if

accurate: "Pasta, pasta products, namely, [specify the products], sauces for pasta," in International Class 030. 37 C.F.R. Section 2.71(a); TMEP sections 804 and 804.08(c).<sup>1</sup>

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 804.09. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

## **2. DISCLAIMER REQUIREMENT:**

The applicant must disclaim the wording AMERICA'S BEST PASTA in the mark because the wording AMERICA'S is a term having geographical significance combined with BEST a laudatory descriptive term, and PASTA a generic term.

Also, the examining attorney has attached third-party registrations showing the term AMERICA(S) combined with laudatory and generic terms disclaimed. See the attached enclosure. Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Dayco Products-Eaglemotive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP section 1213.09(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use "AMERICA'S BEST PASTA" apart from the mark as shown.



Darryl M. Spruill  
Trademark Attorney  
Law Office 101  
(703) 308-9101, Ext. 170  
darryl.spruill@uspto.gov

<sup>1</sup> Please note that the recommended identification of goods is not exhaustive. The applicant is directed to the Office's searchable database of the Manual of Acceptable Identifications of Goods and Services. The address for this is: [http://www.uspto.gov/web/offices/tac/doc/gsmannual/](http://www.uspto.gov/web/offices/tac/doc/gsmmanual/).

**How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>



\*\*\* User: dspruill

\*\*\* Serial Number: 78057808

\*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark

AMERICAS FAVORITE PIZZA FEAST

Goods and Services

IC 030. US 046. G & S: Pizza for consumption on or off the premises.  
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

78057808

Filing Date

April 11, 2001

Publication for Opposition Date

January 15, 2002

Registration Number

2558945

Registration Date

April 9, 2002

Owner Name and Address

(REGISTRANT) Domino's Pizza PMC, Inc. CORPORATION MICHIGAN 30 Frank Lloyd  
Wright Drive Ann Arbor MICHIGAN 48106

Prior Registration(s)

1705234;1791773;1825321;AND OTHERS

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA"  
APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Elizabeth F. Janda

\*\*\* Search: 14 \*\*\* Document Number: 2 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 78039333 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE COOKIE

Goods and Services

IC 030. US 046. G & S: Cookies. FIRST USE: 19980201. FIRST USE IN  
COMMERCE: 19980201

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

78039333

Filing Date

December 14, 2000

Filed ITU

FILED AS ITU

Supplemental Register Date

November 19, 2001

Registration Number

2572410

Registration Date

May 21, 2002

Owner Name and Address

(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE 1105 North  
Market Street, Suite 803 Wilmington DELAWARE 19801

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

2149887

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Live Dead Indicator

LIVE

Attorney of Record

Kathleen J. Gallagher, Esq.

\*\*\* Search: 14 \*\*\* Document Number: 1. \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75768708 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE SOUR GUM

Pseudo Mark

AMERICAS FAVORITE SOUR GUM

Goods and Services

IC 030. US 046. G & S: BUBBLE GUM. FIRST USE: 19990615. FIRST USE IN  
COMMERCE: 19990615

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75768708

Filing Date

August 5, 1999

Supplemental Register Date

December 15, 1999

Registration Number

2347915

Registration Date

May 2, 2000

Owner Name and Address

(REGISTRANT) Philadelphia Chewing Gum Corporation CORPORATION  
PENNSYLVANIA Havertown PENNSYLVANIA 190832189

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOUR GUM" APART FROM THE  
MARK AS SHOWN

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Live Dead Indicator

LIVE

Attorney of Record

Harriet E. Perkins

\*\*\* Search: 14 \*\*\* Document Number: 4 \*\*\*

\*\*\*\* User: dspruill \*\*\* Serial Number: 75618178 \*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark

TUMARO'S GOURMET TORTILLAS -- AMERICA'S FAVORITE

Pseudo Mark

TUMAROS GOURMET TORTILLAS AMERICAS FAVORITE

Goods and Services

IC 030. US 046. G & S: tortillas and crepes. FIRST USE: 20000411.  
FIRST USE IN COMMERCE: 20000411

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75618178

Filing Date

January 11, 1999

Filed ITU

FILED AS ITU

Publication for Opposition Date

October 26, 1999

Registration Number

2419870

Registration Date

January 9, 2001

Owner Name and Address

(REGISTRANT) Tumaro's, Inc. CORPORATION CALIFORNIA 5300 Santa Monica  
Boulevard Los Angeles CALIFORNIA 90029

Prior Registration(s)

1893236;2133513

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GOURMET TORTILLAS- -  
AMERICA'S FAVORITE" APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Corrine M. Freeman

\*\*\* Search: 14 \*\*\* Document Number: 5 \*\*\*

\*\*\*\* \*User: dspruill

\*\*\* Serial Number: 75538444 \*\*\*

10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE

Pseudo Mark

AMERICAS FAVORITE

Goods and Services

IC 030. US 046. G & S: Doughnuts. FIRST USE: 19721003. FIRST USE IN  
COMMERCE: 19721201

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75538444

Filing Date

August 18, 1998

Publication for Opposition Date

April 27, 1999

Registration Number

2263243

Registration Date

July 20, 1999

Owner Name and Address

(REGISTRANT) HDN Development Corporation CORPORATION KENTUCKY 7303  
Turfway Road Florence KENTUCKY 41042

Type of Mark

TRADEMARK

Register

PRINCIPAL-2 (F)

Live Dead Indicator

LIVE

Attorney of Record

JOHN M HARRINGTON

\*\*\* Search: 14 \*\*\* Document Number: 7 \*\*\*



Mark  
AMERICA'S FAVORITE FOODS PRESTO

Pseudo Mark  
AMERICAS FAVORITE FOODS PRESTO

Goods and Services  
IC 030.: US 046. G & S: pizza crust mix, garlic sauce and cheddar  
sauce. FIRST USE: 19920217. FIRST USE IN COMMERCE: 19920217

Mark Drawing Code  
(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code  
261702 261707

Serial Number  
75501805

Filing Date  
June 15, 1998

Publication for Opposition Date  
September 21, 1999

Registration Number  
2299622

Registration Date  
December 14, 1999

Owner Name and Address  
(REGISTRANT) OHIO PIZZA PRODUCTS INC. CORPORATION OHIO 1522 Manchester  
Road Dayton OHIO 454490127

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE FOODS"  
APART FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL

Live Dead Indicator

\*\*\* Search: 14 \*\*\* Document Number: 8 \*\*\*

(cont)

\*\*\* User: dspruill \*\*\* Serial Number: 75501805 \*\*\*

LIVE

Attorney of Record  
THEODORE D LIENESCH

\*\*\* Search: 14 \*\*\* Document Number: 8 \*\*\*

\*\*\* User: dspruill

\*\*\* Serial Number: 75470400

\*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark  
AMERICA'S FAVORITE CANDIES

Pseudo Mark  
AMERICAS FAVORITE CANDIES

Goods and Services  
IC 030. US 046. G & S: CANDY NOT INCLUDING JELLY BEANS. FIRST USE:  
19851118. FIRST USE IN COMMERCE: 19851118

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75470400

Filing Date  
April 20, 1998

Publication for Opposition Date  
November 2, 1999

Registration Number  
2359173

Registration Date  
June 20, 2000

Owner Name and Address  
(REGISTRANT) PROMOTION IN MOTION, INC. CORPORATION DELAWARE 3 REUTEN  
DRIVE CLOSTER NEW JERSEY 07624

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CANDIES" APART FROM THE  
MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2 (F)

Live Dead Indicator  
LIVE

Attorney of Record  
RICHARD M GOLDBERG

\*\*\* Search: 14 \*\*\* Document Number: 9 \*\*\*



\*\*\* User: dspruill \*\*\* Serial Number: 75447700 \*\*\* 10/11/02 10:58:15 AM \*

[Typed Drawing]

Mark BEST PIE IN AMERICA

Goods and Services

IC 030. US 046. G & S: PIES. FIRST USE: 19970100. FIRST USE IN  
COMMERCE: 19970100

IC 042. US 100 101. G & S: RESTAURANT SERVICES. FIRST USE: 19970100.  
FIRST USE IN COMMERCE: 19970100

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75447700

Filing Date  
March 10, 1998

Supplemental Register Date  
October 14, 1998

Registration Number  
2239993

Registration Date  
April 13, 1999

Owner Name and Address  
(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th  
Avenue Denver COLORADO 80216

Assignment Recorded  
ASSIGNMENT RECORDED

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PIE" APART FROM THE MARK  
AS SHOWN

Type of Mark  
TRADEMARK. SERVICE MARK

Register  
SUPPLEMENTAL

Live Dead Indicator  
LIVE

Attorney of Record  
SABRINA C STAVISH

\*\*\* Search: 14 \*\*\* Document Number: 10 \*\*\*

\*\*\* User: dspruill

\*\*\* Serial Number: 75300090

\*\*\* 10/11/02 10:58:15 AM \*



Mark

BAKERS SQUARE BEST PIE IN AMERICA

Goods and Services

IC 030. US 046. G & S: pies. FIRST USE: 19970400. FIRST USE IN  
COMMERCE: 19970400

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

010103 260117

Serial Number

75300090

Filing Date

May 29, 1997

Filed ITU

FILED AS ITU

Publication for Opposition Date

October 6, 1998

Registration Number

2213980

Registration Date

December 29, 1998

Owner Name and Address

(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th  
Avenue Denver COLORADO 80216

Assignment Recorded

ASSIGNMENT RECORDED

\*\*\* Search: 14 \*\*\* Document Number: 11 \*\*\*

(cont)

\*\*\* User: dspruill \*\*\* Serial Number: 75300090 \*\*\*

Prior Registration(s)  
1394236;1394428;1403328;2002503

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEST PIE IN AMERICA"  
APART FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)-IN PART

Live Dead Indicator  
LIVE

Distinctiveness Limitation Statement  
as to "BAKERS"

Attorney of Record  
SABRINA C STAVISH

\*\*\* Search: 14 \*\*\* Document Number: 11 \*\*\*

\*\*\* User: dspruill

\*\*\* Serial Number: 75265223

\*\*\* 10/11/02 10:58:15 AM \*

[Typed Drawing]

Mark AMERICA'S BEST

Pseudo Mark  
AMERICAS BEST

Goods and Services  
IC 030. US 046. G & S: iced coffee-based beverages, namely, unflavored  
iced coffees and coffees with flavorings including cappuccino, hazelnut,  
French vanilla, Viennese mocha and original chocolate flavors. FIRST  
USE: 19930200. FIRST USE IN COMMERCE: 19930200

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75265223

Filing Date  
March 27, 1997

Publication for Opposition Date  
July 21, 1998

Registration Number  
2194941

Registration Date  
October 13, 1998

Owner Name and Address  
(REGISTRANT) America's Best Beverage Company, Inc. CORPORATION FLORIDA 35  
Mason Street Greenwich CONNECTICUT 06830

Assignment Recorded  
ASSIGNMENT RECORDED

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)

Live Dead Indicator  
LIVE

Attorney of Record  
MICHAEL I WOLFSON

\*\*\* Search: 14 \*\*\* Document Number: 12 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75222072 \*\*\* 10/11/02 10:58:16 AM \*

[Typed Drawing]

Mark AMERICA'S FAVORITE CHOCOLATE CHIP COOKIE!

Pseudo Mark  
AMERICAS FAVORITE CHOCOLATE CHIP COOKIE

Goods and Services  
IC 030. US 046. G & S: cookies. FIRST USE: 19960400. FIRST USE IN  
COMMERCE: 19960400

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75222072

Filing Date  
January 8, 1997

Filed ITU  
FILED AS ITU

Supplemental Register Date  
January 20, 1998

Registration Number  
2149887

Registration Date  
April 7, 1998

Owner Name and Address  
(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE One South Wacker  
Drive, Suite 2740 Chicago ILLINOIS 60606

Assignment Recorded  
ASSIGNMENT RECORDED

Type of Mark  
TRADEMARK

Register  
SUPPLEMENTAL

Live Dead Indicator  
LIVE

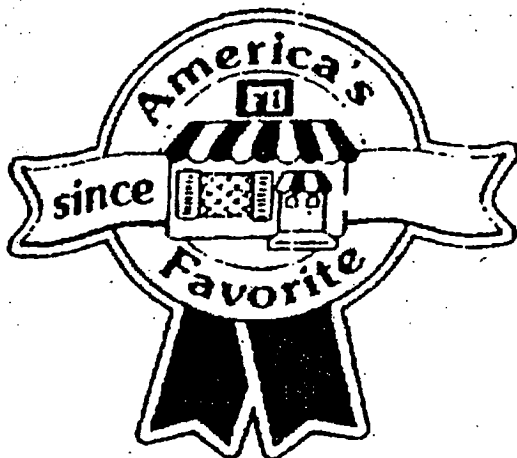
Attorney of Record  
KATHLEEN J. GALLAGHER

\*\*\* Search: 14 \*\*\* Document Number: 13 \*\*\*

User: dspruill

Serial Number: 75144931

10/11/02 10:58:16 AM \*



Mark

AMERICA'S FAVORITE SINCE FBI

Goods and Services

IC 030. US 046. G & S: confectionery, namely, candy, caramels, marshmallows, marshmallow creme, and fudge. FIRST USE: 19960700. FIRST USE IN COMMERCE: 19960700

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

070104 240707 240907

Serial Number

75144931

Filing Date

August 5, 1996

Publication for Opposition Date

September 16, 1997

Registration Number

2119233

Registration Date

December 9, 1997

Owner Name and Address

(REGISTRANT) Favorite Brands International, Inc. CORPORATION DELAWARE 75  
Tri State International Lincolnshire ILLINOIS 60069

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

\*\*\* Search: 14 \*\*\* Document Number: 14 \*\*\*

(cont)

\*\*\* User: dspruill \*\*\* Serial Number: 75144931 \*\*\*

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE SINCE"  
APART FROM THE MARK AS SHOWN

Description of Mark

The mark consists of the design of a canopied building, with the stylized letters "FBI" appearing directly above the building, and the phrase "AMERICA'S FAVORITE SINCE" (followed by a date of origin, which varies from candy to candy), all being enclosed in a banner and seal-with-ribbon design. The lining in the drawing is a feature of the mark, and it is not intended to indicate color.

Type of Mark  
TRADEMARK

Register  
PRINCIPAL

Live Dead Indicator  
LIVE

Attorney of Record  
Paula J. Krasny

\*\*\* Search: 14 \*\*\* Document Number: 14 \*\*\*

\*\*\* User: dspruill

\*\*\* Serial Number: 75116367 \*\*\*

10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark

IT'S AMERICA'S FAVORITE JELLY BEAN

Goods and Services

IC 030. US 046. G & S: jelly beans. FIRST USE: 19890531. FIRST USE  
IN COMMERCE: 19890531

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75116367

Filing Date

June 10, 1996

Publication for Opposition Date

April 15, 1997

Registration Number

2077329

Registration Date

July 8, 1997

Owner Name and Address

(REGISTRANT) HERMAN GOELITZ CANDY CO., INC. CORPORATION CALIFORNIA 2400  
North Watney Way Fairfield CALIFORNIA 94533

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

1604190

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "JELLY BEAN" APART FROM  
THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

JAMES R. CYPHER

\*\*\* Search: 14 \*\*\* Document Number: 15 \*\*\*



\*\*\* User: dspruill

\*\*\* Serial Number: 75068756 \*\*\*

10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark AMERICA'S FAVORITE KETCHUP

Pseudo Mark  
AMERICAS FAVORITE KETCHUP

Goods and Services  
IC 030. US 046. G & S: condiments, namely, ketchup. FIRST USE:  
19920600. FIRST USE IN COMMERCE: 19920600

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75068756

Filing Date  
March 7, 1996

Publication for Opposition Date  
July 1, 1997

Registration Number  
2098790

Registration Date  
September 23, 1997

Owner Name and Address  
(REGISTRANT) H. J. HEINZ COMPANY CORPORATION PENNSYLVANIA 1062 Progress  
Street Pittsburgh PENNSYLVANIA 15212

Assignment Recorded  
ASSIGNMENT RECORDED

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "KETCHUP" APART FROM THE  
MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)

Live Dead Indicator  
LIVE

Attorney of Record  
Dean A. Bierkan

\*\*\* Search: 14 \*\*\* Document Number: 17 \*\*\*

User: dspruill

Serial Number: 75036522

10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE SOFT PRETZEL

Goods and Services

IC 030. US 046. G & S: snack foods, namely, soft pretzels. FIRST USE:  
19960300. FIRST USE IN COMMERCE: 19960300

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75036522

Filing Date

December 26, 1995

Filed ITU

FILED AS ITU

Publication for Opposition Date

February 17, 1998

Registration Number

2155994

Registration Date

May 12, 1998

Owner Name and Address

(REGISTRANT) J&J Snack Foods Corp. CORPORATION NEW JERSEY 6000 Central  
Highway Pennsauken NEW JERSEY 08109

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOFT PRETZEL" APART FROM  
THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

J. Rodman Steele, Jr.

\*\*\* Search: 14 \*\*\* Document Number: 18 \*\*\*

\*\*\* User: dspruill

\*\*\* Serial Number: 75035078

10/11/02 10:58:18 AM \*

[Typed Drawing]

Mark AMERICA'S #1 SPICE VALUE

Goods and Services  
IC 030. US 046. G & S: spices. FIRST USE: 19950324. FIRST USE IN  
COMMERCE: 19950324

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
75035078

Filing Date  
December 20, 1995

Publication for Opposition Date  
March 11, 1997

Registration Number  
2066497

Registration Date  
June 3, 1997

Owner Name and Address  
(REGISTRANT) ROSE SPICE, INC. CORPORATION DELAWARE 4500 Northchase  
Parkway NE Wilmington DELAWARE 28405

Assignment Recorded  
ASSIGNMENT RECORDED

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S #1 SPICE" APART  
FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL

Live Dead Indicator  
LIVE

Attorney of Record  
WILLIAM J MASON

\*\*\* Search: 14 \*\*\* Document Number: 19 \*\*\*

\*\*\* User: dspruill

\*\*\* Serial Number: 74322961

10/11/02 10:58:18 AM \*

[Typed Drawing]

Mark AMERICA'S FAVORITE HOLIDAY CANDY

Pseudo Mark  
AMERICAS FAVORITE HOLIDAY CANDY

Goods and Services  
IC 030. US 046. G & S: chocolates and other candy. FIRST USE:  
19921201. FIRST USE IN COMMERCE: 19921201

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
74322961

Filing Date  
October 15, 1992

Filed ITU  
FILED AS ITU

Supplemental Register Date  
December 14, 1993

Registration Number  
1837304

Registration Date  
May 17, 1994

Owner Name and Address  
(REGISTRANT) R. M. PALMER COMPANY CORPORATION PENNSYLVANIA 77 Second  
Avenue West Reading PENNSYLVANIA 19611

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOLIDAY CANDY" APART FROM  
THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
SUPPLEMENTAL

Affidavit Text  
SECT 8 (6-YR).

Live Dead Indicator  
LIVE

Attorney of Record  
John F. McNulty

\*\*\* Search: 14 \*\*\* Document Number: 21 \*\*\*

\*\*\* User: dspruill

\*\*\* Serial Number: 74270458

\*\*\* 10/11/02 10:58:18 AM \*

## America's Favorite Pizza Feast

Mark AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark AMERICAS FAVORITZ PIZZA FEAST

Goods and Services  
IC 030. US 046. G & S: pizza for consumption on or off the premises.  
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code  
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number  
74270458

Filing Date  
April 29, 1992

Filed ITU  
FILED AS ITU

Publication for Opposition Date  
December 15, 1992

Registration Number  
1791773

Registration Date  
September 7, 1993

Owner Name and Address  
(REGISTRANT) Domino's Pizza, Inc. CORPORATION MICHIGAN 30 Frank Lloyd  
Wright Drive P.O. Box 997 Ann Arbor MICHIGAN 481060997

Assignment Recorded  
ASSIGNMENT RECORDED

Prior Registration(s)  
1700700

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA"  
APART FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL

\*\*\* Search: 14 \*\*\* Document Number: 22 \*\*\*

(cont)

\*\*\*User: dspruill

\*\*\* Serial Number: 74270458 \*\*\*

Affidavit Text  
SECT 15. SECT 8 (6-YR).

Live Dead Indicator  
LIVE

Attorney of Record  
JEFFREY P THENNISCH

\*\*\* Search: 14 \*\*\* Document Number: 22 \*\*\*

User: dspruill

\*\*\* Serial Number: 74044195 \*\*\*

10/11/02 10:58:19 AM \*

[Typed Drawing]

Mark AMERICA'S SNACK FAVORITE

Pseudo Mark  
americas snack favorite

Goods and Services  
IC 030. US 046. G & S: snack cakes. FIRST USE: 19891200. FIRST USE  
IN COMMERCE: 19891200

Mark Drawing Code  
(1) TYPED DRAWING

Serial Number  
74044195

Filing Date  
March 30, 1990

Supplemental Register Date  
November 14, 1990

Registration Number  
1638019

Registration Date  
March 12, 1991

Owner Name and Address  
(REGISTRANT) McKee Baking Company CORPORATION TENNESSEE P.O. Box 750  
Collegedale TENNESSEE 37315

(LAST LISTED OWNER) MCKEE FOODS CORPORATION CORPORATION BY CHANGE OF  
NAME FROM TENNESSEE P.O. BOX 750 COLLEGEDALE TENNESSEE 373150750

Assignment Recorded  
ASSIGNMENT RECORDED

Prior Registration(s)  
1542109

Type of Mark  
TRADEMARK

Register  
SUPPLEMENTAL

Affidavit Text  
SECT 8 (6-YR). SECTION 8(10-YR) 20010618.

Renewal  
1ST RENEWAL 20010618

Live Dead Indicator

\*\*\* Search: 14 \*\*\* Document Number: 23 \*\*\*

(cont)

\*\*\* User: dspruill \*\*\* Serial Number: 74044195 \*\*\*

LIVE

Attorney of Record  
DONALD A. KAUL & PATRICIA R. BROWN

\*\*\* Search: 14 \*\*\* Document Number: 23 \*\*\*



<b>DOCUMENT INFORMATION</b>	
<b>TRADEMARK/SERVICEMARK APPLICATION</b>	
<b>VERSION 1.24</b>	
<b>APPLICANT INFORMATION</b>	
NAME	Barilla Alimentare S.p.A.
STREET	Via Mantova 166
CITY	Parma PR
COUNTRY	Italy
ZIP/POSTAL CODE	43100
<b>APPLICANT ENTITY INFORMATION</b>	
CORPORATION: STATE/COUNTRY OF INCORPORATION	Italy
<b>TRADEMARK/SERVICEMARK INFORMATION</b>	
MARK	BARILLA - AMERICA'S BEST PASTA
TYPED FORM	Yes
<b>BASIS FOR FILING AND GOODS/SERVICES INFORMATION</b>	
INTENT TO USE: SECTION 1(b)	Yes
INTERNATIONAL CLASS NUMBER	030
LISTING OF GOODS AND/OR SERVICES	PASTA, PASTA PRODUCTS, SAUCES FOR PASTA
<b>ATTORNEY INFORMATION</b>	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800

CITY	Washington
STATE	DC
COUNTRY	USA
ZIP/POSTAL CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
ATTORNEY DOCKET NUMBER	2778-128
OTHER APPOINTED ATTORNEY(S)	Robert H. Cameron; Anne M. Sterba
<b>DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT</b>	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800
CITY	Washington
STATE	DC
ZIP CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
<b>FEE INFORMATION</b>	
TOTAL FEES PAID	325
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1

78136701

<b>LAW OFFICE INFORMATION</b>	
E-MAIL ADDRESS FOR CORRESPONDENCE	N/A
<b>SIGNATURE AND OTHER INFORMATION</b>	
SIGNATURE	/Robert H. Cameron/
DATE	06/18/2002
NAME	Robert H. Cameron
TITLE	Attorney for Applicant
<b>MAILING ADDRESS</b>	
LINE	G. Franklin Rothwell, Esq.
LINE	Rothwell, Figg, Ernst & Manbeck, P.C.
LINE	1425 K Street, NW Suite 800
LINE	Washington DC 20005
<b>RAM INFORMATION</b>	
RAM SALE NUMBER	122
RAM ACCOUNTING DATE	20020619
<b>SERIAL NUMBER INFORMATION</b>	
SERIAL NUMBER	78/136701
INTERNET TRANSMISSION DATE	Tuesday, 06-18-2002 16:36:18 EDT
TEAS STAMP	USPTO-12150177130-20020618163622437-78/136701-124e0249a8338c1d8f28003cf12cfeb55ea-RAM-122-20020618163522437
E-MAIL ADDRESS FOR ACKNOWLEDGMENT	bmannings@rothwellfigg.com

&lt;SERIAL NUMBER&gt; 78136701

&lt;FILING DATE&gt; 06/18/2002

## &lt;DOCUMENT INFORMATION&gt;

&lt;TRADEMARK/SERVICEMARK APPLICATION&gt;

&lt;VERSION 1.24&gt;

## &lt;APPLICANT INFORMATION&gt;

&lt;NAME&gt;

Barilla Alimentare S.p.A.

