

To: DAVID L. MAY(trademarkdocketing@nixonpeabody.com)
Subject: U.S. Trademark Application Serial No. 88985303 - CEDAR BAY GRILLING COMPANY LTD. - - 086479-6
Sent: September 11, 2024 03:56:52 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[screencapture-fultonfishmarket-com-products-cedar-planks-17260826724931](#)
[screencapture-fultonfishmarket-com-collections-salmon-17260828982691](#)
[screencapture-popsiefishco-com-products-5x11-alder-grilling-planks-17260829658821](#)
[screencapture-popsiefishco-com-collections-shop-wild-alaskan-seafood-sockeye-salmon-17260830103641](#)
[screencapture-wildbayseafoodco-com-products-alder-grilling-plank-17260830694721](#)
[screencapture-olympiaseafood-com-blogs-recipes-cedar-planked-marbled-king-salmon-with-herb-butter-17260831654961](#)
[ttabvue-86586432-EXA-8.pdf](#)
[screencapture-cedarbaygrilling-com-collections-usa-products-USA-17260839987551](#)
[screencapture-cedarbaygrilling-com-pages-product-tips-17260840209471](#)

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 88985303

Mark: CEDAR BAY GRILLING COMPANY LTD.

Correspondence Address:

DAVID L. MAY
NIXON PEABODY LLP
SUITE 500
799 9TH STREET NW
WASHINGTON DC 20001
UNITED STATES

Applicant: Cedar Bay Grilling Company Limited

Reference/Docket No. 086479-6

Correspondence Email Address: trademarkdocketing@nixonpeabody.com

REQUEST FOR RECONSIDERATION AFTER FINAL ACTION DENIED

Issue date: September 11, 2024

Applicant's request for reconsideration is denied. See 37 C.F.R. §2.63(b)(3). The trademark

examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Applicant presented the same specimen of use for both classes in its application, and has now divided out the Class 021 cedar planks which have been refused as the specimen supports only the Class 029 fish. While fish and cooking/grilling planks may be sold together as a kit, the Nice & Trademark Office's identification and classification practice requires identifying the primary component(s) of the kit and providing a specimen of use to support such primary component. By that logic, the fish shown in the one specimen doing "double duty" cannot be the primary component for both the Class 029 identification of goods and Class 021 identification of goods; nor can the plank be the primary component for both classes. "Planked salmon" is classified in Class 029 to give notice to consumers that the items are primarily fish, which also, secondarily, happen to be set atop a plank.

Industry usage shows that seafood/fish companies offer the cooking/grilling planks separately from their food items for a variety of practical reasons: the planks can be easily stored and transported without concern for the food spoiling and the planks may be sold in bulk to be used with a variety of foods from other, non-proprietary sources. The planks also do not have to be custom sized to fit the particular file of fish as a bundled kit when sold separately and can potentially be re-used if certain methods are employed. Lastly, the planks show the company's logo/name burned into the wood, as yet another indicator of specific and separate source. *See* the attached third party examples from www.fultonfishmarket.com, www.popsiefishco.com, www.wildbayseafood.com and www.olympiaseafood.com for evidence of industry practice in selling fish separate from the wood planks; this is what would be expected of applicant as well, particularly as it parsed its goods into two separate classes and has not limited its Class 021 goods to being used only with salmon.

This examining attorney confronted an analogous issue in a prior decision where a company presented a plastic beverage bottle bearing a mark and argued that the specimen supported the bottle caps parsed separately in Class 020 as opposed to the Class 032 beverages (which had been deleted from the application). The attached evidence (while not precedential) shows that the Trademark Trial and Appeal Board affirmed the specimen rejection as the mark appeared on the bottle but not the caps themselves, and the mark was not shown with caps sold separately as stand-alone goods. In short, the Board agreed in *In re Wholesale & Retail Distribution, Inc.* (June 4, 2018) that "consumers are purchasing Applicant's beverages, not the dispensing and dosing caps" and affirmed the refusal to register.

Similarly, here, consumers are purchasing applicant's fish items (*see* attached from www.cedarbaygrilling.com) primarily for the fish, not the plank; and although the packaging refers to cedar planks, and certainly there is no dispute that the packaging does contain a plank underneath the fish -- though not actually shown in the cellophane "see-through" portion of the packaging -- these items are found in the frozen seafood section of the grocery. Plain cedar planks would not be sold in a freezer section of a grocery as they are shelf-stable items which do not require refrigeration or freezing.

