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Filing date: **11/19/2014**

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

Proceeding	91218280
Party	Defendant Dabes, Ibrahim
Correspondence Address	PAUL D. BIANCO FLEIT GIBBONS GUTMAN BONGINI & BIANCO PL 21355 E DIXIE HWY STE 115 MIAMI, FL 33180-1244 tmmiami@fggbb.com
Submission	Answer
Filer's Name	Paul D. Bianco
Filer's e-mail	tmmiami@fggbb.com
Signature	/Paul D. Bianco/
Date	11/19/2014
Attachments	answer-410Opp.pdf(145834 bytes) exhibit a - office action.pdf(569596 bytes)

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

In re Application No. 86/025,182
For the Mark: AMY GOLD TOBACCO MOLASSES (design)
Published in the *Official Gazette* on May 13, 2014

Mya Saray, LLC,)	
)	
Opposer,)	Opposition No.: 91218280
)	
v.)	
)	
Dabes, Ibrahim DBA)	
Dabes Egyptian Imports,)	
)	
Applicant.)	

ANSWER TO NOTICE OF OPPOSITION

Pursuant to 37 C.F.R. § 2.106, Applicant, Ibrahim Dabes, a citizen of the Federal Republic of Germany, having an address at Neuburger Str. 109, Augsburg 86167, Germany (“Applicant”), by and through its undersigned counsel hereby answers the Notice of Opposition of U.S. Application Serial No. 86/025,182 (“Notice”) filed by Mya Saray, LLC (“Opposer”) as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 1 of the Notice and therefore denies each and every allegation set forth therein.
2. Applicant denies the allegations set forth in Paragraph 2 of the Notice.
3. Applicant admits the allegations set forth in Paragraph 3 of the Notice.
4. Applicant admits that Opposer is indicated in the U.S. Patent and Trademark Office database as the owner of record for US Registration Nos. 3031439, 3031440, 3684311,

3840577 and 3845276, but Applicant denies each and every allegation set forth in Paragraph 4 of the Notice for lack of information of Opposer's ownership thereof with respect to any or all of the goods specified therein.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 5 of the Notice and therefore denies each and every allegation set forth therein.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 6 of the Notice and therefore denies each and every allegation set forth therein.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 7 of the Notice and therefore denies each and every allegation set forth therein.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 8 of the Notice and therefore denies each and every allegation set forth therein.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 9 of the Notice and therefore denies each and every allegation set forth therein.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 10 of the Notice and therefore denies each and every allegation set forth therein.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 11 of the Notice and therefore denies each

and every allegation set forth therein.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 12 of the Notice and therefore denies each and every allegation set forth therein.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 13 of the Notice and therefore denies each and every allegation set forth therein.

14. Applicant denies the allegations set forth in Paragraph 14 of the Notice.

15. Applicant denies the allegations set forth in Paragraph 15 of the Notice.

16. Applicant denies the allegations set forth in Paragraph 16 of the Notice.

17. Applicant denies the allegations set forth in Paragraph 17 of the Notice.

18. Applicant denies the allegations set forth in Paragraph 18 of the Notice.

19. Applicant hereby denies any and all other allegations of the Notice that have not been affirmatively admitted herein.

AFFIRMATIVE DEFENSES

1. Opposer has not pleaded any law or facts that justify a refusal to register Applicant's mark, and consequently, Opposer has failed to state a claim upon which relief can be granted.

2. Applicant's mark AMY GOLD TOBACCO MOLASSES (design), is not likely to cause confusion, to cause mistake or deception with the marks allegedly owned by Opposer.

Trademark Examining Attorney assigned to the subject application concluded on November 21, 2013 that there were no registered or pending marks, including those allegedly owned by Opposer, that would bar registration of Applicant's mark. See Exhibit A. Simply because the respective marks have three letters in common does not mean that confusion, mistake or

deception as to the source of the products is likely. The rearrangement of these letters creates a term that is distinctly different in appearance, sound and commercial impression from that of Opposer's marks. Furthermore, Applicant's mark includes the additional terms "GOLD TOBACCO MOLASSES" and the respective design elements that further preclude any likelihood of confusion, mistake or deception.

3. Opposer will not be damaged by the registration of Applicant's mark.

4. Opposer's claims are barred, in whole or in part, by the equitable defenses of estoppel, laches and acquiescence.

5. Applicant reserves the right to rely on other and further defenses as may be supported by facts to be determined through full and complete discovery and to amend its Answer to assert such defenses.

WHEREFORE, Applicant respectfully requests that this Opposition be denied and/or dismissed with prejudice, that the registration of Applicant's mark, as applied for in application Serial Nos. 86/025,182, be issued, and that Applicant be granted such other and further relief as the Board deems just and proper.