&lt;STREET&gt;

Via Mantova 166

&lt;CITY&gt;

Parma PR

&lt;COUNTRY&gt;

Italy

&lt;ZIP/POSTAL CODE&gt;

43100

## &lt;APPLICANT ENTITY INFORMATION&gt;

&lt;CORPORATION: STATE/COUNTRY OF INCORPORATION&gt; Italy

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

&lt;MARK&gt; BARILLA - AMERICA'S BEST PASTA

&lt;TYPED FORM&gt; Yes

\* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). \*

## &lt;BASIS FOR FILING AND GOODS/SERVICES INFORMATION&gt;

&lt;INTENT TO USE: SECTION 1(b)&gt; Yes

\* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) \*

&lt;INTERNATIONAL CLASS NUMBER&gt; 030

&lt;LISTING OF GOODS AND/OR SERVICES&gt; PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

## &lt;ATTORNEY INFORMATION&gt;

&lt;NAME&gt;

G. Franklin Rothwell, Esq.

&lt;STREET&gt;

1425 K Street, NW Suite 800

&lt;CITY&gt;

Washington

&lt;STATE&gt;

DC

&lt;COUNTRY&gt;

USA

&lt;ZIP/POSTAL CODE&gt;

20005

&lt;FIRM NAME&gt;

Rothwell, Figg, Ernst &amp; Manbeck, P.C.

<TELEPHONE NUMBER> 202-783-6040  
 <FAX NUMBER> 202-783-6031  
 <ATTORNEY DOCKET NUMBER> 2778-128  
 <OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>

\* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served \*

<NAME> G. Franklin Rothwell, Esq.  
 <STREET> 1425 K Street, NW Suite 800  
 <CITY> Washington  
 <STATE> DC  
 <ZIP CODE> 20005  
 <FIRM NAME> Rothwell, Figg, Ernst & Manbeck, P.C.  
 <TELEPHONE NUMBER> 202-783-6040  
 <FAX NUMBER> 202-783-6031

<FEE INFORMATION>

<TOTAL FEES PAID> 325  
 <NUMBER OF CLASSES PAID> 1  
 <NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>

<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

<SIGNATURE AND OTHER INFORMATION>

\* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. \*

<SIGNATURE> /Robert H. Cameron/  
 <DATE> 06/18/2002

78136701

<NAME>  
<TITLE>

Robert H. Cameron  
Attorney for Applicant

<MAILING ADDRESS>

<LINE> G. Franklin Rothwell, Esq.  
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.  
<LINE> 1425 K Street, NW Suite 800  
<LINE> Washington DC 20005

<RAM INFORMATION>

<RAM SALE NUMBER> 122  
<RAM ACCOUNTING DATE> 20020619

<SERIAL NUMBER INFORMATION>

<SERIAL NUMBER> 78/136701  
<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:36:18 EDT  
<TEAS STAMP>

USPTO-12150177130-20020618163622437-78/136701-

124e0249a8338c1d8f28003cf12cf55ea-RAM-122-20020618163522437

E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmannings@rothwellfigg.com

78136701

06/21/2002 9:46 AM

Internet Transmission Date:  
2002/06/18

Serial Number:  
78136701

Filing Date:  
2002/06/18

TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 122  
RAM ACCOUNTING DATE: 20020619

NO OCR

06-18-2002

2778-128  
GPR:RHC:czb



Examining Attorney: SPRUILL, DARRYL  
Serial Number: 78/136701



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Barilla Alimentare S.p.A. )  
Serial No. 78/136,701 ) Trademark Attorney  
Filed: June 18, 2002 ) Darryl M. Spruill  
Mark: BARILLA - AMERICA'S ) Law Office 101  
BEST PASTA )

AMENDMENT AND RESPONSE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Dear Sir:

Applicant hereby responds to Office Action No. 01 in  
accordance with the headings therein.

IN THE IDENTIFICATION OF GOODS

Kindly amend the identification of goods in the subject  
application as follows:

--PASTA, PASTA PRODUCTS, NAMELY MEALS  
CONSISTING PRIMARILY OF PASTA, MACARONI  
SALAD, PASTA SALAD, SAUCES FOR PASTA in  
International Class 30.--

DISCLAIMER REQUIREMENT

The Office Action has called for Applicant to disclaim the  
wording "AMERICA'S BEST PASTA" apart from the mark as shown. The  
grounds cited are that AMERICA'S has geographical significance,



BEST is a laudatory term and PASTA is a generic term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregistrable components of a mark otherwise registrable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive, Applicant respectfully traverses the requirement to disclaim AMERICA'S BEST PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983) ("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA<sup>1</sup>, but obviously creates a commercial impression distinct from that of its house mark. Professor McCarthy provides an illustrative

<sup>1</sup>

See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.

example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991) ("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S BEST PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S BEST PASTA clearly characterize the well-recognized trademark of Applicant -- in other words, they meld with the BARILLA registered mark. All of these factors support a

determination that Applicant's proposed slogan is a unitary mark.  
See Dena, 950 F.2d at 1561 (citing TMEP § 807.13(a) (rev. 1986)).  
For the foregoing reasons, Applicant believes that disclaimer of  
AMERICA'S BEST PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully  
requested that the subject application be approved for  
publication.

Respectfully submitted,

By Robert H. Cameron  
G. Franklin Rothwell  
Robert H. Cameron  
Attorneys for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

2778-128  
GRF:mec:nlf



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Barilla Alimentare S.p.A.	)	
Serial No. 78/136,701	)	
Filed: June 18, 2002	)	Trademark Attorney
	)	Darryl M. Spruill
Mark: BARILLA-AMERICA'S	)	
BEST PASTA	)	Law Office 112

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003,  
Applicant responds in accordance with the headings therein.

DISCLAIMER

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use  
"AMERICA'S BEST PASTA" apart from the mark as  
shown.--

REMARKS

Since this appears to be the only outstanding matter at  
issue it appears this application is in condition to be  
approved for publication.



11-14-2003  
U.S. Patent & TMO/TM Mail Rpt Dt. #11

Serial No.: 78/136,701  
Mark: BARILLA - AMERICA'S BEST PASTA  
Attorney Docket No.: 2778-128

Respectfully submitted,

Barilla Alimentare S.p.A.

By: G. F. Rothwell  
G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040



177D-128  
GK:tpd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
 )  
Barilla G. E R. Fratelli - ) Attention: John Wood  
Societa Per Azioni )  
 )  
Serial No. 78/136701 ) Intent-to-Use Division  
 )  
Filed: June 18, 2002 )  
 )  
Mark: BARILLA - AMERICA'S )  
BEST PASTA )

NOTIFICATION PURSUANT TO 37 C.F.R. § 3.85 AND  
REQUEST FOR ISSUANCE OF  
CERTIFICATE OF REGISTRATION IN NEW NAME

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514



09-10-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #64

Dear Sir:

Applicant wishes to notify the Office that the above-identified applicant has changed its name and address to:

**BARILLA G. E R. FRATELLI - SOCIETÀ PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY**

A request for recordation of the change of name was filed and recorded with the U. S. Patent and Trademark Office on May 18, 2004, at Reel/Frame numbers 002852/0797. Subsequently, an address change was recorded with the U. S. Patent and Trademark Office on August 26, 2004 at Reel/Frame numbers 002923/0924. A copy of the abstract of title is enclosed for your ready reference.

It is requested that the subject application be amended accordingly and that the certificate of registration be issued with Applicant's new name at the appropriate time.

Respectfully submitted,

By



G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, p.c.  
1425 K Street, N.W. Suite 800  
Washington, D.C. 20005  
Telephone: (202) 783-6040



United States Patent and Trademark Office

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Assignments on the Web &gt; Trademark Query

## Trademark Assignment Abstract of Title

## Total Assignments: 2

Serial #: 78136701

Filing Dt: 06/18/2002

Reg #: NONE

Reg. Dt:

Applicant: Barilla Alimentare S.p.A.

Mark: BARILLA - AMERICA'S BEST PASTA

## Assignment: 1

Reel/Frame: 2852/0797

Received: 05/18/2004

Recorded: 05/18/2004

Pages: 3

Conveyance: CHANGE OF NAME

Assignor: BARILLA ALIMENTARE S.P.A.

Exec Dt: 12/24/2003

Entity Type: CORPORATION

Citizenship: ITALY

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO BARILLA 3/A  
PARMA, ITALY

Correspondent: G. FRANKLIN ROTHWELL  
1425 K STREET NW  
SUITE 800  
WASHINGTON, DC 20005

## Assignment: 2

Reel/Frame: 2923/0924

Received: 08/26/2004

Recorded: 08/26/2004

Pages: 4

Conveyance: CHANGE OF ADDRESS

Assignor: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

Exec Dt: 02/12/2004

Entity Type: CORPORATION

Citizenship: ITALY

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY

Correspondent: G. FRANKLIN ROTHWELL  
1425 K STREET NW  
SUITE 800  
WASHINGTON, DC 20005

Search Results as of: 09/10/2004 12:11 PM

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 703-308-9723



2778-128  
GFR: rpd



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Barilla G. E R. Fratelli -	)	Box: ITU
Societa Per Azioni	)	
Serial No. 78/136701	)	Notice of Allowance
Filed: June 18, 2002	)	Mailing Date:
Mark: BARILLA - AMERICA'S BEST	)	May 25, 2004
PASTA	)	

SUBMISSION OF FIRST REQUEST FOR  
EXTENSION OF TIME TO FILE A STATEMENT OF USE

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

Dear Sir:

Submitted herewith for filing is a First Request for Extension of Time to file a Statement of Use. Also attached is a check for \$150.00 in payment of the Government fee for 1 class at \$150.00 per class. If any additional payment is required, please charge the cost thereof to Deposit Account No. 02-2135. An extra copy of this letter is attached for that purpose.

Respectfully submitted,

By G. F. Rothwell  
G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

2772-128  
GER:pd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )

Barilla G. E. R. Fratelli -  
Societa Per Azioni

Box ITU

Serial No. 78/136701

Notice of Allowance

Filed: June 18, 2002

Mailing Date:

May 25, 2004

Mark: BARILLA - AMERICA'S BEST  
PASTA

SUBMISSION OF FIRST REQUEST FOR  
EXTENSION OF TIME TO FILE A STATEMENT OF USE

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

Dear Sir:

Submitted herewith for filing is a First Request for  
Extension of Time to File a Statement of Use. Also attached is a  
check for \$150.00 in payment of the Government fee for 1 class at  
\$150.00 per class. If any additional payment is required, please  
charge the cost thereof to Deposit Account No. 02-2135 [REDACTED]

Respectfully submitted,

By

*G. F. Rothwell*

G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

**REQUEST FOR EXTENSION OF TIME TO FILE A STATEMENT OF USE (15 U.S.C. § 1051(d))**

To the Commissioner for Trademarks

**<TRADEMARK/SERVICEMARK INFORMATION>**

<Mark> BARILLA - AMERICA'S BEST PASTA

<Serial Number> 78/136701

**<APPLICANT INFORMATION>**

<Name> BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

<Street> VIALE RICCARDO E PIETRO BARILLA 3/A

<City> PARMA

<Country> ITALY

**<NOTICE OF ALLOWANCE INFORMATION>**

<Notice of Allowance Mailing Date> 05/25/2004

**<GOODS AND/OR SERVICES INFORMATION>**

<All Goods and/or Services in Notice of Allowance> *The owner has a continued bonafide intention to use the mark in commerce on or in connection with all the goods and/or services listed in the Notice OF ALLOWANCE. If not, list in the next section the goods and/or services to be deleted*

<Goods and/or Services to be Deleted> In following space, list only those goods/services (or entire classes(es)) appearing in the Notice of Allowance for which the owner does not have a continued bonafide intention to use the mark in commerce. **LEAVE THIS SPACE BLANK IF THE OWNER DOES HAVE A CONTINUED BONA FIDE INTENTION TO USE THE MARK IN COMMERCE ON OR IN CONNECTION WITH ALL GOODS/SERVICES LISTED IN THE NOTICE OF ALLOWANCE.**

**<EXTENSION REQUEST INFORMATION>**

<Number of Extension Request> FIRST

**<ONGOING EFFORTS TO USE MARK IN COMMERCE>** *Applies to 2nd, 3rd, 4th & 5th extension requests only.*

The owner has made the following ongoing efforts to use the mark in commerce on or in connection with those goods and/or services for which use of the mark in commerce has not yet been made. <Explanation>

**<STATEMENT OF USE SUBMITTED>** *if applicable*

<Additional Time Requested> Enter YES if you believe the applicant has made valid use of the mark in commerce, as evidenced by the Statement of Use submitted with this request. If the Statement of Use does not meet the requirements of 37 C.F.R. 2.88, you request additional time to correct the Statement of Use. If not, you enter NO.

NO

<FEE INFORMATION>

\$150 x <Number of Classes> 1 = <Total Filing Fee Paid> \$150.00

<SIGNATURE INFORMATION>

Applicant is the owner of the mark sought to be registered and has a continued bona fide intention to use the mark in commerce on or in connection with all the goods and/or services listed in the Notice of Allowance. Applicant requests a six-month extension of time to file the Statement of Use under 37 CFR 2.89.

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner-, and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.-

Signature

*G. F. Rothwell*

<Date Signed> November 16, 2004

<Name> G. Franklin Rothwell

<Title> Attorney for Applicant

<CONTACT INFORMATION>

<Name> G. Franklin Rothwell

<Company/Firm Name> Rothwell, Figg, Ernst & Manbeck, p.c.

<Street> Suite 800, 1425 K Street, N.W.

<City> Washington

<State> D.C.

<Country> U.S.A.

<Zip/Postal Code> 20005

<Telephone Number> 202-783-6040

<Fax Number> 202-783-6031

<e-Mail Address> info@rothwellfigg.com

<Attorney Docket Number> 2778-128

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136701

APPLICANT:

Barilla Alimentare S.p.A.

CORRESPONDENT ADDRESS:

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW Suite 800  
Washington DC 20005

RETURN ADDRESS:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
ecom112@uspto.gov

MARK: BARILLA - AMERICA'S BEST PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-128

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/136701

This letter responds to the applicant's communication filed April 15, 2003.

STATUS OF THE APPLICATION

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

REFUSAL

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229

USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, TMEP §1209.03(s):

#### 1209.03(s) Slogans

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

The wording AMERICA'S BEST PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (BEST), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of *selected* excerpts of stories taken from LEXIS/NEXIS® computerized database, listing the terms BEST PASTA (the examining attorney also attaches selected excerpts of stories featuring the terms AMERICA'S FAVORITE PASTA). See the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2 (e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the term AMERICA'S with other descriptive matter disclaimed. See the attached enclosure.<sup>[1]</sup> Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R.*



Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of "AMERICA'S BEST PASTA " is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill  
Trademark Attorney  
Law Office 112  
(703) 308-9112, Ext. 203  
darryl.spruill@uspto.gov  
/Darryl M. Spruill/

#### RESPONSE GUIDELINES

The applicant may respond via regular mail to the address listed above, or via e-mail to [Ecom112@uspto.gov](mailto:Ecom112@uspto.gov). In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;
2. send the response to [mailto:ecom112@uspto.gov](mailto:mailto:ecom112@uspto.gov). E-mail sent to any other address will N processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG forms NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to [Comments@uspto.gov](mailto:Comments@uspto.gov).

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless

specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

**EVIDENCE**

108B8C

Print Request: Selected Document(s): 2-7,13,16-19,27,31,35-41,43-45,47

Time of Request: June 17, 2003 09:04 PM EDT

Number of Lines: 513

Job Number: 1842:0:4168371

Client ID/Project Name:

Research Information:

US Newspapers and Wires

"BEST pasta!"

Send to: SPRUILL, DARRYL  
TRADEMARK LAW LIBRARY  
2101 CRYSTAL PLAZA ARC  
MAILBOX 314  
ARLINGTON, VIRGINIA 22202-4600

2 of 680 DOCUMENTS



Copyright 2003 Charleston Newspapers  
Charleston Gazette (West Virginia)

May 25, 2003, Sunday

**SECTION:** Life; Pg. P7F

**LENGTH:** 367 words

**HEADLINE:** All ears, Unique pasta shapes adds a little Puglia to your pantry May 25, 2003, Sunday

**BYLINE:** Robert J. Byers and Tara Tuckwiller robbyers@wvgazette.com, tara@wvgazette.com

**BODY:**

Durum wheat is coarsely ground into semolina, the basis for the world's **best pastas**. Different regions of Italy favor different pasta shapes. In the south, ziti and the Pugliese specialty orecchiette top the list. ...

3 of 680 DOCUMENTS

Copyright 2003 The State (Columbia, SC)  
All Rights Reserved  
The State (Columbia, SC)

April 27, 2003 Sunday FINAL EDITION

**SECTION:** F; Pg. 1

**LENGTH:** 847 words

**HEADLINE:** From the vantage of the consumer, the world of dry pasta hasn't changed...

**BYLINE:** By JIM DuPLESSIS; Staff Writer

**BODY:**

...coupled an \$100 million-plus investment with an idea as simple as a straight pin.

"We're trying to make the very **best pasta** at the lowest possible price," said Christopher Gooding, quality assurance manager for the 140-employee plant that made ...

4 of 680 DOCUMENTS

Copyright 2003 The Detroit News  
All Rights Reserved  
The Detroit News

April 16, 2003 Wednesday No dot Edition

**SECTION:** SPECIAL; Pg. 4M

**LENGTH:** 950 words

**HEADLINE:** MICHIGAN'S BEST;  
Food and Drink

**BODY:**

...Mound Rd., Sterling Heights (586) 997-2999

Third place: Hooters

Multiple locations throughout Metro Detroit

**BEST PASTA DISHES**

Antonio's Cucina Italiana

Dearborn Heights and Farmington Hills

Second place: Olive Garden

Multiple locations throughout ...

5 of 680 DOCUMENTS

Copyright 2003 The Journal News (Westchester County, NY)  
All Rights Reserved  
The Journal News (Westchester County, NY)

April 13, 2003 Sunday

**SECTION:** DESTINATIONS; Pg. 1H

**LENGTH:** 2301 words

**HEADLINE:** The shore

**BYLINE:** Mary Shustack, Staff

**BODY:**

...antiques and gift shops, playing more than a few arcade games and dining on everything from fish and chips to one of the **best pasta** dishes I've ever tasted.

6 of 680 DOCUMENTS

Copyright 2003 The Courier-Journal (Louisville, KY)

All Rights Reserved

The Courier-Journal (Louisville, KY)

April 2, 2003 Wednesday metro Met Edition

**SECTION:** FEATURES; Pg. 1C

**LENGTH:** 1286 words

**HEADLINE:** Five easy pastas;  
Noodles are long on variety, short on cooking time

**BYLINE:** FRITSCHNER SARAH, sfritschner@courier-journal.com

**BODY:**

...can only "guesstimate" what the proportions of his ingredients are. We've formed the guess into a recipe that is easy and delicious. He insists on using the **best pasta**. His choice: De Cecco .

1 pound linguine

Salt

2 tablespoons olive oil, approximately

16 ounces mixed ...

7 of 680 DOCUMENTS

Copyright 2003 Press & Sun-Bulletin (Binghamton, NY)  
All Rights Reserved  
Press & Sun-Bulletin (Binghamton, NY)

April 1, 2003 Tuesday

**SECTION:** LIFESTYLE; Pg. 1C

**LENGTH:** 522 words

**HEADLINE:** GOING SOMEWHERE - Most directions lead to the land of the lost

**BYLINE:** MATT SULLIVAN

**BODY:**

...out-of-town friends over how empty their lives must be without spiedies; arguing bitterly with friends about who has the best pasta sauce.

13 of 680 DOCUMENTS

Copyright 2003 St. Louis Post-Dispatch, Inc.  
St. Louis Post-Dispatch (Missouri)

February 26, 2003 Wednesday Five Star Late Lift Edition

**SECTION:** LET'S EAT ; Pg. 10

**LENGTH:** 977 words

**HEADLINE:** POTPOURRI

**BODY:**

...piece Circulon cookware set and a selection of other prizes. For information, go to [www.parade.com](http://www.parade.com), or write to: "**Best Pasta** in the U.S.A. Recipe Contest," P.O. Box 5099, Grand Central Station, New York, N.Y. 10163-5099. ...

16 of 680 DOCUMENTS

Copyright 2003 Boston Herald Inc.  
The Boston Herald

February 15, 2003 Saturday ALL EDITIONS

**SECTION:** NEWS; Pg. 008

**LENGTH:** 701 words

**HEADLINE:** Valentis bid reluctant farewell to loving matriarch of family

**BYLINE:** By JOE FITZGERALD

**BODY:**

...sundaes.' Then when the fair was switched to later in the fall, too cold for ice cream, she opened Mary's Italian Kitchen, advertising 'the best pasta e fagiolo in the country.' When she got sick a few years ago, she finally closed it, but I'm ...

17 of 680 DOCUMENTS

Copyright 2003 The Oregonian  
The Oregonian

February 14, 2003 Friday SUNRISE EDITION

**SECTION:** ARTS AND LIVING; Pg. 31

**LENGTH:** 334 words

**HEADLINE:** MARY ELLEN ROWE

**SOURCE:** By Ted Mahar, The Oregonian

**BODY:**

...84 Charing Cross Road' -- dear friends and love of books; 'Heartburn' -- great Carly Simon songs, food is love, **best pasta** carbonara; 'Out of Africa' -- three hankies, music, scenery, be careful what you ask for; 'Shadowlands' -- Debra Winger and Anthony Hopkins, ...

18 of 680 DOCUMENTS

Copyright 2003 San Jose Mercury News  
All Rights Reserved  
San Jose Mercury News (California)

February 12, 2003 Wednesday MO1 EDITION

**SECTION:** FO; Pg. 3

**LENGTH:** 154 words

**HEADLINE:** A memorable casserole

**BYLINE:** By Linda Gassenheimer, Knight Ridder

**BODY:**

...sauce are other time savers.

The pasta is cooked in the skillet with the other ingredients, not boiled separately. As a result, the **best pasta** for this is fresh. If you do use dried pasta, you'll need to increase the cooking time to 15 minutes and add 1/2 ...

