

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

U.S. APPLICATION SERIAL NO. 79230480

MARK: HUAWEI MATE 10

79230480

CORRESPONDENT ADDRESS:

NTD PATENT & TRADEMARK AGENCY LTD.
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CLICK HERE TO RESPOND TO THIS LETTER:

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

APPLICANT: HUAWEI TECHNOLOGIES CO., LTD.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1397914

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 "IB-1rst 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.

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

SEARCH OF OFFICE'S DATABASE OF MARKS

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).

SUMMARY OF ISSUES:

- Identification of Goods – Indefinite
- Significance of the Mark – Inquiry

IDENTIFICATION OF GOODS – Indefinite

The identification of goods and/or services contains parentheses. Generally, applicants should *not* use parentheses and brackets in identifications in their applications so as to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., "fried tofu pieces (abura-age)." *Id.*

Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

The wording "*stands for tablet computers*" in the identification of goods in International Class 9 is indefinite and must be clarified because applicant must make clear that such stands are adapted for use in connection with tablet computers. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii).

The wording "television apparatus," "routers," "network communication apparatus," "wearable computers with the functions of making calls, monitoring sleeping quality, recording and managing activities," "screens for mobile phones," "wearable network communication apparatus with the functions of making calls, monitoring sleeping quality, recording and managing activities," "covers for telephones" and "electronic monitoring apparatus" in the identification of goods in International Class(es) 9 is indefinite and too broad. This wording must be clarified because applicant must further clarify the nature/type of such apparatus, e.g., "television apparatus for projection purposes, etc.," nature/type of such routers, e.g., "wireless routers, etc.," nature/type of such apparatus, e.g., "computer network adapters, etc.," nature/type of such wearable computers and communication apparatus, e.g., "smartglasses, smartwatches, etc.," nature/type of screens, e.g., "protective display screen covers adapted for use with mobile phones, etc.," nature/type of such covers, e.g., "fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for telephones, etc." and nature/type of such monitoring apparatus, e.g., "wireless controllers to monitor and control the functioning of other electronic devices, etc." See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii).

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods and/or services from that assigned by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, although the goods and/or services may be classified in several international classes, any modification to this wording must identify goods and/or services in International Class(es) 9 only, the class(es) specified in the application for these goods and/or services. See TMEP §1904.02(c), (c)(ii).

Applicant may adopt the following wording in International Class(es) 9, if accurate:

"Smartphones; protective covers for mobile phones; protective cases for mobile phones; electric batteries for mobile phones; tablet computers; protective covers for tablet computers; stands adapted for use in connection with tablet computers; protective cases for tablet computers; headphones; earphones; television apparatus for projection purposes; set-top boxes; portable cabinets for loudspeakers; sound transmitting apparatus; camcorders; digital photo frames; wireless routers; network communication apparatus, namely, computer network adapters; cell phone straps; wearable computers in the nature of smartglasses with the functions of making calls, monitoring sleeping quality, recording and managing activities; protective display screens covers adapted for use with mobile phones; computer keyboards; computer mice (~~computer peripheral~~); wearable network communication apparatus in the nature of smartwatches with the functions of making calls, monitoring sleeping quality, recording and managing activities; modems; covers in the nature of fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for telephones; portable media players; magnetic encoded identification bracelets; pedometers; electric monitoring apparatus in the nature of wireless controllers to monitor and control the functioning of other electronic devices," in International Class 9.

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In a Trademark Act Section 66(a) application, classification of goods and/or services may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods and/or services transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

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Applicant may amend the identification to clarify or limit the goods and/or services, but not to broaden or expand the goods and/or services beyond those in the original application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and/or services may not later be reinserted. See 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 goods and/or 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 goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

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For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable U.S. Acceptable Identification of Goods and Services Manual. See TMEP §1402.04.

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SIGNIFICANCE OF THE MARK – Inquiry

To permit proper examination of the application, applicant must provide the following information:

- (1) Explain whether the wording in the mark "HUAWEI" or the numeral "10" have any meaning or significance in the industry in which the goods and/or services are manufactured/provided, or if such wording is a term of art within applicant's industry.
- (2) Explain whether this wording identifies a geographic place or has any meaning in a foreign language.
- (3) Submit an English translation of all foreign wording in a mark. If the wording does not have meaning in a foreign language, applicant should so specify.

The format for an English translation and transliteration: "The English translation of the word "HUAWEI" in the mark is "___".

The format for when there is no English translation or meaning of the transliteration: "The wording "HUAWEI" has no meaning in a foreign language.

- (4) Respond to the following questions:

- Does the numeral "10" designate a model number, style number, grade designation or other standard designation as used in

connection with the applied-for goods?

See 37 C.F.R. §§2.32(a)(9)-(a)(10), 2.61(b); TMEP §§809-809.03, 814.

Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814.

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RESPONSE GUIDELINES

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.

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>.

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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/mailed 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>.