

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

U.S. APPLICATION SERIAL NO. 79235551

MARK:

79235551

CORRESPONDENT ADDRESS:

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APPLICANT: Gorokhovskaya Tatyana Germanovna

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1410237

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-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.

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).

However, the applicant must address the following.

SUMMARY OF ISSUES:

- Clarification of the Identification of Goods
- Requirement of Mark Description

CLARIFICATION OF THE IDENTIFICATION OF GOODS

Some of the wording in the identification of goods is indefinite and must be clarified to further specify the nature of the goods. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Additionally, the wording "including" in the identification of goods is indefinite and must be deleted and replaced with a definite term, such as "namely," "consisting of," "particularly," or "in particular." See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. This wording is an open-ended term (e.g., "including," "such as") that is not acceptable because it fails to identify specific goods. See TMEP §1402.03(a).

Finally, the identification of goods contains brackets. 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 brackets from the identification and incorporate any parenthetical or bracketed information into the description of the goods.

The applicant may adopt the following identification with suggested edits in **bold** and comments requiring attention in ***bold italics***, if accurate:

Class 003: Abrasives *{specify material composition by common commercial name, e.g., abrasive paste, abrasive cloth}*; air fragrancings preparations; ammonia [volatile alkali] **for household cleaning purposes** ~~{detergent}~~; antistatic preparations for household purposes; ~~aromatics~~ ~~{essential oils}~~ **aromatic essential oils**; bleaching salts; bleaching soda; canned pressurized air for cleaning and dusting purposes; cleaning chalk; cleaning preparations; cloths impregnated with a detergent for cleaning; colour-brightening chemicals for household **laundry** purposes ~~{laundry}~~; creams for leather; waxes for leather; degreasers, other than for use in manufacturing processes; descaling preparations for household purposes; detergents, other than for use in manufacturing operations and ~~for~~ medical purposes, **namely, including** detergents for dishes, **fruit and vegetable wash detergents for fruits, detergents for vegetables**; drying agents for dishwashing machines; dry-cleaning preparations; fabric softeners for laundry use; floor wax; **scouring preparations, namely, floor wax removers** ~~{scouring preparations}~~; furbishing preparations, **namely, polishing preparations**; lacquer-removing preparations; laundry bleaching preparations; laundry blueing; laundry glaze; laundry preparations, **namely, {specify type by common commercial name, e.g., laundry detergent, laundry bleach}**; non-slipping liquids for floors *{specify type, e.g., non-slipping liquid floor polish, non-slipping wax for floors}*; non-slipping wax for floors; oils for cleaning purposes; oil of turpentine for degreasing; paint stripping preparations; polishing creams; polish for furniture and flooring; polishing preparations; polishing stones; polishing wax; **fragrances, namely, aromatic potpourris** ~~{fragrances}~~; ~~preparations for soaking laundry~~ **laundry pre-soak**; preparations for unblocking drain pipes, **namely, {specify type by common commercial name, e.g., drain openers, cleaning preparations for cleansing drains}**; ~~preparations to make the leaves of plants shiny~~ **cleaning and shining preparations for plant leaves**; ~~preservatives for leather~~ ~~{polishes}~~ **leather preserving polishes**; rust removing preparations; sachets for perfuming linen; safrol, **namely, {specify nature by common commercial name, e.g., an essential oil made from sassafras}**; scouring solutions; shining preparations **being polish** ~~{polish}~~; shoemakers' wax; shoe cream; shoe wax; smoothing preparations, **namely, laundry starch** ~~{starching}~~; soap, **namely, {specify type by common commercial name, e.g., laundry soap, bath soap}**; soap for brightening textile; stain removers; starch glaze for laundry purposes; turpentine for degreasing; varnish-removing preparations; volcanic ash for cleaning; wallpaper cleaning preparations; washing soda, for cleaning; windshield cleaning liquids

Scope Advisory

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).

For assistance with identifying 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.

REQUIREMENT OF MARK DESCRIPTION

Applicant has submitted a color drawing and provided a color claim, but has not provided the required description specifying where color appears in the literal and design elements in the mark. See 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §807.07(a)-(a)(ii). Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. See 37 C.F.R. §2.37; TMEP §§808.01, 808.02, 808.03(b). And for marks depicted in color, this description must specify where the color(s) appear(s) on the mark. See 37 C.F.R. §2.52(b)(1); TMEP §807.07(a)(ii).

Generic color names must be used to describe the colors in the mark, e.g., magenta, yellow, turquoise. TMEP §807.07(a)(i)-(ii). If black, white, and/or gray are not being claimed as a color feature of the mark, applicant must exclude them from the color claim and include in the mark description a statement that the colors black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark. See TMEP §807.07(d).

Therefore, applicant must provide a mark description that specifies where all the colors appear in the literal and design elements in the mark. See TMEP §807.07(a)(ii). The following is suggested, if accurate:

The mark consists of the following: a stylized penguin in dark green, with a lighter green beak, a white belly, and a dark green and white eye surrounded by a white circle.

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.

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/ 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>.