19 of 680 DOCUMENTS

Copyright 2003 The Buffalo News  
Buffalo News (New York)

February 2, 2003 Sunday, FINAL EDITION

**SECTION:** FIRST SUNDAY, Pg.M12

**LENGTH:** 1039 words

**HEADLINE:** WHEN BEEF IS KING;  
SAM REDA'S LATEST PUSH TOWARD CULINARY EXCELLENCE

**BYLINE:** LOIS BAKER

**BODY:**

...on its quality: "Some meat I pay for is \$16 a pound," he says. "If you have an Italian restaurant, you better have the **best pasta**. If you have a French restaurant, you better have the best foie gras. And if you have a steakhouse, you better have the best meat."

Red meat reigns, ...

**GRAPHIC:** Photos by SHARON CANTILLON/Buffalo News "If you have an Italian restaurant, you better have the **best pasta**," says Reda. "If you have a steakhouse, you better have the best meat," Reda's creativity has a chance to shine in his appetizers such as tuna ...

27 of 680 DOCUMENTS

Copyright 2003 The Hearst Corporation  
The Times Union (Albany, NY)

January 26, 2003 Sunday THREE STAR EDITION

**SECTION:** CAPITAL REGION, Pg. D3

**LENGTH:** 982 words

**HEADLINE:** Tampa Bay ends doctor's dream of Super Bowl duty

**BYLINE:** Marv Cermak

**BODY:**

...minutes," he said as though the whole town was headed there.

The Italian men's club was my destination because I heard that was the place where you could get the **best pasta fagioli** in the region on the third Friday of each month.

Members of the 102-year-old nonprofit organization said the ...

31 of 680 DOCUMENTS

Copyright 2003 The News Journal (Wilmington, DE)

All Rights Reserved

The News Journal (Wilmington, DE)

January 17, 2003 Friday

**SECTION:** 55 HOURS; Eric Ruth; Pg. 24Z

**LENGTH:** 935 words

**HEADLINE:** Food falls short of warm welcome

**BYLINE:** Staff

**BODY:**

...remember to actually bring the bread.

It's those little touches - along with dependably solid execution - that help lift Little Italy's **best pasta** houses beyond their simple roots. At Assunta's, that execution can be unpredictable: First you're full of admiration over how ...

35 of 680 DOCUMENTS

Copyright 2002 Stern Publishing, Inc.

LA Weekly (California)



December 27, 2002, Friday

**SECTION:** Food; Pg. 50

**LENGTH:** 547 words

**HEADLINE:** NINE KICK-ASS DISHES FROM 2002

**BODY:**

...filling porcini mushrooms. A little olive oil, a little sea salt, some good cheese, and there it is -- the best pasta I had all year.

36 of 680 DOCUMENTS

Copyright 2002 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

November 24, 2002 Sunday FIVE STAR EDITION

**SECTION:** TRAVEL, Pg.H-5

**LENGTH:** 904 words

**HEADLINE:** URUGUAYANS LEAD TRANQUIL LIVES DESPITE TUMULTUOUS TIMES

**BYLINE:** ROYE WERNER, SPECIAL TO THE POST-GAZETTE

**BODY:**

...peppers, cheese, onions, pineapple, eggplant and a fried egg.

In addition, the wave of Italian immigration brought over its best pasta tradition, as seen on just about every menu and in the ubiquitous fresh pasta shops. On the 29th of every ...

37 of 680 DOCUMENTS

Copyright 2002 Stern Publishing, Inc.  
LA Weekly (California)

November 22, 2002, Friday

**SECTION:** Restaurants; Pg. 56

**LENGTH:** 1003 words

**HEADLINE:** MOSTLY VINCENT

**BYLINE:** MICHELLE HUNEVEN

**BODY:**

...crisped flowers with soft, moist hearts. But the showstopper and hands-down best dish of the night -- and possibly one of the five **best pasta** dishes in all of Los Angeles -- was a house-made, ribbony, papardelle with sauteed porcini mushrooms. The mushrooms were slippery and ...

38 of 680 DOCUMENTS

Copyright 2002 Globe Newspaper Company  
The Boston Globe

November 10, 2002, Sunday ,THIRD EDITION

**SECTION:** CITY WEEKLY; Pg. 2

**LENGTH:** 717 words

**HEADLINE:** CITY WEEKLY / TABLE HOPPING;  
WITH WARMEST DISHES

**BYLINE:** SACHA PFEIFFER

**BODY:**

...solely on retail and wholesale pasta-making, a craft he's practiced for 20 years. Dave's makes some of the **best pasta** around, in flavors like chipotle, chive, and jalapeno, and its ravioli are fantastic, from simple cheese-basil to artichoke-fontina, goat ...

39 of 680 DOCUMENTS

Copyright 2002 Internet Wire, Incorporated.  
All rights reserved.  
Internet Wire

October 15, 2002 Tuesday

**LENGTH:** 480 words

**HEADLINE:** Travellers Make The Evolutionary Jump To GLOBOsapiens

**DATELINE:** Oct 15, 2002; SYDNEY, AUSTRALIA; INTERNET WIRE

**BODY:**

...visa for Bhutan, if anyone's interested in joining you for a cycling tour of Europe, what camera gear to take, or where's the best pasta place in Florence.

GLOBOsapiens is the inspiration of Andy Pucko, an Interactive Media graduate from the University of Applied Sciences in ...

40 of 680 DOCUMENTS

Copyright 2002 The Dallas Morning News  
The Dallas Morning News

October 9, 2002, Wednesday SECOND EDITION

**SECTION:** TEXAS TASTE; Pg. 2F; CATHY BARBER cbarber@dallasnews.com

**LENGTH:** 880 words

**HEADLINE:** Chef Mario's fishy mission

**BYLINE:** CATHY BARBER

**BODY:**

...Reggiano, the "king of cheeses."

\*Dried pasta. He says the Rustichella d'Abruzzo brand sold at Viking and other stores is one of the best pastas in the world. In Italy, he said, pasta is sauced lightly, more like Americans dress their salads.  
C.B.

MORE FROM ...

41 of 680 DOCUMENTS

Copyright 2002 Tulare Advance-Register (Tulare, CA)  
All Rights Reserved  
Tulare Advance-Register (Tulare, CA)

October 8, 2002 Tuesday

**SECTION:** LOCAL; Pg. 2A

**LENGTH:** 425 words

**HEADLINE:** Elite eateries honored

**BYLINE:** Laura Florez, Staff

**BODY:**

...Rosal

Best Chocolate Creation Vintage Press

Best Pie or Cake Ryan's Place

Best Gourmet Pizza Fugazzi's

**Best Pasta Dish** Rosa's

Best Fries McDonald's

Best Milkshake Mearle's

Best Dinner for Two The Depot

Best Wine ...

43 of 680 DOCUMENTS

Copyright 2002 The Times Mirror Company; Los Angeles Times All Rights  
Reserved  
Los Angeles Times

October 2, 2002 Wednesday Home Edition

**SECTION:** Food; Part 8; Page 1; Features Desk

**LENGTH:** 2184 words

**HEADLINE:** The Strands of Luxury;  
Is a box of artisanal spaghetti worth the splurge? We test 11 brands and make a surprising discovery.

**BYLINE:** RUSS PARSONS, TIMES STAFF WRITER

**BODY:**

...nothing new. Until the early 20th century, Italy's great sources of durum wheat were the Ukraine and Volga River valley. The very **best pastas** were labeled "Taganrog," for the Russian port city on the sea of Azov, near the Black Sea, from which they were shipped. This source dried ...

44 of 680 DOCUMENTS

Copyright 2002 The Courier-Journal (Louisville, KY)  
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The Courier-Journal (Louisville, KY)

September 20, 2002 Friday Met and metro Editions

**SECTION:** FEATURES; IN SEARCH OF GREAT FOOD; Pg. 1C

**LENGTH:** 557 words

**HEADLINE:** A spoonful of pesto can make perfect pasta or soup

**BYLINE:** FRITSCHNER SARAH

**BODY:**

...middle and a pat of butter atop that. The diner stirs the noodles to coat them, in a dish that David describes as "perhaps the **best pasta** dish in all of Italy."

Or, spoon pesto into the bottom of a bowl before you ladle in hearty vegetable soup ( ...

45 of 680 DOCUMENTS

Copyright 2002 The Wichita Eagle  
All Rights Reserved  
The Wichita Eagle

September 13, 2002 Friday MAIN EDITION

**SECTION:** C; Pg. 24

**LENGTH:** 567 words

**HEADLINE:** Order this next time;  
Local chefs and restaurateurs name the best on their menus.

**BYLINE:** DENISE NEIL The Wichita Eagle

**BODY:**

...Mill, 549 S. Rock Road

The best: Desert fire pasta

Head chef Bill Breen says his restaurant has the **best pastas** in town, but the standout is the desert fire pasta, which features linguine, shrimp and mushrooms in a spicy cream ...

47 of 680 DOCUMENTS

Copyright 2002 The Tennessean  
All Rights Reserved  
The Tennessean

August 25, 2002 Sunday 1st Edition

**SECTION:** WAM; DINING IN; Pg. 5W

**LENGTH:** 814 words

**HEADLINE:** Humor and fun define Natalie Mertie's kitchen

**BYLINE:** VICKI STOUT

**BODY:**

...stir up some mighty fine lemonade, nonetheless.

Contact VickiStout@aol.com with suggestions for Dining In.

**Best pasta ever**

Prepare box or package of bowtie pasta. Add generous amounts of toasted pine nuts, sliced sun-dried tomatoes, ...





108B8C

Print Request: Selected Document(s): 5-8,10,13,16

Time of Request: June 17, 2003 08:15 PM EDT

Number of Lines: 159

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Research Information:

US Newspapers and Wires

"america! favorite! pasta"

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5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.  
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

**SECTION:** LIFESTYLE / FOOD; Pg. F06

**LENGTH:** 449 words

**HEADLINE:** SAUCE IT UP, VEGAN STYLE

**COLUMN:** NATURALLY YOURS

**BYLINE:** JAN WOLFF

**BODY:**

...your spaghetti, and if you're a vegan, you may still  
crave a sprinkling of Parmesan now and then. What's left to put on  
**America's favorite pasta?** Plain old tomato sauce can get tiresome, even  
if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.  
PR Newswire

April 24, 1998, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO FOOD, NATIONAL AND FEATURES EDITORS

**LENGTH:** 301 words

**HEADLINE:** Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998  
**LEXIS-NEXIS Related Topics** Full Article Related Topics Overview

This document contains no targeted Topics.

**DATELINE:** NEW YORK, April 24

**BODY:**

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of **America's favorite pasta** dish is based on consumer research as well as pasta's history in the U.S.," said Julia Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

**SECTION:** FOOD, Pg. J10

**LENGTH:** 475 words

**HEADLINE:** Beard awards nominees

**BODY:**

...Vegetable Cookbook" by Lorraine Bodger, "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, **America's Favorite Pasta**" by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.  
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

**SECTION:** FLORIDA; Pg. 18

**LENGTH:** 861 words

**HEADLINE:** FOR YOUNG TASTE BUDS ONLY

**BYLINE:** By Scott Joseph, Sentinel Restaurant Critic

**BODY:**

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for Americas favorite pasta.

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.  
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

**SECTION:** FEATURES; Pg. 3E

**LENGTH:** 806 words

**HEADLINE:** AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

**BYLINE:** Michael Storey

**BODY:**

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with America's favorite pasta-eating cat going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company; Los Angeles Times All Rights  
Reserved  
Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

**SECTION:** Business; Part D; Page 1; Column 2; Financial Desk

**LENGTH:** 924 words

**HEADLINE:** FARMERS COUNT ON A NEW CASH CROP: PASTA;  
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH DAKOTA  
WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

**BYLINE:** By GREG JOHNSON, TIMES STAFF WRITER

**DATELINE:** IRVINE

**BODY:**

...plant. We can grow it, mill it and send it through the noodle plant."

Pasta Popularity

Spaghetti and linguine are America's favorite pasta products, followed by elbows and twists. Dry pasta retail sales by shape in 1993:  
Long goods ( ...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;  
Copyright Business First of Louisville Inc. 1985;  
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATELINE: Louisville; KY; US

BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while America's favorite pasta may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

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[1] No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.



Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
www.uspto.gov

Feb 11, 2004

### NOTICE OF PUBLICATION UNDER 12(a)

- |                                     |  |
|-------------------------------------|--|
| 1. Serial No.:<br>78/136,701        | 2. Mark:<br>BARILLA - AMERICA'S BEST PASTA |
| 3. International Class(es):<br>30   |  |
| 4. Publication Date:<br>Mar 2, 2004 | 5. Applicant:<br>Barilla Alimentare S.p.A. |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: (202) 512-1800

By direction of the Commissioner.

---

Correspondence Address:

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW Suite 800  
Washington DC 20005

TMP&I

U.S. Patent and Trademark Office (USPTO)

NOTICE OF ALLOWANCE

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 703-746-3400. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: May 25, 2004

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW Suite 800  
Washington DC 20005

ATTORNEY  
REFERENCE NUMBER

2778-128

**\*\* IMPORTANT INFORMATION: 6 MONTH DEADLINE \*\***

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of Use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at <http://www.uspto.gov/teas/index.html> (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

The following information should be reviewed for accuracy:

SERIAL NUMBER: 78/136701  
MARK: BARILLA - AMERICA'S BEST PASTA  
OWNER: Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PR, ITALY 43100

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO      Section 1(b): YES      Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

030 - PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED



---

ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS



Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
[www.uspto.gov](http://www.uspto.gov)

## NOTICE OF APPROVAL OF EXTENSION REQUEST

Dec 4, 2004

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW Suite 800  
Washington DC 20005

TM12

ATTORNEY  
REFERENCE NUMBER:  
2778-128

SERIAL NUMBER: 78/136701  
MARK: BARILLA - AMERICA'S BEST PASTA  
OWNER: BARILLA G. E.R. FRATELLI - SOCIETA PER A  
EXTENSION REQUEST NUMBER: 1 NOTICE OF ALLOWANCE DATE: May 25, 2004

A Notice of Allowance was issued on May 25, 2004 for the trademark application identified above. The FIRST request for Extension of Time to File a Statement of Use has been approved. Applicant must continue to file extension requests every 6 months calculated from the date the Notice of Allowance was issued until a Statement of Use is filed. Please note that a Statement of Use cannot be filed more than 36 months from the issuance date of the Notice of Allowance.

For further information please check the USPTO web site at [www.uspto.gov](http://www.uspto.gov) or call the Trademark Assistance Center at 703-308-9000.

**Drawing Page**

**Serial Number:**

78136701

**Applicant:**

Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PR Italy 43100

**Goods and Services:**

PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

**Mark:**

BARILLA - AMERICA'S BEST PASTA

PUBLISHED  
3/2/04

NO OCR

06-18-2002

\*\*\* User: dspruill \*\*\*

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	39	4	35	14	0:01	"barilla alimentare"[on]
02	1609	N/A	0	0	0:04	*b\$l r(v) l \$ l(v)*[bi,ti]
03	223	0	223	67	0:11	2 and "030"[cc] not dead[ld]
04	34385	N/A	0	0	0:06	*m{v}r{v}{"ckqx"}a*[bi,ti]
05	1017	N/A	0	0	0:11	*{"fh"}avor{v}t*[bi,ti]
06	8369	N/A	0	0	0:02	*be{"sz"}t*[bi,ti]
07	1530	N/A	0	0	0:01	*pre{"fp"}\$ler*[bi,ti]
08	23850	N/A	0	0	0:04	("1" one*)[bi,ti]
09	1325	N/A	0	0	0:01	*pa{"sz"}ta*[bi,ti]
10	901	N/A	0	0	0:01	4 and (5 6 7 8 9)
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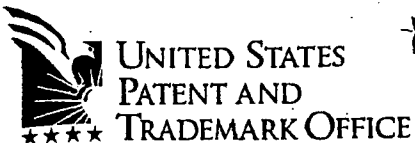
Session started 10/11/02 9:29:16 AM

Session finished 10/11/02 9:44:24 AM

Total search duration 0 minutes 53 seconds

Session duration 15 minutes 8 seconds

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Feb 11, 2004

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## NOTICE OF PUBLICATION UNDER 12(a)

- |                                     |  |
|-------------------------------------|--|
| 1. Serial No.:<br>78/136,701        | 2. Mark:<br>BARILLA - AMERICA'S BEST PASTA |
| 3. International Class(es):<br>30   |  |
| 4. Publication Date:<br>Mar 2, 2004 | 5. Applicant:<br>Barilla Alimentare S.p.A. |

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Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
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By direction of the Commissioner.

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW Suite 800  
Washington DC 20005

TMP&I

# TRADEMARK EXAMINATION WORKSHEET

☐ AMENDMENT STAGE

☒ NO CHANGE

☒ PUBLICATION/REGISTRATION STAGE

Name TRACY SMITH L.O. 112 Date 01/14/2004 Serial No. 7 /

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

## Legal Instrument Examiner (LIE)

	Amended	Data Element	
Class Data	<input type="checkbox"/>	<input type="checkbox"/> Prime/International Class	<input type="checkbox"/> Goods and Services
	<input type="checkbox"/>	<input type="checkbox"/> First Use Date	<input type="checkbox"/> First Use in Commerce Date
	<input type="checkbox"/>	<input type="checkbox"/> In Another Form	<input type="checkbox"/> Certification
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Mark Data	<input type="checkbox"/>	<input type="checkbox"/> Word Mark	<input type="checkbox"/> Pseudo Mark
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Misc. Mark Data	<input type="checkbox"/>	<input type="checkbox"/> Mark Description	<input type="checkbox"/> Disclaimer
	<input type="checkbox"/>	<input type="checkbox"/> Lining/Stippling	<input type="checkbox"/> Name/Portrait/Consent
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Section 2(f)	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Entire Mark	
	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Limitation Statement	<input type="checkbox"/> Section 2(f) in Part
	<input type="checkbox"/>	<input type="checkbox"/> Amended Register	<input type="checkbox"/> Amended Register Date
Foreign Reg. Data	<input type="checkbox"/>	<input type="checkbox"/> Foreign Country	<input type="checkbox"/> 44(d)
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	<input type="checkbox"/>	<input type="checkbox"/> Zip Code	
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	<input type="checkbox"/>	<input type="checkbox"/> Assignment(s)/Name Change	
Amd/Corr Restr.	<input type="checkbox"/>	<input type="checkbox"/> Concurrent Use	
Prior U.S. Reg.	<input type="checkbox"/>	<input type="checkbox"/> Prior Registration	
Correspondence	<input type="checkbox"/>	<input type="checkbox"/> Attorney	<input type="checkbox"/> Domestic Representative
	<input type="checkbox"/>	<input type="checkbox"/> Attorney Docket Number	
	<input type="checkbox"/>	<input type="checkbox"/> Correspondence Firm Name/Address	

I certify that all corrections have been entered in accordance with text editing guidelines.

LIE TRACY SMITH

Other: \_\_\_\_\_

# TRADE MARK EXAMINATION WORKSHEET

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Name TRACY SMITH L.O. 112 Date 12/ 16/2003 Serial No. 7 /

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

## Legal Instrument Examiner (LIE)

	Amended	Data Element	
Class Data		<input type="checkbox"/> Prime/International Class	<input type="checkbox"/> Goods and Services
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		<input type="checkbox"/> In Another Form	<input type="checkbox"/> Certification
		<input type="checkbox"/> 1b	
Mark Data		<input type="checkbox"/> Word Mark	<input type="checkbox"/> Pseudo Mark
		<input type="checkbox"/> Mark Drawing Code	<input type="checkbox"/> Design Search Code
		<input type="checkbox"/> Scan Sub Drawing	
Misc. Mark Data		<input checked="" type="checkbox"/> Mark Description	<input checked="" type="checkbox"/> Disclaimer
		<input type="checkbox"/> Lining/Stippling	<input type="checkbox"/> Name/Portrait/Consent
		<input type="checkbox"/> Translation	
Section 2(f)		<input type="checkbox"/> Section 2(f) Entire Mark	
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		<input type="checkbox"/> Amended Register	<input type="checkbox"/> Amended Register Date
Foreign Reg. Data		<input type="checkbox"/> Foreign Country	<input type="checkbox"/> 44(d)
		<input type="checkbox"/> Foreign Application Number	<input type="checkbox"/> Foreign Application Filing Date
		<input type="checkbox"/> Foreign Registration Number	<input type="checkbox"/> Foreign Registration Date
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Owner Data		<input type="checkbox"/> Owner Name	<input type="checkbox"/> DBA/AKA/TA
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		<input type="checkbox"/> Entity Statement	<input type="checkbox"/> Composed of
		<input type="checkbox"/> Assignment(s)/Name Change	
Amd/Corr Restr.		<input type="checkbox"/> Concurrent Use	
Prior U.S. Reg.		<input type="checkbox"/> Prior Registration	
Correspondence		<input type="checkbox"/> Attorney	<input type="checkbox"/> Domestic Representative
		<input type="checkbox"/> Attorney Docket Number	
		<input type="checkbox"/> Correspondence Firm Name/Address	

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LIE

DATE

TRACY SMITH

12/ 16/2003

Other:

DEC 23 2003



# Incoming Correspondence Routing Sheet

To: ~~OFFICE OF TRADEMARK QUALITY REVIEW~~

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Word Mark: BARILLA - AMERICA'S BEST PASTA

Serial No: 78136701

Mail Date: 11142003

Doc. Type: Responses to Office Actions

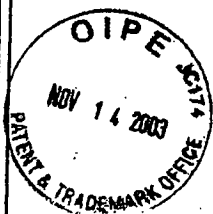
12/03

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No Fee

RAM Mail Date: 111403

2778-128  
GRF:mec:nlf



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Barilla Alimentare S.p.A.

Serial No. 78/136,701

Filed: June 18, 2002

Mark: BARILLA-AMERICA'S  
BEST PASTA

)  
)  
) Trademark Attorney  
) Darryl M. Spruill

) Law Office 112  
)

RECEIVED

2003 DEC -3 A 11:58

TMEO  
LAW OFFICE 112

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003,  
Applicant responds in accordance with the headings therein.

DISCLAIMER

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use  
"AMERICA'S BEST PASTA" apart from the mark as  
shown.--

REMARKS

Since this appears to be the only outstanding matter at  
issue it appears this application is in condition to be  
approved for publication.



11-14-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #11

Serial No.: 78/136,701  
Mark: BARILLA - AMERICA'S BEST PASTA  
Attorney Docket No.: 2778-128

Respectfully submitted,

Barilla Alimentare S.p.A.

By: G. F. Rothwell  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/136701

**APPLICANT:** Barilla Alimentare S.p.A.

JUN 18 2003

**CORRESPONDENT ADDRESS:**

G. Franklin Rothwell, Esq.  
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1425 K Street, NW Suite 800  
Washington DC 20005

**RETURN ADDRESS:**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
ecom112@uspto.gov

**MARK:** BARILLA - AMERICA'S BEST PASTA

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 2778-128

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

**RE:** Serial Number 78/136701

This letter responds to the applicant's communication filed April 15, 2003.

***STATUS OF THE APPLICATION***

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

## **REFUSAL**

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, TMEP §1209.03(s):

### **1209.03(s) Slogans**

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

The wording AMERICA'S BEST PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (BEST), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of *selected* excerpts of stories taken from LEXIS/NEXIS® computerized database, listing the terms BEST PASTA (the examining attorney also attaches selected excerpts of stories featuring the terms AMERICA'S FAVORITE PASTA). See the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the term **AMERICA'S with other descriptive matter** disclaimed. *See* the attached enclosure.<sup>1</sup> Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." *See* TMEP section 1207.01(c)(iv); *see also*, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of **"AMERICA'S BEST PASTA"** is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, *see* 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill  
Trademark Attorney  
Law Office 112  
(703) 308-9112, Ext. 203  
darryl.spruill@uspto.gov  
/Darryl M. Spruill/

#### **RESPONSE GUIDELINES**

The applicant may respond via regular mail to the address listed above, or via e-mail to [Ecom112@uspto.gov](mailto:Ecom112@uspto.gov). In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;

---

<sup>1</sup> No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.