As discussed previously, the fact that prior examiners permitted similar specimens, or the same specimen for both classes of goods, is not persuasive. When determining whether an applied-for mark is eligible for registration, each application must be considered on its own record. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) ("[The Federal Circuit], like the

Board, must evaluate the evidence in the present record to determine whether there is sufficient evidence”); In re Shinnecock Smoke Shop, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Applicant’s allegations regarding similar marks are irrelevant because each application must be considered on its own merits.”); see also In re Nett Designs, Inc., 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the [Trademark Trial and Appeal] Board or this court.”).

Accordingly, the specimen requirement made final in the Office action dated May 6, 2024 is **maintained and continued**: See TMEP §§715.03(a)(ii)(B), 715.04(a).

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the response period for the final Office action, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) [file a notice of appeal](#) to the Board. TMEP §715.03(a)(ii)(B).

/Toby Bulloff/
Toby Bulloff
Trademark Examining Attorney
Law Office 119
(571) 270-1531
Toby.Bulloff@USPTO.GOV

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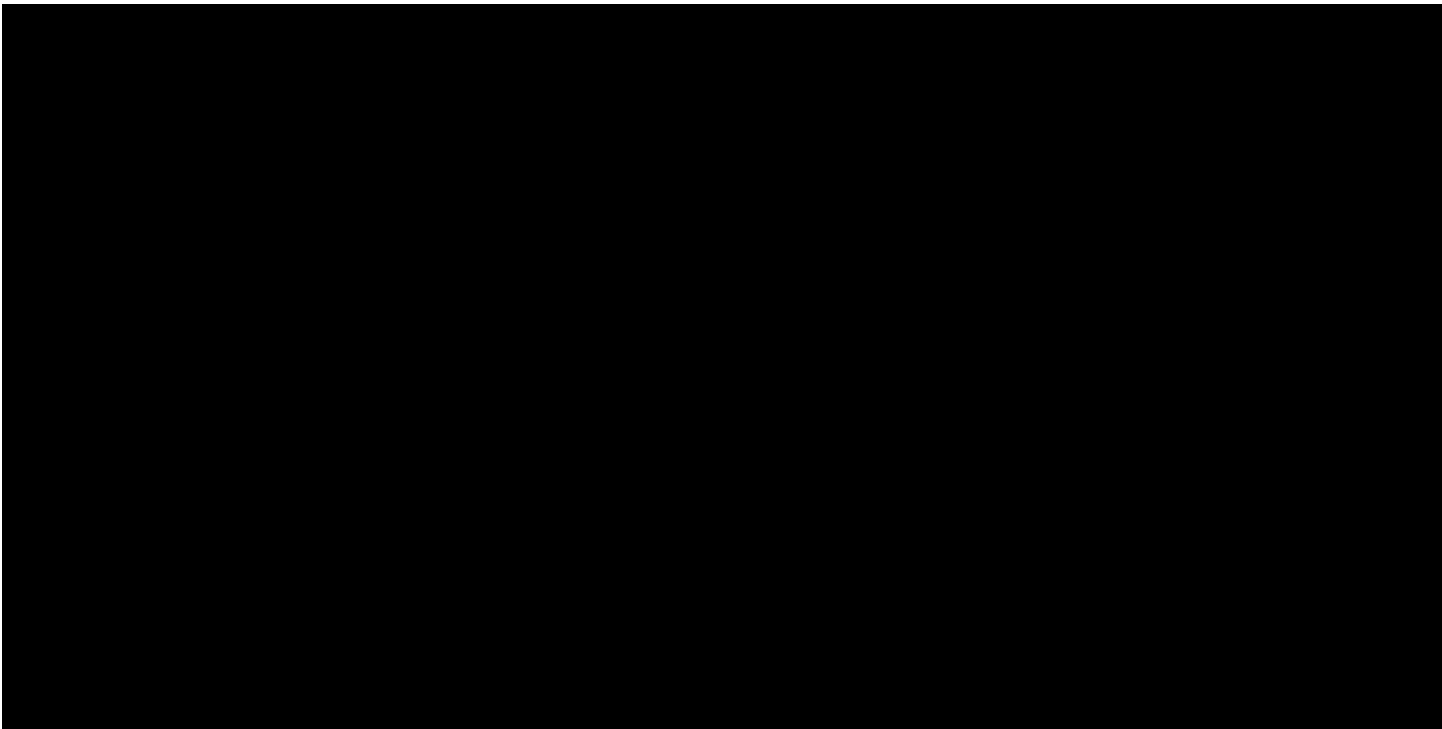
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