

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

U.S. APPLICATION SERIAL NO. 79202279

MARK: HB REAVIS

79202279

CORRESPONDENT ADDRESS:

Law & Trust -
advokátska kancelária, spol. s r.o.
Karadžicova 12
SK-821 08 Bratislava
SLOVAKIA

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http://www.uspto.gov/trademarks/tac/response_form.jsp

APPLICANT: HB REAVIS Slovakia a.s.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1332599

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "1B-1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

INTRODUCTION

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.

SUMMARY OF ISSUES

1. Identification Of Services Overly Broad And Indefinite In Classes 35, 36, And 37 Only – Clarification And Amendment Required
2. Clarification Of Entity Type Required
3. Name Inquiry- Response Required

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).

However, applicant must respond to the following requirements.

IDENTIFICATION OF SERVICES OVERLY BROAD AND INDEFINITE IN CLASSES 35, 36, AND 37 ONLY – CLARIFICATION AND AMENDMENT REQUIRED

Class 35

The wording "*market studies*" in the identification of services is indefinite and overly broad in that it could include goods in other classes such as *printed market studies in the field of real estate* in Class 16 for printed publications. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods or services from that assigned by the International Bureau of the World Intellectual Property Organization (International Bureau) in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, any modification to this wording must identify services in International Class 35, the classification assigned by the International Bureau for these services.

Class 36

The underlined wording in the identification, "*Real estate brokers*," is indefinite and must be clarified because *brokers* identifies a person or people, whereas *brokerage* identifies an actionable service. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: "*real estate brokerage*."

Class 37

The wording, "*Construction*" in the identification of services is indefinite because applicant must clarify the nature of its services are the construction "*of building*" for the goods to be acceptably definite. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording "*construction information*" in the identification of services is indefinite and overly broad in that it could include goods in other classes such as *printed pamphlets featuring construction information* in Class 16 for printed publications. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods or services from that assigned by the International Bureau of the World Intellectual Property Organization (International Bureau) in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, any modification to this wording must identify services in International Class 37, the classification assigned by the International Bureau for these services.

Class 35 –	“Advertising; Commercial business management; Business organization consultancy; Conducting market studies.”
Class 36 –	“Real estate broker age ; Rental of real estate; Real estate management; Real estate agency services.”
Class 37 –	“Construction of buildings ; building construction supervision; Building construction information.”

Applicant's services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different services or add services not found or encompassed by those in the original application or as acceptably narrowed. *See* TMEP §1402.06(a)-(b). The scope of the services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the services will further limit scope, and once services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Applicant must also respond to the following requirement.

Applicant's business name includes the foreign business designation "A.S."; however, applicant set forth "Société anonyme" as the entity type in the application. This business designation is generally considered the equivalent of a "Akcieva Spolocnost" or "Joint Stock Company" in Slovakia. See TMEP app. D, at <https://tmap.uspto.gov/EDMS/TMEP/current/#/result/TMEP-Dd1e1.html?q=sarl&cb=on&n=off&ib=on&fb=off&er=current&yr=and&results=compact&sort=relevance&rst=10&index=4>. Therefore, applicant must clarify the entity type in the application. See TMEP §803.03(j). Applicant may satisfy this requirement by amending the entity type to one of those immediately listed above from Appendix D of the *Trademark Manual of Examining Procedure* (TMEP) for this business designation, as appropriate. See *id.*

If, in response to the above request, applicant provides information indicating that it is not the owner of the mark, registration will be refused because the application was void as filed. *See* 37 C.F.R. § 2.71(d); TMEP §§803.06, 1201.02(b). An application must be filed by the party who owns or is entitled to use the mark as of the application filing date. TMEP §§1201, 1201.02(b).

Applicant must clarify whether the name “HB REAVIS” in the mark identifies a particular living individual. *See* 37 C.F.R. §2.61(b); TMEP §§813, 1206.03. In this case, the application neither specifies whether the name in the mark identifies a particular living individual nor includes a written consent. *See* TMEP §§813.01(a)-(b), 1206.04(a), 1206.05.

Accordingly, if the name in the mark does **not** identify a particular living individual, applicant must submit a statement to that effect (e.g., “The name shown in the mark does not identify a particular living individual.”).

(1) The following **statement**: “The name(s) shown in the mark identifies a living individual(s) whose consent(s) to register is made of record.” If the name is a pseudonym, stage name, or nickname, applicant must provide the following statement:

(2) **A written consent**, personally signed by the named individual(s), as follows:

For an overview of the requirements pertaining to names appearing in marks, and instructions on how to satisfy this requirement online using the Trademark Electronic Application System (TEAS) response form, please go to <http://www.uspto.gov/trademarks/law/consent.jsp>.

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options specified in this Office action for responding to a refusal and should consider those options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see “Responding to Office Actions” on the USPTO’s website.

If applicant does not respond to this Office action within six months of the issue/mailling date, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. See 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§718.01, 718.02. Additionally, the USPTO will not refund the application filing fee, which is a required processing fee. See 37 C.F.R. §§2.6(a)(1)(i)-(iv), 2.209(a); TMEP §405.04.

When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and may be filed online via the Trademark Electronic Application System (TEAS) with a \$100 fee. *See* 37 C.F.R. §§2.6(a)(15)(ii), 2.66(b)(1).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; *see* 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

ASSISTANCE

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. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) 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.

/Tiffany Y. Chiang/
Trademark Examining Attorney
Law Office 113
(571) 272-7681
tiffany.chiang@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_form.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/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.