2. send the response to <mailto:ecom112@uspto.gov>. E-mail sent to any other address will NOT be processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG format only. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the Office action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to [Comments@uspto.gov](mailto:Comments@uspto.gov).

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>.

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

#### **EVIDENCE**

108B8C

Print Request:            Selected Document(s): 2-7, 13, 16-19, 27, 31, 35-41, 43-45, 47

Time of Request: June 17, 2003 09:04 PM EDT

Number of Lines: 513

Job Number: 1842:0:4168371  
Client ID/Project Name:  
Research Information:  
US Newspapers and Wires  
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2 of 680 DOCUMENTS

Copyright 2003 Charleston Newspapers  
Charleston Gazette (West Virginia)

May 25, 2003, Sunday

**SECTION:** Life; Pg. P7F

**LENGTH:** 367 words

**HEADLINE:** All ears, Unique pasta shapes adds a little Puglia to your pantry May 25, 2003, Sunday

**BYLINE:** Robert J. Byers and Tara Tuckwiller [robbyers@wvgazette.com](mailto:robbyers@wvgazette.com), [tara@wvgazette.com](mailto:tara@wvgazette.com)

**BODY:**

Durum wheat is coarsely ground into semolina, the basis for the world's best pastas. Different regions of Italy favor different pasta shapes. In the south, ziti and the Pugliese specialty orecchiette top the list. ...

3 of 680 DOCUMENTS



The State (Columbia, SC) April 27, 2003 Sunday FINAL EDITION

Copyright 2003 The State (Columbia, SC)  
All Rights Reserved  
The State (Columbia, SC)

April 27, 2003 Sunday FINAL EDITION

**SECTION:** F; Pg. 1

**LENGTH:** 847 words

**HEADLINE:** From the vantage of the consumer, the world of dry pasta hasn't changed...

**BYLINE:** By JIM DuPLESSIS; Staff Writer

**BODY:**

...coupled an \$100 million-plus investment with an idea as simple as a straight pin.

"We're trying to make the very **best pasta** at the lowest possible price," said Christopher Gooding, quality assurance manager for the 140-employee plant that made ...

4 of 680 DOCUMENTS

Copyright 2003 The Detroit News  
All Rights Reserved  
The Detroit News

April 16, 2003 Wednesday No dot Edition

**SECTION:** SPECIAL; Pg. 4M

**LENGTH:** 950 words

**HEADLINE:** MICHIGAN'S BEST;  
Food and Drink

**BODY:**

...Mound Rd., Sterling Heights (586) 997-2999

Third place: Hooters

Multiple locations throughout Metro Detroit

The Detroit News April 16, 2003 Wednesday No dot Edition

**BEST PASTA DISHES**

Antonio's Cucina Italiana

Dearborn Heights and Farmington Hills

Second place: Olive Garden

Multiple locations throughout ...

5 of 680 DOCUMENTS

Copyright 2003 The Journal News (Westchester County, NY)

All Rights Reserved

The Journal News (Westchester County, NY)

April 13, 2003 Sunday

**SECTION:** DESTINATIONS; Pg. 1H

**LENGTH:** 2301 words

**HEADLINE:** The shore

**BYLINE:** Mary Shustack, Staff

**BODY:**

...antiques and gift shops, playing more than a few arcade games and dining on everything from fish and chips to one of the **best pasta** dishes I've ever tasted.

6 of 680 DOCUMENTS

Copyright 2003 The Courier-Journal (Louisville, KY)

All Rights Reserved

The Courier-Journal (Louisville, KY)

April 2, 2003 Wednesday metro Met-Edition

The Courier-Journal (Louisville, KY) April 2, 2003 Wednesday metro Met E

**SECTION:** FEATURES; Pg. 1C

**LENGTH:** 1286 words

**HEADLINE:** Five easy pastas;  
Noodles are long on variety, short on cooking time

**BYLINE:** FRITSCHNER SARAH, sfritschner@courier-journal.com

**BODY:**

...can only "guesstimate" what the proportions of his ingredients are. We've formed the guess into a recipe that is easy and delicious. He insists on using the **best pasta**. His choice: De Cecco .

1 pound linguine

Salt

2 tablespoons olive oil, approximately

16 ounces mixed ...

7 of 680 DOCUMENTS

Copyright 2003 Press & Sun-Bulletin (Binghamton, NY)

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Press & Sun-Bulletin (Binghamton, NY)

April 1, 2003 Tuesday

**SECTION:** LIFESTYLE; Pg. 1C

**LENGTH:** 522 words

**HEADLINE:** GOING SOMEWHERE - Most directions lead to the land of the lost

**BYLINE:** MATT SULLIVAN

**BODY:**

...out-of-town friends over how empty their lives must be without spiedies; arguing bitterly with friends about who has the **best pasta sauce**.

St. Louis Post-Dispatch (Missouri) February 26, 2003 Wednesday Five Star

13 of 680 DOCUMENTS

Copyright 2003 St. Louis Post-Dispatch, Inc.  
St. Louis Post-Dispatch (Missouri)

February 26, 2003 Wednesday Five Star Late Lift Edition

**SECTION:** LET'S EAT ; Pg. 10

**LENGTH:** 977 words

**HEADLINE:** POTPOURRI

**BODY:**

...piece Circulon cookware set and a selection of other prizes. For information, go to [www.parade.com](http://www.parade.com), or write to: "Best Pasta in the U.S.A. Recipe Contest," P.O. Box 5099, Grand Central Station, New York, N.Y. 10163-5099. ...

16 of 680 DOCUMENTS

Copyright 2003 Boston Herald Inc.  
The Boston Herald

February 15, 2003 Saturday ALL EDITIONS

**SECTION:** NEWS; Pg. 008

**LENGTH:** 701 words

**HEADLINE:** Valentis bid reluctant farewell to loving matriarch of family

**BYLINE:** By JOE FITZGERALD

**BODY:**

...sundaes.' Then when the fair was switched to later in the fall, too cold for ice cream, she opened Mary's Italian Kitchen, advertising 'the best pasta e fagiolo in the country.' When she got sick a few years ago, she finally closed it, but I'm ...

17 of 680 DOCUMENTS

Copyright 2003 The Oregonian  
The Oregonian

February 14, 2003 Friday SUNRISE EDITION

**SECTION:** ARTS AND LIVING; Pg. 31

**LENGTH:** 334 words

**HEADLINE:** MARY ELLEN ROWE

**SOURCE:** By Ted Mahar, The Oregonian

**BODY:**

...84 Charing Cross Road' -- dear friends and love of books; 'Heartburn' -- great Carly Simon songs, food is love, best pasta carbonara; 'Out of Africa' -- three hankies, music, scenery, be careful what you ask for; 'Shadowlands' -- Debra Winger and Anthony Hopkins, ...

18 of 680 DOCUMENTS

Copyright 2003 San Jose Mercury News  
All Rights Reserved  
San Jose Mercury News (California)

February 12, 2003 Wednesday MO1 EDITION

**SECTION:** FO; Pg. 3

**LENGTH:** 154 words

**HEADLINE:** A memorable casserole

**BYLINE:** By Linda Gassenheimer; Knight Ridder

**BODY:**

...sauce are other time savers.

The pasta is cooked in the skillet with the other ingredients, not boiled separately. As a result, the **best pasta** for this is fresh. If you do use dried pasta, you'll need to increase the cooking time to 15 minutes and add 1/2 ...

19 of 680 DOCUMENTS

Copyright 2003 The Buffalo News  
Buffalo News (New York)

February 2, 2003 Sunday, FINAL EDITION

**SECTION:** FIRST SUNDAY, Pg.M12

**LENGTH:** 1039 words

**HEADLINE:** WHEN BEEF IS KING;  
SAM REDA'S LATEST PUSH TOWARD CULINARY EXCELLENCE

**BYLINE:** LOIS BAKER

**BODY:**

...on its quality: "Some meat I pay for is \$16 a pound," he says. "If you have an Italian restaurant, you better have the **best pasta**. If you have a French restaurant, you better have the best foie gras. And if you have a steakhouse, you better have the best meat."

Red meat reigns, ...

**GRAPHIC:** Photos by SHARON CANTILLON/Buffalo News "If you have an Italian restaurant, you better have the **best pasta**," says Reda. "If you have a steakhouse, you better have the best meat," Reda's creativity has a chance to shine in his appetizers such as tuna ...

27 of 680 DOCUMENTS

Copyright 2003 The Hearst Corporation  
The Times Union (Albany, NY)

The Times Union (Albany, NY) January 26, 2003 Sunday

January 26, 2003 Sunday THREE STAR EDITION

**SECTION:** CAPITAL REGION, Pg. D3

**LENGTH:** 982 words

**HEADLINE:** Tampa Bay ends doctor's dream of Super Bowl duty

**BYLINE:** Marv Cermak

**BODY:**

...minutes," he said as though the whole town was headed there.

The Italian men's club was my destination because I heard that was the place where you could get the best pasta fagioli in the region on the third Friday of each month.

Members of the 102-year-old nonprofit organization said the ...

31 of 680 DOCUMENTS

Copyright 2003 The News Journal (Wilmington, DE)

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The News Journal (Wilmington, DE)

January 17, 2003 Friday

**SECTION:** 55 HOURS; Eric Ruth; Pg. 24Z

**LENGTH:** 935 words

**HEADLINE:** Food falls short of warm welcome

**BYLINE:** Staff

**BODY:**

...remember to actually bring the bread.

It's those little touches - along with dependably solid execution - that help lift Little Italy's best pasta houses beyond their simple roots. At Assunta's, that execution can be unpredictable: First you're full of admiration over how ...

35 of 680 DOCUMENTS

Copyright 2002 Stern Publishing, Inc.  
LA Weekly (California)

December 27, 2002, Friday

**SECTION:** Food; Pg. 50

**LENGTH:** 547 words

**HEADLINE:** NINE KICK-ASS DISHES FROM 2002

**BODY:**

...filling porcini mushrooms. A little olive oil, a little sea salt, some good cheese, and there it is -  
- the best pasta I had all year.

36 of 680 DOCUMENTS

Copyright 2002 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

November 24, 2002 Sunday FIVE STAR EDITION

**SECTION:** TRAVEL, Pg.H-5

**LENGTH:** 904 words

**HEADLINE:** URUGUAYANS LEAD TRANQUIL LIVES DESPITE TUMULTUOUS TIMES

**BYLINE:** ROYE WERNER, SPECIAL TO THE POST-GAZETTE

**BODY:**

...peppers, cheese, onions, pineapple, eggplant and a fried egg.

In addition, the wave of Italian immigration brought over its best pasta tradition, as seen on just about every menu and in the ubiquitous fresh pasta shops. On the 29th of every ...



37 of 680 DOCUMENTS

Copyright 2002 Stern Publishing, Inc.  
LA Weekly (California)

November 22, 2002, Friday

**SECTION:** Restaurants; Pg. 56

**LENGTH:** 1003 words

**HEADLINE:** MOSTLY VINCENT

**BYLINE:** MICHELLE HUNEVEN

**BODY:**

...crisped flowers with soft, moist hearts. But the showstopper and hands-down best dish of the night -- and possibly one of the five best pasta dishes in all of Los Angeles -- was a house-made, ribbony, papardelle with sauteed porcini mushrooms. The mushrooms were slippery and ...

38 of 680 DOCUMENTS

Copyright 2002 Globe Newspaper Company  
The Boston Globe

November 10, 2002, Sunday ,THIRD EDITION

**SECTION:** CITY WEEKLY; Pg. 2

**LENGTH:** 717 words

**HEADLINE:** CITY WEEKLY / TABLE HOPPING;  
WITH WARMEST DISHES

**BYLINE:** SACHA PFEIFFER

The Boston Globe, November 10, 2002

**BODY:**

...solely on retail and wholesale pasta-making, a craft he's practiced for 20 years. Dave's makes some of the **best pasta** around, in flavors like chipotle, chive, and jalapeno, and its ravioli are fantastic, from simple cheese-basil to artichoke-fontina, goat ...

39 of 680 DOCUMENTS

Copyright 2002 Internet Wire, Incorporated.  
All rights reserved.  
Internet Wire

October 15, 2002 Tuesday

**LENGTH:** 480 words

**HEADLINE:** Travellers Make The Evolutionary Jump To GLOBOsapiens

**DATELINE:** Oct 15, 2002; SYDNEY, AUSTRALIA; INTERNET WIRE

**BODY:**

...visa for Bhutan, if anyone's interested in joining you for a cycling tour of Europe, what camera gear to take, or where's the **best pasta** place in Florence.

GLOBOsapiens is the inspiration of Andy Pucko, an Interactive Media graduate from the University of Applied Sciences in ...

40 of 680 DOCUMENTS

Copyright 2002 The Dallas Morning News  
The Dallas Morning News

October 9, 2002, Wednesday SECOND EDITION

**SECTION:** TEXAS TASTE; Pg. 2F; CATHY BARBER cbarber@dallasnews.com

**LENGTH:** 880 words

**HEADLINE:** Chef Mario's fishy mission

**BYLINE:** CATHY BARBER

**BODY:**

...Reggiano, the "king of cheeses."

\*Dried pasta. He says the Rustichella d'Abruzzo brand sold at Viking and other stores is one of the **best pastas** in the world. In Italy, he said, pasta is sauced lightly, more like Americans dress their salads. C.B.

MORE FROM ...

41 of 680 DOCUMENTS

Copyright 2002 Tulare Advance-Register (Tulare, CA)  
All Rights Reserved  
Tulare Advance-Register (Tulare, CA)

October 8, 2002 Tuesday

**SECTION:** LOCAL; Pg. 2A

**LENGTH:** 425 words

**HEADLINE:** Elite eateries honored

**BYLINE:** Laura Florez, Staff

**BODY:**

...Rosal

Best Chocolate Creation Vintage Press

Best Pie or Cake Ryan's Place

Best Gourmet Pizza Fugazzi's

Best Pasta Dish Rosa's

Best Fries McDonald's

Best Milkshake Mearle's

Best Dinner for Two The Depot

Tulare Advance-Register (Tulare, CA) October 8, 2002 Tuesday

Best Wine ...

43 of 680 DOCUMENTS

Copyright 2002 The Times Mirror Company; Los Angeles Times All  
Rights Reserved  
Los Angeles Times

October 2, 2002 Wednesday Home Edition

**SECTION:** Food; Part 8; Page 1; Features Desk

**LENGTH:** 2184 words

**HEADLINE:** The Strands of Luxury;

Is a box of artisanal spaghetti worth the splurge? We test 11 brands and make a surprising discovery.

**BYLINE:** RUSS PARSONS, TIMES STAFF WRITER

**BODY:**

...nothing new. Until the early 20th century, Italy's great sources of durum wheat were the Ukraine and Volga River valley. The very best pastas were labeled "Taganrog," for the Russian port city on the sea of Azov, near the Black Sea, from which they were shipped. This source dried ...

44 of 680 DOCUMENTS

Copyright 2002 The Courier-Journal (Louisville, KY)  
All Rights Reserved  
The Courier-Journal (Louisville, KY)

September 20, 2002 Friday Met and metro Editions

**SECTION:** FEATURES; IN SEARCH OF GREAT FOOD; Pg. 1C

**LENGTH:** 557 words

The Courier-Journal (Louisville, KY) September 20, 2002 Friday Met and m

**HEADLINE:** A spoonful of pesto can make perfect pasta or soup

**BYLINE:** FRITSCHNER SARAH

**BODY:**

...middle and a pat of butter atop that. The diner stirs the noodles to coat them, in a dish that David describes as "perhaps the **best pasta** dish in all of Italy."

Or, spoon pesto into the bottom of a bowl before you ladle in hearty vegetable soup ( ...

45 of 680 DOCUMENTS

Copyright 2002 The Wichita Eagle  
All Rights Reserved  
The Wichita Eagle

September 13, 2002 Friday, MAIN EDITION

**SECTION:** C; Pg. 24

**LENGTH:** 567 words

**HEADLINE:** Order this next time;  
Local chefs and restaurateurs name the best on their menus.

**BYLINE:** DENISE NEIL The Wichita Eagle

**BODY:**

...Mill, 549 S. Rock Road

The best: Desert fire pasta

Head chef Bill Breen says his restaurant has the **best pastas** in town, but the standout is the desert fire pasta, which features linguine, shrimp and mushrooms in a spicy cream ...

47 of 680 DOCUMENTS

Copyright 2002 The Tennessean  
All Rights Reserved

The Tennessean August 25, 2002 Sunday 1st Edition

The Tennessean

August 25, 2002 Sunday 1st Edition

**SECTION:** WAM; DINING IN; Pg. 5W

**LENGTH:** 814 words

**HEADLINE:** Humor and fun define Natalie Mertie's kitchen

**BYLINE:** VICKI STOUT

**BODY:**

...stir up some mighty fine lemonade, nonetheless.

Contact VickiStout@aol.com with suggestions for Dining In.

**Best pasta ever**

Prepare box or package of bowtie pasta. Add generous amounts of toasted pine nuts, sliced sun-dried tomatoes, ...

108B8C

Print Request: Selected Document(s): 5-8,10,13,16

Time of Request: June 17, 2003 08:15 PM EDT

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"america! favorite! pasta"

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5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.  
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

**SECTION:** LIFESTYLE / FOOD; Pg. F06

**LENGTH:** 449 words

**HEADLINE:** SAUCE IT UP, VEGAN STYLE

**COLUMN:** NATURALLY YOURS

**BYLINE:** JAN WOLFF

**BODY:**

...your spaghetti, and if you're a vegan, you may still crave a sprinkling of Parmesan now and then. What's left to put on America's favorite pasta? Plain old tomato sauce can get tiresome, even if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.  
PR Newswire

April 24, 1998, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO FOOD, NATIONAL AND FEATURES EDITORS

**LENGTH:** 301 words



**HEADLINE:** Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998LEXIS-NEXIS Related Topics Full Article Related Topics Overview

This document contains no targeted Topics.

**DATELINE:** NEW YORK, April 24

**BODY:**

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of America's favorite pasta dish is based on consumer research as well as pasta's history in the U.S.," said Julia Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

**SECTION:** FOOD, Pg. J10

**LENGTH:** 475 words

**HEADLINE:** Beard awards nominees

**BODY:**

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, America's Favorite Pasta" by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.  
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

Orlando Sentinel Tribune, January 22, 1995

**SECTION:** FLORIDA; Pg. 18

**LENGTH:** 861 words

**HEADLINE:** FOR YOUNG TASTE BUDS ONLY

**BYLINE:** By Scott Joseph, Sentinel Restaurant Critic

**BODY:**

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for Americas favorite pasta.

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.  
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

**SECTION:** FEATURES; Pg. 3E

**LENGTH:** 806 words

**HEADLINE:** AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

**BYLINE:** Michael Storey

**BODY:**

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with America's favorite pasta-eating cat going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

Los Angeles Times, September 7, 1994

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Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

**SECTION:** Business; Part D; Page 1; Column 2; Financial Desk

**LENGTH:** 924 words

**HEADLINE:** FARMERS COUNT ON A NEW CASH CROP: PASTA;  
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH  
DAKOTA WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

**BYLINE:** By GREG JOHNSON, TIMES STAFF WRITER

**DATeline:** IRVINE

**BODY:**

...plant. We can grow it, mill it and send it through the noodle plant."

**Pasta Popularity**

Spaghetti and linguine are America's favorite pasta products, followed by elbows and twists.  
Dry pasta retail sales by shape in 1993:  
Long goods ( ...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;  
Copyright Business First of Louisville Inc. 1985;  
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATELINE: Louisville; KY; US

BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while America's favorite pasta may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

# TRADEMARK EXAMINATION WORKSHEET

☒ AMENDMENT STAGE

☐ NO CHANGE

☐ PUBLICATION/REGISTRATION STAGE

Name: Lorri White L.O. 112

Serial No. 78,134701

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

## Legal Instrument Examiner (LIE)

	Amended	Data Element
Class Data	<input checked="" type="checkbox"/>	<input type="checkbox"/> Prime/International Class
	<input type="checkbox"/>	<input checked="" type="checkbox"/> Goods and Services
	<input type="checkbox"/>	<input type="checkbox"/> First Use Date
	<input type="checkbox"/>	<input type="checkbox"/> First Use in Commerce Date
Mark Data	<input type="checkbox"/>	<input type="checkbox"/> In Another Form
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Misc. Mark Data	<input type="checkbox"/>	<input type="checkbox"/> Pseudo Mark
	<input type="checkbox"/>	<input type="checkbox"/> Mark Drawing Code
	<input type="checkbox"/>	<input type="checkbox"/> Design Search Code
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Section 2(f)	<input type="checkbox"/>	<input type="checkbox"/> Mark Description
	<input type="checkbox"/>	<input type="checkbox"/> Disclaimer
	<input type="checkbox"/>	<input type="checkbox"/> Lining/Stippling
	<input type="checkbox"/>	<input type="checkbox"/> Name/Portrait/Consent
Foreign Reg. Data	<input type="checkbox"/>	<input type="checkbox"/> Translation
	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Entire Mark
	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Limitation Statement
	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) in Part
Owner Data	<input type="checkbox"/>	<input type="checkbox"/> Amended Register
	<input type="checkbox"/>	<input type="checkbox"/> Amended Register Date
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Country
	<input type="checkbox"/>	<input type="checkbox"/> 44(d)
Amd/Corr Restr.	<input type="checkbox"/>	<input type="checkbox"/> Foreign Application Number
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Application Filing Date
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Registration Number
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Registration Date
Prior U.S. Reg.	<input type="checkbox"/>	<input type="checkbox"/> Foreign Registration Expiration Date
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Renewal Reg. Number
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Reg. Renewal Expiration Date
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Renewal Reg. Date
Correspondence	<input type="checkbox"/>	<input type="checkbox"/> Owner Name
	<input type="checkbox"/>	<input type="checkbox"/> DBA/AKA/TA
	<input type="checkbox"/>	<input type="checkbox"/> Address 1
	<input type="checkbox"/>	<input type="checkbox"/> Address 2
Other:	<input type="checkbox"/>	<input type="checkbox"/> City
	<input type="checkbox"/>	<input type="checkbox"/> State
	<input type="checkbox"/>	<input type="checkbox"/> Zip Code
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	<input type="checkbox"/>	<input type="checkbox"/> Entity Statement
	<input type="checkbox"/>	<input type="checkbox"/> Composed of
	<input type="checkbox"/>	<input type="checkbox"/> Assignment(s)/Name Change
	<input type="checkbox"/>	<input type="checkbox"/> Concurrent Use
	<input type="checkbox"/>	<input type="checkbox"/> Prior Registration
	<input type="checkbox"/>	<input type="checkbox"/> Attorney
	<input type="checkbox"/>	<input type="checkbox"/> Domestic Representative
	<input type="checkbox"/>	<input type="checkbox"/> Attorney Docket Number
	<input type="checkbox"/>	<input type="checkbox"/> Correspondence Firm Name/Address
	<input type="checkbox"/>	
	<input type="checkbox"/>	

I certify that all corrections have been entered in accordance with text editing guidelines.

Lorri White  
LIE

5/7/2003  
DATE

Other:

# Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET

Word Mark: BARILLA - AMERICA'S BEST PASTA

2A

Serial No: 78136701

[REDACTED]

Mail Date: 04152003

[REDACTED]

Doc Type: Amendments to Response

[REDACTED]

No Fee

RA M Mail Date: 041503

[REDACTED]

RECEIVED

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TMO  
LAW OFFICE 112

2

2778-128  
GFR:RHC:czb



Examining Attorney: SPRUILL, DARRY  
Serial Number: 78/136701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Barilla Alimentare S.p.A. )  
Serial No. 78/136,701 ) Trademark Attorney  
Filed: June 18, 2002 ) Darryl M. Spruill  
Mark: BARILLA - AMERICA'S ) Law Office 101  
BEST PASTA )

AMENDMENT AND RESPONSE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Dear Sir:

Applicant hereby responds to Office Action No. 01 in  
accordance with the headings therein.