Date: November 19, 2014

Respectfully submitted,

/Paul D. Bianco/
Paul D. Bianco

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Attorneys for Applicant
Dabes, Ibrahim

CERTIFICATE OF SERVICE

It is hereby certified that a copy of this ANSWER TO NOTICE OF OPPOSITION was served by First Class Mail to M. Keith Blankenship, Esq., Da Vinci's Notebook, LLC, 10302 Bristow Center Dr. #52, Bristow, VA 20136, Attorney for Opposer, on this 19th day of November 2014.

/Paul D. Bianco/
Paul D. Bianco

FLEIT GIBBONS GUTMAN
BONGINI & BIANCO PL

To: Dabes, Ibrahim (tmmiami@fggbb.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86025182 - AMY GOLD TOBACCO MOLASSES - 7400-T13-410
Sent: 11/21/2013 3:57:14 PM
Sent As: ECOM104@USPTO.GOV
Attachments: [Attachment - 1](#)

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

U.S. APPLICATION SERIAL NO. 86025182

MARK: AMY GOLD TOBACCO MOLASSES

86025182

CORRESPONDENT ADDRESS:

PAUL D. BIANCO
FLEIT GIBBONS GUTMAN BONGINI & BIANCO

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http://www.uspto.gov/trademarks/teas/response_forms.jsp

PL

21355 E DIXIE HWY STE 115
MIAMI, FL 33180-1244

APPLICANT: Dabes, Ibrahim

CORRESPONDENT'S REFERENCE/DOCKET NO :

7400-T13-410

CORRESPONDENT E-MAIL ADDRESS:

tmmiami@fggbb.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

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

ISSUE/MAILING DATE: 11/21/2013

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

NO LIKELIHOOD OF CONFUSION FOUND

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

TRANSLATION OF FOREIGN REGISTRATION REQUIRED

The applicant must submit an English translation of the foreign registration. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01(a)-(b). The translation should be signed by the translator. TMEP §1004.01(b).

PLEASE NOTE – Until a translation is provided, the examining attorney is unable to determine if the foreign registration contains a color claim. Since the foreign registration copy is not in color, it is impossible to tell. Accordingly, the examining attorney must presume that the mark in the foreign registration is in black and white. Thus, the following requirement is raised:

MARK DIFFERS ON FOREIGN REGISTRATION – MARK NOT IN COLOR

The drawing of the mark in the U.S. application is not acceptable because it does not correspond to the mark shown in the foreign registration. *See* 15 U.S.C. §1126(e); 37 C.F.R. §2.51(c). Specifically, the drawing in the U.S. application displays the mark in color and includes a color claim, but the foreign registration does not show the mark in color or otherwise indicate that particular colors are claimed as a feature of the mark.

The drawing of a mark in a U.S. application must be a substantially exact representation of the mark that appears in the foreign registration. 37 C.F.R. §2.51(c); *In re Hacot-Colombier*, 105 F.3d 616, 618-19, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997); TMEP §§807.07(b), 1011.01; *see United Rum Merchs. Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481 (TTAB 1988). If the foreign registration includes a color claim, the U.S. application must include the same color claim; if the foreign registration does not include a color claim, the U.S. application may not contain a color claim. *See* TMEP §§807.07(d)(ii), 1011.01.

Therefore, applicant must clarify whether the foreign registration includes the same color claim set forth in the U.S. application by satisfying one of the following:

- (1) If the foreign registration does not include a color claim or its legal equivalent, applicant must submit: (a) a new black-and-white drawing of the mark for the U.S. application that conforms to the mark shown in the foreign registration and which does not otherwise materially alter the mark in the U.S. application (amending the drawing of the mark in the U.S. application to agree with the mark in the foreign registration would not be considered a material alteration of the mark in this case); (b) a statement that color is not claimed as a feature of the mark in the U.S. application and deleting any color claim; and (c) an amended mark description that accurately describes all literal and design elements of the applied-for mark but does not reference color. *See* 37 C.F.R. §§2.37, 2.52(b)(1), 2.72(c); TMEP §§807.07(a)(i)-(b), 807.12(b), 1011.01.; or
- (2) If the foreign registration includes a color claim or the legal equivalent, applicant must provide a statement to that effect, specifying the colors claimed and describing where they appear in the mark in the foreign registration. *See* TMEP §§807.07(b), 1011.01. Applicant must also submit a color photocopy of the foreign registration. TMEP §1011.01. If the foreign registration is not issued in color, applicant must provide evidence establishing that (a) the colors shown in the mark in the U.S. drawing are the same colors claimed in the foreign registration, and (b) the colors appear in the same locations within the mark in the U.S. drawing and foreign registration. *See* TMEP §§807.12(b), 1011.01. Such evidence may include a written statement from the intellectual

property office of the foreign country that indicates the colors claimed and their location in the mark in the foreign registration. The color claims and mark descriptions in both the U.S. application and foreign registration must agree. *See* TMEP §§807.07(d)(ii), 1011.01.

