

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE**

IN THE MATTER OF:

Serial No. 86860062
Trademark: Yummies
Applicant: Advanced Total Marketing
Systems, Inc.
Office Action of: January 28, 2016

July 11, 2016

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ANSWER TO FIRST OFFICE ACTION

The following is Applicant Advanced Total Marketing Systems, Inc. (“Applicant” or “ATM”)’s response to the Office Action sent via email on January 28, 2016 by Examining Attorney Samuel R. Paquin (the “Examiner”) whereby registration of Applicant’s mark “YUMMIES” with Serial No. 86860062, for “snacks and/or snacks using fried corn tortilla with different flavors, fried plantain slices with different flavors, fried yucca chips with different flavors, fried pork with salt and chili, extruded corn with different flavors, popcorn of different flavors, potato flakes of different flavors” under Class 29, (the “Mark” or the “Application”) was refused on the basis of purported likelihood of confusion with one prior registration and one pre-filed application, while requesting a disclaimer and clarification of the goods and services covered by the subject application (the “Refusal”).

Applicant has considered the Refusal and upon the incorporation of the amendments set forth herein, Applicant requests that the Examiner reconsider the statutory refusal and allow registration of the Mark.

APPLICANT'S SUBSTANTIVE RESPONSES TO THE EXAMINER'S REMARKS

**I. RESPONSE TO SECTION ENTITLED "SECTION 2(D) REFUSAL-
LIKELIHOOD OF CONFUSION"**

The Examiner has refused registration of the Mark pursuant to Section 2(d) of the Lanham Act, 15 USC § 1052(d), on the grounds of a purported likelihood of confusion with the mark in U.S. Registration No. 1458548, "YUMMIES" for "roasted nuts and dried fruits for consumption on and off the premises", under Class 29 (the "Reference Mark No. 1") and under Class 30 for "candy [and baked goods, namely, cookies and crackers] for consumption on and off the premises", and with prior-filed Application Serial No. 86791053, "SUPER YUMMYS", which was subsequently allowed for registration under the Supplemental Register with No. 4957659 on May 10, 2016 under Class 29 for "Vegetable-based snack foods; Fruit-based snack foods; Vegetable chips; Fruit chips; Milk products excluding ice cream, ice milk and frozen yogurt" (the "Reference Mark No. 2").

As discussed during the telephone conference held between the undersigned attorneys and the Examiner on July 26, 2016 (the "Communication"), Applicant is the owner of Registered Trademark "YUMMIES CRUNCH", with Registration No. 4975767 for "Baking-powder; Cheese flavored snacks, namely, cheese curls; Coffee; Coffee substitutes; Flour; Honey; Ice creams; Molasses syrup; Mustard; Rice; Sago; Salt; Sugar; Tapioca; Tea; Tortilla chips; Vinegar; Yeast", under Class 30 ("Applicant's Registered Trademark"). During the Communication, the parties agreed that Applicant's Registered Trademark suffices to overcome the Examiner's Section 2(d) initial objection, contingent to the incorporation of the Examiner's remaining objections in the Refusal.

In adherence to the Communication, Applicant hereby amends the Application and addresses Examiner's objections as follows:

II. RESPONSE TO SECTION ENTITLED "DESCRIPTION AND COLOR CLAIM"

Applicant has considered Examiner's remarks and adopts Examiner's proposed disclaimer to read as follows:

Color claim:

The colors red, white, blue and light blue are claimed as a feature of the mark.

Mark description:

The mark consists of the white word "YUMMIES" with a red circle over the letter "I" in a curved blue banner with a red and white border at the top and red, white and light blue borders at the bottom all to the right of a white winking smiley face outlined in blue and light blue with a red and white tongue wearing a white crown outlined in blue and light blue.

III. RESPONSE TO SECTION ENTITLED "IDENTIFICATION OF GOODS"

Applicant has considered Examiner's remarks and adopts Examiner's proposed wording for the identification of goods and/or services as follows:

Class 29

"Snacks, **namely**, fried plantain slices with different flavors, fried yucca chips with different flavors, fried pork with salt and chili, potato flakes of different flavors."

Class 30

"Peanuts, flavored peanuts, roasted peanuts, and mixed seeds, excluding nuts and roasted nuts; fried corn-based tortilla snack foods with different flavors; corn-based snack foods, namely, extruded corn with different flavors; popcorn of different flavors."

IV. MULTIPLE-CLASS APPLICATION REQUIREMENTS

Since the application identifies goods and/or services in more than one international class, Applicant hereby adopts and incorporates the Examiner's recommendations to satisfy all the requirements below for each international class based on use in commerce under Section 1(a):

(1) List the goods and/or services by their international class number in consecutive numerical order, starting with the lowest numbered class.

Response to Item No. IV (1):

i. **Class 29:** Snacks, namely, fried plantain slices with different flavors, fried yucca chips with different flavors, fried pork with salt and chili, potato flakes of different flavors.

ii. **Class 30:** Peanuts, flavored peanuts, roasted peanuts, and mixed seeds, excluding nuts and roasted nuts; fried corn-based tortilla snack foods with different flavors; corn-based snack foods, namely, extruded corn with different flavors; popcorn of different flavors.

(2) Applicant shall submit a filing fee for each international class not covered by the fee(s) already paid.

Response to Item No. IV (2):

The Commissioner is authorized to charge to counsel's Deposit Account No. 505829, the corresponding filing fees for the additional international class incorporated hereto, and any other fees due.

(3) Applicant shall verify dates of first use of the mark anywhere and in commerce for each international class.

Response to Item No. IV (3):

First use of the mark anywhere and in commerce for Class 29 is: June 1, 2011.

First use of the mark anywhere and in commerce for Class 30 is: June 1, 2011.

(4) Applicant shall submit a specimen for each international class. The current specimen is acceptable for Class 29.

Response to Item No. IV (4):

As requested by the Examiner, included below is a specimen of the Mark, and a bag of corn chips representing YUMMIES, as used under International Class 30.



(5) Applicant shall submit a verified statement that “The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.”

Response to Item No. IV (5):

As requested by the Examiner, Applicant hereby states that: “The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.”

V. CONCLUSION

In light of the foregoing, we ask that upon your review, you withdraw the Refusal and grant Applicant’s application for the sole rights to the trademark “YUMMIES” for the goods and services sought.

The Applicant has responded to all issues raised in the Refusal. If any further information or response is required, please contact Applicant's attorneys.

Dated: July 27, 2016.

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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. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

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