IN THE IDENTIFICATION OF GOODS

Kindly amend the identification of goods in the subject  
application as follows:

--PASTA, PASTA PRODUCTS, NAMELY MEALS  
CONSISTING PRIMARILY OF PASTA, MACARONI  
SALAD, PASTA SALAD, SAUCES FOR PASTA in  
International Class 30.--

DISCLAIMER REQUIREMENT

The Office Action has called for Applicant to disclaim the  
wording "AMERICA'S BEST PASTA" apart from the mark as shown. The  
grounds cited are that AMERICA'S has geographical significance,

BEST is a laudatory term and PASTA is a generic term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregistrable components of a mark otherwise registrable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive, Applicant respectfully traverses the requirement to disclaim AMERICA'S BEST PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983) ("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA<sup>1</sup>, but obviously creates a commercial impression distinct from that of its house mark. Professor McCarthy provides an illustrative

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<sup>1</sup> See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.



example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991) ("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S BEST PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S BEST PASTA clearly characterize the well-recognized trademark of Applicant -- in other words, they meld with the BARILLA registered mark. All of these factors support a

determination that Applicant's proposed slogan is a unitary mark.  
See Dena, 950 F.2d at 1561 (citing TMEP § 807.13(a) (rev. 1986)).  
For the foregoing reasons, Applicant believes that disclaimer of  
AMERICA'S BEST PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully  
requested that the subject application be approved for  
publication.

Respectfully submitted,

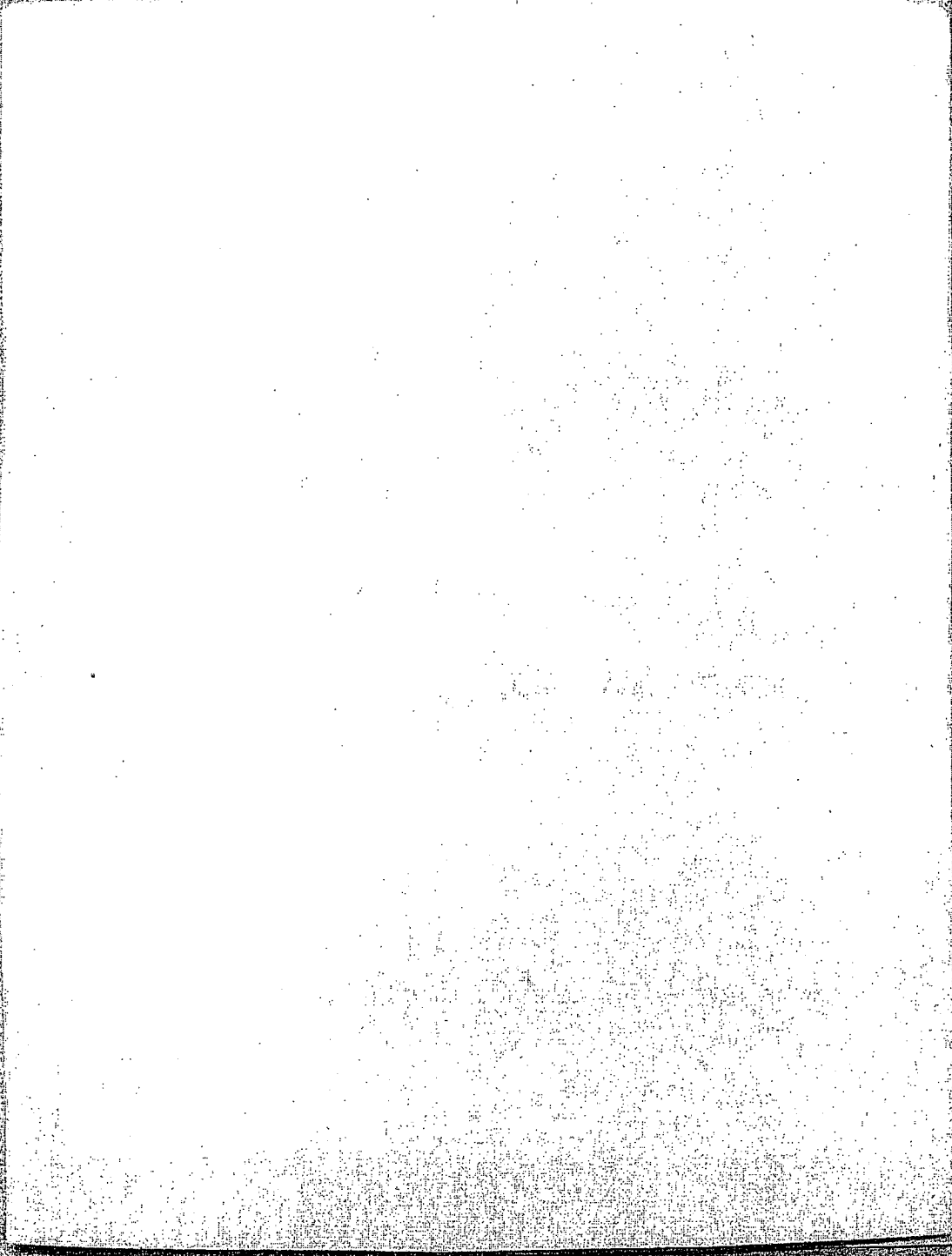
By Robert H. Cameron  
G. Franklin Rothwell  
Robert H. Cameron  
Attorneys for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202)783-6040

# Trademark

FORM TDM-100

2-99

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office



Applicant's Name (Print or Type)	<b>PUBLISHED</b> 3/2/04	NOA
Applicant's Address (Print or Type)	<input type="checkbox"/> Abandoned	
Applicant's Signature (Print or Type)		

## Poster Session

[illegible]



Trademark

NEW CASE DELIVERED

Serial Number

TRADEMARK

78136701

NEW CASE DELIVERED

SEP 23

PROSECUTION HISTORY

TM OFFICE TX

Entry

Date

Initial

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NOP  
3/2/04

NOA  
5/25/04

42

# **Exhibit 18**

794445

# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**January 09, 2006**

**THE ATTACHED U.S. TRADEMARK REGISTRATION 2,005,752 IS  
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND  
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN  
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *October 08, 1996***

**SECTION 8 & 15**

**SAID RECORDS SHOW TITLE TO BE IN:**

***BARILLA G. E R. FRATELLI-SOCIETA PER AZIONI  
A ITALY CORPORATION***

**By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office**

*M. Tarver*

**M. TARVER  
Certifying Officer**



Int. Cl.: 30

Prior U.S. Cl.: 46

**United States Patent and Trademark Office** **Reg. No. 2,005,752**  
Registered Oct. 8, 1996

**TRADEMARK  
PRINCIPAL REGISTER**

**BARILLA**

BARILLA ALIMENTARE S.P.A. (ITALY JOINT  
STOCK COMPANY)  
VIALE R. BARILLA 3/A  
43100 PARMA, ITALY

FOR: FLOUR AND PREPARATIONS MADE  
FROM CEREALS, BREAD, BREADSTICKS,  
RUSKS, CRACKERS; PASTA, IN CLASS 30 (U.S.  
CL. 46).

FIRST USE 0-0-1900; IN COMMERCE  
0-0-1965.

OWNER OF U.S. REG. NOS. 897,460, 1,308,222,  
AND 1,432,123.  
SEC. 2(F).

SER. NO. 74-678,653, FILED 5-22-1995.

DARREN COHEN, EXAMINING ATTORNEY



# **Exhibit 19**

# United States Patent Office

897,460  
Registered Aug. 25, 1970

## PRINCIPAL REGISTER Trademark

Ser. No. 337,215, filed Sept. 5, 1969



Barilla G. e R. F.lli S.p.A. (Italian corporation)  
3, Viale Veneto  
Parma, Italy

For: PASTA, in CLASS 46 (INT. CL. 30).  
Owner of Italian Reg. No. 231,675, dated Aug. 8, 1968.

A. G. DIETZ, Examiner

Int. Cl.: 30

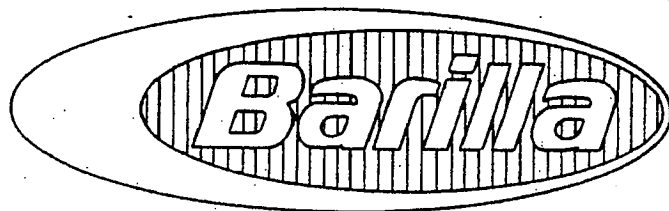
Prior U.S. Cl.: 46

**United States Patent and Trademark Office**

Reg. No. 1,432,123

Registered Mar. 10, 1987

**TRADEMARK  
PRINCIPAL REGISTER**



BARILLA G. ER. F.I.I.I SOCIETA' PER AZIONI  
(ITALY CORPORATION)  
VIALE RICCARDO BARILLA, 3/A  
PARMA, ITALY

FOR: BREADSTICKS AND RUSKS, IN CLASS  
30 (U.S. CL. 46).

FIRST USE 1-1-1973; IN COMMERCE  
1-1-1973.

THE DRAWING IS LINED FOR THE COLOR  
RED.

SER. NO. 567,655, FILED 11-8-1985.

JERRY L. PRICE, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

**United States Patent and Trademark Office** **Reg. No. 2,005,752**  
**Registered Oct. 8, 1996**

**TRADEMARK  
PRINCIPAL REGISTER**

**BARILLA**

BARILLA ALIMENTARE S.P.A. (ITALY JOINT  
STOCK COMPANY)  
VIALE R. BARILLA 3/A  
43100 PARMA, ITALY

FOR: FLOUR AND PREPARATIONS MADE  
FROM CEREALS, BREAD, BREADSTICKS,  
RUSKS, CRACKERS; PASTA, IN CLASS 30 (U.S.  
CL. 46).

FIRST USE 0-0-1900; IN COMMERCE  
0-0-1965.

OWNER OF U.S. REG. NOS. 897,460, 1,308,222,  
AND 1,432,123.  
SEC. 2(F).

SER. NO. 74-678,653, FILED 5-22-1995.

DARREN COHEN, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 2,022,842

United States Patent and Trademark Office

Registered Dec. 17, 1996

TRADEMARK  
PRINCIPAL REGISTER



BARILLA ALIMENTARE S.P.A. (ITALY JOINT-STOCK COMPANY)  
VIALE R. BARILLA 3/A  
43100 PARMA, ITALY

FOR: GREEN AND BLACK OLIVE SAUCE, SWEET PEPPERS AND GARLIC SAUCE, SPICY PEPPER SAUCE, TOMATO AND BASIL SAUCE, MARINARA SAUCE, MUSHROOM AND GARLIC SAUCE, PASTA SAUCE, ARTICHOKE SAUCE, BARBECUE SAUCE, CHEESE SAUCE, KETCHUP, TARTAR SAUCE,

TOMATO SAUCE, WALNUT, OLIVE AND MUSHROOM CREAM SAUCES, SPAGHETTI SAUCE, IN CLASS 30 (U.S. CL. 46).

FIRST USE 1-0-1970; IN COMMERCE 1-0-1995.

OWNER OF U.S. REG. NOS. 897,460, 1,308,222, AND 1,432,123.

SER. NO. 74-578,737, FILED 9-26-1994.

DARREN COHEN, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 2,074,319

**United States Patent and Trademark Office**

Registered June 24, 1997

**TRADEMARK  
PRINCIPAL REGISTER**

**BARILLA**

BARILLA ALIMENTARE S.P.A. (ITALY CORPORATION)  
VIALE R. BARILLA 3/A  
PARMA, ITALY

FOR: GREEN AND BLACK OLIVE SAUCE, SWEET PEPPERS AND GARLIC SAUCE, SPICY PEPPER SAUCE, TOMATO AND BASIL SAUCE, MARINARA SAUCE, MUSHROOM AND GARLIC SAUCE, PASTA SAUCE, ARTICHOKE SAUCE, BARBEQUE SAUCE, CHEESE SAUCE, KETCHUP, TARTAR SAUCE, TOMATO SAUCE, WALNUT, OLIVE, AND

MUSHROOM CREAM SAUCES, AND SPAGHETTI SAUCE, IN CLASS 30 (U.S. CL. 46).

FIRST USE 6-1-1995; IN COMMERCE 6-1-1995.

OWNER OF U.S. REG. NOS. 897,460, 1,432,123, AND OTHERS.

SEC. 2(F).

SN 74-672,505, FILED 4-12-1995.

EVERETT FRUEHLING, EXAMINING ATTORNEY

Int. Cls.: 30 and 42

Prior U.S. Cls.: 46, 100 and 101

**United States Patent and Trademark Office**

**Reg. No. 2,657,872**

Registered Dec. 10, 2002

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**



BARILLA ALIMENTARE S.P.A. (ITALY JOINT  
STOCK COMPANY)  
VIA MANTOVA 166  
43100 PARMA, ITALY

FOR: READY-MADE AND PRE-PREPARED  
DISHES BASED ON PASTA, IN CLASS 30 (U.S. CL.  
46).

FOR: RESTAURANT AND CATERING SERVI-  
CES, IN CLASS 42 (U.S. CLS. 100 AND 101).

OWNER OF ITALY REG. NO. 826277, DATED 5-12-  
2000, EXPIRES 5-12-2010.

OWNER OF U.S. REG. NOS. 897,460, 2,005,752 AND  
OTHERS.

THE MARK CONSISTS OF THE WORD "BARIL-  
LA" IN STYLIZED WHITE LETTERS INSIDE AN  
ELONGATED RED OVAL WHICH IS INSIDE A  
LARGER ELONGATED WHITE OVAL OUTLINED  
IN RED. THE COLORS RED AND WHITE ARE  
CLAIMED AS A FEATURE OF THE MARK.

SER. NO. 76-093,283, FILED 7-21-2000.

ELIZABETH HUGHITT, EXAMINING ATTORNEY

Int. Cls.: 29, 30, 35 and 43

Prior U.S. Cls.: 46, 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,964,682

Registered July 5, 2005

TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER



BARILLA G. E R. FRATELLI - SOCIETA PER  
AZIONI (ITALY CORPORATION)  
VIALE RICCARDO E PIETRO BARILLA 3/A  
PARMA, ITALY

FOR: MEAT, FISH, POULTRY AND GAME;  
MEAT EXTRACTS; PRESERVED, DRIED AND  
COOKED FRUITS AND VEGETABLES; JELLIES,  
JAMS, COMPOTES; EGGS, MILK AND MILK  
BASED PRODUCTS, NAMELY DAIRY PRODUCTS,  
EXCLUDING ICE CREAM, ICE MILK AND FRO-  
ZEN YOGURT; EDIBLE OILS AND FATS, IN CLASS  
29 (U.S. CL. 46).

FOR: COFFEE, TEA, COCOA, SUGAR, RICE,  
TAPIOCA, SAGO, ARTIFICIAL COFFEE; FLOUR  
AND PREPARATIONS MADE FROM CEREALS,  
NAMELY CEREAL-BASED SNACK FOODS,  
BREAKFAST CEREALS, READY-TO-EAT CEREAL  
DERIVED FOOD BARS, BREAD, PASTA, BISCUITS,  
PASTRY AND CONFECTIONERY, NAMELY CAN-  
DIES, ICES; HONEY, TREACLE; YEAST, BAKING-  
POWDER; SALT, MUSTARD; VINEGAR, SAUCES,  
CONDIMENTS; SPICES; ICE, IN CLASS 30 (U.S. CL.  
46).

FOR: ADVERTISING; BUSINESS MANAGEMENT  
IN FRANCHISING; RESTAURANT FRANCHISING;  
BUSINESS ADMINISTRATION; OFFICE FUNC-  
TIONS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FOR: SERVICES FOR PROVIDING FOOD AND  
DRINK; PROVIDING TEMPORARY ACCOMMO-  
DATION, IN CLASS 43 (U.S. CLS. 100 AND 101).

OWNER OF ITALY REG. NO. 899753, DATED 6-26-  
2003, EXPIRES 6-13-2013.

OWNER OF U.S. REG. NOS. 897,460, 2,657,872 AND  
OTHERS.

THE COLOR(S) RED AND WHITE IS/ARE  
CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THE WORD BARILLA  
IN STYLIZED WHITE LETTERS INSIDE AN ELON-  
GATED RED OVAL WITH A WHITE FADE IN THE  
UPPER LEFT SIDE; THE ELONGATED RED OVAL  
IN TURN IS INSIDE A LARGER ELONGATED  
WHITE OVAL OUTLINED IN RED, WITH A WHITE  
FADE IN THE UPPER LEFT AND LOWER RIGHT  
OF THE RED OUTLINE.

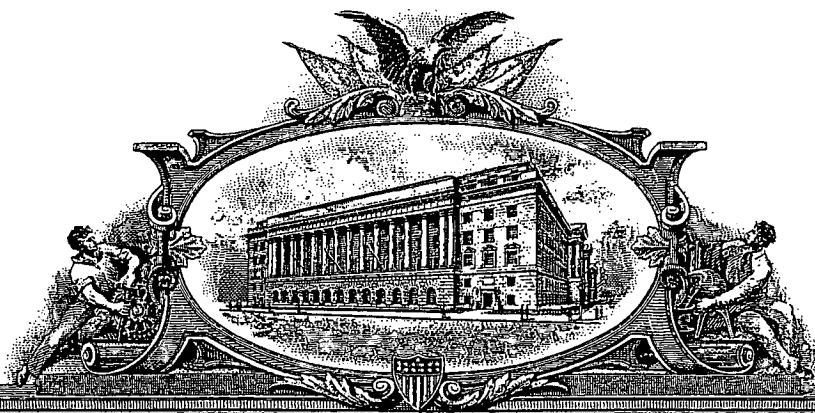
SER. NO. 76-570,344, FILED 1-15-2004.

CHERYL STEPLIGHT, EXAMINING ATTORNEY



# **Exhibit 20**

774115



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

**July 22, 2005**

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE TRADEMARK FILE WRAPPER AND  
CONTENTS OF:**

**TRADEMARK APPLICATION: 78/136,703**

**FILING DATE: June 18, 2002**

**By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office**

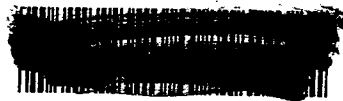


*H. L. Jackson*  
**H. L. JACKSON**  
**Certifying Officer**

Internet Transmission Date:  
2002/06/18

Serial Number:  
78136703

Filing Date:  
2002/06/18

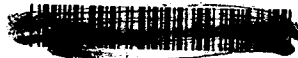


TRADEMARK APPLICATION

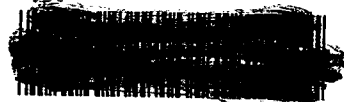
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 127  
RAM ACCOUNTING DATE: 20020619



NO OCR



06-18-2002

&lt;SERIAL NUMBER&gt; 78136703

&lt;FILING DATE&gt; 06/18/2002

## &lt;DOCUMENT INFORMATION&gt;

&lt;TRADEMARK/SERVICEMARK APPLICATION&gt;

&lt;VERSION 1.24&gt;

## &lt;APPLICANT INFORMATION&gt;

<NAME> Barilla Alimentare S.p.A.  
<STREET> Via Mantova 166  
<CITY> Parma PR  
<COUNTRY> Italy  
<ZIP/POSTAL CODE> 43100

## &lt;APPLICANT ENTITY INFORMATION&gt;

&lt;CORPORATION: STATE/COUNTRY OF INCORPORATION&gt; Italy

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

&lt;MARK&gt; BARILLA - AMERICA'S FAVORITE PASTA

&lt;TYPED FORM&gt; Yes

\* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). \*

## &lt;BASIS FOR FILING AND GOODS/SERVICES INFORMATION&gt;

&lt;INTENT TO USE: SECTION 1(b)&gt; Yes

\* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended). \*

&lt;INTERNATIONAL CLASS NUMBER&gt; 030

&lt;LISTING OF GOODS AND/OR SERVICES&gt; PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

## &lt;ATTORNEY INFORMATION&gt;

<NAME> G. Franklin Rothwell, Esq.  
<STREET> 1425 K Street, NW Suite 800  
<CITY> Washington  
<STATE> DC  
<COUNTRY> USA  
<ZIP/POSTAL CODE> 20005  
<FIRM NAME> Rothwell, Figg, Ernst & Manbeck, P.C.  
<TELEPHONE NUMBER> 202-783-6040

<FAX NUMBER> 202-783-6031  
<ATTORNEY DOCKET NUMBER> 2778-127  
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

**<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>**

\* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served \*

<NAME> G. Franklin Rothwell, Esq.  
<STREET> 1425 K Street, NW Suite 800  
<CITY> Washington  
<STATE> DC  
<ZIP CODE> 20005  
<FIRM NAME> Rothwell, Figg, Ernst & Manbeck, P.C.  
<TELEPHONE NUMBER> 202-783-6040  
<FAX NUMBER> 202-783-6031

**<FEE INFORMATION>**

<TOTAL FEES PAID> 325  
<NUMBER OF CLASSES PAID> 1  
<NUMBER OF CLASSES> 1

**<LAW OFFICE INFORMATION>**

<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

**<SIGNATURE AND OTHER INFORMATION>**

\* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

\*

<SIGNATURE> /Robert H. Cameron/  
<DATE> 06/18/2002  
<NAME> Robert H. Cameron  
<TITLE> Attorney for Applicant

78136703

**<MAILING ADDRESS>**

<LINE> G. Franklin Rothwell, Esq.  
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.  
<LINE> 1425 K Street, NW  
<LINE> Suite 800  
<LINE> Washington DC 20005

**<RAM INFORMATION>**

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<RAM ACCOUNTING DATE> 20020619

**<SERIAL NUMBER INFORMATION>**

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<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:40:16 EDT  
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E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmannig@rothwellfigg.com

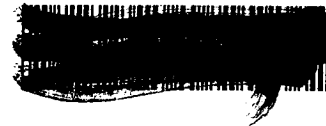
**Drawing Page**

**Serial Number:**

78136703

**Applicant:**

Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PR Italy 43100



**Goods and Services:**

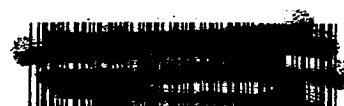
PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

**Mark:**

BARILLA - AMERICA'S FAVORITE PASTA



NO OCR



06-18-2002

2778-127  
GFR:RHC:czb



Examining Attorney: SPRUILL, DARRYL  
Serial Number: 78/136703



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Barilla Alimentare S.p.A.	)	
Serial No. 78/136,703	)	
Filed: June 18, 2002	)	Trademark Attorney
Mark: BARILLA - AMERICA'S	)	Darryl M. Spruill
FAVORITE PASTA	)	Law Office 101

AMENDMENT AND RESPONSE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Dear Sir:

Applicant hereby responds to Office Action No. 01 in  
accordance with the headings therein.

IN THE IDENTIFICATION OF GOODS

Kindly amend the identification of goods in the subject  
application as follows:

--PASTA, PASTA PRODUCTS, NAMELY MEALS  
CONSISTING PRIMARILY OF PASTA, MACARONI  
SALAD, PASTA SALAD, SAUCES FOR PASTA in  
International Class 30.--

DISCLAIMER REQUIREMENT

The Office Action has called for Applicant to disclaim the  
wording "AMERICA'S FAVORITE PASTA" apart from the mark as shown.  
The grounds cited are that AMERICA'S has geographical  
significance, FAVORITE is a laudatory term and PASTA is a generic



term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregistrable components of a mark otherwise registrable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive and does not concede that the term FAVORITE is laudatory in this instance, Applicant respectfully traverses the requirement to disclaim AMERICA'S FAVORITE PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983) ("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA<sup>1</sup>, but obviously creates a commercial impression distinct from that of its house mark. Professor McCarthy provides an

---

<sup>1</sup>  
See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.

illustrative example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991) ("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S FAVORITE PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S FAVORITE PASTA clearly characterize the well-recognized trademark of Applicant -- in other words, they meld with the BARILLA registered mark. All of these factors support a

determination that Applicant's proposed slogan is a unitary mark.  
See Dena, 950 F.2d at 1561 (citing TMEP § 807.13(a) (rev. 1986)).