If applicant cannot satisfy the above requirements, and the application currently also contains a Trademark Act Section 1 filing basis, applicant may respond by deleting the Section 44 basis from the application and proceeding solely on the Section 1 basis. *See* 15 U.S.C. §§1051(a)-(b), 1126(d)-(e); 37 C.F.R. §2.35(b)(1); TMEP §806.04. A foreign registration certificate is not required for a Section 1(a) or 1(b) basis. *See* 15 U.S.C. §1051(a)-(b); TMEP §806.01(a)-(b). If the application is currently based solely on Section 44, applicant may amend the basis from Section 44 to Section 1(a) or 1(b), if applicant can satisfy the requirements for the chosen basis. *See* 15 U.S.C. §§1051(a)-(b), 1126(e); 37 C.F.R. §2.35(b)(1); TMEP §806.03.

IDENTIFICATION OF GOODS

The identification of goods includes “smoking articles,” which is the heading of International Class 34. The purpose of such class headings is to indicate the subject matter and general scope of each international class of goods. *See* TMEP §1401.02(a). While such broad designations may be acceptable under the trademark laws and practice of other countries, the USPTO considers these headings too broad to identify goods in a U.S. application. *See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1297-99 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); TMEP §§1401.08, 1402.01 *et seq.*, 1402.07(a).

An identification of goods in a U.S. application must be specific, definite, clear, accurate, and concise. TMEP §1402.01; *see In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d at 1298-99. Identifications may be amended only to clarify or limit the goods and/or services, adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.* The scope of the identification for purposes of permissible amendments to class headings is limited by both the ordinary meaning of the words in and the international class of the heading. *See* TMEP §§1402.06(a), (b), 1402.07(a).

Therefore, applicant must amend the class heading to identify goods that fall within (1) the ordinary meaning of the words specified in the class heading, and (2) the international classification of the heading. *See* TMEP §§1402.06(a), (b), 1402.07(a).

Applicant may adopt the following identification of goods, if accurate:

International Class 34 – “Tobacco; smoking articles, namely, {please indicate the type of goods, e.g. cigarettes, cigars, smoking pipes, etc.}”

For assistance with identifying and classifying goods in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahhtml/tidm.html>. *See* TMEP §1402.04.

DISCLAIMER

Applicant must disclaim the descriptive wording “TOBACCO” and “MOLASSES” apart from the mark as shown because it merely describes an ingredient and feature of applicant’s goods. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103

USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); TMEP §§1213, 1213.03(a).

Specifically, applicant's own identification of goods describes the goods as “*tobacco*,” making the term highly descriptive or generic for applicant's goods. (Emphasis added.)

Similarly, the term “MOLASSES” means “a thick syrup produced during the refining of sugar or from sorghum, varying from light to dark brown in color.” See attached dictionary evidence. Because applicant's goods contain a thick sweet syrup, the term “MOLASSES” is merely descriptive of an ingredient of applicant's goods.

A “disclaimer” is a statement in the application record that applicant does not claim exclusive rights to an unregistrable component of a mark; a disclaimer of unregistrable matter does not affect the appearance of the mark or physically remove disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive or generic of an applicant's goods. 15 U.S.C. §1052(e); see TMEP §§1209.03(f), 1213.03 *et seq.* Such words need to be freely available for other businesses to market comparable goods or services and should not become the proprietary domain of any one party. See *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use “TOBACCO” and “MOLASSES” apart from the mark as shown.

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

/Jason Paul Blair/
Examining Attorney
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please

wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

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

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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mo-las-ses [muh-las-iz] [Show IPA](#)

noun

a thick syrup produced during the refining of sugar or from sorghum, varying from light to dark brown in color.

Origin:

1575-85; earlier *molassos*, *molasso* (*e*) *s* < Portuguese *melaços*, plural of *melaço* (< Late Latin *mellācium* half-boiled new wine, for **mellāceum*, neuter of **mellāceus* honeylike, equivalent to *mell-*, stem of *mel* honey + *-āceus* *-aceous*)

Dictionary.com Unabridged
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World English Dictionary

Collins

Matching Quote

"Mechanic,
you're trying to make **molasses**
but you're not using the machine
the way I want you to.
Idiot,
don't you know
that you can't get **molasses**
without juice?"

-Hla Stavhana

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Accent
 [Color swatches: yellow, orange, red, purple, blue, black]

To: Dabes, Ibrahim (tmmiami@fggbb.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86025182 - AMY GOLD TOBACCO MOLASSES - 7400-T13-410
Sent: 11/21/2013 3:57:15 PM
Sent As: ECOM104@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **11/21/2013** FOR U.S. APPLICATION SERIAL NO. 86025182

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **11/21/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.