

# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 76/634174

**APPLICANT:** American Wholesale Wine & Spirits, Inc.

**\*76634174\***

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**CORRESPONDENT'S REFERENCE/DOCKET NO:**  
105,008,940

Please provide in all correspondence:

**CORRESPONDENT EMAIL ADDRESS:**

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

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 76/634174

This letter responds to the applicant's communication filed on December 7, 2005. The applicant (1) clarified the "stippling" in the drawing, (2) provided a description of the mark, and (3) submitted a specimen showing how the applicant uses the mark. Nos. 1 and 2 are fully acceptable. The specimen is acceptable as to form, but the examiner notes the following.

### **Mark as Used on Specimen Not Inherently Distinctive**

The mark consists of a velvet textured covering for a wine bottle. Though the mark is quite striking, it is not inherently distinctive product packaging. In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529

U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000), the Supreme Court distinguished between two types of trade dress - product design and product packaging. If the trade dress falls within the category of product design, it can *never* be inherently distinctive.

Product design almost invariably serves purposes other than source identification, and consumers are aware that even the most unusual product design is intended not to identify the source, but to render the product itself more useful or appealing. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000). *See also Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019, 224 USPQ 625 (Fed. Cir. 1985); *In re Craigmyle*, 224 USPQ 791 (TTAB 1984); TMEP §1202.02(b)(i).

Unlike product design, product packaging may be inherently distinctive and registrable on the Principal Register without a showing of acquired distinctiveness. However, in close cases in which it is difficult to determine whether the trade dress at issue is product packaging or product design, “courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” *Wal-Mart*, 529 U.S. at 215, 54 USPQ2d at 1070.

*Note:* If the trade dress is functional, it cannot be registered despite acquired distinctiveness. *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001).

Other companies use velvet bags or sacks for packing their wine or liquor. See attachments “velvet1” and “velvet2”. Moreover, the covering of a wine bottle with a particular material is not unheard of; the applicant is likely familiar with the old bottles of Chianti wrapped in straw to protect the glass. For these reasons, the applicant’s mark is capable, but not inherently distinctive. As a result, the applicant may seek registration either under Section 2(f) with the appropriate evidence or amend to the Supplemental Register.

There are three basic types of evidence that may be used to establish acquired distinctiveness under §2(f):

- (1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (*See* 37 C.F.R. §2.41(b); TMEP §§1212.04 *et seq.*);
- (2) A statement verified by applicant that the mark has become distinctive of applicant’s goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (*See* 37 C.F.R. §2.41(b); TMEP §§1212.05 *et seq.*);
- (3) Actual evidence of acquired distinctiveness (*See* 37 C.F.R. §2.41(a); TMEP §§1212.06 *et seq.*).

Applicant may submit one or any combination of these types of evidence. Depending on the mark and the facts in the record, a claim of ownership of a prior registration(s) or a claim of five years’ substantially exclusive and continuous use in commerce may be insufficient to establish a *prima facie* case of acquired distinctiveness. Actual evidence of acquired distinctiveness may be submitted regardless of the length of time the mark has been used. *Ex parte Fox River Paper Corp.*, 99 USPQ 173

(Comm'r Pats. 1953).

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Karen Bracey/  
Examining Attorney  
Law Office 116  
571-272-9132

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
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## Crown Royal

### Wikipedia

### Crown Royal

**Crown Royal** is a blended [Canadian whisky](#), 40% alcohol ([ethanol](#)) by volume, 80 [proof](#). It has a very smooth, sweet, almost [sherry](#)-like flavor.

The tradition of Crown Royal began in [1939](#) with the first Royal Tour of Canada by reigning British monarchs, [King George VI](#) and [Queen Elizabeth](#). To mark this historic occasion, [Samuel Bronfman](#), President of the [Seagram Company](#), decided to create a quality whisky to be packaged in a crown-shaped bottle and dressed in a royal purple bag. Like the packaging, the name chosen for the product was intended to reflect the quality of the spirit, a marketing concept that quickly caught the consumer's attention.

[Gimli](#), [Manitoba](#), [Canada](#), is the sole location where Crown Royal is produced.

Crown Royal is also involved in [NASCAR](#) sponsorship, sponsoring the #97 [Ford](#) of [Kurt Busch](#).

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