For the foregoing reasons, Applicant believes that disclaimer of  
AMERICA'S FAVORITE PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully  
requested that the subject application be approved for  
publication.

Respectfully submitted,

By Robert H. Cameron  
G. Franklin Rothwell  
Robert H. Cameron  
Attorneys for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040



2778-127  
GRF:mec:nlf

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Barilla Alimentare S.p.A.	)	
Serial No. 78/136,703	)	
Filed: June 18, 2002	)	Trademark Attorney
	)	Darryl M. Spruill
Mark: BARILLA-AMERICA'S	)	
FAVORITE PASTA	)	Law Office 112

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003,  
Applicant responds in accordance with the headings therein.

DISCLAIMER

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use  
"AMERICA'S FAVORITE PASTA" apart from the mark as  
shown.--

REMARKS

Since this appears to be the only outstanding matter at  
issue it appears this application is in condition to be  
approved for publication.



11-14-2003

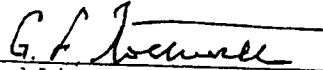
U.S. Patent & TMO/TM Mail Rpt Dtd. #11

Serial No.: 78/136,703  
Mark: BARILLA - AMERICA'S FAVORITE PASTA  
Attorney Docket No.: 2778-126

Respectfully submitted,

Barilla Alimentare S.p.A.

By:



G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136703

APPLICANT: Barilla Alimentare S.p.A.

CORRESPONDENT ADDRESS:  
G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

RETURN ADDRESS:  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
ecom112@uspto.gov

MARK: BARILLA - AMERICA'S FAVORITE PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-127

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/136703

This letter responds to the applicant's communication filed April 15, 2003.

STATUS OF THE APPLICATION

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

REFUSAL

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229

USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, TMEP §1209.03(s):

#### 1209.03(s) Slogans

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

The wording AMERICA'S FAVORITE PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (FAVORITE), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of *selected* excerpts of stories taken from LEXIS/NEXIS® computerized database, listing the terms AMERICA'S FAVORITE PASTA. See the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2 (e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the terms AMERICA'S FAVORITE disclaimed. See the attached enclosure.<sup>[1]</sup> Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4

USPO2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of "AMERICA'S FAVORITE PASTA" is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b), 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill  
Trademark Attorney  
Law Office 112  
(703) 308-9112, Ext. 203  
darryl.spruill@uspto.gov  
/Darryl M. Spruill/

#### RESPONSE GUIDELINES

The applicant may respond via regular mail to the address listed above, or via e-mail to [Ecom112@uspto.gov](mailto:Ecom112@uspto.gov). In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;
2. send the response to [mailto:ecom112@uspto.gov](mailto:mailto:ecom112@uspto.gov). E-mail sent to any other address will not be processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG format. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the action;
5. respond in English; and
6. sign the response electronically, e.g. /John Smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to [Comments@uspto.gov](mailto:Comments@uspto.gov).

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless



specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

**EVIDENCE**

108B8C

Print Request: Selected Document(s): 5-8,10,13,16

Time of Request: June 17, 2003 08:15 PM EDT

Number of Lines: 159

Job Number: 1842:0:4165955

Client ID/Project Name:

Research Information:

US Newspapers and Wires

"america! favorite! pasta"

Send to: SPRUILL, DARRYL

TRADEMARK LAW LIBRARY

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ARLINGTON, VIRGINIA 22202-4600

5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.  
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

**SECTION:** LIFESTYLE / FOOD; Pg. F06

**LENGTH:** 449 words

**HEADLINE:** SAUCE IT UP, VEGAN STYLE

**COLUMN:** NATURALLY YOURS

**BYLINE:** JAN WOLFF

**BODY:**

...your spaghetti, and if you're a vegan, you may still  
crave a sprinkling of Parmesan now and then. What's left to put on  
**America's favorite pasta?** Plain old tomato sauce can get tiresome, even  
if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.  
PR Newswire

April 24, 1998, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO FOOD, NATIONAL AND FEATURES EDITORS

**LENGTH:** 301 words

**HEADLINE:** Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998  
LEXIS-NEXIS Related Topics Full Article Related Topics Overview

This document contains no targeted Topics.

**DATELINE:** NEW YORK, April 24

**BODY:**

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of America's favorite pasta dish is based on consumer research as well as pasta's history in the U.S.," said Julia Kinnaid, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

**SECTION:** FOOD, Pg. J10

**LENGTH:** 475 words

**HEADLINE:** Beard awards nominees

**BODY:**

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, America's Favorite Pasta" by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.  
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

**SECTION:** FLORIDA; Pg. 18

**LENGTH:** 861 words

**HEADLINE:** FOR YOUNG TASTE BUDS ONLY

**BYLINE:** By Scott Joseph, Sentinel Restaurant Critic

**BODY:**

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for **Americas favorite pasta.**

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.  
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

**SECTION:** FEATURES; Pg. 3E

**LENGTH:** 806 words

**HEADLINE:** AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

**BYLINE:** Michael Storey

**BODY:**

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with **America's favorite pasta-eating cat** going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company; Los Angeles Times All Rights  
Reserved  
Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

**SECTION:** Business; Part D; Page 1; Column 2; Financial Desk

**LENGTH:** 924 words

**HEADLINE:** FARMERS COUNT ON A NEW CASH CROP: PASTA;  
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH DAKOTA  
WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

**BYLINE:** By GREG JOHNSON, TIMES STAFF WRITER

**DATELINE:** IRVINE

**BODY:**

...plant. We can grow it, mill it and send it through the noodle plant."

Pasta Popularity

Spaghetti and linguine are America's favorite pasta products, followed by elbows and twists. Dry  
pasta retail sales by shape in 1993:  
Long goods ( ...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;  
Copyright Business First of Louisville Inc. 1985;  
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATELINE: Louisville; KY; US

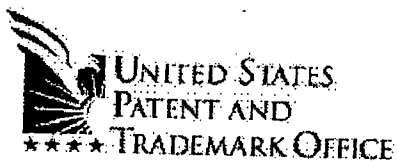
BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while America's favorite pasta may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

---

[1] No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.



Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
www.uspto.gov

Mar 3, 2004

### NOTICE OF PUBLICATION UNDER 12(a)

1. Serial No.:  
78/136,703
2. Mark:  
BARILLA - AMERICA'S FAVORITE PASTA
3. International Class(es):  
30
4. Publication Date:  
Mar 23, 2004
5. Applicant:  
Barilla Alimentare S.p.A.

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: (202) 512-1800

By direction of the Commissioner.

Correspondence Address:

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

TMP&I

\*\*\* User: dspruill \*\*\*

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	39	4	35	14	0:01	"barilla alimentare"[on]
02	1609	N/A	0	0	0:04	*b\$l(r{v})l\$l{v}*[bi,ti]
03	223	0	223	67	0:11	2 and "030"[cc] not dead[ld]
04	34385	N/A	0	0	0:06	*m{v)r{v}{"ckqx"}a*[bi,ti]
05	1017	N/A	0	0	0:11	*{"fh"}avor{v}t*[bi,ti]
06	8369	N/A	0	0	0:02	*be{"sz"}t*[bi,ti]
07	1530	N/A	0	0	0:01	*pre{"fp"}\$ler*[bi,ti]
08	23850	N/A	0	0	0:04	("1" one*) [bi,ti]
09	1325	N/A	0	0	0:01	*pa{"sz"}ta*[bi,ti]
10	901	N/A	0	0	0:01	4 and (5 6 7 8 9)
11	23	13	10	2	0:01	9 and (5 6 7 8)
12	214	0	214	69	0:10	10 and "030"[cc] not dead[ld]

Session started 10/11/02 9:29:16 AM  
Session finished 10/11/02 9:44:24 AM  
Total search duration 0 minutes 53 seconds  
Session duration 15 minutes 8 seconds

Default NEAR limit= 1 ADJ limit= 1




# **Incoming Correspondence Routing Sheet**

**To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET**

**Word Mark: BARILLA - AMERICA'S FAVORITE PASTA**

**Serial No: 78136703**  


**Mail Date: 11142003**  


**Doc. Type: Responses to Office Actions**  


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**No Fee**

**RAM Mail Date: 111403**  


2778-127  
GRF:mec:nlf



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Barilla Alimentare S.p.A. )  
Serial No. 78/136,703 ) Trademark Attorney  
Filed: June 18, 2002 ) Darryl M. Spruill  
Mark: BARILLA-AMERICA'S ) Law Office 112  
FAVORITE PASTA )

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003,  
Applicant responds in accordance with the headings therein.

DISCLAIMER

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use  
"AMERICA'S FAVORITE PASTA" apart from the mark as  
shown.--

REMARKS

Since this appears to be the only outstanding matter at  
issue it appears this application is in condition to be  
approved for publication.

RECEIVED  
2003 DEC -3 A 11:58  
LAW OFFICE 112



11-14-2003

U.S. Patent & TMO/TM Mail Rpt/Dt #11

Serial No.: 78/136,703  
Mark: BARILLA - AMERICA'S FAVORITE PASTA  
Attorney Docket No.: 2778-126

Respectfully submitted,

Barilla Alimentare S.p.A.

By:

*G. F. Rothwell*

G. Franklin Rothwell  
Attorney for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

May 8, 2003

78136703

2:48 PM

**TYPED DRAWING**

**Serial Number**  
78136703

**Filing Date**  
Jun 18, 2002

**Status of Application**  
RESPONSE AFTER NON-FINAL ACTION - ENTERED

**Register**  
PRINCIPAL

**MARK DATA**

**Word Mark**  
BARILLA - AMERICA'S FAVORITE PASTA

**Mark Drawing Code**  
(1) TYPED DRAWING

**FILING BASIS DATA**

FILED 1(a): NO	CURRENT 1(a): NO	AMENDED 1(a): NO
FILED 1(b): YES	CURRENT 1(b): YES	AMENDED 1(b): NO
FILED 44D: NO	CURRENT 44D: NO	AMENDED 44D: NO
FILED 44E: NO	CURRENT 44E: NO	AMENDED 44E: NO
FILED NO B: NO	CURRENT NO B: NO	

**GOODS AND SERVICES DATA**

**Type of Mark**  
TRADEMARK

G & S: Class Status -- ACTIVE. IC 030. US 046. PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

**OWNER DATA**

PARTY TYPE 10 - ENTRY NUMBER 001 - COMPOSED FLAG FALSE

ASSIGNMENT RECORDED: NO

Barilla Alimentare S.p.A.  
CORPORATION

May 8, 2003

78136703

2:48 PM

ITALY  
Via Mantova 166  
Parma PR, ITALY 43100

**OTHER DATA**

**FOREIGN REGISTRATION DATA**

**CORRESPONDENCE DATA**

**Attorney of Record**  
G. Franklin Rothwell, Esq.

**Telephone Number**  
202-783-6040

**Fax Number**  
202-783-6031

**Domestic Representative**  
G. Franklin Rothwell, Esq.

**Telephone Number**  
202-783-6040

**Fax Number**  
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**Correspondence Address**  
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Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

**Telephone Number**  
202-783-6040

**Fax Number**  
202-783-6031

**Effective Date of Change**  
Jun 18, 2002

**Automatic Last Update**  
NOT UPDATED

**Attorney Docket Number**  
2778-127

**HISTORY OF CORRESPONDENCE CHANGES**

May 8, 2003

78136703

2:48 PM

**PROSECUTION HISTORY**

DATE: 2003/04/15  
COMMUNICATION RECEIVED FROM APPLICANT

DATE: 2003/04/15  
PAPER RECEIVED

DATE: 2002/10/15  
NON-FINAL ACTION MAILED

DATE: 2002/10/01 - PROCEEDING NUMBER: 076731  
ASSIGNED TO EXAMINER

DATE: 2002/09/28 - PROCEEDING NUMBER: 069249  
ASSIGNED TO EXAMINER

**Examining Attorney**  
SPRUILL, DARRYL  
LAW OFFICE 112

May 8, 2003

78136708

2:24 PM

**TYPED DRAWING**

**Serial Number**  
78136708

**Filing Date**  
Jun 18, 2002

**Status of Application**  
RESPONSE AFTER NON-FINAL ACTION - ENTERED

**Register**  
PRINCIPAL

**MARK DATA**

**Word Mark**  
BARILLA - AMERICA'S PREFERRED PASTA

**Mark Drawing Code**  
(1) TYPED DRAWING

**FILING BASIS DATA**

FILED 1(a) : NO	CURRENT 1(a) : NO	AMENDED 1(a) : NO
FILED 1(b) : YES	CURRENT 1(b) : YES	AMENDED 1(b) : NO
FILED 44D : NO	CURRENT 44D : NO	AMENDED 44D : NO
FILED 44E : NO	CURRENT 44E : NO	AMENDED 44E : NO
FILED NO B : NO	CURRENT NO B : NO	

**GOODS AND SERVICES DATA**

**Type of Mark**  
TRADEMARK

G & S: Class Status -- ACTIVE. IC 030. US 046. PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

**OWNER DATA**

PARTY TYPE 10 - ENTRY NUMBER 001 - COMPOSED FLAG FALSE

ASSIGNMENT RECORDED: NO

Barilla Alimentare S.p.A.  
CORPORATION

May 8, 2003

78136708

2:24 PM

ITALY  
Via Mantova 166  
Parma PR, ITALY 43100

**OTHER DATA**

**FOREIGN REGISTRATION DATA**

**CORRESPONDENCE DATA**

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202-783-6040

**Fax Number**  
202-783-6031

**Effective Date of Change**  
Jun 18, 2002

**Automatic Last Update**  
NOT UPDATED

**Attorney Docket Number**  
2778-132

**HISTORY OF CORRESPONDENCE CHANGES**



May 8, 2003

78136708

2:24 PM

**PROSECUTION HISTORY**

DATE: 2003/04/15  
COMMUNICATION RECEIVED FROM APPLICANT

DATE: 2003/04/15  
PAPER RECEIVED

DATE: 2002/10/15  
NON-FINAL ACTION MAILED

DATE: 2002/10/08 - PROCEEDING NUMBER: 076731  
ASSIGNED TO EXAMINER

DATE: 2002/10/01 - PROCEEDING NUMBER: 073358  
ASSIGNED TO EXAMINER

DATE: 2002/10/01 - PROCEEDING NUMBER: 076731  
ASSIGNED TO EXAMINER

DATE: 2002/09/28 - PROCEEDING NUMBER: 069249  
ASSIGNED TO EXAMINER

**Examining Attorney**  
SPRUILL, DARRYL  
LAW OFFICE 112

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/136703

**APPLICANT:** Barilla Alimentare S.p.A.

**CORRESPONDENT ADDRESS:**

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

**JUN 18 2003**  
**RETURN ADDRESS:**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
ecom112@uspto.gov

**MARK:** BARIILLA - AMERICA'S FAVORITE PASTA

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 2778-127

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

**RE:** Serial Number 78/136703

This letter responds to the applicant's communication filed April 15, 2003.

**STATUS OF THE APPLICATION**

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

## REFUSAL

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, TMEP §1209.03(s).

### **1209.03(s) Slogans**

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

The wording AMERICA'S FAVORITE PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (FAVORITE), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of selected excerpts of stories taken from LEXIS/NEXIS® computerized database, listing the terms AMERICA'S FAVORITE PASTA. See the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the terms **AMERICA'S FAVORITE** disclaimed. See the attached enclosure.<sup>1</sup> Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Dayco Products-Eagle Motive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of **"AMERICA'S FAVORITE PASTA"** is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill  
Trademark Attorney  
Law Office 112  
(703) 308-9112, Ext. 203  
darryl.spruill@uspto.gov  
/Darryl M. Spruill/

### **RESPONSE GUIDELINES**

The applicant may respond via regular mail to the address listed above, or via e-mail to [Ecom112@uspto.gov](mailto:Ecom112@uspto.gov). In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;

---

<sup>1</sup> No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.

2. send the response to <mailto:ecom112@uspto.gov>. E-mail sent to any other address will NOT be processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG format only. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the Office action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. See 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to [Comments@uspto.gov](mailto:Comments@uspto.gov).

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

#### **EVIDENCE**

108B8C

Print Request: Selected Document(s): 5-8, 10, 13, 16

Time of Request: June 17, 2003 08:15 PM EDT

Number of Lines: 159

Job Number: 1842:0:4165955

Client ID/Project Name:

Research Information:

US Newspapers and Wires

"america! favorite! pasta"

Send to: SPRUILL, DARRYL

TRADEMARK LAW LIBRARY

2101 CRYSTAL PLAZA ARC

MAILBOX 314

ARLINGTON, VIRGINIA 22202-4600

5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.  
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

**SECTION:** LIFESTYLE / FOOD; Pg. F06

**LENGTH:** 449 words

**HEADLINE:** SAUCE IT UP, VEGAN STYLE

**COLUMN:** NATURALLY YOURS

**BYLINE:** JAN WOLFF

**BODY:**

...your spaghetti, and if you're a vegan, you may still  
crave a sprinkling of Parmesan now and then. What's left to put on  
America's favorite pasta? Plain old tomato sauce can get tiresome, even  
if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.  
PR Newswire

April 24, 1998, Friday

**SECTION:** Financial News

**DISTRIBUTION:** TO FOOD, NATIONAL AND FEATURES EDITORS

**LENGTH:** 301 words

**HEADLINE:** Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998  
**LEXIS-NEXIS Related Topics Full Article Related Topics Overview**

This document contains no targeted Topics.

**DATELINE:** NEW YORK, April 24

**BODY:**

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of America's favorite pasta dish is based on consumer research as well as pasta's history in the U.S.," said Julia Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.  
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

**SECTION:** FOOD, Pg. J10

**LENGTH:** 475 words

**HEADLINE:** Beard awards nominees

**BODY:**

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, America's Favorite Pasta" by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.  
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR



**SECTION:** FLORIDA; Pg. 18

**LENGTH:** 861 words

**HEADLINE:** FOR YOUNG TASTE BUDS ONLY

**BYLINE:** By Scott Joseph, Sentinel Restaurant Critic

**BODY:**

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for America's favorite pasta.

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.  
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

**SECTION:** FEATURES; Pg. 3E

**LENGTH:** 806 words

**HEADLINE:** AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

**BYLINE:** Michael Storey

**BODY:**

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with America's favorite pasta-eating cat going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company, Los Angeles Times All  
Rights Reserved  
Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

**SECTION:** Business; Part D; Page 1; Column 2; Financial Desk

**LENGTH:** 924 words

**HEADLINE:** FARMERS COUNT ON A NEW CASH CROP: PASTA;  
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH  
DAKOTA WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

**BYLINE:** By GREG JOHNSON, TIMES STAFF WRITER

**DATeline:** IRVINE

**BODY:**

...plant. We can grow it, mill it and send it through the noodle plant."

Pasta Popularity

Spaghetti and linguine are America's favorite pasta products, followed by elbows and twists.  
Dry pasta retail sales by shape in 1993:  
Long goods ( ...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;  
Copyright Business First of Louisville Inc. 1985;  
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATELINE: Louisville; KY; US

BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while America's favorite pasta may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

# TRADE MARK EXAMINATION WORKSHEET

☒ AMENDMENT STAGE      ☐ NO CHANGE      ☐ PUBLICATION/REGISTRATION STAGE

Name: Lorri White L.O. 112

Serial No. 7 81134703

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

## Legal Instrument Examiner (LIE)

	Amended	Data Element	
Class Data	<input checked="" type="checkbox"/>	<input type="checkbox"/> Prime/International Class	<input checked="" type="checkbox"/> Goods and Services
		<input type="checkbox"/> First Use Date	<input type="checkbox"/> First Use in Commerce Date
		<input type="checkbox"/> In Another Form	<input type="checkbox"/> Certification
		<input type="checkbox"/> 1b	
Mark Data		<input type="checkbox"/> Word Mark	<input type="checkbox"/> Pseudo Mark
		<input type="checkbox"/> Mark Drawing Code	<input type="checkbox"/> Design Search Code
		<input type="checkbox"/> Scan Sub Drawing	
Misc. Mark Data		<input type="checkbox"/> Mark Description	<input type="checkbox"/> Disclaimer
		<input type="checkbox"/> Lining/Stippling	<input type="checkbox"/> Name/Portrait/Consent
		<input type="checkbox"/> Translation	
Section 2(f)		<input type="checkbox"/> Section 2(f) Entire Mark	
		<input type="checkbox"/> Section 2(f) Limitation Statement	<input type="checkbox"/> Section 2(f) in Part
		<input type="checkbox"/> Amended Register	<input type="checkbox"/> Amended Register Date
Foreign Reg. Data		<input type="checkbox"/> Foreign Country	<input type="checkbox"/> 44(d)
		<input type="checkbox"/> Foreign Application Number	<input type="checkbox"/> Foreign Application Filing Date
		<input type="checkbox"/> Foreign Registration Number	<input type="checkbox"/> Foreign Registration Date
		<input type="checkbox"/> Foreign Registration Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Number
		<input type="checkbox"/> Foreign Reg. Renewal Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Date
Owner Data		<input type="checkbox"/> Owner Name	<input type="checkbox"/> DBA/AKA/TA
		<input type="checkbox"/> Address 1	<input type="checkbox"/> Address 2
		<input type="checkbox"/> City	<input type="checkbox"/> State
		<input type="checkbox"/> Zip Code	
		<input type="checkbox"/> Citizenship	<input type="checkbox"/> Entity
		<input type="checkbox"/> Entity Statement	<input type="checkbox"/> Composed of
		<input type="checkbox"/> Assignment(s)/Name Change	
Amd/Corr Restr.		<input type="checkbox"/> Concurrent Use	
Prior U.S. Reg.		<input type="checkbox"/> Prior Registration	
Correspondence		<input type="checkbox"/> Attorney	<input type="checkbox"/> Domestic Representative
		<input type="checkbox"/> Attorney Docket Number	
		<input type="checkbox"/> Correspondence Firm Name/Address	

I certify that all corrections have been entered in accordance with text editing guidelines.

Lorri White  
LIE

5/7/2003  
DATE

Other: \_\_\_\_\_

# Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET

Word Mark: BARILLA - AMERICA'S FAVORITE PASTA

Serial No: 78136703

Mail Date: 04152003

Doc. Type: Amendments to Response

No Fee

RAM Mail Date: 041503

TMO  
LAW OFFICE 112

112 - 6 AIC 112


RECEIVED

2A

2

2778-127  
GFR:RHC:czb



Examining Attorney: SPRUILL DARRYL  
Serial Number: 78/136703  


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Barilla Alimentare S.p.A. )  
Serial No. 78/136,703 ) Trademark Attorney  
Filed: June 18, 2002 ) Darryl M. Spruill  
Mark: BARILLA - AMERICA'S ) Law Office 101  
FAVORITE PASTA )

AMENDMENT AND RESPONSE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Dear Sir:

Applicant hereby responds to Office Action No. 01 in  
accordance with the headings therein.

IN THE IDENTIFICATION OF GOODS

Kindly amend the identification of goods in the subject  
application as follows:

--PASTA, PASTA PRODUCTS, NAMELY MEALS  
CONSISTING PRIMARILY OF PASTA, MACARONI  
SALAD, PASTA SALAD, SAUCES FOR PASTA in  
International Class 30.--

DISCLAIMER REQUIREMENT

The Office Action has called for Applicant to disclaim the  
wording "AMERICA'S FAVORITE PASTA" apart from the mark as shown.  
The grounds cited are that AMERICA'S has geographical  
significance, FAVORITE is a laudatory term and PASTA is a generic

term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregistrable components of a mark otherwise registrable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive and does not concede that the term FAVORITE is laudatory in this instance, Applicant respectfully traverses the requirement to disclaim AMERICA'S FAVORITE PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983) ("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA<sup>1</sup>, but obviously creates a commercial impression distinct from that of its house mark. Professor McCarthy provides an

<sup>1</sup>

See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.

illustrative example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991) ("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S FAVORITE PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S FAVORITE PASTA clearly characterize the well-recognized trademark of Applicant -- in other words, they meld with the BARILLA registered mark. All of these factors support a



determination that Applicant's proposed slogan is a unitary mark.  
See Dena, 950 F.2d at 1561 (citing TMEP § 807.13(a) (rev. 1986)).  
For the foregoing reasons, Applicant believes that disclaimer of  
AMERICA'S FAVORITE PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully  
requested that the subject application be approved for  
publication.

Respectfully submitted,

By

Robert H. Cameron

G. Franklin Rothwell  
Robert H. Cameron  
Attorneys for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202) 783-6040

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/136703

**APPLICANT:** Barilla Alimentare S.p.A.

**OCT 15 2002**

**CORRESPONDENT ADDRESS:**

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, NW  
Suite 800  
Washington DC 20005

**RETURN ADDRESS:**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
**ecom101@uspto.gov**

**MARK:** BARILLA - AMERICA'S FAVORITE PASTA

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 2778-127

**CORRESPONDENT EMAIL ADDRESS:**

N/A

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**PRIORITY ACTION**

**OFFICE SEARCH:** 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. Section 1052(d). TMEP section 704.02.

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.** This case will be given priority as an amended case if you respond to the requirements stated below within two months.

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

**RE:** Serial Number 78/136703

The following issues were discussed in communication with G. Franklin Rothwell on 10/11/02.

**1. IDENTIFICATION OF GOODS -UNACCEPTABLE:**

The identification of goods is indefinite because the applicant uses the wording "products." The identification of goods must be specific. The applicant must amend the identification to specify the common commercial name of the goods or to indicate their nature. The recitation identification must be all-inclusive. The applicant should amend the identification to replace this wording with "namely." The applicant may amend the identification to substitute the following wording, if

accurate: "Pasta, pasta products, namely, [specify the products], sauces for pasta," in International Class 030. 37 C.F.R. Section 2.71(a); TMEP sections 804 and 804.08(c).<sup>1</sup>

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 804.09. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

## **2. DISCLAIMER REQUIREMENT:**

The applicant must disclaim the wording AMERICA'S FAVORITE PASTA in the mark because the wording AMERICA'S is a term having geographical significance combined with FAVORITE a laudatory descriptive term, and PASTA a generic term.

Also, the examining attorney has attached third-party registrations showing the term AMERICA(S) combined with laudatory and generic terms disclaimed. See the attached enclosure. Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." See TMEP section 1207.01(c)(iv); see also, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Dayco Products-Eagle Motive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP section 1213.09(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use "AMERICA'S FAVORITE PASTA" apart from the mark as shown.



Darryl M. Spruill  
Trademark Attorney  
Law Office 101  
(703) 308-9101, Ext. 170  
darryl.spruill@uspto.gov

<sup>1</sup> Please note that the recommended identification of goods is not exhaustive. The applicant is directed to the Office's searchable database of the Manual of Acceptable Identifications of Goods and Services. The address for this is: [http://www.uspto.gov/web/offices/tac/doc/gsmannual/](http://www.uspto.gov/web/offices/tac/doc/gsmmanual/).

**How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

\*\*\* User: dspruill \*\*\* Serial Number: 78057808 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark

AMERICAS FAVORITE PIZZA FEAST

Goods and Services

IC 030. US 046. G & S: Pizza for consumption on or off the premises.  
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

78057808

Filing Date

April 11, 2001

Publication for Opposition Date

January 15, 2002

Registration Number

2558945

Registration Date

April 9, 2002

Owner Name and Address

(REGISTRANT) Domino's Pizza PMC, Inc. CORPORATION MICHIGAN 30 Frank Lloyd  
Wright Drive Ann Arbor MICHIGAN 48106

Prior Registration(s)

1705234;1791773;1825321;AND OTHERS

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA"  
APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Elizabeth F. Janda

\*\*\* Search: 14 \*\*\* Document Number: 2 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 78039333 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE COOKIE

Goods and Services

IC 030. US 046. G & S: Cookies. FIRST USE: 19980201. FIRST USE IN  
COMMERCE: 19980201

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

78039333

Filing Date

December 14, 2000

Filed ITU

FILED AS ITU

Supplemental Register Date

November 19, 2001

Registration Number

2572410

Registration Date

May 21, 2002

Owner Name and Address

(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE 1105 North  
Market Street, Suite 803 Wilmington DELAWARE 19801

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

2149887

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Live Dead Indicator

LIVE

Attorney of Record

Kathleen J. Gallagher, Esq.

\*\*\* Search: 14 \*\*\* Document Number: 1 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75768708 \*\*\* 10/11/02 10:58:13 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE SOUR GUM

Pseudo Mark

AMERICAS FAVORITE SOUR GUM

Goods and Services

IC 030. US 046. G & S: BUBBLE GUM. FIRST USE: 19990615. FIRST USE IN  
COMMERCE: 19990615

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75768708

Filing Date

August 5, 1999

Supplemental Register Date

December 15, 1999

Registration Number

2347915

Registration Date

May 2, 2000

Owner Name and Address

(REGISTRANT) Philadelphia Chewing Gum Corporation CORPORATION  
PENNSYLVANIA Havertown PENNSYLVANIA 190832189

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOUR GUM" APART FROM THE  
MARK AS SHOWN

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Live Dead Indicator

LIVE

Attorney of Record

Harriet E. Perkins

\*\*\* Search: 14 \*\*\* Document Number: 4 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75618178 \*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark

TUMARO'S GOURMET TORTILLAS -- AMERICA'S FAVORITE

Pseudo Mark

TUMAROS GOURMET TORTILLAS AMERICAS FAVORITE

Goods and Services

IC 030. US 046. G & S: tortillas and crepes. FIRST USE: 20000411.  
FIRST USE IN COMMERCE: 20000411

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75618178

Filing Date

January 11, 1999

Filed ITU

FILED AS ITU

Publication for Opposition Date

October 26, 1999

Registration Number

2419870

Registration Date

January 9, 2001

Owner Name and Address

(REGISTRANT) Tumaro's, Inc. CORPORATION CALIFORNIA 5300 Santa Monica  
Boulevard Los Angeles CALIFORNIA 90029

Prior Registration(s)

1893236; 2133513

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GOURMET TORTILLAS- -  
AMERICA'S FAVORITE" APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Corrine M. Freeman

\*\*\* Search: 14 \*\*\* Document Number: 5 \*\*\*



\*\*\* User: dspruill \*\*\* Serial Number: 75538444 \*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

ark

AMERICA'S FAVORITE

Pseudo Mark

AMERICAS FAVORITE

Goods and Services

IC 030. US 046. G & S: Doughnuts. FIRST USE: 19721003. FIRST USE IN  
COMMERCE: 19721201

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75538444

Filing Date

August 18, 1998

Publication for Opposition Date

April 27, 1999

Registration Number

2263243

Registration Date

July 20, 1999

Owner Name and Address

(REGISTRANT) HDN Development Corporation CORPORATION KENTUCKY 7303  
Turfway Road Florence KENTUCKY 41042

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

JOHN M HARRINGTON

\*\*\* Search: 14 \*\*\* Document Number: 7 \*\*\*



Mark

AMERICA'S FAVORITE FOODS PRESTO

Pseudo Mark

AMERICAS FAVORITE FOODS PRESTO

Goods and Services

IC 030. US 046. G & S: pizza crust mix, garlic sauce and cheddar sauce. FIRST USE: 19920217. FIRST USE IN COMMERCE: 19920217

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

261702 261707

Serial Number

75501805

Filing Date

June 15, 1998

Publication for Opposition Date

September 21, 1999

Registration Number

2299622

Registration Date

December 14, 1999

Owner Name and Address

(REGISTRANT) OHIO PIZZA PRODUCTS INC. CORPORATION OHIO 1522 Manchester Road Dayton OHIO 454490127

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE FOODS" APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

\*\*\* User: dspruill \*\*\* Serial Number: 75501805 \*\*\*

LIVE

Attorney of Record  
THEODORE D LIENESCH

\*\*\* Search: 14 \*\*\* Document Number: 8 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75470400 \*\*\* 10/11/02 10:58:14 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE CANDIES

Pseudo Mark

AMERICAS FAVORITE CANDIES

Goods and Services

IC 030. US 046. G & S: CANDY NOT INCLUDING JELLY BEANS. FIRST USE:  
19851118. FIRST USE IN COMMERCE: 19851118

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75470400

Filing Date

April 20, 1998

Publication for Opposition Date

November 2, 1999

Registration Number

2359173

Registration Date

June 20, 2000

Owner Name and Address

(REGISTRANT) PROMOTION IN MOTION, INC. CORPORATION DELAWARE 3 REUTEN  
DRIVE CLOSTER NEW JERSEY 07624

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CANDIES" APART FROM THE  
MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

RICHARD M GOLDBERG

\*\*\* Search: 14 \*\*\* Document Number: 9 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75447700 \*\*\* 10/11/02 10:58:15 AM \*

[Typed Drawing]

Mark

BEST PIE IN AMERICA

Goods and Services

IC 030. US 046. G & S: PIES. FIRST USE: 19970100. FIRST USE IN  
COMMERCE: 19970100

IC 042. US 100 101. G & S: RESTAURANT SERVICES. FIRST USE: 19970100.  
FIRST USE IN COMMERCE: 19970100

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75447700

Filing Date

March 10, 1998

Supplemental Register Date

October 14, 1998

Registration Number

2239993

Registration Date

April 13, 1999

Owner Name and Address

(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th  
Avenue Denver COLORADO 80216

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PIE" APART FROM THE MARK  
AS SHOWN

Type of Mark

TRADEMARK. SERVICE MARK

Register

SUPPLEMENTAL

Live Dead Indicator

LIVE

Attorney of Record

SABRINA C STAVISH

\*\* Search: 14 \*\*\* Document Number: 10 \*\*\*



Mark

BAKERS SQUARE BEST PIE IN AMERICA

Goods and Services

IC 030. US 046. G & S: pies. FIRST USE: 19970400. FIRST USE IN  
COMMERCE: 19970400

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

010103 260117

Serial Number

75300090

Filing Date

May 29, 1997

Filed ITU

FILED AS ITU

Publication for Opposition Date

October 6, 1998

Registration Number

2213980

Registration Date

December 29, 1998

Owner Name and Address

(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th  
Avenue Denver COLORADO 80216

Assignment Recorded

ASSIGNMENT RECORDED

\*\*\* User: dspruill \*\*\* Serial Number: 75300090 \*\*\*

Prior Registration(s)  
1394236;1394428;1403328;2002503

Disclaimer Statement  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEST PIE IN AMERICA"  
APART FROM THE MARK AS SHOWN

Type of Mark  
TRADEMARK

Register  
PRINCIPAL-2(F)-IN PART

Live Dead Indicator  
LIVE

Distinctiveness Limitation Statement  
as to "BAKERS"

Attorney of Record  
SABRINA C STAVISH

\*\*\* Search: 14 \*\*\* Document Number: 11 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75265223 \*\*\* 10/11/02 10:58:15 AM \*

[Typed Drawing]

Mark

AMERICA'S BEST

Pseudo Mark

AMERICAS BEST

Goods and Services

IC 030. US 046. G & S: iced coffee-based beverages, namely, unflavored iced coffees and coffees with flavorings including cappuccino, hazelnut, French vanilla, Viennese mocha and original chocolate flavors. FIRST USE: 19930200. FIRST USE IN COMMERCE: 19930200

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75265223

Filing Date

March 27, 1997

Publication for Opposition Date

July 21, 1998

Registration Number

2194941

Registration Date

October 13, 1998

Owner Name and Address

(REGISTRANT) America's Best Beverage Company, Inc. CORPORATION FLORIDA 35  
Mason Street Greenwich CONNECTICUT 06830

Assignment Recorded

ASSIGNMENT RECORDED

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

MICHAEL I WOLFSON

\*\*\* Search: 14 \*\*\* Document Number: 12 \*\*\*



\*\*\* User: dspruill \*\*\* Serial Number: 75222072 \*\*\* 10/11/02 10:58:16 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE CHOCOLATE CHIP COOKIE!

Pseudo Mark

AMERICAS FAVORITE CHOCOLATE CHIP COOKIE

Goods and Services

IC 030. US 046. G. & S: cookies. FIRST USE: 19960400. FIRST USE IN  
COMMERCE: 19960400

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75222072

Filing Date

January 8, 1997

Filed ITU

FILED AS ITU

Supplemental Register Date

January 20, 1998

Registration Number

2149887

Registration Date

April 7, 1998

Owner Name and Address

(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE One South Wacker  
Drive, Suite 2740 Chicago ILLINOIS 60606

Assignment Recorded

ASSIGNMENT RECORDED

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

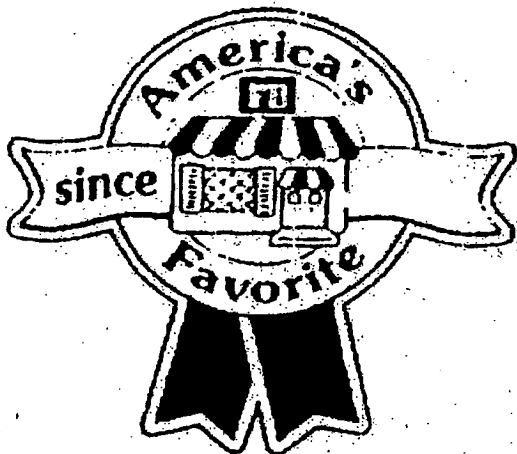
Live Dead Indicator

LIVE

Attorney of Record

KATHLEEN J GALLAGHER

\*\* Search: 14 \*\*\* Document Number: 13 \*\*\*



Mark

AMERICA'S FAVORITE SINCE FBI

Goods and Services

IC 030. US 046. G & S: confectionery, namely, candy, caramels, marshmallows, marshmallow creme, and fudge. FIRST USE: 19960700. FIRST USE IN COMMERCE: 19960700

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

070104 240707 240907

Serial Number

75144931

Filing Date

August 5, 1996

Publication for Opposition Date

September 16, 1997

Registration Number

2119233

Registration Date

December 9, 1997

Owner Name and Address

(REGISTRANT) Favorite Brands International, Inc. CORPORATION DELAWARE 75  
Tri State International Lincolnshire ILLINOIS 60069

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

\*\*\* User: dspruill \*\*\* Serial Number: 75144931 \*\*\*

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE SINCE"  
APART FROM THE MARK AS SHOWN

Description of Mark

The mark consists of the design of a canopied building, with the stylized letters "FBI" appearing directly above the building, and the phrase "AMERICA'S FAVORITE SINCE" (followed by a date of origin, which varies from candy to candy), all being enclosed in a banner and seal-with-ribbon design. The lining in the drawing is a feature of the mark, and it is not intended to indicate color.

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Paula J. Krasny

\*\*\* Search: 14 \*\*\* Document Number: 14 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75116367 \*\*\* 10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark

IT'S AMERICA'S FAVORITE JELLY BEAN

Goods and Services

IC 030. US 046. G & S: jelly beans. FIRST USE: 19890531. FIRST USE  
IN COMMERCE: 19890531

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75116367

Filing Date

June 10, 1996

Publication for Opposition Date

April 15, 1997

Registration Number

2077329

Registration Date

July 8, 1997

Owner Name and Address

(REGISTRANT) HERMAN GOELITZ CANDY CO., INC. CORPORATION CALIFORNIA 2400  
North Watney Way Fairfield CALIFORNIA 94533

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

1604190

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "JELLY BEAN" APART FROM  
THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

JAMES R. CYPHER

\*\* Search: 14 \*\*\* Document Number: 15 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75068756 \*\*\* 10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE KETCHUP

Pseudo Mark

AMERICAS FAVORITE KETCHUP

Goods and Services

IC 030. US 046. G & S: condiments, namely, ketchup. FIRST USE:  
19920600. FIRST USE IN COMMERCE: 19920600

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75068756

Filing Date

March 7, 1996

Publication for Opposition Date

July 1, 1997

Registration Number

2098790

Registration Date

September 23, 1997

Owner Name and Address

(REGISTRANT) H. J. HEINZ COMPANY CORPORATION PENNSYLVANIA 1062 Progress  
Street Pittsburgh PENNSYLVANIA 15212

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "KETCHUP" APART FROM THE  
MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

Dean A. Bierkan

\*\*\* Search: 14 \*\*\* Document Number: 17 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75036522 \*\*\* 10/11/02 10:58:17 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE SOFT PRETZEL

Goods and Services

IC 030. US 046. G & S: snack foods, namely, soft pretzels. FIRST USE:  
19960300. FIRST USE IN COMMERCE: 19960300

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75036522

Filing Date

December 26, 1995

Filed ITU

FILED AS ITU

Publication for Opposition Date

February 17, 1998

Registration Number

2155994

Registration Date

May 12, 1998

Owner Name and Address

(REGISTRANT) J&J Snack Foods Corp. CORPORATION NEW JERSEY 6000 Central  
Highway Pennsauken NEW JERSEY 08109

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOFT PRETZEL" APART FROM  
THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL-2(F)

Live Dead Indicator

LIVE

Attorney of Record

J. Rodman Steele, Jr.

\*\*\* Search: 14 \*\*\* Document Number: 18 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 75035078 10/11/02 10:58:18 AM \*

[Typed Drawing]

Mark

AMERICA'S #1 SPICE VALUE

Goods and Services

IC 030: US 046. G & S: spices. FIRST USE: 19950324. FIRST USE IN  
COMMERCE: 19950324

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75035078

Filing Date

December 20, 1995

Publication for Opposition Date

March 11, 1997

Registration Number

2066497

Registration Date

June 3, 1997

Owner Name and Address

(REGISTRANT) ROSE SPICE, INC. CORPORATION DELAWARE 4500 Northchase  
Parkway NE Wilmington DELAWARE 28405

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S #1 SPICE" APART  
FROM THE MARK AS SHOWN.

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

WILLIAM J MASON

\*\*\* Search: 14 \*\*\* Document Number: 19 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 74322961 \*\*\* 10/11/02 10:58:18 AM \*

[Typed Drawing]

Mark

AMERICA'S FAVORITE HOLIDAY CANDY

Pseudo Mark

AMERICAS FAVORITE HOLIDAY CANDY

Goods and Services

IC 030. US 046. G & S: chocolates and other candy. FIRST USE:  
19921201. FIRST USE IN COMMERCE: 19921201

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

74322961

Filing Date

October 15, 1992

Filed ITU

FILED AS ITU

Supplemental Register Date

December 14, 1993

Registration Number

1837304

Registration Date

May 17, 1994

Owner Name and Address

(REGISTRANT) R. M. PALMER COMPANY CORPORATION PENNSYLVANIA 77 Second  
Avenue West Reading PENNSYLVANIA 19611

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOLIDAY CANDY" APART FROM  
THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Affidavit Text

SECT 8 (6-YR).

Live Dead Indicator

LIVE

Attorney of Record

John F. McNulty

\*\*\* Search: 14 \*\*\* Document Number: 21 \*\*\*



## America's Favorite Pizza Feast

Mark

AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark

AMERICAS FAVORITZ PIZZA FEAST

Goods and Services

IC 030. US 046. G & S: pizza for consumption on or off the premises.  
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number

74270458

Filing Date

April 29, 1992

Filed ITU

FILED AS ITU

Publication for Opposition Date

December 15, 1992

Registration Number

1791773

Registration Date

September 7, 1993

Owner Name and Address

(REGISTRANT) Domino's Pizza, Inc. CORPORATION MICHIGAN 30 Frank Lloyd  
Wright Drive P.O. Box 997 Ann Arbor MICHIGAN 481060997

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

1700700

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA"  
APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

\*\*\* User: dspruill \*\*\* Serial Number: 74270458 \*\*\*

Affidavit Text  
SECT 15. SECT 8 (6-YR).

Live Dead Indicator  
LIVE

Attorney of Record  
JEFFREY P THENNISCH

\*\*\* Search: 14 \*\*\* Document Number: 22 \*\*\*

\*\*\* User: dspruill \*\*\* Serial Number: 74044195 \*\*\* 10/11/02 10:58:19 AM \*

[Typed Drawing]

Mark

AMERICA'S SNACK FAVORITE

Pseudo Mark

americas snack favorite

Goods and Services

IC 030. US 046. G & S: snack cakes. FIRST USE: 19891200. FIRST USE  
IN COMMERCE: 19891200

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

74044195

Filing Date

March 30, 1990

Supplemental Register Date

November 14, 1990

Registration Number

1638019

Registration Date

March 12, 1991

Owner Name and Address

(REGISTRANT) McKee Baking Company CORPORATION TENNESSEE P.O. Box 750  
Collegedale TENNESSEE 37315

(LAST LISTED OWNER) MCKEE FOODS CORPORATION CORPORATION BY CHANGE OF  
NAME FROM TENNESSEE P.O. BOX 750 COLLEGEDALE TENNESSEE 373150750

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

1542109

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Affidavit Text

SECT 8 (6-YR). SECTION 8 (10-YR) 20010618.

Renewal

1ST RENEWAL 20010618

Live Dead Indicator

\*\*\* Search: 14 \*\*\* Document Number: 23 \*\*\*

(cont)

\*\*\* User: dspruill \*\*\* Serial Number: 74044195 \*\*\*

LIVE

Attorney of Record  
DONALD A. KAUL & PATRICIA R. BROWN

\*\*\* Search: 14 \*\*\* Document Number: 23 \*\*\*

<b>DOCUMENT INFORMATION</b>	
<b>TRADEMARK/SERVICEMARK APPLICATION</b>	
<b>VERSION 1.24</b>	
<b>APPLICANT INFORMATION</b>	
NAME	Barilla Alimentare S.p.A.
STREET	Via Mantova 166
CITY	Parma PR
COUNTRY	Italy
ZIP/POSTAL CODE	43100
<b>APPLICANT ENTITY INFORMATION</b>	
CORPORATION: STATE/COUNTRY OF INCORPORATION	Italy
<b>TRADEMARK/SERVICEMARK INFORMATION</b>	
MARK	BARILLA - AMERICA'S FAVORITE PASTA
TYPED FORM	Yes
<b>BASIS FOR FILING AND GOODS/SERVICES INFORMATION</b>	
INTENT TO USE: SECTION 1(b)	Yes
INTERNATIONAL CLASS NUMBER	030
LISTING OF GOODS AND/OR SERVICES	PASTA, PASTA PRODUCTS, SAUCES FOR PASTA
<b>ATTORNEY INFORMATION</b>	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800

78136703

CITY	Washington
STATE	DC
COUNTRY	USA
ZIP/POSTAL CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
ATTORNEY DOCKET NUMBER	2778-127
OTHER APPOINTED ATTORNEY(S)	Robert H. Cameron; Anne M. Sterba
<b>DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT</b>	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800
CITY	Washington
STATE	DC
ZIP CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
<b>FEE INFORMATION</b>	
TOTAL FEES PAID	325
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1

78136703

<b>LAW OFFICE INFORMATION</b>	
E-MAIL ADDRESS FOR CORRESPONDENCE	N/A
<b>SIGNATURE AND OTHER INFORMATION</b>	
SIGNATURE	/Robert H. Cameron/
DATE	06/18/2002
NAME	Robert H. Cameron
TITLE	Attorney for Applicant
<b>MAILING ADDRESS</b>	
LINE	G. Franklin Rothwell, Esq.
LINE	Rothwell, Figg, Ernst & Manbeck, P.C.
LINE	1425 K Street, NW
LINE	Suite 800
LINE	Washington DC 20005
<b>RAM INFORMATION</b>	
RAM SALE NUMBER	127
RAM ACCOUNTING DATE	20020619
<b>SERIAL NUMBER INFORMATION</b>	
SERIAL NUMBER	78/136703
INTERNET TRANSMISSION DATE	Tuesday, 06-18-2002 16:40:16 EDT
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E-MAIL ADDRESS FOR	bmanning@rothwellfigg.com

78136703

ACKNOWLEDGMENT



&lt;SERIAL NUMBER&gt; 78136703

&lt;FILING DATE&gt; 06/18/2002

## &lt;DOCUMENT INFORMATION&gt;

&lt;TRADEMARK/SERVICEMARK APPLICATION&gt;

&lt;VERSION 1.24&gt;

## &lt;APPLICANT INFORMATION&gt;

&lt;NAME&gt;

Barilla Alimentare S.p.A.

&lt;STREET&gt;

Via Mantova 166

&lt;CITY&gt;

Parma PR

&lt;COUNTRY&gt;

Italy

&lt;ZIP/POSTAL CODE&gt;

43100

## &lt;APPLICANT ENTITY INFORMATION&gt;

&lt;CORPORATION: STATE/COUNTRY OF INCORPORATION&gt; Italy

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

&lt;MARK&gt; BARILLA - AMERICA'S FAVORITE PASTA

&lt;TYPED FORM&gt; Yes

\* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). \*

## &lt;BASIS FOR FILING AND GOODS/SERVICES INFORMATION&gt;

&lt;INTENT TO USE: SECTION 1(b)&gt; Yes

\* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) \*

&lt;INTERNATIONAL CLASS NUMBER&gt; 030

<LISTING OF GOODS AND/OR SERVICES> PASTA, PASTA PRODUCTS,  
SAUCES FOR PASTA

## &lt;ATTORNEY INFORMATION&gt;

&lt;NAME&gt;

G. Franklin Rothwell, Esq.

&lt;STREET&gt;

1425 K Street, NW Suite 800

&lt;CITY&gt;

Washington

&lt;STATE&gt;

DC

&lt;COUNTRY&gt;

USA

&lt;ZIP/POSTAL CODE&gt;

20005

&lt;FIRM NAME&gt;

Rothwell, Figg, Ernst &amp; Manbeck, P.C.

<TELEPHONE NUMBER> 202-783-6040  
<FAX NUMBER> 202-783-6031  
<ATTORNEY DOCKET NUMBER> 2778-127  
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

**<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>**

\* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served \*

<NAME> G. Franklin Rothwell, Esq.  
<STREET> 1425 K Street, NW Suite 800  
<CITY> Washington  
<STATE> DC  
<ZIP CODE> 20005  
<FIRM NAME> Rothwell, Figg, Ernst & Manbeck, P.C.  
<TELEPHONE NUMBER> 202-783-6040  
<FAX NUMBER> 202-783-6031

**<FEE INFORMATION>**

<TOTAL FEES PAID> 325  
<NUMBER OF CLASSES PAID> 1  
<NUMBER OF CLASSES> 1

**<LAW OFFICE INFORMATION>**

<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

**<SIGNATURE AND OTHER INFORMATION>**

\* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. \*

<SIGNATURE> /Robert H. Cameron/  
<DATE> 06/18/2002

78136703

<NAME>  
<TITLE>

Robert H. Cameron  
Attorney for Applicant

<MAILING ADDRESS>

<LINE> G. Franklin Rothwell, Esq.  
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.  
<LINE> 1425 K Street, NW  
<LINE> Suite 800  
<LINE> Washington DC 20005

<RAM INFORMATION>

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<RAM ACCOUNTING DATE> 20020619

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<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:40:16 EDT  
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E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmannig@rothwellfigg.com

78136703

Internet Transmission Date:  
2002/06/18

Serial Number:  
78136703

Filing Date:  
2002/06/18



TRADEMARK APPLICATION

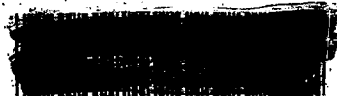
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 127  
RAM ACCOUNTING DATE: 20020619



NO OCR



06-18-2002

**Drawing Page**

**Serial Number:**

78136703

**Applicant:**

Barilla Alimentare S.p.A.  
Via Mantova 166  
Parma PR Italy 43100

**Goods and Services:**

PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

**Mark:**

BARILLA - AMERICA'S FAVORITE PASTA

NO OCR

06-18-2002

Trademark

REGISTERED

Serial Number

TRADEMARK

REGISTERED

PROSECUTION

Serial Number

TRADEMARK

PROSECUTION HISTORY

Entry

Date

Initial

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See map of the world on page 10

# **Exhibit 21**

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

AMERICAN ITALIAN PASTA  
COMPANY,

Opposer

V.

Opposition No. 91-161,373

BARILLA G. E R. FRATELLI - SOCIETA  
PER AZIONI,

Applicant.

## APPLICANT'S RESPONSE TO OPPOSER'S FIRST SET OF INTERROGATORIES

Applicant, Barilla G. E R. Fratelli-Societa Per Azioni (“Barilla”) by and through counsel,  
hereby responds pursuant to the Federal Rules of Civil Procedure to Opposer’s First Set of  
Interrogatories as follows:

## GENERAL OBJECTIONS

1. Barilla objects to all Interrogatories to the extent that they purport to impose on Applicant obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

2. Barilla objects to all Interrogatories to the extent that they seek the production of information and material protected by the attorney-client privilege and/or the attorney-work product doctrine, or any other privilege recognized by law. Barilla will not disclose such privileged information and material, and any inadvertent disclosure thereof shall not be deemed



a waiver of any privilege or work product exemption with respect to such information and material.

3. Barilla objects to all Interrogatories to the extent that they request information or material not currently in its possession, custody or control or refer to persons, entities, or events not known to Barilla, on the grounds that any such Interrogatories would seek to require more of Barilla than obligations imposed by law; would subject Barilla to unreasonable and undue annoyance, oppression, burden and expense; or would seek to impose upon Barilla an obligation to investigate, or to discover information or materials from third-parties or sources which may be equally accessible to Opposer.

4. Barilla objects to all Interrogatories to the extent that they are unduly burdensome in that they call for information or material which is unreasonably cumulative or duplicative of material or information provided or they require Applicant to incur unreasonable burden or expense in ascertaining information or providing documents.

5. Barilla objects to all Interrogatories to the extent that they call for material or information which is not relevant to the subject matter of the present lawsuit and/or appear not to be calculated to lead to the discovery of admissible evidence.

6. Barilla objects to the use of the phrase "all documents" in all Interrogatories to the extent that it renders such Interrogatories unduly burdensome in calling for material or information which is unreasonably cumulative or duplicative of material or information provided, or in requiring Barilla to incur unreasonable burden or expense in ascertaining information or providing documents.

7. Indications herein that responsive, non-privileged documents will be produced are made only to the extent that any such documents exist and can be located; and any such production will occur at a mutually agreed-to time and place.

8. The below responses are based on Barilla's present information, materials located and investigation and are subject to any additional or different information or material located that discovery or further investigation may disclose.

9. Barilla specifically reserves all of its objections, including those based on attorney-client privilege and attorney work product and confidentiality (unless and until a Protective Order is in place) with respect to requests for which documents do not exist, to the extent that documents come into existence or are located at a later date.

### **RESPONSES**

Subject to, and without waiver of the foregoing general objections, Barilla responds to the Interrogatories as follows:

#### **INTERROGATORY NO. 1:**

Identify each person having knowledge with regard to Applicant's intention to use Applicant's Mark for each of Applicant's Goods.

#### **RESPONSE TO INTERROGATORY NO. 1:**

Kirk Trofholz, President and General Manger  
Sergio Pereira, Vice President of Marketing  
Barilla USA

#### **INTERROGATORY NO. 2:**

Describe the circumstances surrounding Applicant's creation, selection, adoption and use of Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 2:**

Barilla objects to "circumstances surrounding...use" as vague and ambiguous. Barilla further objects to this Interrogatory to the extent that it calls for information protected from disclosure by the attorney-client privilege and/or the attorney work product doctrine. Subject to the foregoing objections, the mark was selected by then President and General Manager, Paul Davis for use in packaging/advertising to notify consumers that contrary to Mueller's false claim, Barilla was the leading brand of pasta in terms of market share in the United States. Applicant's Mark has not been used in commerce.

**INTERROGATORY NO. 3:**

Identify and describe each pasta item, pasta products item, and/or pasta sauce item ever sold by Applicant or on its behalf under Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 3:**

Subject to the general objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 4:**

With regard to each of the pasta items, pasta products item, and/or pasta sauce item identified in response to Interrogatory No. 3, provide the date upon which Applicant's Mark was first used in the United States in connection with the sale of such item.

**RESPONSE TO INTERROGATORY NO. 4:**

Subject to the general objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 5:**

Identify all packaging or advertising materials which show Applicant's use of Applicant's Mark from the first use to the present, and specify the periods during which each identified item was used.

**RESPONSE TO INTERROGATORY NO. 5:**

Subject to the general objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 6:**

Identify each use of any mark or term including the words "America's Favorite" by Applicant in connection with the items identified in response to Interrogatory No. 3, and the date that such use was first exposed to a third party, whether or not such exposure constitutes a date of first use of the mark in commerce.

**RESPONSE TO INTERROGATORY NO. 6:**

Subject to the general objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 7:**

Identify all third parties who have any responsibilities connected with the advertising or promotion of Applicant's Goods under Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 7:**

Subject to the general objections, none.

**INTERROGATORY NO. 8:**

Identify each presentation to any customer or potential customer at which Applicant has promoted Applicant's Goods which it has or intends to sell under Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 8:**

Barilla objects to "presentation" as vague and ambiguous. Barilla further objects to this Interrogatory on grounds that it is entirely irrelevant to the subject matter of this Board proceeding and does not appear to be calculated to lead to the discovery of any admissible evidence. Subject to the foregoing objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 9:**

Identify the channels of trade through which each item of Applicant's Goods are or will be sold under Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 9:**

Subject to the general objections, retail channels, "big box" retailers such as Walmart, Costco, military commissaries.

**INTERROGATORY NO. 10:**

Identify each instance wherein Applicant received knowledge of use of Opposer's Mark by Opposer, Best Foods and/or Unilever in connection with any packaging, advertising or promotion bearing Opposer's Mark.

**RESPONSE TO INTERROGATORY NO. 10:**

Barilla objects to this Interrogatory to the extent that it calls for information protected from disclosure by the attorney-client privilege and/or the attorney work product doctrine. Subject to the foregoing objections, Barilla first became aware of Opposer's claim of trademark use of AMERICA'S FAVORITE PASTA when it was served with notice of the instant opposition.

**INTERROGATORY NO. 11:**

Identify all uses of the mark BARILLA by Applicant on any of Applicant's Goods or advertising for Applicant's Goods in the United States, setting forth the dates of each such use.

**RESPONSE TO INTERROGATORY NO. 11:**

Barilla objects to this Interrogatory on grounds that it requires Barilla to specify information concerning those of its numerous BARILLA marks that are not involved in this proceeding. *See* TBMP Sec. 414(11). Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 12:**

Set forth in detail the circumstances under which Applicant first offered each of Applicant's Goods in commerce in the United States under the mark BARILLA.

**RESPONSE TO INTERROGATORY NO. 12:**

Barilla objects to this Interrogatory on grounds that it requires Barilla to specify information concerning those of its numerous BARILLA marks that are not involved in this proceeding. *See* TBMP Sec. 414(11). Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 13:**

Identify each pasta item, pasta product item, and each pasta sauce item ever sold or distributed in the United States under Applicant's mark BARILLA by or on behalf of Applicant.

**RESPONSE TO INTERROGATORY NO. 13:**

Barilla objects to this Interrogatory on grounds that it requires Barilla to specify information concerning those of its numerous BARILLA marks that are not involved in this proceeding. *See* TBMP Sec. 414(11). Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 14:**

If any item set forth in Interrogatory No. 14 has been discontinued for sale or on behalf of Applicant, set forth the dates of such discontinuance for each item.

**RESPONSE TO INTERROGATORY NO. 14:**

Barilla is unable to respond to this Interrogatory because it is unintelligible.

**INTERROGATORY NO. 15:**

Does Applicant contest Opposer's right to use the mark AMERICA'S FAVORITE PASTA in connection with Applicant's goods? If so, state all facts supporting such contest.

**RESPONSE TO INTERROGATORY NO. 15:**

Barilla objects to this Interrogatory on grounds that Opposer's right to use or register the mark AMERICA'S FAVORITE PASTA is not involved in this proceeding. Such a request purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 16:**

Does Applicant consent to Opposer's application to register the mark AMERICA'S FAVORITE PASTA as set forth in Application No. 76/497,489? If not, state all facts supporting

any basis on which Applicant contests Opposer's right to registration of the mark set forth in Application No. 76/497,489.

**RESPONSE TO INTERROGATORY NO. 16:**

Subject to the general objections, Barilla does not consent to Opposer's application.

Under Board precedent, the mark AMERICA'S FAVORITE PASTA is laudatory and so highly descriptive that it is incapable of serving as a source identifier.

**INTERROGATORY NO. 17:**

Identify each person, organization, or agency responsible for advertising or promoting each pasta item identified in response to Interrogatory No. 3.

**RESPONSE TO INTERROGATORY NO. 17:**

Barilla objects to this Interrogatory to the extent it is unreasonably cumulative and/or duplicative of other discovery requests made by Opposer and would require Barilla to incur unreasonable burden or expense in responding thereto. Subject to the foregoing objection, *See* Response to Interrogatory No. 7.

**INTERROGATORY NO. 18:**

Identify each person, organization, or agency responsible for advertising or promotion each pasta item identified in response to Interrogatory No. 13.

**RESPONSE TO INTERROGATORY NO. 18:**

*See* Response to Interrogatory No. 13.

**INTERROGATORY NO. 19:**

Identify each location where each pasta item, pasta product item, and pasta sauce item of Applicant sold under the mark BARILLA in the United States has been manufactured, since the date of first use to the present.



**RESPONSE TO INTERROGATORY NO. 19:**

Barilla objects to this Interrogatory on grounds that it requires Barilla to specify information concerning those of its numerous BARILLA marks that are not involved in this proceeding. *See* TBMP Sec. 414(11). Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 20:**

Identify all facts supporting Applicant's use of the phrase "America's Favorite Pasta" on or in connection with Applicant's Goods.

**RESPONSE TO INTERROGATORY NO. 20:**

Subject to the general objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 21:**

Identify all uses of the phrase "America's Favorite Pasta" on or in connection with the advertising or promotion of Applicant's Goods.

**RESPONSE TO INTERROGATORY NO. 21:**

Barilla objects to "uses" as vague and ambiguous. Barilla further objects to this Interrogatory to the extent it is unreasonably cumulative and/or duplicative of other discovery requests made by Opposer and would require Barilla to incur unreasonable burden or expense in responding thereto. Subject to the foregoing objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 22:**

Give the dollar sales by month, quarter, and year for all pasta items, pasta product items, and pasta sauce items sold by or on behalf of Applicant bearing the mark BARILLA in the United States since the date of first use to the present.

**RESPONSE TO INTERROGATORY NO. 22:**

Barilla objects to this Interrogatory as calling for trade secret or other confidential research, development or commercial information and no protective order is yet in place. Barilla further objects to providing sales by month, quarter and year as overly broad and unduly burdensome such that it potentially seeks information that is neither relevant nor likely to lead to the discovery of admissible evidence. Barilla also objects to this Interrogatory on grounds that it requires Barilla to specify information concerning those of its numerous BARILLA marks that are not involved in this proceeding. *See* TBMP Sec. 414(11). Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO.23:**

NO INTERROGATORY

**INTERROGATORY NO. 24:**

If Applicant claims the benefit of any use of Applicant's Mark or any variation thereof by any predecessor in title, identify the predecessor in title, and describe in detail the nature and extent of the predecessor's use of the mark.

**RESPONSE TO INTERROGATORY NO. 24:**

Subject to the general objections, not applicable. Applicant's mark has not been used in U.S. commerce.

**INTERROGATORY NO. 25:**

Identify and describe all consumer studies that Applicant has conducted or caused to be conducted regarding the words "America's Favorite Pasta" used alone or in connection with any other word or words.

**RESPONSE TO INTERROGATORY NO. 25:**

Barilla objects to this Interrogatory as calling for trade secret or other confidential research, development or commercial information and no protective order is yet in place. Subject to the foregoing objection, no consumer studies have been conducted or caused to be conducted.

**INTERROGATORY NO. 26:**

Identify and describe all consumer studies that Applicant has conducted or caused to be conducted regarding the word "Barilla" used alone or in connection with any other word or words.

**RESPONSE TO INTERROGATORY NO. 26:**

Barilla objects to this Interrogatory as calling for trade secret or other confidential research, development or commercial information and no protective order is yet in place. Barilla further objects to this Interrogatory on grounds that it requires Barilla to specify information concerning those of its numerous BARILLA marks that are not involved in this proceeding. *See* TBMP Sec. 414(11). Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 27:**

Identify and describe Applicant's knowledge of any use by Opposer or any other person or entity of "America's Favorite" alone or in combination with any other term, in connection with food items.

**RESPONSE TO INTERROGATORY NO. 27:**

Barilla objects to this Interrogatory to the extent that it purports to impose upon it an obligation to investigate and discover information and materials from third parties or sources equally accessible to Opposer. Barilla further objects to this Interrogatory to the extent that it calls for information protected from disclosure by the attorney-client privilege and/or the attorney work product doctrine. Subject to the foregoing objections, Barilla was generally aware since 1997 of Mueller's use of the phrase "America's Favorite Pasta" on packaging on Mueller's pasta products and freestanding inserts.

**INTERROGATORY NO. 28:**

Describe any criteria promulgated by any person regarding standards for the use of the term "favorite" in connection with the advertising, promotion, or sales of goods or services, and identify the person promulgating such criteria.

**RESPONSE TO INTERROGATORY NO. 28:**

Barilla objects to this Interrogatory on grounds that it purports to impose upon it an obligation to investigate and discover information and materials from third parties or sources equally accessible to Opposer. Subject to the foregoing objection, statistics on national sales of branded products by A.C. Nielsen.

**INTERROGATORY NO. 29:**

State with particularity what Applicant contends is the meaning of the terms: (i) America's, (ii) Favorite, and (iii) Pasta.

**RESPONSE TO INTERROGATORY NO. 29:**

Subject to the general objections, Barilla responds as follows: (i) of the United States; (ii) leading brand by sales; (iii) products sold in the retail pasta category.

**INTERROGATORY NO. 30:**

State with particularity all facts supporting the statement set forth in the opposed application number 78/136,703 that "Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services."

**RESPONSE TO INTERROGATORY NO. 30:**

Barilla objects to this Interrogatory to the extent that it calls for information protected from disclosure by the attorney-client privilege and/or the attorney work product doctrine. Subject to the foregoing objection, Barilla plans to use BARILLA - AMERICA'S FAVORITE PASTA in packaging, collateral and sales materials.

**INTERROGATORY NO. 31:**

Describe in detail all agreements into which Applicant has entered concerning the sale of goods in connection with Applicant's Mark or the mark BARILLA, including but not limited to, all licensing agreements.

**RESPONSE TO INTERROGATORY NO. 31:**

Barilla objects to this Interrogatory as calling for trade secret or other confidential research, development or commercial information and no protective order is yet in place.

Barilla further objects to this Interrogatory to the extent that it requires Barilla to specify information concerning those of its numerous BARILLA marks that are not involved in this proceeding. *See* TBMP Sec. 414(11). Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 32:**

Describe in detail every search or investigation conducted by or on behalf of Applicant in connection with Applicant's Mark, including any search of the records of the U.S. Patent and Trademark Office or of any other records or publications.

**RESPONSE TO INTERROGATORY NO. 32:**

Barilla objects to this Interrogatory to the extent that it calls for information protected from disclosure by the attorney-client privilege and/or the attorney work product doctrine. Subject to the foregoing objection, Barilla is not aware of any search or investigation conducted by or on its behalf.

**INTERROGATORY NO. 33:**

With the exception of this opposition proceeding, state whether Applicant is now or ever has been a party to any civil action or administrative proceeding in the United States involving the ownership of and/or right to use or register Applicant's Mark or any other mark having the terms "America's Favorite" as a part thereof, and, if so, identify the parties to the proceeding and for each such proceeding, the persons now employed by Applicant most familiar with such proceeding.

**RESPONSE TO INTERROGATORY NO. 33:**

Subject to the general objections, none.

**INTERROGATORY NO. 34:**

If Applicant intends to call any individual to provide expert testimony under the provisions of the Federal Rules of Evidence 702, 703 or 705, provide a disclosure of such testimony as set forth in Fed.R.Civ.P. 26(a)(2).

**RESPONSE TO INTERROGATORY NO. 34:**

Barilla objects to this Interrogatory on grounds that it requires Barilla to specify all the witnesses and evidence it intends to present in support of its case. Such a requirement purports to impose on Barilla obligations not required by the Federal Rules of Civil Procedure or those of the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 35:**

State in detail the dates and circumstances known to Applicant of any instance of actual or possible confusion or any reports of such confusion, of which Applicant is aware, between Applicant's Mark and Opposer's Mark.

**RESPONSE TO INTERROGATORY NO. 35:**

Subject to the general objections, Barilla is not aware of any actual or possible confusion or reports of such confusion in the marketplace. Applicant's Mark is not in use in commerce.

**INTERROGATORY NO. 36:**

State whether Applicant has ever received any opinion of counsel with respect to any alleged rights which Applicant may have obtained in and to Applicant's Mark as compared to the rights of Opposer or other parties in marks having the term "America's Favorite" as a part thereof and if so, identify all opinions of counsel and identify the person (s) in receipt of such opinions.

**RESPONSE TO INTERROGATORY NO. 36:**

Barilla objects to this Interrogatory to the extent that it calls for information protected from disclosure by the attorney-client privilege and/or the attorney work product doctrine.

Subject to the foregoing objection, Applicant received an opinion of counsel from attorneys at Perani Mezzanotte & Partners.

**INTERROGATORY NO. 37:**

Identify each and every person who supplied information utilized in the preparation of the answers to these Interrogatories and indicate the specific Interrogatories to which each person contributed all or part of the information comprising the answer.

**RESPONSE TO INTERROGATORY NO. 37:**

Subject to the general objections, Sergio Pereira, Vice President of Marketing; Kim Stevens, Business Director, Barilla U.S.A; U.S. and European counsel for Applicant.

Dated: January 28, 2005 As to Objections:

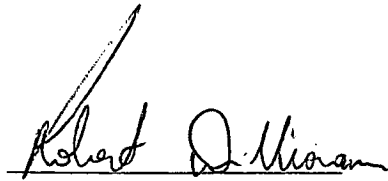
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**CERTIFICATE OF SERVICE**

I hereby certify that on the 28<sup>th</sup> day of January, 2005, I served the foregoing  
APPLICANT'S RESPONSE TO OPPOSER'S FIRST SET OF INTERROGATORIES by first  
class mail, to the following:

Thomas H. Van Hoozer, Esq.  
Hovey Williams LLP  
2405 Grand Blvd., Suite 400  
Kansas City, MO 64108

A handwritten signature in black ink, appearing to read "Robert DiGiovanni", is written over a horizontal line.

Robert DiGiovanni